

OTDP After PTA: What You Need to Know

The Federal Circuit just rendered a decision *In re Collect, LLC*, Case Nos. 2022-1293; -1294; -1295; -1296 (Fed. Cir. Aug. 28, 2023), which raises potential validity issues where multiple patents by the same Applicant have claims covering overlapping inventions and expire at different times due to patent term adjustment (PTA). The Federal Circuit concluded that such patents can be invalidated due to nonstatutory obviousness-type double-patenting (OTDP). In particular, the Federal Circuit found that when members of a patent family have different expiration dates due to PTA, earlier expiring family members can be used as a basis for challenging the validity of later expiring family members based on OTDP, even if the Examiner did not appreciate or raise OTDP.

During *ex parte* reexaminations of the *Collect* patents, the Board found the challenged claims for each of the four patents that received PTA to be invalid because the claims were determined to be patentably indistinct from claims in earlier-expired patents. None of the four challenged patents were subject to a terminal disclaimer nor subject to an OTDP rejection during regular examination before grant. All four patents were challenged during reexamination based on claims in patents that were issued from later-filed patent applications, including one patent that did not receive PTA. The Applicant did not argue that the claims were patentably distinct over the earlier-expired patents during the *ex parte* reexaminations.

This Federal Circuit decision raises important issues for commonly owned patents with different expiration dates:

1. During prosecution, Applicants need to consider substantively challenging an OTDP rejection or even amending claims rather than filing a terminal disclaimer (TD). If filing a TD in a pending application, one should consider filing a TD in the other patent(s) that gave rise to the OTDP rejection, particularly where the other patent(s) that gave rise to the OTDP rejection are entitled to PTA.
2. Applicants should consider proactive filing of terminal disclaimers, even in the absence of an OTDP rejection, although such must be balanced against possible loss of adjusted patent term. The proactive filing of terminal disclaimers should be considered at least across patent family members but also possibly between members of different patent families.
3. Applicants should consider proactive filing of terminal disclaimers, even in the absence of an OTDP rejection, although such must, of course, be balanced against possible loss of adjusted patent term. The proactive filing of terminal disclaimers should be considered at least across patent family members but also possibly between members of different patent families.
4. When considering the filing of continuation applications where the parent is entitled to PTA, Applicants should weigh the potential of losing the PTA in the parent relative to the value of claims that may be granted in the continuation since the continuation may not itself be entitled to at least the same amount of PTA as the parent.
5. Applicants may alternatively consider docketing a reminder to review and consider the filing of a TD in advance of the unadjusted expiration date of patents that received PTA. If following this course, a review of the patents with respect to OTDP should be performed prior to bring suit to enforce such.



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Related Practice Areas

- Intellectual Property
- Patents

While it may be possible to cure OTDP with a TD after grant, it is not possible to cure such after patent expiration.

We also note that the Applicant in *In re Collect, LLC* argued that the Examiner must have considered OTDP because the Examiner prosecuted the applications of the family. The Federal Circuit rejected this argument, suggesting the Court has implicitly rejected the concept that Examiners consider all grounds of patentability during prosecution.

Our team is available to answer any questions regarding best practice in this situation.