



UNIVERSITY OF
MARYLAND
SCHOOL OF LAW

**PATENT LAW
UPDATE**

***Superior
Fireplace Co.
v.
Majestic Prods.
Co.***

Nos. 00-1233,
-1281,-1282
Federal Circuit
Nov. 1, 2001

"[A] mistake in a claim the correction of which broadens the scope of coverage of that claim and is not clearly evident from the specification, drawings, and prosecution history is not a 'mistake of a clerical or typographical nature' subject to correction under 35 U.S.C. § 255."

On November 1, 2001, the Federal Circuit affirmed the district court's summary judgment that Superior's certificate of correction under 35 U.S.C. § 255 for U.S. Patent No. 5,678,534 is invalid and that Majestic did not infringe the uncorrected patent, which related to gas fireplace technology. Superior had sought to change the claim term from "rear walls" to "rear wall." The Federal Circuit noted:

Challenges to the validity of claims, whether regularly issued, issued after a reexamination pursuant to 35 U.S.C. §§ 301-307, or issued after a reissue pursuant to 35 U.S.C. §§ 251-252, must meet the clear and convincing standard of persuasion. [T]he present challenge is a challenge to the validity of the certificate of correction. But since the effect of that challenge in the present case is to challenge the validity of a claim, the clear and convincing standard applicable under our precedent to other validity challenges should also apply to the present challenge to the validity of the certificate of correction. . . .

The parties . . . dispute whether a § 255 clerical or typographical mistake, the correction of which would broaden a claim, must be evident from the public record. This question arises from the observation that not all clerical or typographical mistakes are immediately apparent, and even where the mistake is apparent, it may not be clear how the mistake should be corrected. This leads to a classification of these typographical mistakes into three categories. Some mistakes are immediately apparent and leave no doubt as to what the mistake is. Examples of such errors include misspellings that leave no doubt as to the word which was intended; "frane" instead of "frame," for example. In contrast, a second category includes those typographical mistakes not apparent to the reader at all; for example, a mistake resulting in another word that is spelled correctly and that reads logically in the context of the sentence. A third category of mistakes includes those where it is apparent that a mistake has been made, but it is unclear what the mistake is. [W]e interpret § 255 to require that a broadening correction of a clerical or typographical error be allowed only where it is clearly evident from the specification, drawings, and prosecution history how the error should appropriately be corrected.

[In this case], the claim limitation in question is itself syntactically correct and on its face raises no question of a mistake. The rest of the claim, the other claims and the written description and drawings do not make it clearly evident that the "rear walls" limitation is a mistake and should have been "rear wall." Furthermore, the prosecution history provides compelling evidence that "rear walls" was the correct phrase. Thus, the requested correction of the alleged mistake was not apparent from the specification, drawings, and prosecution history. The alleged mistake is, therefore, not a clerical or typographical mistake correctable under § 255. Were we to apply the APA's standard of review, we would agree with the district court that the PTO's decision that the change to "rear walls" was of a clerical or typographical nature correctable under § 255 was an abuse of discretion.