

Abstract

The Court supported the U.S. Patent Office's rejection of inventor's oath due to the fact that the U.S. national application was different from the PCT application. The support was given due to the fact that the submitted oath did not satisfy 35 U.S.C. sec. 371(c)(4).

DR. CHACKO P. ZACHARIAH, Plaintiff-Appellant, v. COMMISSIONER OF PATENTS AND TRADEMARKS, JAMES O. THOMAS, JR., DAC for patents, CHARLES PEARSON, Head PCT Legal & Office of Administrator of Legal Affairs, RICHARD B. LAZARUS, Supervisor PCT Legal, and UNITED STATES ATTORNEY GENERAL, Defendants-Appellees.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT
2000 U.S.

August 8, 2000, Decided

JUDGES:

Before RADER, SCHALL, and LINN, Circuit Judges.

OPINIONBY: RADER

OPINION:

RADER, Circuit Judge.

Dr. Chacko P. Zachariah appeals the decisions of the United States District Court for the Southern District of Florida, dismissing two counts and granting the Government's motion for summary judgment on the remaining counts. Because this court concludes that two of appellant's counts are not ripe for review and finds no genuine issue of material fact in connection with the remaining counts, this court affirms.

I. Dr. Zachariah filed an international application to patent an "element and energy production device" under the Patent Cooperation Treaty (PCT). The PCT process consists of an international and a national stage. During the international stage, the World Intellectual Property Organization (WIPO) preliminarily processes the application under the terms of the PCT. During the national stage, the applicant designates member countries in which the applicant desires patent protection. Thereafter, the patent office of each designated country processes the application under its own patent laws. This appeal concerns Dr. Zachariah's national stage filing. In order to enter the national stage in the United States, an applicant must provide: (1) a national fee; (2) a copy of the international

application unless it has already been forwarded to the member country's patent office; (3) any amendments to the international application; (4) an oath asserting that the applicant invented the subject of the application; and (5) translations if necessary. See 35 U.S.C. § 371(c) (1994).

After filing his international application, Dr. Zachariah commenced prosecution of his application in the United States. Dr. Zachariah's national stage application contained twenty claims; however, his international application contained only fifteen claims. The national stage application also contained additional written description not present in his international application. Dr. Zachariah contends that the additional claims resulted from the separation of previously compound claims. Therefore, he asserts, the application contained no "new matter."

On May 6, 1992, the United States Patent and Trademark Office (PTO) accepted Dr. Zachariah's application for prosecution. However, on November 8, 1994, the PTO vacated its acceptance because of differences between the national application and his international application.

The PTO rejected Dr. Zachariah's oath because it supported only the invention in the national application, not the invention in the international application. Hence, the PTO determined that the oath did not satisfy the requirements in 35 U.S.C. § 371(c)(4) and 37 C.F.R. § 1.63 (1999). The PTO offered Dr. Zachariah two options for proceeding with his application. Either he could proceed with the national phase using the original international application, or he could forgo the international filing date and proceed as if the national application was a newly-filed United States patent application. Following Dr. Zachariah's petition requesting review of this revocation, the PTO offered a third option--treating his application as a domestic application but according it an advantageous unity of invention treatment under the PCT.

In lieu of these options, Dr. Zachariah sued the PTO seeking: (1) declaratory judgment that PTO actions and interpretations violated the law, (2) a writ of mandamus directing the PTO to withdraw its decision revoking acceptance, (3) a writ of prohibition preventing the PTO from selectively prosecuting his application, and (4) injunctive relief preventing the PTO from "tampering with the original filing status" of the application. The district court dismissed the latter two counts because they were not ripe for review. See *Zachariah v. Commissioner of Patents & Trademarks*, 990 F. Supp. 1404, 1405-06 (S.D. Fla. 1996). The district court granted the PTO's motion for summary judgment on the remaining counts. See *Zachariah v. Commissioner of Patents & Trademarks*, Civ. No. 95-6040 (S.D. Fla. Search - 39 Results - patent cooperation treaty

II. When reviewing a district court's conclusion that causes of action in a case are not ripe for review, this court applies the law of the regional circuit in which the district court sits. See *Cedars-Sinai Medical Center v. Watkins*, 11 F.3d 1573, 1580, 29 U.S.P.Q.2D (BNA) 1188, 1194 (Fed. Cir. 1993). The U.S. Court of Appeals for the Ninth Circuit reviews de novo a dismissal under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction. See *GTE Directories Publ'g Corp. v. Trimen Am., Inc.*, 67 F.3d 1563 (11th Cir. 1995).

This court also reviews the district court's grant of summary judgment without deference. See *Conroy v. Reebok Int'l, Ltd*, 14 F.3d 1570, 1575, 29 U.S.P.Q.2D (BNA) 1373, 1377 (Fed. Cir. 1994). Summary judgment may stand only if the record shows no genuine issue of material fact and the PTO's entitlement to judgment as a matter of law. See Fed. R. Civ. P. 56(c). The Federal Rules of Civil Procedure also require courts considering summary judgment to draw all reasonable inferences in favor of the non-movant. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986).

III. The PTO vacated the acceptance of Dr. Zachariah's application for failure to meet the requirements of 35 U.S.C. § 371(c)(4) and 37 C.F.R. § 1.63. Section 371(c) requires an inventor commencing a national application to file a "copy of the international application" and an oath. Section 1.63(a)(2) requires the oath to identify the specification to which it applies. The oath in Dr. Zachariah's national application applied only to his national application. Dr. Zachariah's national application contained more claims than his international application. Dr. Zachariah's national stage application therefore differed from his international application. Because Dr. Zachariah did not have a declaration covering the invention in his international application and because the national and international applications differ, Dr. Zachariah's oath was insufficient to satisfy § 371(c)(4). The PTO was therefore statutorily barred from accepting Dr. Zachariah's national application.

Dr. Zachariah's first and second counts asked the district court to: (1) declare that the PTO had broken the law, and (2) reverse its actions. Because this court finds that there is no genuine issue of material fact as to whether the PTO's notice withdrawing acceptance was appropriate, this court affirms the district court's summary judgment on both of these counts.

Dr. Zachariah's third and fourth counts ask the district court to restrain the PTO during the prosecution of the patent. The district court dismissed these complaints because it found that the regulatory scheme prevented the court's intervention until after the PTO has issued final agency action.

The act of an agency is reviewable when made reviewable by statute or when it is final. See 5 U.S.C. § 704 (1994). Because there has been no final agency action in the case of Dr. Zachariah's application, the PTO's action is not reviewable in the district courts. There is no construction of the facts that would have allowed the district court to enter judgment for Dr. Zachariah on his third and fourth counts. Therefore, this court concludes that the district court properly dismissed them.

Based on the above determinations, this court affirms the judgments of the district court.