

insights

TYPES NOT MAPPED YET November 30, 2023 | TTR not mapped yet | William A. Holtz Ph.D.

Patent Term Adjustment woes

Generally, receiving Patent Term Adjustment (PTA) for a patent that took the United States Patent Office (USPTO) a long time to issue is welcome. The purpose of awarding PTA is to compensate applicants for lost patent term due to Office delays not attributable to the applicant.

Imagine, however, a court holds that because the Office's award of PTA causes a certain patent to expire later than another related patent, even with the same priority date, obviousness type double patenting (OTDP) applies, and your later expiring patent is invalid because it was not terminally disclaimed to the term of the earlier expiring patent. This occurs even though the USPTO never raised the issue of OTDP during prosecution. How can it be that the Office's policy of compensating applicants for the Office's delay puts those same patents at risk of being invalidated under OTDP?

That appears to be the holding in the Federal Circuit's recent decision in *In re Collect, LLC*. How the Federal Circuit decides to handle Collect's petition for en banc rehearing and potentially decides to uphold, clarify, or alter the earlier decision may have big consequences for many patent portfolios, including whether detailed reviews of patents with PTA for OTDP issues and filing of terminal disclaimers in cases where the Office didn't itself raise the issue of OTDP is advisable.

In August 2023, the Federal Circuit decided an important case questioning how obviousness-type double patenting (OTDP) is impacted when the terms of two family-member patents that would otherwise expire on the same day are separated by patent term adjustment (PTA) added to the term of one of the patents. In re Collect, LLC, 81 F.4th 1216 (Fed. Cir. 2023). [...] Collect has now petitioned for en banc rehearing and has received support from several amici, including IPO, NYIPLA, and Bob Armitage.

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