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FEDERAL CIRCUIT PATENT LAW CASE UPDATE

The court affirmed the Court of Federal Claims dismissal of Hornback’s “claim seeking compensation for the reclassification of his patent application as secret.” There was no declassification and reclassification that might trigger a taking claim because only the PTO commissioner can rescind a secrecy order. The mere internal downgrading and later upgrading of the application by the Air Force does not qualify.

Hornback’s patent application of 1986 issued in 2000 as U.S. Patent No. 6,079,666, for a “Real Time Boresight Error Slope Sensor.” There was a secrecy order on the application from 1987 to 1999.

The appeal concerns two issues.

First, Hornback filed in the Court of Federal Claims, arguing that the government declassified and reclassified the patent application, constituting a taking of his property. In that same suit, he petitioned for a remand of the patent to the PTO for correction.

The court affirmed the Court of Federal Claim’s determination that Hornback was barred by claim preclusion.

The Court of Federal Claims referred to Mr. Hornback's nine prior suits seeking declassification of the secrecy order or compensation therefor, five of which were dismissed with prejudice . . .

Mr. Hornback argues that the present case is brought not on the initial secrecy order, but on the reclassification. As support, he points to three documents in the record.

The court rejected Hornback’s approach because in an earlier opinion it had already opined that the documents did not describe a declassification and then a reclassification: “the internal action of the Air Force in downgrading his application to unclassified in 1994 did not lift the order ‘because only the Commissioner of Patents may rescind a secrecy order.’” Thus, this aspect of his claim had already been adjudicated and claim preclusion was a proper basis for the Court of Federal Claims to dismiss the action.

Second, Hornback sought to correct the issued patent, but took a circuitous and jurisdictionally incorrect approach. After petitioning the PTO to correct the patent, in 2001 Hornback filed a writ of mandamus at the Federal Circuit. The court denied the petition because Hornback should have started in the district court.

Given these setbacks, Hornback added a petition to his suit before the Court of Federal Claims to cause the PTO to correct the patent.

We agree that the Court of Federal Claims does not have subject matter jurisdiction of an adverse ruling of the PTO Director. 28 U.S.C. § 1361 vests “original jurisdiction” for the issuance of mandamus orders in the district courts, authorizing the district court to hear any action “to compel an officer or employee of the United States or any agency thereof to perform a duty owed to the plaintiff.”