

In re Collect, LLC, 81 F.4th 1216 (Fed. Cir. 2023) (Lourie, Dyk, Reyna)

BY MICHAEL JOFFRE

Collect owned four patents with claims that were found unpatentable by the PTAB in ex parte reexaminations for obviousness-type double patenting. The patents were granted Patent Term Adjustment (“PTA”) for the Office’s delay during prosecution pursuant to pre-AIA 35 U.S.C. § 154(b). The four patents claimed priority to a fifth Collect patent—the ’036 patent—which was the only member of the patent family that did not receive a grant of PTA. Thus, but for the PTA, the five patents would have expired the same day. Each of the four patents in reexamination were found unpatentable over each other or the ’036 patent. All the invalidated claims ultimately traced back to the ’036 patent.

Collect appealed, arguing that, in determining unpatentability for obviousness-type double patenting, the PTAB should have used the expiration date of the patents before any PTA was added, as is done for Patent Term Extension pursuant to 35 U.S.C. § 156. Using that date, the patents could not have been found unpatentable (because the four patents at issue would not be later-expiring). Collect also argued that the policy reasons for obviousness-type double patenting—preventing improper patent term extension and split ownership of related patents—did not apply.

The Federal Circuit disagreed and held that the date for determining obviousness-type double patenting is the patent’s expiration date after PTA is added. The court held that “Collect’s interpretation of the PTA statute would effectively extend the overall patent term awarded to a single invention contrary to Congress’s purpose by allowing patents subject to PTA to have a longer term” than a prior-expiring, patently indistinct patent. Section 154(b)(2)(B), the court observed, provides that “[n]o patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.” The court found this language instructive because, “[g]iven the interconnection of ODP and terminal disclaimers as ‘two sides of the

The date for determining obviousness-type double patenting is the patent’s expiration date after PTA is added.

same coin,’ the statutory recognition of the of the binding power of terminal disclaimers in § 154(b)(2) (B) is tantamount to a statutory acknowledgement that ODP concerns can arise when PTA results in a later-expiring claim that is patentably indistinct.”

The court held that Collect could have avoided this invalidity result by filing a terminal disclaimer for all the patents that had received PTA. Moreover, the court held that filing terminal disclaimers would have avoided the risk of split patent ownership of the same invention that obviousness-type double patenting was meant to prevent. Therefore, the court affirmed the PTAB’s decision.

Collect has filed a petition for rehearing, and the Federal Circuit has requested a response from the government. The court denied the petition in January 2024.