IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PETITION FOR RULEMAKING UNDER 5 U.S.C. § 553(e) AND 35 U.S.C. § 2(b)(2) TO CORRECT THE TEXT PLACED ON ISSUED PATENT COVER BINDERS TO REMOVE WRONG INFORMATION ABOUT RIGHTS GRANTED UNDER A PATENT

Director of the United States Patent and Trademark Office
P.O. Box 1450
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This is a Petition to require the United States Patent and Trademark Office (the "USPTO"), through rulemaking, to correct the text printed on the cover binder on issued patents. The current text is incorrect. It describes the rights granted by an issued patent in a manner that seems accurate under the text of the United States Constitution, but does not comport with Supreme Court law.[1]

STATEMENT OF FACTS AND INTRODUCTION

Petitioners include inventors, assignees, patent practitioners, and inventor clubs. Petitioners and their membership rely on a strong and predictable patent system. Petitioners are listed in the signature block. Petitioners and their membership have done and continue to do business before the USPTO. Petitioners and their membership have an interest in preventing misunderstandings about the rights granted under an issued patent. In this case, the (correctible) misunderstandings originate on the patent document itself.

[1] This Petition seeks interpretive rulemaking, and therefore does not ask the USPTO to do anything that would require notice and comment. *See Animal Legal Def. Fund v. Quigg*, 932 F.2d 920, 922 (Fed. Cir. 1991).

REQUEST FOR RULEMAKING

The USPTO has authority to decide this Petition under at least 5 U.S.C. § 553(e) of the Administrative Procedure Act ("APA"), which provides that "[e]ach agency shall give an interested person the right to petition for the issuance, amendment, or repeal of a rule."

Petitioner seeks "issuance . . . of a rule" to correct certain inaccuracies in the patent grant on the cover of the binder of issued patents, which currently reads:

> The Director of the United States Patent and Trademark Office
>
> Has received an application for a patent for a new and useful invention. The title and description of the invention are enclosed. The requirements of law have been complied with, and it has been determined that a patent on the invention shall be granted under the law.
>
> Therefore, this
>
> United States Patent
>
> Grants to the person(s) having title to this patent the ***right to exclude*** others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America, and if the invention is a process, of the ***right to exclude*** others from using, offering for sale, or selling throughout the United States of America, or importing into the United States of America, products made by that process, for the term set forth in 35 U.S.C. 154(a)(2) or (c)(1), subject to the payment of maintenance fees as provided by 35 U.S.C. 41(b). See Maintenance Fee Notice on the inside of the cover.

(emphasis added.) The patent covers currently (and wrongly) convey the impression to inventors that there is a "right to exclude" under a United States patent. Inventors who receive patents risk making business, investment and research decisions based on inaccurate information. Petitioners request that the text be amended to comport with Supreme Court law and accurately describe the rights conveyed by the grant. This is so that inventors and their successors do not risk making

injurious and incorrect business, investment and research decisions. This is also so that Petitioners no longer are burdened with economic injury arising from a current need to educate colleagues and clients of the true rights under a patent, and to avoid their placement in the untenable position to have to teach others that the patent document itself describes its own rights incorrectly. The cost to the agency to correct the text is expected to be negligible or zero.

The current cover incorrectly informs the reader that the title owner of a patent has a "right" to exclude. That is unfortunately not so. Inventors have not had a "right" to exclude since the Supreme Court's decision in *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006). True, the Constitution requires Congress to pass laws securing to inventors the "exclusive right" to their discoveries. U.S. Const. Art. I. Sec. 8, Cl. 8. Even so, the Supreme Court clarified that the patent laws, as enacted by Congress under the Intellectual Property clause, supply solely a mere trigger for a trial court to exercise discretion concerning exclusivity. *eBay*, 547 U.S. at 391-92. That is, even after jury or judge findings of infringement and no invalidity, and even after all infringer appellate remedies have been exhausted, inventors and their successors in title remain uncertain as to whether they will get to enjoy exclusivity. Instead, trial courts consider a "four-factor test" before granting injunctive relief. *Id.* at 391. Those factors are whether a plaintiff has demonstrated "(1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction." *Id*.

Black's Law Dictionary defines a "right" as follows:

> **right**, n. (bef. 12c) 1. That which is proper under law, morality, or ethics <know **right** from wrong>. 2. **Something that is due** to a person by just claim, legal guarantee, or moral principle <the **right** of liberty>. 3. A power, privilege, or immunity secured to a person by law <the **right** to dispose of one's estate>. 4.

> A legally enforceable claim that another will do or will not do a given act; a recognized and protected interest the violation of which is a wrong <a breach of duty that infringes one's **right**>. 5. (often pl.) The interest, claim, or ownership that one has in tangible or intangible property <a debtor's rights in collateral> <publishing rights>.

Black's Law Dictionary 1436 (9th ed. 2009). "Excluding" under a patent is not a "right" in any of the operative senses of the word. For example, under *eBay*, excluding an infringer is not "something that is due" to a patentee. Nor is excluding an infringer a "power . . . secured . . . by law." Rather, a trial court may apply wide-ranging discretion to deny this power. Only by grace, not by right, will a patentee who prevails in court receive a judgment excluding an infringer.[2]

The words of the patent grant are not aspirational, nor visionary, nor a historical statement. Instead they must accurately and legally convey to the patentee the actual rights under Supreme Court law. As the executive branch agency, the USPTO is responsible for issuing patents in accordance with the statutes and Supreme Court law. Petitioners request rulemaking by the USPTO to apply appropriate and necessary revisions to the cover text of issued patents so that it comports with Supreme Court law. Petitioners stand ready to work with the USPTO to come up with an adequate and minimal text revision that will achieve the purpose of this Petition.

CONCLUSION

Petitioners request the USPTO adopt a rule correcting the cover text of issued patents to comport with Supreme Court law and accurately describe the rights conveyed by the grant. This will prevent injury to inventors (and their successors in title) who would otherwise be led to

[2] Statutory law suggests that the content of a patent must include a "grant" of a right to exclude. 35 U.S.C. § 154(a)(1). Statutory language does not, however, mandate any particular text that must go onto a cover, and thus would not affect this Petition. Also, *eBay* has interpreted a patentee's exclusionary power to depend on a trial court's discretion, thus interpreting what the "grant" mentioned in Section 154(a)(1) actually means, and how it should be explained to lay persons.

believe that a "right" to exclude exists under an issued United States patent.

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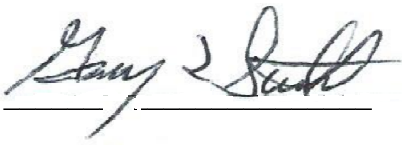

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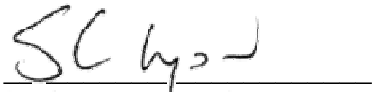

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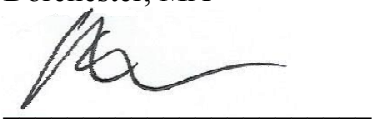

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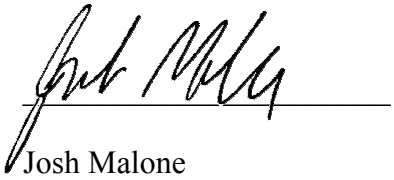

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