

**In Re Collect, LLC, 2022-1293, 2022-1294, 2022-1295, and 2022-1296 (Fed. Cir. 8/28/2023).**

This is a decision on appeals 2022-1293, 2022-1294, 2022-1295, and 2022-1296, from PTAB cases 90/014,453, 90/014,454, 90/014,455, and 90/014,457. Collect appealed PTAB decisions affirming unpatentability during reexamination of certain claims of four patents, for obviousness-type double patenting. The Federal Circuit affirmed.

This case is interesting factually because it identified one patent (issuing from the '036 application) that did not receive PTA, which was a member of a family of related applications. The reexamined patents issued from applications in this family, and had PTA, but their challenged claims turned out to be obvious variations of the claims issued from the '036 application. The patentee had failed to file terminal disclaimers in the asserted patents to avoid invalidity for invalidity for obviousness-type double patenting ("ODP").

**35 USC 101, double patenting, judicial doctrine of obviousness-type double patenting, unjustified timewise extension, expired patents**

The Federal Circuit concluded that challenged claims were obvious variations of the claims issued from the '036 application. The Federal Circuit therefore concluded that PTA extension of the term of the challenged claims was unjustified extension of patent term.

We agree with the USPTO that the Board did not err in determining that Collect received unjustified extensions of patent term. Neither Collect nor the USPTO disputes that the asserted claims in the challenged patents would have been obvious variations of the respective claims in the invalidating ODP references. The obviousness of the asserted claims in each of the challenged patents can be traced back to the '036 patent. That is the only patent in the family that did not receive a grant of PTA and that expired on October 6, 2017, twenty years from the date on which the priority application was filed. Therefore, any extension past that date constitutes an inappropriate timewise extension for the asserted claims of the challenged patents. To hold otherwise would, in effect, confer on the reference claims of the '036 patent PTA to which they were not entitled. We do, however, note that the non-asserted claims in the challenged patents are entitled to their full term, including the duly granted PTA, unless they are found to be later-filed obvious variations of earlier-filed, commonly owned claims. We have no basis for consideration of that issue here. [In re Collect, LLC, 2022-1293 et al. (Fed. Cir. 8/28/2023).]

The Federal Circuit concluded that lack of bad faith failed to moot unjustified timewise extension of term.

Collect argues that, because it acted in good faith and because the grant of PTA takes into account any actions on the part of the applicant that may exacerbate the USPTO's delay, 35 U.S.C. § 154(b)(2)(C), it should not lose out on

the grant of extra term that is required by statute. But there is no basis for an examiner to inquire into the intent of an applicant, or credit it. The ability of the applicant to show good faith during prosecution does not entitle it to a patent term to which it otherwise is not entitled. An applicant's ability to show that it did not engage in gamesmanship in obtaining a grant of PTA is not sufficient to overcome a finding that it has received an unjust timewise extension of term. [In re Collect, LLC, 2022-1293 et al. (Fed. Cir. 8/28/2023).]

The Federal Circuit concluded that invalidity for ODP of claims of an expired patent over a reference patent (in circumstances where no terminal disclaimer was filed in either patent) is not limited to portion of the term of the expired patent extending beyond the term of the reference patent.

We also agree with the USPTO that the question of invalidation of only the adjustment period raised by Collect on appeal is forfeited, as it was not raised before the Board. We further agree with the USPTO that, even if not forfeited, invalidation of only the adjustment would be tantamount to granting a retroactive terminal disclaimer, tying the expiration of the later-filed claims to the earlier-filed reference claims. A terminal disclaimer is not an escape hatch to be deployed after a patent expires. Collect had the opportunity to file terminal disclaimers during prosecution, even in the absence of an ODP rejection, yet it declined to do so. Now the challenged patents have expired, and the opportunity has passed. Invalidating only the adjusted term would in effect give Collect the opportunity to benefit from terminal disclaimers that it never filed. [In re Collect, LLC, 2022-1293 et al. (Fed. Cir. 8/28/2023).]

The Federal Circuit restated that Patent Term Extension (PTE under 35 USC 156) is added to the term of a patent subject to the truncated term defined by any terminal disclaimer.

Our case precedent has clearly delineated how a patent that has received PTE, a statutorily authorized extension, interacts with ODP, a doctrine that limits the term of a patent or, at least, ties later-filed, commonly owned, obvious variations to the expiration date of an earlier-filed reference patent. In *Merck*, we held that PTE is not foreclosed by a terminal disclaimer. 482 F.3d at 1322, 1324. That holding was based on the fact that, while § 156 does not expressly reference terminal disclaimers, it provides for other requirements that must be met to obtain a PTE and that the extension "shall" run from the expiration date of the patent, as adjusted under § 154(b) to account for any USPTO delays. *Id.* at 1321-22. We noted that § 154(b)(2)(B) expressly excludes patents in which a terminal disclaimer was filed from the benefit of a term adjustment beyond that disclaimed date for delays caused by the USPTO, but that no similar prohibition existed in § 156. *Id.* at 1322. We therefore concluded that the calculation of a grant of PTE on a patent that has a terminal disclaimer "is from the expiration date resulting from the

terminal disclaimer and not from the date the patent would have expired in the absence of the terminal disclaimer." *Id.* at 1322-23. [In re Collect, LLC, 2022-1293 et al. (Fed. Cir. 8/28/2023).]

Together, *Merck* and *Novartis* establish that ODP for a patent that has received PTE should be applied based on the expiration date (adjusted to a disclaimed date if a terminal disclaimer has been filed) before the PTE is added, so long as the extended patent is otherwise valid without the extension. For the first time, here, we address how another statutorily authorized extension, PTA, interacts with ODP. Even though both PTA and PTE are statutorily authorized extensions, and each serves to recover lost term, each has its own independent framework established through an independent statutory schema. [In re Collect, LLC, 2022-1293 et al. (Fed. Cir. 8/28/2023).]

The Federal Circuit in dicta stated that any other claims in the same patents for which claims found invalid for ODP, if non obvious over the claims of the reference patent, “were entitled to their full term, including the duly granted PTA.”

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Note: The statement that “non-asserted claims in the challenged patents are entitled to their full term, including the duly granted PTA, unless they are found to be later-filed obvious variations of earlier-filed, commonly owned claims” is dicta. My take is that patent applicant’s should not rely upon this statement when considering whether to place claims that are non-obvious over claims in a reference patent in a separate application to immunize them from ODP.