



Patent Owner Granted Leave in IPR to Seek Correction of Claims Held Indefinite in Parallel District Court Litigation

Jan 29, 2021

Reading Time : **2 min**

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The petitioner in this case sought IPR of some, but not all, claims of the patent under review. After considering the patent owner's preliminary response, the board instituted trial. Soon after institution, the patent owner filed its motion seeking leave to petition the Director for a certificate of correction related to certain claims not under review in the IPR. According to the patent owner, those claims included a mistake correctable under § 255. The petitioner filed an opposition and the patent owner subsequently filed a reply.

In analyzing the patent owner's motion, the board explained that the Federal Circuit in *Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349–50 (Fed. Cir. 2019) describes the three steps a patent owner must take when seeking a certificate of correction of a patent undergoing an IPR—namely: (1) seek authorization from the board to file a motion for leave; (2) if the board grants authorization, the patent owner must ask the board to cede its exclusive jurisdiction so that the patent owner can request a certificate of correction from the Director; and (3) if the board cedes its jurisdiction, the patent owner can then petition the Director for a certificate of correction.

In resolving the patent owner's motion, the board explained that it did not have the authority to decide whether the patent owner met the requirements of § 255. Instead, according to the board, it could determine only whether the patent owner had provided enough basis to support its position that the mistake may be correctable by the Patent Office.

The board explained that § 255 states that the director may correct “a mistake of a clerical or typographical nature, or of minor character,” which “appears in a patent and a showing has

been made that such mistake occurred in good faith.” The patent owner contended that the claims for which it sought correction contained such a mistake because they contained words such as “absorption bands,” which made no sense in the context of the patent, instead of the correct terminology, “diffraction peaks.” Although the patent owner acknowledged that the claims for which it sought correction were held indefinite—by a district court in a related litigation—they were correctable through a certificate of correction. The patent owner argued that Federal Circuit precedent made clear that the Patent Office has broader authority than a district court to correct errors in a patent. In granting the motion for leave, the board ordered the patent owner to submit, along with its request for a certificate of correction to the Patent Office, the full briefing before the board as well as the board’s decision.

Practice Tip: Patent owners facing a district court holding of indefiniteness should recognize that, under certain circumstances, they may seek a certificate of correction from the Patent Office, even if the patent is under review before the board. Critically, a patent owner facing such a situation must follow the proper procedural channels before the board to maximize its chances of success.

Mylan Pharms. Inc. et al. v. Merch Sharp & Dohme Corp., IPR2020-00040, Paper 76 (PTAB Dec. 23, 2020)

Categories

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Inter Partes Review

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