

In Re Collect, A Big ToDo About Nothing

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On August 28, 2023, the Federal Circuit issued a precedential decision, *In Re Collect, LLC*. This decision considers several issues dealing with the law of Obviousness-type Double Patenting (“ODP”). Commentators suggest that this case provides significant new precedent and insight on patent prosecution, suggesting automatic filing of terminal disclaimers in later applications in a patent family. My view is that *Collect* elucidates nothing that was not already obvious. Specifically, whenever downstream application are filed, it has always been a consideration amongst sophisticated patent counsel whether claims in the related cases (related cases refers to applications and patents) were likely to be found obvious variations of one another. And it has always been a best practice to segment claims arguably non-obvious, by placing them in applications that do not contain claims likely to be found obvious variations of one another.

In *Collect*, all of the challenged patents had expired by the time the challenges were decided. And the challenged patents also had additional patent term, specifically Patent Term Adjustment (“PTA”). PTA is the type of additional patent term attributable to delays by the United States Patent and Trademark Office (“USPTO”) in issuing the application into a patent. However, one patent in the same family, the reference patent, had no PTA. The challenged claims in the challenged patents were obvious variations of the claims in the reference patent. And the challenged claims were held invalid for ODP in view of the reference patent.

In US practice, filing a terminal disclaimer in a patent or application which contains claims that are obvious variations of claims in some reference patent moots invalidity for ODP. The terminal disclaimer limits both the term of the patent to the natural term of the reference patent and limits enforceability of both patents to only when they are owned by the same legal entity. A terminal disclaimer has the effect of making both patents legally one patent.

In *Collect*, no terminal disclaimer had been filed before the terms of the challenged patents expired, so ODP was at issue. (The case was not moot because under US law damages for past infringement was at issue.)

With all of that background, my view is that *Collect* stands for the unremarkable propositions that claims that are found to be ODP are invalid, unless a terminal disclaimer was timely filed. Timely, here, meaning in response to rejection for ODP during prosecution, before a judgement in litigation asserting invalidity for ODP, and in any case during term of the patent. My writeup of the specifics of *Collect* appears my article here: "In re Collect, LLC, 2022-1293 et al. (Fed. Cir. 8/28/2023)" Rick Neifeld, September 11, 2023 available here: <https://www.neifeld.com/pubs/2023-08-28%20In%20Re%20Collect%202022-1293%20et%20al.pdf>