

IN RE YAMAZAKI, Appeal No. 2012-1086 (Fed. Cir. December 6, 2012). Before Lourie, Reyna and Krieger (D. Col., by designation). Appealed from Board of Patent Appeals and Interferences.

Background:

During prosecution of Yamazaki's patent application, Yamazaki initially filed a terminal disclaimer to overcome an obviousness-type double patenting rejection relying upon an earlier patent. Subsequently, Yamazaki amended each independent claim in a manner believed to also distinguish over the earlier patent claims. Yamazaki thus filed a Petition to withdraw the terminal disclaimer while the application was still pending. However, the Patent Office never acted on the Petition, and subsequently a Notice of Allowance was issued, the Issue Fee was paid, and the patent issued 22 months after the Petition had been filed. The patent was thus set to expire in 2003 instead of 2018.

The Patent Office finally dismissed the Petition, indicating that a terminal disclaimer cannot be withdrawn after the subject patent is issued. Yamazaki then filed a Reissue Application in 2002, attempting to rescind the terminal disclaimer. The Patent Office rejected the Reissue Application for failing to recite an error upon which a reissue application could proceed. Yamazaki appealed to the Board of Patent Appeals and Interferences, which held that the patent could not be reissued to remove the terminal disclaimer because 35 U.S.C. §251 prohibits reissuing a patent for more than its original term, which could occur if the terminal disclaimer were to be withdrawn by reissue.

Issue/Holding:

Did the Board err in holding that 35 U.S.C. §251 precludes a reissue to withdraw a terminal disclaimer that would result in a longer term for the original patent? No, affirmed.

Discussion:

Yamazaki argued that a terminal disclaimer does not alter the statutorily defined term (in this case, 17 years from issuance), but only adjusts a patent's expiration date. Thus, they argued that the disclaimed portion of the base "term" is still available to recover under reissue without violating 35 U.S.C. §251.

The Federal Circuit disagreed. The Federal Circuit interpreted 35 U.S.C. §253 (relating to terminal disclaimers) as requiring that the terminal disclaimer be treated as a part of the original patent. Thus, they determined that a terminal disclaimer defines the term of the patent as issued. The Federal Circuit agreed with the Patent Office that 35 U.S.C. §251 precludes the Patent Office from extending the term of a reissued patent beyond the term of the original patent as set by the terminal disclaimer.

The Federal Circuit thus concluded that the Patent Office lacked the authority to rescind the terminal disclaimer through reissue.