

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMONWEALTH SCIENTIFIC AND INDUSTRIAL RESEARCH
ORGANISATION,

Petitioner,

v.

BASF PLANT SCIENCE GMBH,
Patent Owner.

PGR2020-00033
Patent 10,301,638 B2

Before ULRIKE W. JENKS, JO-ANNE M. KOKOSKI, and JEFFREY W.
ABRAHAM, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

ORDER

Granting Patent Owner's Motion for Leave to
Seek a Certificate of Correction
37 C.F.R. §§ 1.323, 42.20

Pursuant to our authorization (Paper 15), BASF Plant Science GmbH (“Patent Owner” or “BASF”) filed a Motion for Leave to request a certificate of correction for the challenged patent, U.S. Patent No. 10,301,638 B2 (“the ’638 patent,” Ex. 1001). Paper 19 (“Motion” or “Mot.”). Commonwealth Scientific and Industrial Research Organisation (“Petitioner”) filed an Opposition. Paper 21 (“Opp.”). For the reasons that follow, Patent Owner’s Motion is granted.

Background

The ’638 patent claims priority to a German application filed on February 21, 2006 (“the German priority application”). Ex. 1007, codes (30), (63). Specifically, the ’638 patent states:

This application is a continuation of patent application Ser. No. 12/280,090, filed Aug. 20, 2008, which is a national stage application (under 35 U.S.C. § 371) of PCT/EP2007/051675, filed Feb. 21, 2007, which claims benefit of German application 10 2006 008 030.3, filed Feb. 21, 2006, and European application 06120309.7, filed Sep. 7, 2006.

Ex. 1001, 1:7–12; *see id.* at codes (30), (63). Patent Owner moves for leave to request from the Director a certificate correcting the ’638 patent to reference a written joint research agreement (“JRA”) with Bioriginal Food & Science Corporation (“Bioriginal”) that Patent Owner asserts was effective by the February 21, 2006 filing date of the German priority application.

Mot. 1. According to Patent Owner, one or more of the Canadian inventors listed on the ’638 patent was affiliated with Bioriginal before the German priority application’s filing date, when the JRA between BASF and Bioriginal was already in effect. Mot. 1–2 (citing Ex. 2041, 2, 7). Patent Owner asserts that “in the spring of 2007, *all* of the inventors assigned their rights in the disclosed subject matter to BASF, as evidenced by an

assignment recorded in the PTO's assignment database at Reel/Frame No. 039636/0233." *Id.* at 2.

Patent Owner asserts that BASF filed an international (PCT) application claiming priority to the German priority application that timely entered the U.S. national phase, and then subsequently filed a continuation that issued as the '638 patent. Mot. 2. Patent Owner asserts, however, that "the specification text of these U.S. patent applications was never amended to reference the written joint research agreement, a reference peculiar to U.S. patent practice." *Id.* (citing 37 C.F.R. §§ 1.71(g)(1), 1.9(e)). Patent Owner argues that the failure to identify the parties to the JRA is a correctable mistake. *Id.* at 5 (quoting 37 C.F.R. § 1.71(g)(3)).

The correction sought could bear on whether art cited in the Petition (Ex. 1006, the '093 publication) is prior art to the '638 patent. Pet. 36; Mot. 3–4; Opp. 2–4.

Discussion

In order to file a request for a certificate of correction, Patent Owner must:

- (1) seek authorization from the Board to file a motion, 37 C.F.R. § 42.20(b);
- (2) if authorization is granted, file a motion with the Board, asking the Board to cede its exclusive jurisdiction so that the patentee can seek a Certificate of Correction from the Director, 37 C.F.R. § 1.323; MPEP § 1485;
- and (3) if the motion is granted, petition the Director for a Certificate of Correction under 35 U.S.C. § 255.

Honeywell Int'l Inc. v. Arkema Inc., 939 F.3d 1345, 1349 (Fed. Cir. 2019).

As to the first step in *Honeywell*, we granted authorization to file the instant motion in an Order dated December 4, 2020 (Paper 15), and Patent Owner filed this Motion as required by the second step.

According to the Federal Circuit, “the Director—not the Board—will evaluate the merits of the patentee’s petition, including whether the mistake is of ‘minor character’ or ‘occurred in good faith.’” *Honeywell*, 939 F.3d at 1349 (citing 35 U.S.C. § 255). The statute gives this authority to the Director, and the Director has not delegated this authority to the Board. *Id.* The Board’s role is simply “to determine whether there is sufficient basis supporting Patent Owner’s position that the mistake may be correctable.” *Id.* (internal quotation marks and citation omitted).

Rule 1.71 provides that “[t]he specification may disclose or be amended to disclose the names of the parties to a joint research agreement as defined in § 1.9(e).” 37 C.F.R. § 1.71(g)(1). It goes on to state:

If an amendment under paragraph (g)(1) of this section is filed after the date the issue fee is paid, the patent as issued may not necessarily include the names of the parties to the joint research agreement. If the patent as issued does not include the names of the parties to the joint research agreement, the patent must be corrected to include the names of the parties to the joint research agreement by a certificate of correction under 35 U.S.C. 255 and § 1.323 for the amendment to be effective.

Id. § 1.71(g)(3). Rule 1.9(e) defines “joint research agreement” to mean “a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental developmental, or research work in the field of the claimed invention.” *Id.* § 1.9(e). Patent Owner submits a copy of its JRA with Bioriginal (Ex. 2041), and identifies the text it proposes to insert at the beginning of the ’638 patent specification (Mot. 4).

Petitioner opposes Patent Owner’s Motion. Specifically, Petitioner argues that Patent Owner’s “failure to amend the specification to describe the JRA during prosecution is not a mistake of clerical or typographical

nature, nor is it a mistake of minor character.” Opp. 5. Our role, however, is not to decide whether Patent Owner’s request for a certificate of correction is meritorious; instead, we are tasked with simply assessing whether there is a sufficient basis to support Patent Owner’s position. If so, it is up to the Director to decide whether to exercise the authority under § 255 and issue a certificate of correction.

We have reviewed the arguments in the Motion and conclude that “there is a sufficient basis supporting Patent Owner’s position that the mistake may be correctable.” *Honeywell*, 939 F.3d at 1349. Petitioner’s arguments in the Opposition are either unpersuasive or go to the merits of Patent Owner’s requested correction, which we do not have the authority to decide. *Id.* Accordingly, we cede exclusive jurisdiction over the ’638 patent and grant Patent Owner permission to file a petition to the Director.

Petitioner makes two requests in the event the Motion is granted. Opp. 1. First, Petitioner requests that we instruct Patent Owner to include Petitioner’s Opposition with its petition to the Director. *Id.* In our view, Petitioner’s Opposition may be useful to the Director in determining whether it is appropriate to issue a certificate of correction. Therefore, we order Patent Owner to include a copy of Petitioner’s Opposition with the petition submitted to the Director. Second, Petitioner “requests that the Board not alter the existing schedule of deadlines” in the Scheduling Order if the Motion is granted. *Id.* at 7. Patent Owner’s Motion does not include a request to change the existing schedule, and we confirm that the schedule is unaffected by the pendency of Patent Owner’s petition to the Director.

Order

In consideration of the foregoing, it is hereby

ORDERED that Patent Owner’s Motion is *granted*;

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