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Cover Page Footnote

The author thanks Inge Osman and Jonathan Strang for guidance and mentorship specifically while drafting this Article and generally in his career.

CERTIFICATES OF CORRECTION AND AIA TRIALS

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*Intellectual Property Litigation Associate, Latham & Watkins LLP. The opinions expressed are those of the author and do not necessarily reflect the views of his employer, its clients, or any of his or its respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice. The author thanks Inge Osman and Jonathan Strang for guidance and mentorship specifically while drafting this Article and generally in his career. Any errors or omissions are the author's alone.

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CERTIFICATES OF CORRECTION AND AIA TRIALS

I. INTRODUCTION

Certificates of correction, which fix mistakes in patents, are commonplace, but judicial decisions addressing their effect are not so common. Most cases applying the statutes that enable the United States Patent and Trademark Office (USPTO) to issue certificates of correction arose in the federal district courts. There is little academic discussion on these statutes.¹

But with the advent of post-grant proceedings under the America Invents Act (AIA trials), the Patent Trial and Appeal Board (PTAB) has had to grapple with the scope of these statutes. Drawing on caselaw from the Supreme Court, the Federal Circuit, and the PTAB, this Article interprets these statutes to explore how they apply to AIA trials. In particular, this Article explains that these statutes, through the key phrase “trial of actions for causes thereafter arising,” apply in AIA trials to give effect to certificates issued before the filing of a petition.

II. OVERVIEW OF THE STATUTORY SCHEMES

A. Methods of Correcting Patents

Before Congress codified formal correction methods,² there were informal methods to correct patents. Since at least an 1832 Supreme Court decision,³ officials in the Executive Branch could reissue patents, i.e., accept surrender of the patent and reissue it with corrections.⁴ Shortly thereafter, this practice became the first statutory

1. The most thorough academic examination of the certificate of correction statutes appears in Chelsea A. Priest, *Certificates of Correction Corrected: Their History and Retroactive Application*, 67 STAN. L. REV. 961 (2015).

2. 35 U.S.C. §§ 251–27 (2018) (Chapter 25: Amendment and Correction of Patents).

3. *Grant v. Raymond*, 31 U.S. (6 Pet.) 218 (1832), *superseded by statute on other grounds as stated in United States v. Arthrex*, 141 S. Ct. 1970, 1976–77 (2021).

4. *Id.* at 242–43.

method of correction.⁵ Several amendments ultimately produced the current reissue statutes, 35 U.S.C. §§ 251 and 252.⁶

Congress's next correction statute authorized the USPTO to issue certificates of correction to fix the USPTO's mistakes in patents.⁷ Then the 1952 Act overhauled the patent laws, including adding an equivalent provision for the USPTO to fix an applicant's mistakes.⁸ Under the current certificate of correction statutes that are the subject of this Article—35 U.S.C. §§ 254 and 255—the USPTO may correct mistakes that it makes⁹ and that an applicant makes.¹⁰

Sections 254 and 255 share language about a certificate's effect: upon its issuance, the certificate effects any “trial of actions for causes thereafter arising” as if the patent were always corrected.¹¹

A final correction method comes from another source: the district courts. Since at least 1926, courts could correct obvious errors

5. Act of July 3, 1832, ch. 162, § 3, 4 Stat. 559, 559.

6. 35 U.S.C. §§ 251 (“Reissue of defective patents”), 252 (“Effect of reissue”). Reissue is available for any patent that “is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent[.]” 35 U.S.C. § 251(a).

7. Act of Mar. 4, 1925, Pub. L. No. 68-610, § 1, 43 Stat. 1268, 1268–69 (codified as amended at 35 U.S.C. § 254 (2013)).

8. The Patent Act of 1952, Pub. L. No. 82–593, 66 Stat. 792, added section 255 to Title 35 and revised section 254, 66 Stat. at 809–10. See Act of Mar. 4, 1925, Pub. L. No. 68-610, § 1, 43 Stat. 1268, 1268-69. The USPTO may also correct the named inventor of a patent under another section within Chapter 25. 35 U.S.C. § 256. The remaining provisions in Chapter 25 pertain to disclaimers (35 U.S.C. § 253) and supplemental examination (35 U.S.C. § 257).

9. 35 U.S.C. § 254 (“Certificate of correction of Patent and Trademark Office mistake”). The full text of the provision (with key language emphasized) is:

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the *trial of actions for causes thereafter arising* as if the same had been originally issued in such corrected form. The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

10. 35 U.S.C. § 255 (“Certificate of correction of applicant's mistake”). The full text of the provision (with key language emphasized) is:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the *trial of actions for causes thereafter arising* as if the same had been originally issued in such corrected form.

11. 35 U.S.C. §§ 254, 255. This language also appears in § 252 to apply the same effect to reissue certificates, but it appears nowhere else in the patent laws. Because this language (which is the subject of this Article in the context of certificates of correction under §§ 254 and 255) does not appear in § 256 (“Correction of named inventor”), this Article does not discuss that type of correction.

in patents.¹² Today, courts 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.”¹³ Interestingly, errors that pass this test enjoy retroactive correction in the respective district court action.¹⁴

B. AIA Trials

In 2011, Congress enacted the Leahy-Smith America Invents Act (AIA),¹⁵ which converted the Board of Patent Appeals and Interferences into PTAB,¹⁶ and created new post-grant proceedings for patent validity disputes.¹⁷ These proceedings, including *inter partes* review (IPR) and post-grant review (PGR), came to be known as AIA trials.¹⁸

“[A] person who is not the owner of a patent” may file a petition requesting an IPR.¹⁹ The AIA sets deadlines by which the Director must decide whether to institute an IPR.²⁰ This decision is commonly known as an institution decision (ID).²¹ If the parties do not settle the matter,²² PTAB must issue a final written decision resolving the patentability of the claim(s) the petitioner challenged.²³

12. *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1354 (Fed. Cir. 2003) (citing *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429 (1926)).

13. *Id.* at 1357.

14. *Id.* (“The district court always would apply its own corrections retroactively in the action before it[.]”); *Grp. One, Ltd. v. Hallmark Cards, Inc.*, 407 F.3d 1297, 1303 (Fed. Cir. 2005) (“[W]e have held that in some circumstances the district court can correct errors retroactively.”).

15. Pub. L. No. 112-29, 125 Stat. 284 (2011) (codified as amended in scattered sections of 35 U.S.C. (2012)).

16. 35 U.S.C. § 6(a).

17. 35 U.S.C., chs. 31 (Inter Partes Review), 32 (Post-Grant Review).

18. *See, e.g.*, AIA TRIAL TYPES, <https://www.uspto.gov/patents/ptab/trials/aia-trial-types> (last visited March 8, 2023). For most purposes of this Article, the analysis applies equally to IPR and PGR. Therefore, the Article refers to IPR only, except when clarifying any differences between IPR and PGR.

19. 35 U.S.C. §§ 311(a), 321(a).

20. 35 U.S.C. §§ 311(b), 321(b). The Director has delegated the authority to make this decision to PTAB. 37 C.F.R. § 42.4(a).

21. TRIAL, 37 C.F.R. § 42.2 (“Trial means a contested case *instituted* by the Board based upon a petition. A trial begins with a written *decision* notifying the petitioner and patent owner of the *institution* of the trial.”) (emphases added).

22. 35 U.S.C. §§ 317(a), 327(a).

23. 35 U.S.C. §§ 318(a), 328(a).

III. PRECEDENT ADDRESSING THE EFFECT OF CERTIFICATES OF CORRECTION

The main source of judicial interpretation of a certificate of correction statute came in 2000 from the Federal Circuit in *Southwest Software, Inc. v. Harlequin Inc.*²⁴ There, at the patentee's request, the USPTO issued a certificate to correct the omission from the patent of a 300-page code appendix related to a feature of the invention.²⁵ But the certificate issued over a year after the patentee filed its infringement suit in district court.²⁶

On appeal, the Federal Circuit had to interpret 35 U.S.C. § 254 and decide, as an issue of first impression, whether a certificate's effect applied prospectively or retroactively.²⁷ The court rejected the argument that the certificate applied retroactively back to the patent's issuance.²⁸ If that interpretation were correct, it "could produce an illogical or unworkable result."²⁹ For example, a correction may fix a patent's validity, but before the certificate issues, the uncorrected patent would appear invalid.³⁰ It would be illogical, the court explained, for the correction to take effect as of the patent's issuance—the patentee could then recover for any activities after the patent's issuance, even those when the public reasonably believed an (uncorrected) invalid patent did not obstruct their affairs.³¹

Instead, the court concluded § 254 was clear: a certificate applies only prospectively from the certificate's issuance to causes "thereafter arising."³² Because the patentee's "cause of action against [the defendant] arose before the certificate of correction was issued," the Federal Circuit held the certificate was "not to be given effect in th[at] pre-certificate lawsuit."³³ As another consideration, the court pointed out that it was not unreasonable "to expect a patentee to check

24. *Sw. Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280 (2000).

25. *Id.* at 1287.

26. *Id.* at 1287–88, 1294.

27. *Id.* at 1294–95.

28. *Id.* at 1295–96.

29. *Id.* at 1295.

30. *Id.* at 1295–96.

31. *Id.*

32. *Id.* at 1294–95.

33. *Id.* at 1294.

a patent when it is issued in order to determine whether it contains any errors that require the issuance of a certificate of correction.”³⁴

Fast forward 20 years and this issue resurfaces, this time at PTAB. In *Emerson Electric Co. v. SIPCO, LLC*,³⁵ a certificate of correction issued after PTAB issued its final written decision finding the challenged claims unpatentable (and after the patentee noticed its appeal to the Federal Circuit).³⁶ The Federal Circuit remanded, at the patentee’s request, and ordered PTAB to determine what, if any, impact the certificate had on the final written decision.³⁷ Rather than fully interpret “trial of actions for causes thereafter arising” in § 255, PTAB resolved the case on timing alone because the IPR did not arise after the certificate issued.³⁸ After another appeal to the Federal Circuit, the court summarily affirmed PTAB’s remand decision.³⁹ PTAB still has not interpreted this phrase.⁴⁰

IV. INTERPRETING THE CERTIFICATE OF CORRECTION STATUTES IN THE PTAB CONTEXT

When interpreting a statute, the Federal Circuit “begins by inspecting its language for plain meaning. If the words are unambiguous, no further inquiry is usually required.”⁴¹ But the court also considers the words’ “placement and purpose in the statutory scheme.”⁴² “In appropriate cases, ambiguity may be resolved by

34. *Id.* at 1296.

35. *Emerson Elec. Co. v. Sipco, LLC*, IPR2016-00984, Paper No. 52, 2020 WL 407144 (P.T.A.B. Jan. 24, 2020).

36. *Id.* at *2.

37. Order on Mot. for Remand, *SIPCO, LLC v. Emerson Elec. Co.*, No. 2018-1364, slip op. at 4 (Fed. Cir. June 27, 2018).

38. *Emerson Elec.*, 2020 WL 407144, at *7 (noting that “[a]ssuming, without deciding, that an *inter partes* review falls within the statute’s “trial of actions” language, the statute makes a certificate of correction applicable only to actions arising *after* a certificate issues.”) (emphasis in original).

39. *SIPCO, LLC v. Emerson Elec. Co.*, 834 F. App’x 595 (Fed. Cir. 2021) (affirmance under Fed. Cir. R. 36).

40. Not long after the *Emerson Electric* affirmance, PTAB came across another chance to interpret “trial of actions for causes” and again decided the case on timing (deciding based on “thereafter arising”) without further interpreting the statute. See *Election Sys. & Software, LLC v. Hart Intercivic, Inc.*, PGR2020-00031, Paper 18 at 6, 2021 WL 409335, at *3 (P.T.A.B. Feb. 5, 2021).

41. *Superior Fireplace Co. v. Majestic Prod. Co.*, 270 F.3d 1358, 1369 (Fed. Cir. 2001) (quoting *Camargo Correa Metais, S.A. v. United States*, 200 F.3d 771, 773 (Fed. Cir. 1999) (citation omitted)).

42. *Id.* (quoting *Fanning, Phillips & Molnar v. West*, 160 F.3d 717, 721 (Fed. Cir. 1998) (internal quotations omitted); *Tyler v. Cain*, 533 U.S. 656, 121 S. Ct. 2478, 2482 (2001) (stating courts “interpret the words in their context and with a view to their place in the overall statutory scheme”) (internal quotations omitted); *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998) (“[S]tatutory interpretation is a ‘holistic endeavor’ that requires consideration of a statutory scheme in its entirety.” (citation omitted))).

considering the public notice function in interpreting the patent statutes.”⁴³

The legislative history of §§ 254 and 255 is slim,⁴⁴ so the bulk of interpreting these statutes rests on their text, then their placement and purpose in the statutory scheme of patent correction.

A. “trial of actions for causes”

The first phrase requiring interpretation is “trial of actions for causes.” In all the U.S. Code, this precise phrase appears in a single location: Title 35, Chapter 25.⁴⁵

Black’s Law Dictionary defines “action,” in the sense used in this phrase, as “civil or criminal judicial proceeding.”⁴⁶ “Cause,” in the sense used in this phrase, is defined as either “ground for a legal action” or a “lawsuit; a case.”⁴⁷ The second definition is essentially “action,” so the former definition should apply to avoid redundancy.⁴⁸ For both “action” and “cause,” the remainder of the AIA and the other patent laws shed no light on how to interpret these terms.⁴⁹

The first definition of “cause” is similar to the common term “cause of action,” which is defined in the relevant sense as “[a] group of operative facts giving rise to one or more bases for suing; a factual

43. *Id.* (quoting *Vectra Fitness*, 162 F.3d at 1384). In fact, the provision interpreted in *Superior Fireplace* was § 255. The Federal Circuit explained that “[t]he statutory scheme here encompasses 35 U.S.C. §§ 251–256,” so the court proceeded to “consider not only the bare meaning of the word[s] [of § 255] but also [their] placement and purpose in the statutory scheme.” *Id.* at 1370 (alterations in original) (quoting *Fanning, Phillips & Molnar*, 160 F.3d at 721).

44. Priest, *supra* at n. 1, at 965–69 & nn. 28–39.

45. 35 U.S.C. §§ 252, 254, 255.

46. *Action*, BLACK’S LAW DICTIONARY (11th ed. 2019).

47. *Cause*, BLACK’S LAW DICTIONARY (11th ed. 2019).

48. Avoiding this redundancy achieves the goal of the antisurplusage canon of interpretation, also called the antisuperfluosity canon. See *Rubin v. Islamic Republic of Iran*, 138 S. Ct. 816, 824 (2018) (“[O]ne of the most basic interpretive canons [is] that a statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void or insignificant.” (internal alteration omitted) (quoting *Corley v. United States*, 556 U.S. 303, 314 (2009))).

49. The only references to any type of “action” in the AIA refer to district court actions in the context of time bars for filing a petition, staying the parallel proceeding in district court, and estoppel. 35 U.S.C. §§ 315(a)(1) (time bar based on petitioner’s conduct), 315(a)(2) (stay), 315(b) (time bar based on patentee’s conduct), 315(e)(2) (estoppel), 325(a)(1) (time bar based on petitioner’s conduct), 325(a)(2) (stay), 325(b) (exception to stay related to motion for preliminary injunction), 325(e)(2) (estoppel). Similarly, references to “civil action” elsewhere in Title 35 relate to district court actions, not IPR or PGR. 35 U.S.C. §§ 257, 281, 291, 292, 297, 299. As for “cause,” other sections that include that term use it either in the sense related to causation or as part of the term “good cause.” See 35 U.S.C. §§ 271 (referring to causation in the context of infringement), 316, 326 (both referring to “caus[ing] unnecessary delay”); 35 U.S.C. §§ 316, 326 (both referring to “good cause”); 317, 327 (both permitting settlement “for good cause”).

situation that entitles one person to obtain a remedy in court from another person.”⁵⁰ Applying these definitions to the phrase, the best interpretation would focus on “cause” meaning “ground for legal action,” which is synonymous with “cause of action” in most contexts.

These definitions point to the first inquiry in applying the phrase “trial of actions for causes” in the context of an IPR: does the IPR statutory scheme include a cause?

Though no court has explicitly held that the IPR statute entails a “cause,” that conclusion is a reasonable application of the Supreme Court’s opinion in *Oil States Energy Services, LLC v. Greene’s Energy Group, LLC*.⁵¹ There, the Supreme Court clarified that IPR “falls squarely within public-rights doctrine” because it involves the “reconsideration of the Government’s decision to grant a public franchise.”⁵²

The public-rights doctrine embraces the principle that “Congress may effectively supplant a common-law cause of action carrying with it a right to a jury trial with a statutory cause of action shorn of a jury trial right if that statutory cause of action inheres in, or lies against, the Federal Government in its sovereign capacity.”⁵³ If the statutory cause of action does not involve a “public right,” “then Congress may not assign its adjudication to a specialized non-Article III court lacking ‘the essential attributes of the judicial power.’”⁵⁴ If it involves a public right, the Seventh Amendment does not bar Congress from assigning its adjudication to a non-jury factfinder in a non-Article III tribunal.⁵⁵ The Court’s opinion in *Tull v. United States*⁵⁶ provides the test to determine whether a statutory action for a public right may be assigned outside the Article III courts.⁵⁷

50. *Cause of Action*, BLACK’S LAW DICTIONARY (11th ed. 2019).

51. *Oil States*, 138 S. Ct. 1365 (2018).

52. *Id.* at 1373.

53. *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 53 (1989) (citing *Atlas Roofing Co. v. Occupational Safety and Health Review Comm’n*, 430 U.S. 442, 458 (1977)).

54. *Id.* at 53 (citing *Crowell v. Benson*, 285 U.S. 22, 51 (1932)).

55. *Id.* (citations omitted). *See also* *Oil States*, 138 S. Ct. at 1373 (Congress has “significant latitude to assign adjudication of public rights to entities other than Article III courts.”).

56. 481 U.S. 412 (1987).

57. *Id.* at 417–18 (“First, we compare the statutory action to 18th-century actions brought in the courts of England prior to the merger of the courts of law and equity. Second, we examine the remedy sought and determine whether it is legal or equitable in nature.”).

In *Oil States*, the Court explained that IPR “is simply a reconsideration of [the patent] grant, and Congress has permissibly reserved the PTO’s authority to conduct that reconsideration.”⁵⁸ Two considerations from the Court’s public-rights precedents reaffirm that patents are a matter of public rights. First, the grant of a patent is a matter between the government and others,⁵⁹ and the patentee receives the grant from the public.⁶⁰ Second, the USPTO’s grant of patents is the performance of constitutional functions⁶¹ by exercising executive power authorized by Congress.⁶² Additionally, addressing the historical analysis under *Tull*’s test, the Court summarized a pre-founding analog that resembled IPR, demonstrating that patent validity was not always decided by a court then and need not be now either.⁶³

The Court’s public-rights doctrine analysis not only demonstrates that IPR involves a public right, but it also suggests IPR entails a cause. First, this reflects the practical functioning of the public-rights doctrine.⁶⁴ Second, the Court’s descriptions of AIA trials liken them to district court actions, which arise from a cause.⁶⁵ Based on these similarities, AIA trials should be understood to arise out of a cause as well.

Therefore, IPR constitutes a “trial of actions for causes” because it comprises a properly authorized statutory cause under the public-rights doctrine.

58. *Oil States*, 138 S. Ct. at 1373.

59. *Id.* at 1373 (quoting *Ex Parte Bakelite Corp.*, 279 U.S. 438, 451 (1929)).

60. *Id.* (quoting *United States v. Duell*, 172 U.S. 576, 586 (1899)).

61. *Id.* at 1374 (quoting U.S. Const. Art. I, § 8, cl. 8 (Congress has the power “[t]o promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”)).

62. *Id.* (citing *Freytag v. Commissioner*, 501 U.S. 868, 910 (1991)) (Scalia, J., concurring in part and concurring in judgment).

63. *Id.* at 1377–78 (summarizing petitions to the Privy Council to vacate a patent); *but see* Christopher Beauchamp, *Repealing Patents*, 72 VAND. L. REV. 647 (2019) (discussing the pre-Founding English writ of *scire facias* to have a patent cancelled by a court and arguing the history of patent reexamination proceedings is not as clear as described in the majority opinion in *Oil States*).

64. *Granfinanciera*, 492 U.S. at 53 (“Congress may effectively supplant a common-law *cause of action* carrying with it a right to a jury trial with a statutory *cause of action* shorn of a jury trial right if that statutory cause of action inheres in, or lies against, the Federal Government in its sovereign capacity.”) (citation omitted) (emphasis added).

65. *Oil States*, 138 S. Ct. at 1378 (recognizing the IPR includes motion practice, discovery, depositions, cross-examination, introduction of evidence based on the Federal Rules of Evidence, and an adversarial hearing); *Return Mail, Inc. v. United States Postal Service*, 139 S. Ct. 1853, 1860 (2019) (describing AIA trials as “adjudicatory in nature,” and discussing aspects such as discovery, oral hearing, the petitioner’s burden of unpatentability, and the final decision).

Moreover, excluding IPR from §§ 254 and 255 would produce problems and including it would maintain the overall goals of the patent laws.⁶⁶ As to problems, if IPR lacks a “cause,” a certificate of correction would not have effect in an IPR even though it would have effect in a district court action. Though each matter would involve the same patent, the patent would be uncorrected at PTAB but corrected in district court. This could produce different versions of the specification or, even worse, the scope of a patent could differ among the fora: there could be corrected claims in district court but uncorrected claims at PTAB. As to maintaining the overall goals of the patent laws, a hallmark of the patent system is disclosure of the invention so the public can understand what they can and cannot do.⁶⁷ To provide the public with access to this disclosure, the USPTO makes an issued patent’s entire record (including certificates of correction) available for public inspection.⁶⁸ The public may then rely on the patent’s record when making decisions. Certificates of correction are included in this reliance, as they should be, because the public must know whether a patent’s disclosure has changed. So just as the public can rely on the notice function of the rest of the patent’s record, so may the public (including diligent petitioners) observe an issued certificate of correction and proceed with certainty that the certificate will apply to the patent in a given dispute, whether it ensues in district court or at PTAB.

B. “thereafter arising”

The second phrase requiring interpretation is “thereafter arising.” “Thereafter” is unambiguous,⁶⁹ but the definition of “arising” depends on the context of its use. Black’s Law Dictionary defines “arise” (with examples) in two ways plausible for interpretation in this phrase: “[t]o originate; to stem (from),” as in a claim “arising” under certain source of law, or “[t]o result from,” as in

66. *Vetra Fitness*, 162 F.3d at 1384–85 (considering, when construing 35 U.S.C. §§ 251 and 253, the notice function of the patent and the public’s justified reliance on a patent’s record); *see also* *Griffin v. Oceanic Contractors, Inc.*, 458 U.S. 564, 575 (1982) (“[I]nterpretations of a statute which would produce absurd results are to be avoided if alternative interpretations consistent with the legislative purpose are available.”).

67. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (“It has long been understood that a patent must describe the exact scope of an invention and its manufacture to ‘secure to the patentee all to which he is entitled, and apprise the public of what is still open to them.’”) (quoting *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891)) (cleaned up). Even the term “patent” itself reflects this purpose: its origin is the Latin verb “patere,” which means “to lay open.” Colleen V. Chien, *Contextualizing Patent Disclosure*, 69 VAND. L. REV. 1849, 1850 (2016).

68. 37 C.F.R. § 1.11 (“Files open to the public”).

69. *Thereafter*, BLACK’S LAW DICTIONARY (11th ed. 2019) (“Afterward; later”).

a claim for a remedy that “arises” out of an event.⁷⁰ The former is the familiar language of, for example, jurisdictional statutes,⁷¹ but the latter definition better lends itself to identifying a point in time, so it is the more plausible interpretation for this phrase.

The first complication with this phrase is that it is not immediately apparent what must be “thereafter arising”: the trial, the action, or the cause. *Southwest Software* suggests “thereafter arising” cannot refer to “trial”; otherwise, the certificate would have had effect because it issued before the trial.⁷² Some of the *Southwest Software* opinion recites “cause of action” instead of “actio[n] for caus[e]” from the statutes.⁷³ Subsequent cases apply *Southwest Software* differently: one case reveals an understanding that the “action” must arise after the certificate issues for the certificate to have effect,⁷⁴ but another reveals an understanding that the “cause” must thereafter arise.⁷⁵

The latter case presents the better read of *Southwest Software* because, in an infringement suit in district court, a patentee’s “cause” “arises” each time an infringer infringes the patent’s claims,⁷⁶ so she brings an “action” for that cause to remedy the infringement.

70. *Arise*, BLACK’S LAW DICTIONARY (11th ed. 2019).

71. See 28 U.S.C. § 1338(a) (“The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks.”) (emphasis added).

72. *Sw. Software*, 226 F.3d at 1287–88, 1294.

73. *Id.* at 1294 (“Southwest’s cause of action against Harlequin and ECRM arose before the certificate of correction was issued.”) (emphasis added); *id.* at 1297 (“Finally, we point out that, for any cause of action arising after April 1, 1997, the date the certificate of correction issued, the certificate will be treated as part of the original patent.”) (emphasis added).

74. *Novo Indus.*, 350 F.3d at 1357 (citing *Sw. Software*, 226 F.3d at 1297) (“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[.]”) (emphasis added). This case supports the understanding that *Southwest Software* concluded the “action” must thereafter arise, not the “cause”: if a certificate applies “only” in an “action brought” after the certificate issues, then it would not matter whether the “cause” occurred before or after the certificate’s issuance.

75. *E.I. du Pont de Nemours & Co. v. MacDermid Printing Sols., L.L.C.*, 525 F.3d 1353, 1362 (Fed. Cir. 2008). Several district court decisions also pick up on this nuance and reiterate that *Southwest Software*, properly understood, distinguishes between infringement pre-certificate issuance (which is not recoverable) and infringement post-issuance (which is recoverable). See, e.g., *Kreg Enterprises, Inc. v. Armor Tool, LLC*, No. 19-CV-1125-BAS-WVG, 2019 WL 13214975 (S.D. Cal. Dec. 11, 2019); *Masonite Corp. v. Craftmaster Mfg., Inc.*, No. 09 CV 2131, 2011 WL 1642518 (N.D. Ill. Apr. 29, 2011).

76. *E.I. du Pont de Nemours*, 525 F.3d at 1362 (“[E]ach act of infringement gives rise to a separate cause of action.”) (citing *Hazelquist v. Guchi Moochie Tackle Co., Inc.*, 437 F.3d 1178, 1180 (Fed. Cir. 2006) (“Our case law clearly states that each act of patent infringement gives rise to a separate cause of action.”)).

Accordingly, the best reading of the statutes gives certificates effect on causes arising after the certificate's issuance.⁷⁷

This leads to the second complication with this phrase: when does the IPR cause arise? Unlike plaintiffs filing civil actions in federal court, an IPR petitioner before PTAB need not satisfy Article III standing and thus never establishes any injury prompting the filing of the petition.⁷⁸ In fact, at PTAB there need not be any infringement precipitating a cause because the AIA authorizes “any person” to file a petition.⁷⁹ Also, a petitioner has limited opportunity to challenge a patent through IPR, unlike patent owners who can have multiple causes from separate infringements.⁸⁰

As explained below, considering the uniqueness of the statutory schemes and slight mismatch between the correction statutes and IPR, this Article concludes “trial of actions for causes thereafter arising” in §§ 254 and 255 means the IPR cause arises, as a default, upon filing a petition, subject to one exception.

This interpretation satisfies the considerations underlying the AIA and overall patent system and those showing proper statutory assignment of a cause of action under the public-rights doctrine. For instance, the public has an interest in valid patents because patents remove the public's ability to practice the claimed invention without

77. Applying the nearest-reasonable-referent canon of interpretation yields the same result, i.e., that the “cause” must be “thereafter arising” for the certificate to have effect. *Parm v. Nat'l Bank of California*, N.A., 835 F.3d 1331, 1336 (11th Cir. 2016) (“When the syntax involves something other than a parallel series of nouns or verbs, a prepositive or postpositive modifier normally applies only to the nearest reasonable referent.”) (quoting ANTONIN SCALIA & BRYAN GARNER, *READING LAW: THE INTERPRETATION OF LEGAL TEXTS* 152 (2012)).

78. 35 U.S.C. §§ 311(a), 321(a). In contrast, the USPTO did impose an injury requirement like Article III standing on those interested in filing a petition for the formerly available covered business method review. 37 C.F.R. § 42.302(a) (“A petitioner may not file with the Office a petition to institute a covered business method patent review of the patent unless the petitioner, the petitioner's real party-in-interest, or a privy of the petitioner has been sued for infringement of the patent or has been charged with infringement under that patent.”). See also *Coal. for Affordable Drugs VI, LLC v. Celgene Corp.*, IPR2015-01092, slip. op. at 3–4 (PTAB Sept. 25, 2015) (Paper 19) (unlike covered business method reviews, which require a party or privy to have been sued or charged with infringement of the patent, any person who is not the owner of the patent may file a petition for IPR).

79. The language of the IPR cause of action is broad. As the Supreme Court explained, “any third party can ask the agency to initiate inter partes review of a patent claim,” with the clarifying caveat that “third party” apparently reflects that patent owners are carved out from “any person” in the statutes. *Cuozzo v. Lee*, 579 U.S. at 267–68; see 35 U.S.C. §§ 311(a), 321(a) (“a person who is not the owner of a patent may file with the Office a petition to institute” an IPR or PGR, respectively).

80. See *Code200 UAB et al. v. Bright Data Ltd.*, IPR2022-00861, Paper 18 (P.T.A.B. Aug. 23, 2022) (precedential) (discussing standard for denying institution for filing serial petitions); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017) (precedential as to § II.B.4.i) (same).

fear of lawsuit.⁸¹ So to protect that interest, IPR enables any member of the public, aside from the patent owner, to challenge what she will argue is an invalid patent and return to the public the ability to practice what the patent claims. Also, notice plays a role here too—just as we assume a potential infringer is aware a patent was corrected after a certificate of correction issues, we may also assume a diligent petitioner is aware of any certificate before she files her petition and can adjust her patentability challenges accordingly.

This interpretation also precludes the potential complication associated with a certificate issuing (and having effect) after a petition is filed but before PTAB issues an ID. Because certificates of correction do not apply retroactively, this timing would produce uncertainty for the parties (and public) and impracticalities for PTAB issuing its ID by the statutory deadline, including any potential need for conference with and more briefing from the parties. And this complication is particularly acute at PTAB as compared to district court: while PTAB lacks retroactive corrective authority, a post-complaint correction under district court authority applies retroactively, thereby eliminating confusion.

Moreover, the IPR cause comes with conditions. First, a would-be petitioner's filing of a civil action challenging a patent in court extinguishes her ability to seek an IPR of that patent.⁸² Second, the AIA imposes time bars. There can be no IPR more than one year after the patent owner serves the petitioner (or its real party in interest (RPI) or privy) with a complaint alleging infringement of the patent.⁸³ Also, an IPR petition may be filed only after the later of nine months after the grant of the patent, or the date of termination of a PGR of the patent, if one was instituted.⁸⁴

But one condition warrants an exception to the general rule. While a petition may be filed without any injury to the petitioner, the AIA's time bar for filing a petition after service of an infringement

81. *Oil States*, 138 S. Ct. at 1374 (“So, like the PTO’s initial review, the Board’s inter partes review protects ‘the public’s paramount interest in seeing that patent monopolies are kept within their legitimate scope[.]’”) (quoting *Cuozzo v. Lee*, 136 S. Ct. at 2144).

82. 35 U.S.C. §§ 315(a)(1), 325(a)(1). *But see* 35 U.S.C. §§ 315(a)(3), 325(a)(3) (a counterclaim challenging validity is not an IPR- or PGR-precluding civil action challenging validity under subsection (a)(1)).

83. 35 U.S.C. § 315(b).

84. 35 U.S.C. § 311(c). As for PGR, a petition may only be filed not later than nine months after the grant of the patent. 35 U.S.C. § 321(c).

complaint on the petitioner (or its RPI or privy) is notable. That deadline gives the petitioner a personal motivation for seeking IPR that resembles the particularized injury required for Article III standing, so service of the complaint should accelerate when a petitioner's IPR cause arises. Moreover, if a petitioner's IPR cause did not arise upon it being served with an infringement complaint, an unsuitable situation could occur: when a certificate of correction issues after service of the complaint but before filing a petition, the uncorrected claims would apply in district court, but the corrected claims would apply at PTAB.

Thus, the IPR cause arises upon the earlier of (1) the filing of an IPR petition, or (2) the patent owner serving the petitioner, its RPI, or its privy with a complaint alleging infringement.

V. CONCLUSION

In sum, “trial of actions for causes thereafter arising” in §§ 254 and 255 means a certificate of correction applies in an AIA trial when the certificate issues before the filing of a petition. The IPR statutory cause—which PTAB can hear under the public-rights doctrine—arises upon the earlier of the filing of a petition or the patent owner serving the petitioner, her RPI, or her privy with a complaint alleging infringement. Because the cause arose after this certificate issued, the certificate has the same effect and operation in law as if the patent were always corrected. This ensures the same version of a patent (and its claims) apply in parallel proceedings in district court and at PTAB.