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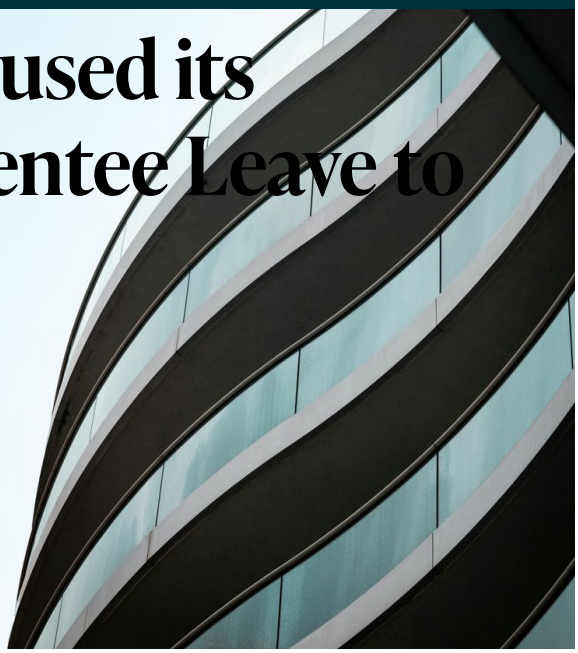
Axinn IP Update: PTAB Abused its Discretion in Denying Patentee Leave to Correct Chain of Priority



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Axinn Update

On October 1, 2019, the Federal Circuit vacated and remanded the PTAB's decision denying a patentee's motion for leave to petition the PTO Director for a Certificate of Correction to fix a mistake in the chain of priority of a patent facing two post-grant reviews ("PGRs").[1]

The error arose during prosecution when Honeywell amended its application to cancel all of the listed claims of then pending U.S. Patent No. 9,157,017 (the "'017 patent") and replaced them with 20 new claims claiming priority to 2002.[2] The cancelled claims were directed to fluoroalkene compounds used in refrigeration systems, and the new claims were directed to automobile air conditioning systems.[3] Honeywell could have amended its list of priority applications to identify corresponding applications providing support for the automobile air conditioning systems but neglected to do so.[4]

Two petitioners filed PGRs arguing that the priority applications did not provide written description support for the claims and that the patent was only entitled to a 2014 priority date.[5] The 2014 priority date allowed petitioners to assert that (1) the '017 patent was eligible for PGR proceedings because the claims had an effective filing date on or after March 16, 2013, and (2) use prior art from the period between 2002 and 2014.[6]

Under Section 255, a patentee may petition the Director to issue a Certificate of Correction for an issued patent to correct "a mistake of clerical or typographical nature, or of minor character, which was not the fault of the [PTO]."[7] Furthermore, the patentee must show that the mistake "occurred in good faith" and that "the correction does not involve such changes in the patent as would constitute new matter or would require re-examination."[8]

To correct a patent during a PGR, a patentee must seek authorization to file a motion asking the Board to cede jurisdiction so that the patentee can petition the Director for a Certificate of Correction. The Board's gatekeeping role is merely to "determine whether there is *sufficient basis* supporting the patentee's position that the mistake *may* be correctable."

Honeywell only realized the mistake when preparing its Patent Owner Response and sought permission from the Board to file a motion for leave to request a Certificate of Correction.[9] Honeywell proposed a correction that would have added additional patent applications to the list of priority applications, thus making the '017 ineligible for PGRs and entitled to an earlier priority date.[10]

The Federal Circuit held the Board exceeded its authority by requiring Honeywell to meet Section 255's requirements on the merits and usurping the Director's role to decide a petition for Certificate of Correction on the merits.[11] The Board's role was limited to deciding whether Honeywell had a "sufficient basis" to seek review of a correctable mistake.[12]

Honeywell Int'l Inc v. Arkema Inc. should serve as a reminder to patentees and petitioners alike: Every detail is important.

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[1] *Honeywell Int'l Inc. v. Arkema Inc.*, No. 2018-1151 (Fed. Cir. Oct. 1, 2019).
[2] *Id.* at 2.
[3] *Id.*
[4] *Id.*
[5] *Id.* at 3.
[6] *Id.*
[7] 35 U.S.C. § 255.
[8] *Id.*
[9] *Honeywell Int'l Inc., v. Arkema Inc.*, slip op. at 6-7.
[10] *Id.* at 3-4.
[11] *Id.* at 6.
[12] *Id.* at 8.

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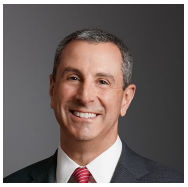

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