IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ISCO INTERNATIONAL, INC.,	)	
	)	
Plaintiff,	)	
	)	C.A. No. 01-487-GMS
v.	)	
	)	
CONDUCTUS, INC. AND	)	
SUPERCONDUCTOR	)	
TECHNOLOGIES, INC.,	)	
	)	
Defendants.	)	

MEMORANDUM AND ORDER

I. INTRODUCTION

On July 17, 2001, the plaintiff, ISCO International, Inc. ("ISCO") filed this action alleging infringement of United States Patent No. 6,263,215 (D.I. 1). The defendants, Conductus, Inc. ("Conductus") and Superconductor Technologies, Inc. ("STI") (collectively "the defendants"), each filed an Answer and Counterclaim on August 6, 2001 and August 22, 2001, respectively (D.I. 6, 11). Since that time, the plaintiff and the defendants have submitted other counterclaims, as well as numerous motions for summary judgment. These include Conductus' Motion for Summary Judgment of Invalidity of All Asserted Claims for Causes of Action Existing Prior to the Date of a Certificate of Correction and of Invalidity of Claim 13 ("the Conductus motion") (D.I. 205). The plaintiff has filed an answering brief in opposition to the Conductus motion, and conditionally moves for leave to file an amended complaint. The plaintiff's motion for leave to amend is conditional on the court's granting the Conductus motion for summary judgment. Should the court deny the Conductus motion, ISCO will withdraw its conditional motion for leave to amend. For the following reasons, the court will deny the plaintiff's motion for leave to file an amended complaint.

This order does not reach the merits of the Conductus motion for summary judgment.

II. DISCUSSION

A. Leave to Amend Pleadings

ISCO moves to amend its complaint pursuant to Federal Rule of Civil Procedure 15(a). Rule 15(a) provides that a party may amend its pleading "by leave of court . . . and leave shall be freely given when justice so requires." FED. R. CIV. P. 15(a). Leave should be freely granted unless there is an apparent or declared reason for denial, *e.g.*, undue delay, bad faith, or dilatory motive on the part of the movant; undue prejudice to the opposing party; or futility of the amendment. *Foman v. Davis*, 371 U.S. 178, 182 (1962); *see also In re Burlington Coat Factory Sec. Litig.*, 114 F.3d 1410, 1434 (3d Cir. 1997). Absent such grounds for denial, "it is an abuse of discretion for a district court to deny leave to amend." *Alvin v. Suzuki*, 227 F.3d 107, 121 (3d Cir. 2000) (citations omitted). However, leave to amend is by no means "automatic," and 'the liberal policy of granting leave to amend must not be interpreted to permit amendment without restraint.' *Agere Sys. Guardian Corp. V. Proxim, Inc.*, 190 F. Supp. 2d 726, 732 (D. Del. 2000) (quoting *Microsurgical Sys. v. Cooper Companies, Inc.*, 797 F. Supp. 333, 336 (D. Del. 1992)). Thus, the decision of whether to grant or deny leave to amend a pleading is fully within the discretion of the court. *Id.*

B. Effect of the Certificate of Correction

ISCO moves for leave to amend, conditioned on the court's ruling on the Conductus motion for summary judgment. At the heart of both motions is a Certificate of Correction issued by the Patent Office on February 19, 2002. The Certificate amended claim 10 of the patent to read, in relevant part, "amplifiers" instead of "planar amplifiers." It was issued pursuant to 35 U.S.C. § 254,

"Certificate of correction of Patent and Trademark Office mistake."[1] The plaintiff seeks to amend its complaint to include the Certificate for two apparent reasons.

First, ISCO believes that, if granted leave to amend its complaint, the amended pleading then would "relate back" to the date of the issuance of the Certificate of correction.[2] The court is baffled by this suggestion. Federal Rule of Civil Procedure 15 dictates that "[a]n amendment of a pleading relates back to the date of the original pleading." FED. R. CIV. P. 15(c). In the instant case, the original complaint was filed on July 17, 2001. For purposes of relating back, July 17, 2001, and no other date, is the relevant reference point. ISCO offers no support whatsoever, and the court has found none, for its suggestion that its amended complaint should relate back to February 19, 2002, the date of the issuance of the Certificate of correction. Presumably, this is because the plain language of the Rule is profoundly clear as to this issue.

Implicit in the plaintiff's suggestion, however, is an attempt to circumvent the rule

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[1] The entire text of the statute reads:

> 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.

[2] ISCO's Reply Brief in Support of Conditional Motion for Leave to File Amended Complaint at 2.

announced in *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280 (Fed. Cir. 2000). In *Southwest*, the court held that a Certificate of correction issued pursuant to 35 U.S.C. § 254 "is only effective for causes of action arising after it was issued." *Id.* at 1294; *see also Rambus, Inc. v. Infineon Techs. AG*, 155 F. Supp. 2d 668, 677 at n.6 (E.D. Va. 2001) ("Federal Circuit law clearly holds that a patent holder cannot rely on a certificate of correction in a patent infringement suit filed before the certificate issues"); *Elec. Planroom v. McGraw-Hill Cos., & Estate of Devon Shire*, 135 F. Supp. 2d 805, 827 (E.D. Mich. 2001) ("a certificate of correction has no effect on litigation pending at the time it is issued"); *Adrain v. Hypertech, Inc.*, 2001 WL 740542 at *3 (D.Utah 2001) ("It is clear that the certificates of correction, once issued, have prospective application."). Clearly, and despite the plaintiff's insistence to the contrary, the Certificate of correction which issued on February 19, 2002 is not effective in this case, which arose on July 17, 2001. Were the court to grant ISCO's request to relate an amended complaint back to the date of the issuance of the Certificate, thereby rendering the Certificate effective for purposes of this litigation, *Southwest* would be stripped of all meaning. The court will not accede to such a transparent and ill-informed invitation to ignore the Federal Circuit's clear mandate, as well as the language of 35 U.S.C. § 254. Because an amended complaint would relate back to the date of the original complaint, July 17, 2001, and because the Certificate of Correction issued after that date, granting leave to amend would be utterly futile as a matter of law.

As a second basis for leave to amend, ISCO maintains that even if the Certificate is not effective for purposes of this action, the term "planar" may be disregarded by the court as a typographical error. Accordingly, ISCO moves to amend its complaint to include the Certificate of correction as evidence that the inclusion of the word "planar" in Claim 10 was **a** typographical error.

As to this point, the court refers the parties to its October 30, 2002 order regarding claim construction. Because the court already has construed the relevant part of Claim 10 to read "planar amplifiers," ISCO's second argument for leave to amend its complaint is futile as well.[3]

III. CONCLUSION

As stated earlier, leave to amend a pleading is properly denied when the amendment would be futile. *See Foman*, 371 U.S. at 182; *In re Burlington Coat Factory Sec. Litig.*, 114 F.3d at 1434; *Site Microsurgical Sys*., 797 F. Supp. 333 (D. Del. 1992). In this case, the proposed amendment to ISCO's complaint would be utterly fruitless in that the amendment would not render the Certificate of correction effective, nor alter the construction of the claims. Therefore, the plaintiff's motion is denied.

For the aforementioned reasons, IT IS HEREBY ORDERED that:

1. The plaintiff's Conditional Motion for Leave to File Amended Complaint is DENIED.

Gregory M. Sleet

November 8, 2002 UNITED STATES DISTRICT JUDGE

[3] To the extent questions remain as to the October 30, 2002 order, and per the plaintiff's request, the court has granted supplemental briefing regarding specific issues surrounding the term "planar amplifiers." The court will, of course, address any issues arising from the supplemental briefing after having received and reviewed the same.