

HONEYWELL INTERNATIONAL INC. v. ARKEMA INC., Appeal No. 2018-1151, 2018-1153 (Fed. Cir. October 1, 2019). Before Newman, Reyna and Hughes. Appealed from Patent Trial and Appeal Board.

Background:

Honeywell owns a patent related to compounds in refrigeration systems. The patent was intended to claim priority, via an extended chain of priority applications, to 2002, and thus intended to be subject to pre-AIA law. Due to an error in the priority chain, Arkema argued that the patent was only to be afforded priority to 2014, and thus, post-AIA law would apply. Arkema thus requested a post-grant review (PGR) proceeding, asserting lack of written description and obviousness of claims of the patent.

The Patent Trial and Appeals Board (PTAB) instituted the PGR proceedings. Upon Honeywell realizing, allegedly when preparing its Patent Owner Response, that the lack of written description was due to a mistake in the priority chain on the patent, it requested authorization to file a motion for leave to request a Certificate of Correction to amend the priority chain. The PTAB rejected the request, determining that there was not adequate basis for a Certificate of Correction.

Issue/Holding:

Did the PTAB abuse its discretion in rejecting Honeywell's request for leave to request a Certificate of Correction to amend an allegedly incorrect priority chain? Yes, vacated and remanded.

Discussion:

Under 35 U.S.C. §255, a patentee may correct in an issued patent "a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office." When a patentee attempts to correct a patent subject to a post-issuance review proceeding using §255, the patentee must first request authorization from the PTAB to file a motion for leave. Then, if authorization is granted, the patentee must file the motion for leave, asking the Board to cede its exclusive jurisdiction so that a Certificate of Correction can be sought. Then, if granted, the patentee can petition the Director for the Certificate of Correction. After those steps are completed, the director will evaluate the merits of the patentee's petition, including whether the mistake is of minor character and occurred in good faith.

The Federal Circuit held that the PTAB abused its discretion in rejecting the request for authorization. The Federal Circuit indicated that the PTAB only should have determined if Honeywell had demonstrated a sufficient basis that the mistake may be correctable, but instead effectively required that the requirements of §255 be met before even authorizing Honeywell to file the motion for leave. The Federal Circuit commented that in other cases, the Patent Office has allowed patentees to correct priority claims by Certificates of Correction, and thus, the mistake may be correctable.

The Federal Circuit remanded the case to the PTAB indicating that the PTAB should authorize Honeywell to file the motion seeking leave to petition for a Certificate of Correction, and then review the motion for leave and evaluate whether there is any prejudice to Arkema that requires accommodation.