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# TECHNOLOGY LAW UPDATE

A report of the latest Federal Circuit updates brought to you by Preston Gates.

## Novo Indus., L.P. v. Micro Molds Corp.

Nos. 03-1230, -1249 (Fed. Cir. Dec. 5, 2003).

***“A district court can correct a patent only if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims.”***

On December 5, 2003, the Federal Circuit, *inter alia*, reversed the district court’s judgment entering the jury verdict that Micro Molds infringed U.S. Patent No. 5,056,578, which related to a carrier assembly that holds one of a plurality of vertical slats (or blinds) that cover the interior of a window. The Federal Circuit stated:

This case presents the question whether a district court can act to correct an error in a patent by interpretation of the patent where no certificate of correction has been issued. We hold that a district court can do so only if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims. . . .

[In 1926, in *I.T.S. Rubber Co. v. Essex Rubber Co.*] the Supreme Court held that, in a patent infringement suit, the courts could properly interpret a patent to correct an obvious error. . . . The Patent Act of 1952 added section 255 to Title 35 and revised section 254. Nothing in the enactment of either section 255 or 254 suggests that Congress intended to overrule *Essex* or to deny limited correction authority to the district courts. . . . Indeed, sections 255 and 254 themselves suggest that they were not intended to address the authority of the district courts to correct patents by construction where no certificate of correction has been issued by the PTO. Those sections deal only with the authority of the PTO to make prospectively effective corrections, and the PTO was given no authority to correct the claims retroactively. [U]nder sections 254 and 255, a “certificate of correction is only effective for causes of action arising after it was issued.” For causes of action that arise before the correction becomes effective, the patent must be considered without the benefit of the certificate of correction. Thus, if we were to hold that the district court was powerless to correct any and all errors when construing the patent, every patent containing an error that makes a claim indefinite would be invalid until and unless corrected by the PTO. At the same time, the PTO properly refuses to correct truly minor errors in the section 255 process.

[But] we do not think that Congress intended that the district courts have the authority to correct any and all errors that the PTO would be authorized to correct under sections 254 and 255. First, there is the fact that sections 254 and 255 . . . do not give the district courts the same authority as the PTO. “Section 255 [like section 254] does not provide for action by a district court. Rather, the statute permits only the Director to issue a certificate of correction for a clerical error.” Second, the authority of the PTO to make corrections under section 255, while limited to review of the intrinsic record is not limited to obvious errors. Rather, it extends even to broadening corrections, so long as “it is clearly evident from the specification, drawings, and prosecution history how the error should appropriately be corrected.” Third, where the error is not evident from the face of the patent itself, as it was in *Essex*, it is important that the PTO bring its expertise to bear and consider whether such a correction is appropriate. Finally, to allow the district court to correct such errors would effectively write the nonretroactivity provisions out of sections 254 and 255. The district court always would apply its own corrections retroactively in the action before it, unlike certificates of correction issued by the PTO, which apply only in actions brought after the certificate of correction is issued.