

IN RE DINSMORE, Appeal No. 2013-1637 (Fed. Cir. June 10, 2014). Before Taranto, Bryson and Hughes. Appealed from the Patent Trial and Appeal Board.

Background:

Dinsmore sought reissue of U.S. Patent No. 7,236,568 ("the '568 patent") to remove or modify a terminal disclaimer previously submitted to overcome an obviousness-type double patenting rejection. As required by rule, the terminal disclaimer included a clause that declared the '568 patent "shall be enforceable only and during such period" as it is commonly owned with U.S. Patent No. 6,658,086 ("the '086 patent"). Because the two patents were never commonly owned, Dinsmore sought to modify the recorded terminal disclaimer to delete the common-ownership provision, and to modify the claims that gave rise to the terminal disclaimer. The examiner rejected the reissue application on the basis that this error is not the type of error that is correctable by reissue under 35 U.S.C. §251 and the PTAB affirmed.

Issue/Holding:

Did the PTAB error in finding that Dinsmore had not met the "error" requirement of §251? No, affirmed.

Discussion:

On appeal, Dinsmore argued that because the '568 patent and the '086 patent were never commonly owned, the recorded terminal disclaimer was ineffective and invalid. The Federal Circuit found that the provision in the terminal disclaimer to be "enforceable only for and during such period that it and the prior patent are commonly owned" can readily be given effect. Thus, the Federal Circuit held that the terminal disclaimer was not inoperative.

In analyzing inoperability, the Federal Circuit considered whether the terminal disclaimer could be inoperative because the '568 patent was unenforceable without common ownership due to the disclaimer and that Dinsmore erred in producing that result. The Federal Circuit noted that, even if the alleged error resulted in the '568 patent being inoperative within the meaning of §251, it was not an error that met the requirements under §251, because Dinsmore identified no cognizable false or deficient understanding of fact or law underlying the choice to file the terminal disclaimer. The Federal Circuit opined that not every choice that produces inoperability or invalidity qualifies under §251. According to the Federal Circuit, only choices based on error meet the requirements of §251. Interestingly, Dinsmore never asserted that he believed common ownership existed when he filed the terminal disclaimer, as this may have been a sufficient basis for obtaining reissuance according to the Federal Circuit.

The Federal Circuit also found that there was nothing in the terminal disclaimer that was missing what was required or anything included that was forbidden. Thus, the Federal Circuit held that the terminal disclaimer was also valid. Therefore, the Federal Circuit held that Dinsmore had not met the error requirement of §251.