Corrections of "Obvious Mistakes" During an Interference[1]

By Charles L. Gholz[2]

I. Introduction

It is, regrettably, not uncommon for claims to "make no damn sense" if read literally. That can result in a holding that such a claim is unpatentable under the 35 USC 112 ¶2. However, as explained in Scripps Research Institute v. Nemerson, 78 USPQ2d 1019 (PTOBPAI 2005) (non-precedential) (opinion by APJ Torczon for a panel that also consisted of APJs Medley and Poteate), it need not.

II. What Happened in Scripps Research Institute v. Nemerson

Nemerson's clams 36-39 referred to "Figure 1." Nemerson's problem was that there was no Figure 1. What those claims should have referred to was "Formula 1". Nemerson argued that the intended meaning of those claims "would have been apparent to one skilled in the art reading…[them] in the context of the specification and other claims."[3] However, it did not move to correct them. That failure plainly ticked the panel off:

> A lax standard for indefiniteness is well suited to validity contests in courts where there is no opportunity to

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[3] 78 USPQ2d at 1033.

amend away even trivial defects in the claims.[4] By contrast, this sort of rejection rarely arises in proceedings within the Office because applicants usually rush to correct the defect as soon as it is pointed out. Nemerson did not do so here. We are thus confronted with the dilemma of holding a claim unpatentable for a seemingly trivial reason or of rewarding a failure to correct a plain, acknowledged mistake. Unlike district courts, the Office is not required to construe a claim to the extent possible so as to preserve its patentability. *In re Morris,* 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997). An applicant's liberty in defining the claimed subject matter is bounded, in part, by the requirement to provide clear notice to the public of what the applicants regard as their invention. One mechanism for enforcing the requirement is rejection under § 112(2).

In an ex parte proceeding, an examiner may enter an amendment to fix obvious mistakes. 37 C.F.R. § 1.121(g). Whether we should exercise analogous discretion in an inter partes proceeding where a movant has clearly identified the problem and the applicant has made no

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[4] See also In re Prater, 415 F. 2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969), for the classic statement of this proposition.

effort--even contingently--to protect its interests is more problematic. In determining whether we should exercise our discretion to permit correction of the mistake in this case, we draw an analogy to the three categories of mistakes that the Federal Circuit identified for corrections under 35 U.S.C. 255: (1) those that are immediately apparent and leave no doubt as to what the mistake is; (2) those where the mistake is not immediately apparent because it makes sense in context; and (3) those where the fact of a mistake is immediately apparent, but it is not clear what the mistake is. *Superior Fireplace Co. v. Majestic Prods.,* 270 F.3d 1358, 1370, 60 USPQ2d 1668, 1677 (Fed. Cir. 2001) (involving a type 3 mistake). The mistake here is a type 2 mistake because a reference to "Figure I" makes sense in the context of the claim. The Federal Circuit has further explained that[,] even in the absence of an attempt to correct, a claim may be construed as if corrected, but only if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims. *Novo Indus., L. P. v. Micro Molds Corp.,* 350 F.3d 1348, 1354, 69 USPQ2d 1128, 1132 (Fed. Cir. 2003) (not permitting

correction). Read in the context of the specification and other claims, the need to correct "Figure" to "Formula" is readily apparent.

Nemerson's failure to move to correct a plain, acknowledged error in this case is inexplicable. Nevertheless, we will exercise our discretion to DEFER decision on claim 36 (and by extension its dependent claims 37-39) to permit Nemerson one last chance to correct the mistake. Nemerson has *30 days from the entry of this decision* to file an amendment changing each instance of "Figure I" in claim 36 to "Formula I", and making no other alteration to any of the claims. Failure to file such an amendment will result in the automatic GRANTING of Scripps' motion with regard to claims 36-39.[5]

III. Comments

(1) According to counsel for Nemerson, "It was our understanding from an earlier decision that the APJ would not allow a further amendment to the claims, so we took the course of 'living with' the error, which we were aware of but under the mistaken

[5] 78 USPQ2d at 1033.

understanding could not be rectified." The moral here is to get a formal, written order from the APJ expressly deferring the issue to post-interference ex parte prosecution.[6]

(2) According to counsel for Nemerson, she did indeed "rush to correct the defect" promptly after receipt of the panel's opinion.

(3) As far as the rest of us are concerned, we shouldn't count on the APJs being willing to "exercise…[their] discretion" in our favor if we are similarly belated in dealing with such a problem. For instance, later in the opinion,[7] the panel discussed a series of dependent claims that were written to depend from the wrong claims and held that "The ambiguity between claims 33 and 34 is precisely the sort of problem that §§ 112(2)/112(4) exist to prevent."[8] This time Their Honors did not cut Nemerson a break, holding that "this is a *Superior Fireplace Co.* type 3 error that is not amenable to simple correction."[9] The moral here is to deal promptly with such problems, either by getting an order deferring the issue to post-interference ex parte prosecution or by moving to correct the mistake in the interference.

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[6] We obtained such an order from APJ Lane in Howell v. Lentz, Int. No. 105,413. See paper No. 26.

[7] 78 USPQ2d at 1034-35.

[8] 78 USPQ2d at 1035.

[9] 78 USPQ2d at 1035.