The Honorable Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Re: Docket No. PTO-P-2024-0003; Terminal Disclaimer Practice to Obviate Nonstatutory Double Patenting

Under Secretary Vidal:

Introduction – USPTO Regulatory Authority and Scope of Present Submission

This submission is offered in response to the USPTO Notice of Proposed Rulemaking on Terminal Disclaimer Practice to Obviate Nonstatutory Double Patenting, published at 89 Fed. Reg. 40439-40449 on May 10, 2024. The Federal Register notice indicated that the USPTO was seeking to promulgate “practice and procedure, and/or interpretive rules” that “do not require notice-and-comment rulemaking.” The Office cites to authority for the Office to “advise the public of the agency’s construction of the statutes … which it administers.” [Emphasis added.]

In accordance with this notice, the comments below are limited to the responsibility of the Office to promulgate practice and procedure regulations pursuant to two statutes, specifically §3(b)(2) of the Leahy-Smith America Invents Act1 (herein the “AIA”) and §532(a)(1) of the Uruguay Round Agreements Act2 (herein the URRAA). To this end, this submission additionally references relevant legislative work in connection with the Patent Law Amendments Act of 19843 (herein the “PLAA”) and the CREATE Act.4

To the extent that the USPTO is proposing practice and procedure rules that could bar issuance of a patent, but rules that are not based upon the interpretation of either an explicit or an implicit statutory requirement (such as those from AIA §3(b)(2) or derived from a new statute (the URRAA §532(a)(1)), the Office runs the risk of regulating outside any proper authority to do so. For example, there would appear to be little dispute that the Office lacks authority to impose via regulation new, arbitrary, non-statutory requirements, in connection with securing a patent, that would flatly contradict controlling statutory provisions.5

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3 Pub. L. No. 98-622, 98 Stat. 3383 (1"
55 The comments below do not address the merits of the proposed rule requiring a disclaimer of enforceability of a double patent upon invalidation of a claim in the reference patent, given the proposed regulations appear on their face to constitute a new, arbitrary, non-statutory requirement in connection with securing a patent and flatly contradict explicit statutory provisions, including 35 U.S.C. §282(a) providing that each claim in each patent is to be
Summary of Submission

The current USPTO rulemaking, at the very minimum, should implement the statutory directive in AIA §3(b)(2). To implement this directive most efficiently and transparently, the Office should mandate that each patent applicant (or each patent owner) to which AIA §3(b)(2) is applicable, must separately file a disclaimer of separate enforceability, with one such disclaimer filed in the reference patent and another in the double patent. As to the content of the separate enforceability disclaimers, the Office should exercise its interpretative authority to require that such a disclaimer of separate enforcement should preclude the enforcement of either the reference patent or the double patent involved in the obviousness-type double patenting to the extent—and only to the extent—that res judicata principles would have barred an enforcement action had all the claims of the involved patents been instead issued in a single patent.

While AIA §3(b)(2) requires a “separate enforceability” disclaimer of this type only for patents subject to the CREATE Act, the USPTO should again exercise its interpretative rulemaking authority to require this same form of “separate enforceability” disclaimer in all situations of obviousness-type double patenting, thereby replacing and superseding the currently mandated disclaimer of separate ownership applicable to non-CREATE Act obviousness-type double patenting. Universal use of such a “separate enforceability” disclaimer is appropriate because it would more accurately and completely address the “potential for harassment” concerns arising in any obviousness-type double patenting circumstance and simplify disclaimer practice rules.

In addition, consistent with URAA §532(a)(1), which enacted into law a new 35 U.S.C. §154, the USPTO should forego any mandate for any disclaimer of term in cases of obviousness-type double patenting, with the possible exception of when the combined period of exclusive rights (i.e., the period from the issue date of the first-issuing patent to the expiration date of the later-expiring patent), exclusive of any patent term adjustment or extension under 35 U.S.C. §154 or §156, would exceed 20 years. The sole situation in which the Office should determine whether the statute mandates such a disclaimer is when a non-continuation “double patent” results in an aggregate period of exclusive rights for the involved patents of greater than 20 years.

The USPTO’s authority to establish practices and procedures by rulemaking should be confined to assuring that all conditions Congress has established as necessary to allow a valid patent to issue have been met. With the enactment of AIA §3(b)(2) and URAA §532(a)(1), the Office would have accomplished this objective under the rulemaking outlined above, while not precluding a patent applicant from making such additional disclaimers as might be desired—including to address any nonstatutory concerns over the ability to enforce a double patent in the courts, e.g., by filing a disclaimer of separate ownership or term not otherwise required.

Under the rulemaking proposed above, the USPTO would assure that double patenting could not result in the ability to enforce exclusionary rights in the involved patents, to a greater extent or for a longer exclusivity period, than would have been possible had only a single patent issued containing all the involved claims. The doctrine demands no more and neither should the Office.

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independently presumed to be valid. The comments herein are premised, however, on the unexamined assumption that the Office has the asserted rulemaking authority and endeavor to identify how this effort might best proceed.
The USPTO’s notice indicated that it was undertaking “interpretative” rulemaking. Specifically, the notice described rulemaking of a “practice and procedure” nature. At least in part, the Office suggested a purpose of such rulemaking could be to “advise the public of the agency’s construction of the statutes … which it administers,” quoting from *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336–37 (Fed. Cir. 2008). [Emphasis added.]

The title of the Federal Register notice references “nonstatutory double patenting,” which, at best, could be potentially confusing, if the Office were attempting to advise the public of its construction of a statute. The Federal Register notice does, however, attempt to address this potential for confusion by indicating that the term “nonstatutory double patenting” is intended to reference the law on obviousness-type double patenting. The Office asserts that “obviousness-type double patenting [is] also referred to as nonstatutory double patenting.”

The USPTO’s suggested equivalency between what it terms “nonstatutory double patenting” and “obviousness-type double patenting” would not appear to be entirely accurate. At least since the enactment of the AIA, the law on obviousness-type double patenting does have a statutory component. Moreover, the statutory component is relevant to the Office’s rulemaking here because that statutory component includes a directive to the Office on the practices and procedures applicable in certain circumstances in which obviousness-type double patenting arises.

As noted above, the comments in this submission will be limited to the statutory provisions in AIA §3(b)(2) and URAA §532(a)(1) that are relevant to practices and procedures in the USPTO—and the stated objective in the Federal Register notice that the Office wishes to exercise what it has terms is its interpretive authority. These comments are offered based on the premise that obviousness-type double patenting rulemaking by the Office—at least in 2024—cannot proceed without, at a minimum, addressing how best to implement the statutory aspects of obviousness-type double patenting law enacted more than a decade ago by Congress.

**Background – The Statutory Law Relevant to Obviousness-Type Double Patenting**

The statutory law that is relevant to obviousness-type double patenting comes in two forms. One form is through a *statute per se*—as through a public law, which—in this case—is the AIA and the URAA. The other is through a statute’s legislative history, particularly where the legislative process has provided an affected agency with express and specific direction as to its practices and procedures, as an adjunct to the enactment of the statute itself. Where Congress has directed the USPTO to establish practices and procedures needed to implement a new statute—whether in the statute itself or through legislative history—it becomes difficult to argue that the agency does not have inherent rulemaking authority to address what Congress has directed.

With respect to the latter point, Congress has, from time to time, directed the USPTO to address obviousness-type double patenting issues in quite specific ways, specifically as to the practices and procedures for the Office’s conduct of the examination of applications for patent. The first

The Committee expects that the Patent and Trademark Office will reinstitute in appropriate circumstances the practice of rejecting claims in commonly owned applications of different inventive entities on the ground of double patenting. This will be necessary in order to prevent an organization from obtaining two or more patents with different expiration dates covering nearly identical subject matter. In accordance with established patent law doctrines, double patenting rejections can be overcome in certain circumstances by disclaiming the terminal portion of the term of the later patent, thereby eliminating the problem of extending patent life.

Congress, through this *practices-and-procedures* legislative history, directed the USPTO to interpret obviousness-type double patenting law in a more expansive manner than in the Office’s 1967 interpretative guidance, declaring “‘double patenting’ is properly applicable only to cases involving two or more applications and/or patents of the same inventive entity.” See 849 O.G. 1615 (January 31, 1967). The response of the USPTO was full acquiescence to this *practices-and-procedures* directive. In the Manual of Patent Examining Procedure, the Office offered the categorical declaration that “[t]he Patent and Trademark Office has withdrawn the Commissioners Notice of January 9, 1967, Double Patenting, 834 O.G. 1615 (Jan. 31, 1967).” M.P.E.P. 804.03, Rev. 6.2 (July 1996) at p. 800-25.

As noted above, not all congressional *practices-and-procedures* directives to the USPTO on the interpretation to be given to the law on obviousness-type double patenting have been through legislative history. The most recent congressional direction has been statutory.

In an historically unprecedented legislative act, Congress elected—for the first time in the 220 years of enacting patent statutes—to explicitly address obviousness-type double patenting law as part of the AIA. Under the AIA, §3(b)(2) provides specific, interpretative direction to the USPTO that should guide any related and relevant rulemaking effort. Moreover, as a statutory directive, not merely a statement of legislative intent, AIA §3(b)(2) now self-evidently operates to limit the Office’s options in exercising any interpretative authority as it proceeds with practices-and-procedures rulemaking on obviousness-type double patenting issues. The relevant portion of the AIA reads as follows:

(2) CONTINUITY OF INTENT UNDER THE CREATE ACT.—The enactment of section 102(c) of title 35, United States Code, under paragraph (1) of this subsection is done with the same intent to promote joint research activities that was expressed, including in the legislative history, through the enactment of the Cooperative Research and Technology Enhancement Act of 2004 (Public Law 108–453; the “CREATE Act”), the amendments of which are stricken by subsection (c) of this section. The United States Patent and Trademark Office shall administer section 102(c) of title 35, United States Code, in a manner consistent with the legislative history of the CREATE Act that was relevant to its...
administration by the United States Patent and Trademark Office. [Emphasis added.]

The legislative history that is relevant to the USPTO administration of the CREATE Act (introduced as S. 2192, by Senator Orrin Hatch on March 10, 2004) is the sponsor’s floor statement. The Hatch floor statement was made on June 25, 2004 and appears in the Congressional Record at S7520-S7522. The portions relevant to AIA §3(b)(2) are reproduced below (emphasis added):

The Patent Law Amendments Act of 1984 first created the opportunity for double patenting for patents issued to different inventors that were owned by one entity or which were commonly assigned. In the legislative history for the Patent Law Amendments Act of 1984, Congress indicated its expectation that any newly created opportunities for double patenting would be treated no differently than double patenting for patents issued to the same inventor. We do the same today with respect to the remedial provision in the CREATE Act, but discuss the form of disclaimer that is required of the patent owner whenever double patenting exists.

At its core, the double patenting doctrine addresses the situation where multiple patents have issued with respective claims in the different patents that meet one or more of the relationship tests set out by the courts. Double patenting can arise when the two involved patents are determined not to relate to independent and distinct inventions. It can also arise if a claim in a later-issued patent would not be novel with respect to a claim in a first-issued patent. A third type of double patenting—and perhaps the most common—is where a claim in a later-issued patent is obvious in view of a claim in a first-issued patent. Whatever the relationship that forms the basis for the double patenting, the current principles governing double patenting should be applied to all such situations involving the issuance of double patents where the provisions of the CREATE Act apply.

The double patenting doctrine exists as a matter of policy to prevent a multiplicity of patents claiming patentably indistinct inventions from becoming separately owned and enforced. Thus, it applies to situations where multiple patents have issued, even if the patents are filed on the same day, issue on the same day and expire on the same day. All that is required for double patenting to arise is that one or more claims in each of the involved patents is determined to represent double patenting under established principles of law. The double patenting doctrine can invalidate claims in any later or concurrently issued patent if those claims are determined to represent double patenting with respect to any of the claims in a first-issued patent. For clarity, any later or concurrently issued patent that creates double patenting can simply be termed a “patentably indistinct patent” with respect to the first-issued patent.

Invalidity of the patentably indistinct claims under the doctrine of double patenting can be avoided, however, if an appropriate disclaimer is filed in the
patent containing those claims. Under existing practice in the U.S. Patent and Trademark Office, the disclaimer must be filed in the patent with the patently indistinct claims and must reference the first-issued patent against which the disclaimer applies. Thus, the disclaimer only affects the ability to enforce the disclaimed patent, and historically has not affected the enforceability of the first-issued patent against which the disclaimer has been made. Accordingly, under existing double patenting principles, if the indistinct patent becomes separately owned, i.e., such that it can be separately enforced, the disclaimed patent is rendered invalid in accordance with the terms of the required disclaimer, while the first-issued patent’s enforceability is unaffected.

Patents issued after enactment of the CREATE Act will be enforceable in the same manner and to the same extent as when patents are issued to a common owner or are subject to common assignment. One modification of existing disclaimer practice, however, is needed for double patenting to achieve its policy objectives where the CREATE Act applies. The CREATE Act will now permit patents with patently indistinct claims to be separately owned, but remain valid. Heretofore, this separate ownership would have rendered the indistinct patent invalid. To protect the public interest, these separately owned patents must be subjected to a new form of disclaimer that will protect the public against separate actions for enforcement of both the first-issued patent and any patents with claims that are not patently distinct over the claims of the first-issued patent.

Accordingly, in every situation where double patenting is created based upon revised section 103(c), the patently indistinct patent must include a disclaimer that will require the owner of that patent to waive the right to enforce that patent separately from the first-issued patent. The disclaimer also must limit, as is required for all disclaimers related to double patenting, the disclaimed patent such that it can be enforced only during the term of the first-issued patent.

Additionally, the disclaimer required for the valid issuance of a patently indistinct patent pursuant to the CREATE Act must apply to all owners of all involved patents, i.e., the owner of the patently indistinct patents as well as any owners of any first-issued patents against which the disclaimer is made. In order for this to be the case, the CREATE Act effectively requires parties that separately own patents subject to the CREATE Act to enter into agreements not to separately enforce patents where double patenting exists and to join in any required disclaimer if the parties intend to preserve the validity of any patently indistinct patent for which a disclaimer is required.

To give effect to this requirement, the disclaimer in the patently indistinct patent must be executed by all involved patent owners, as the right to separately enforce the first-issued patent apart from the patently indistinct patent cannot be avoided unless the owner of the first-issued patent has disclaimed its right to do so. If an enforcement action is brought with respect to a patently indistinct
patent, but the owner of the first-issued patent was not a party to the disclaimer, and had not disclaimed separate enforceability of the first-issued patent once an enforcement action had been commenced on the indistinct patent, the owner of the first-issued patent could not legally be prevented from bringing a later action for infringement against the same party absent disclaiming the right to do so. Thus, the disclaimer of the separate enforceability of an indistinct patent cannot be assured unless the owner of a second indistinct patent has an agreement with the owner of the first-owned patent prohibiting the right of separate enforcement. The CREATE Act will not require the owner of a first-issued patent or an indistinct patent to enforce any such patent. Rather, the prohibition against separate enforcement described above is necessary to address the sole policy objective of preventing different patent owners from separately enforcing a first-issued patent and a related indistinct patent.

Also as indicated in the House report, we expect the U.S. Patent and Trademark Office to take such steps as are necessary to implement the requirements of this act in the manner we have described. In particular, the Patent and Trademark Office should exercise its responsibility for determining the necessity for, and for requiring the submission and recording of, disclaimers in patent applications and to promulgate such regulations as are necessary including, inter alia, rules analogous to 37 CFR § 1.321, that requires disclaimers in patent applications where double patenting exists. To meet the requirements of the act, the parties to the joint research agreement must agree to accept the conditions concerning common term and the prohibition against separate patent enforcement and all involved parties must agree to be signatories to any required terminal disclaimer. I do not believe any particular form need be followed to give effect to this requirement, and that the Office will address these issues pursuant to its implementation of the act. [Emphasis added throughout.]

Given that the USPTO is currently proposing practice and procedure rules covering the content of disclaimers in cases of obviousness-type double patenting, one overarching imperative of the current rulemaking should be to address the statutory directives enacted under the AIA. Since the enactment of the AIA was in 2011—more than a dozen years ago—there should be a special urgency, in the course of any relevant, active rulemaking efforts, to reflect this outstanding statutory dictate.

In this regard, the AIA directive to the USPTO is—if nothing else—clear-cut. The Office was mandated to implement practices and procedures providing, in certain circumstances, that all involved parties participate as signatories to the required disclaimer of separate enforcement in cases of obviousness-type double patenting. Under the AIA, this requirement for securing a valid patent was dictated in each circumstance where the involved patents (i.e., both the “reference patent” and the “double patent” issued with patentably indistinct claims) are not commonly owned. Specifically, these are the obviousness-type double patenting situations that arise for patents subject to the CREATE Act, which eliminated the “reference patent” claims as prior art under 35 U.S.C. §103 to facilitate issuance of the “double patent.”
It would appear incongruous in the extreme for the USPTO to publish proposed *practice and procedure* rules on a narrow, specialized aspect of the Office’s examination practices (i.e., the content of the disclaimer necessary to obviate a rejection on obviousness-type double patenting grounds) with proposed rules limiting the enforceability of a double patent, yet fail to incorporate into such proposed rules an unambiguous “dual disclaimer” requirement as that mandated under the AIA. Thus, as an exercise of its practice-and-procedure authority, interpreting a statutory mandate, it would seem essential for the Office to address—and ensconce in its regulations—the statutory directive in AIA §3(b)(2).

*Opportunity to Mandate Universal Use of a “Separate Enforceability Bar” in ODP*

**Use of Separate Disclaimers in the Reference Patent and the Double Patent**

Within the ambit of the AIA §3(b)(2) statutory dictate, the USPTO’s interpretative authority could assure that both involved patent owners of the CREATE Act patents either join together in a single disclaimer document—or, equivalently, each file the required form of disclaimer in separate disclaimer documents. Although both parties must join in a disclaimer to satisfy AIA §3(b)(2), AIA §3(b)(2) does not require that this be accomplished through a single document.

In a similar vein, the USPTO could require not only *separate disclaimer documents*, but further require that those documents be *separately filed*, one in connection with the reference patent by its owner and a second in connection with the double patent by its owner. This separate-documents, separate-filings approach has the self-evident benefit of more complete public notice of the status of each of the patents involved in the obviousness-type double patenting.

Thus, if it does nothing more, the USPTO should consider mandating AIA §3(b)(2) disclaimers be filed separately—one in connection with the reference patent and a second in connection with the double patent. This would fully inform the public that neither of the involved patents could be separately enforceable from the other.

As noted above, the form of disclaimer under the current regulations does not do so. As explained in the legislative history for the CREATE Act, the dual disclaimer practice is essential so the once the owner of the double patent had secured damages for patent infringement, the separate owner of the reference patent would be bound by any disclaimer of enforceability and would be unable to assert a claim for damages for the very same acts of infringement.

**Use of “Separate Enforceability” Disclaimers to Supersede Alienation Disclaimers**

As the USPTO proceeds to implement the AIA §3(b)(2) mandate that the above form of disclaimer be required by owners of both the reference patent and the double patent to obviate a

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6 For CREATE Act patents, under current USPTO regulations, the exact form of separate enforcement disclaimer appears at 37 C.F.R. § 1.321(d)(3) and timewise limits the enforceable rights under the double patent to only the period before which, if ever, the patents are “separately enforced.” This regulation reads in relevant part that such a disclaimer must “[i]nclude a provision waiving the right to separately enforce [the double] patent … and the [reference] patent…, and that [the double] patent … shall be enforceable only for and during such period that [the double] patent and the [reference] patent … are not separately enforced.
rejection on obviousness-type double patenting grounds, it would be the ideal opportunity for the Office to consider whether this form of “separate enforcement” disclaimer might be employed universally. Congress has already determined that such a form of disclaimer is sufficient to address all issues of “potential harassment” in cases of obviousness-type double patenting “potential harassment” issues—at least in cases where the reference and double patents are not commonly owned. On policy grounds, therefore, this form of disclaimer should a fortiori address any and all “potential harassment” issues in cases where the reference and double patents were initially commonly owned.

The entire purpose of the “common ownership” limitation was to prevent harassment should the involved patents that were initially commonly owned ever become separately owned—such as all CREATE Act patents. Once AIA §3(b)(2) dictated that all the policy issues arising in cases of separate ownership can be fully addressed through a disclaimer of separate enforcement, there could be no legal, policy, or logical reason not to address all obviousness-type double patenting situations through this very same form of disclaimer.

Indeed, nothing in the AIA would preclude the Office’s implementation of AIA §3(b)(2) by making universal use of a “separate enforceability” bar—which would supersede any use of the current alienation disclaimer—because the “separate enforcement” disclaimer would specifically address “potential harassment” policy once the involved patents were no long commonly owned. Universal use of such a separate enforcement waiver could introduce a greater simplicity and efficiency compared to the existing regulations specifying separate types of disclaimers depending upon the source of the double patenting. In addition, the result would be greater uniformity in the treatment of the involved patents. If implemented by requiring separate disclaimer documents in both involved patents, the notice function in cases of obviousness-type double patenting would be enhanced.

**Defining “Separate Enforcement” Disclaimers Using Res Judicata Principles**

Assuming that the USPTO proceeds with the universal use of a disclaimer of separate enforcement—and no longer requires a disclaimer of separate ownership—the present rulemaking effort, the Office should address the further question of the scope and content of the required disclaimer. The present rulemaking should address how best to constitute the disclaimer of separate enforcement to meet the objectives described in the CREATE Act legislative history.

As noted above, a disclaimer of separate enforcement as required under the CREATE Act was never intended to mean that only one of the two patent owners could ever enforce the involved patents. Some examples are illustrative:

- If the owner of the reference patent sued alleged infringer A, then a CREATE Act-compliant disclaimer should not preclude the owner of the double patent from separately bringing an infringement action against an alleged infringer B.

- The disclaimer of separate enforcement was likewise not intended to preclude serial infringement actions against alleged infringer A, at least in the situation where a first
enforcement action was brought alleging the reference patent infringed a device X, prior to a second enforcement action alleging the reference patent infringed an unrelated device Y.

- Similarly, if the double patent holder is successful in enforcing the double patent against infringer A, then the reference patent holder ought to be able to bring a second infringement action against infringer A if the infringing subject matter has been modified to avoid the double patent, but would nonetheless infringe valid claims of the reference patent.

In the case of separately owned patents, the disclaimer barring separate enforcement that was envisioned in the legislative history of the CREATE Act was a res judicata-like bar on separate enforcements. Such a disclaimer applies to bar a second enforcement action in the same manner res judicata principles would, had only a single patent issued containing all the claims of the two patents.

This type of res judicata bar, as applied to CREATE Act patents, should—on policy grounds—apply equally to all situations in which obviousness-type double patenting is present, i.e., specifically to the situation where the patents involved are—and remain—commonly owned. Indeed, the “potential for harassment” policy concern in cases of obviousness-type double patenting is only partially addressed in barring separate ownership of the involved patents. This policy objective is more clearly, if not more fully, addressed by eliminating the potential for serial enforcement actions that would have been categorically barred on res judicata grounds had all the claims of the two patents been issued instead in a single patent.

Were the USPTO to adopt a unified disclaimer of separate enforcement applicable to all types of obviousness-type double patenting, it could accomplish this result with a remarkably simple rule—and it could be implemented by requiring the filing of remarkably simple disclaimer documents. Such a unified practice would require no detailed explanation or examples as to how the disclaimer would operate in practice. The well-established res judicata principles would speak for themselves.

In addition, it would be challenging for critics of such a res judicata approach to argue unfairness—that multiple “apple bites” into an accused infringer should be permitted in circumstances where the issuance of just a single patent containing all the patentably indistinct claims would have confined the patent owner or owners to just a single bite. Lastly, such a separate enforcement disclaimer should have effect in relatively rare situations, largely where a patent owner is amassing a “patent thicket” with the potential for serial assertions of patentably indistinct claims, e.g., where—following a failed infringement action—a second patent infringement action was brought on a subsequently issued continuation patent containing patentably indistinct claims.

Opportunity to Eliminate, At Least in Part, Disclaimers of Term Based on Double Patenting

The URAA Justified Up to at Least 20 Years of Exclusive Rights for any Invention
Were the USPTO to move forward with such a unified separate-enforceability disclaimer, a second question would then become ripe for the Office to consider. What more can the Office demand, consistent with the patent statute, before allowing a patent to be issued? Would a “separate enforceability” disclaimer be the only form of disclaimer that would be consistent with the 2024 patent statute—or would the extant statute require something more?

Prior to the enactment of the URAA, the “what more” question was trivial to address. As long as patents were issued for 17-year terms and the 17-year term commenced only when a patent initially was issued, any later-issued “double patent” provided a period of exclusive rights exceeding the congressionally justified period of 17 years for any single patent. If nothing else, the U.S. Constitution would demand that this loophole be remedied for a patent statute to satisfy the “limited Times” clause of Article I, Section 8, Clause 8.7

The URAA obviated this constitutional defect through two salient ways. First, the URAA rejected the notion that no more than a 17-year period for an inventor’s exclusive rights for any particular discovery could be justified. Under the URAA §532(a)(1), the period justified for exclusive rights for any single patent was increased to a period of up to 20 years.8 For an initial, nonprovisional patent filing, this full 20-year period is reduced only by the Office’s application processing time.

Second, the URAA set a cap on the combined period of exclusionary rights that could be secured through multiple patents containing patentably indistinct claims. This was done in two ways. In the case of “continuation application double patenting” (the double patent is a continuation application claiming the benefit of the filing date of the reference patent), the URAA did not just permit the involved patents to secure the same period of up to 20 years of exclusive rights, but it set this 20-year period as a cap on the combined period of exclusive rights under the involved

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7 Indeed, if nothing else, a disclaimer of term beyond the 17-year period of exclusivity rights would have been demanded on constitutional grounds. The ability to secure serially issued continuation patents, each with its own 17-year period of exclusive rights, meant that there was no “limited Time” confining protection for patentably indistinct claims. The pre-URAA “disclaimers of term” addressed this constitutional issue. Today, unlike in the pre-URAA era, double patenting law serves no constitutional purpose for URAA patents.

8 URAA §532(b)(2) provides that, except for the required USPTO processing time, an inventor is entitled to secure a period of 20 years of exclusive rights in a patented discovery, upon filing of a nonprovisional application for patent. Under the URAA, Congress even provided a mechanism through which securing the full 20-year period of exclusionary right might be routinely possible in the course of USPTO examination. The USPTO itself could help routinely secure this outcome. The Office has already instituted Track One Prioritized Examination designed to assure that a such a nonprovisional patent application could have a final determination of patentability completed within one year. For such a fully examined and ready-to-issue application, it could be converted to a provisional application, once that examination was completed. This provisional application could then serve as the basis for priority of a further nonprovisional application, filed at the end of the converted provisional application’s priority year. This nonprovisional application could be in condition for an immediate eGrant upon filing, i.e., with respect to the already examined and found-to-be-patentable claims. Proceeding with a date-of-filing eGrant would produce exclusive rights with a full 20-year duration. Even without this type of razzle-dazzle—converting a Track One nonprovisional application—prioritized examination offers the prospect for thousands of inventors each year to secure patent with 19 years of exclusive right or longer. The URAA’s intent that exclusive rights under a patent should no longer be restricted to the pre-URAA 17 years is further evident from 35 U.S.C. §154(c)(1), providing for up to 20 years of exclusive rights for certain pre-URAA issued patents. The URAA cannot be read in any other manner than to provide inventors up to a 20-year period of exclusive rights, diminished only by the USPTO processing time.
The only possible exceptions to this 20-year cap are found in the patent term adjustment and patent term extension (35 U.S.C. §154(b) and §156) provisions of the patent statute. Both of these exceptions specify additional “limited Times” that Congress separately justified.

For non-continuation patents constituting obviousness-type double patenting, the URAA’s new patent term provides a somewhat longer cap on the combined period of exclusive rights. The period for exclusive rights available for any non-continuation collection of patents containing patentably indistinct claims can be no longer than 22 years.

Aside from the extension or adjustment of patent term under 35 U.S.C. §154 or §156, the only way in which the combined period of exclusive rights for non-continuation URAA patents can exceed the URAA’s potential for up to 20 years of exclusive rights for any single patent is if a patent issues on a claimed invention and, thereafter, a new nonprovisional patent filing is made on some obvious variant of it that takes advantage of either or both of the inventor’s one-year “grace period” (to the extent still available) and the one-year provisional filing period. By maximizing both a “grace period” and the provisional filing period, the involved patents can theoretically add up to two additional years of exclusive rights from the issue date of the earlier-issuing patent to the expiration date of the later-expiring patent.

As a result, the upshot of the URAA §532(a)(1) was to both close the constitutional loophole in the patent statute arising from the possibility of unlimited, sequential, 17-year terms and set a new benchmark for the justified period for exclusive rights. As noted above, the benchmark satisfied the need for a constitutionally required “limited Time” by allowing to protect an inventor’s discovery for a time-limited exclusivity period. The URAA dictated separate “limited Times” for any single patent or a set of continuation patents, on the one hand, and for any non-continuation collection of patents with patentably indistinct claims, on the other. The former period was set at up to 20 years and the latter could not exceed 22 years.

The URAA Created the Possibility for Removing Any Required Disclaimer of Term

All of the consequences of obviousness-type double patenting law relating to the duration of an inventor’s exclusive rights are built on the policy premise that Congress, for any single patent, has only justified exclusive rights for a limited period—and that limited period for exclusive rights justified for any single patent must not be unjustifiably, extended in a timewise manner on account of patentably indistinct inventions being spread among a multiplicity of patents. For over a century, as noted above, obviousness-type double patenting required a trivial policy exercise because no single patent was entitled to more than a statutory term producing 17 years of exclusive rights—and double patenting could represent an unjustified timewise extension of this 17-year period.

Since 1994, Congress has justified more—not less—than this 17-year exclusivity period for any single patent. As noted above, the URAA §543(b)(2) expressly justified providing inventors a period of up to 20 years of exclusive rights for any single patent. Current USPTO regulations, however, require disclaimers of term in circumstances where the combined period of exclusive rights of the involved patents is not only shorter than 20 years, but shorter in duration than 17
years. The current rulemaking, therefore, is an opportunity—however belated—to align the Office rulemaking with this 30-year-old statute.

Manifestly, the Office could limit the requirement for any disclaimer of term to situations involving double patenting where the aggregate period of exclusive rights might exceed the 20-year period of exclusive rights that the URRA justified for any single patent. Were the Office to do so, the requirement for a disclaimer of term could disappear entirely for all continuation-application double patenting.

This potential for a total disappearing act is possible because the only way in which a period of exclusive rights of greater than 20 years can be realized in the case of continuation-application double patenting is if, following the common expiration date of the two patents, a congressionally justified extension or adjustment of patent term exists, i.e., a patent term adjustment under 35 U.S.C. §154 or a patent term extension under 35 U.S.C. §156.9 By their very nature, these special statutory provisions fall outside any obviousness-type double patenting policy concern over an unjustified timewise extension of exclusive rights because Congress justified the “limited Times” for the period of adjustment or extension that is possible under these statutes.

Eliminating disclaimers of term from continuation application double patenting would leave, as the only residual disclaimer issue, the question of whether a 22-year period of exclusive rights—potential available for non-continuation application double patenting—was justified by Congress.10 If the Office were to conclude that the proper interpretation of the patent statute was that these provisions could result in an unjustified timewise extension of the 20-year period, a disclaimer of term should be required by regulation to obviate this possibility. If not, then there should be no circumstance under URRA §532(b)(2) in which a disclaimer would be appropriate.

The USPTO Should Confine Double Patenting Rules to Statutory Dictates Alone

When the USPTO is engaged in statutory interpretation rulemaking, it should specify only those practices and procedures that are necessary for issuing a patent, consistent with the statute. Here, AIA §3(b(2) lays out an unambiguous requirement for disclaimers of separate enforceability that neither the current rules nor the proposed rules implement. One aspect of the present rulemaking should correct this situation. This will require changes in disclaimer practices and the procedures needed to require such disclaimers.

Similarly, URRA §532(a)(1) reflects that any single patent is entitled to a congressionally justified period of exclusionary rights of up to 20-years, subject to USPTO processing time. A

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9 When two URRA patent application are copending before the Office, such that one of the applications issues as a patent after the 20-year patent term has commenced, the aggregate period of exclusive rights, aside from any adjustment or extension of term available, will be less than 20 years—because the later-issued patent will expire less than 20 years from the issue date of the previously copending patent application. Thus, the sole circumstance in which the 20-year limitation can arise is with the later-issued patent having a filing date that is after the issue date of the earlier-issuing patent, which is a possibility solely on account of either the inventor’s one-year “grace period” or the use of a provisional patent filing or both.

10 As noted above, these are double patenting situations arising where the double patent filing arose from an inventor’s use of the one-year “grace period” or the provisional patent application “priority year.”
second aspect of the present rulemaking should align the required disclaimer of term practice to eliminate any need for a disclaimer of term that would result in cases of double patenting a lesser aggregate period of exclusionary rights than any single patent could be entitled to receive. The statute itself does not demand more—and neither should the Office’s interpretation of the statute.

By regulating what is necessary under the statute, the USPTO would not preclude patent applicants from making judgments on what an individual applicant might deem is sufficient to assure a patent could be successfully enforced. The rulemaking described above would leave open opportunities for patent applicants to disclaim more than what such regulations might require, possibly in anticipation that the courts might insist on something more or different to obviate invalidity on obviousness-type double patenting grounds.

For this reason, any USPTO rulemaking should not preclude an applicant additionally disclaiming enforceability of a double patent in the event that the reference patent was to be separately owned. Similarly, the Office should not preclude an applicant from making a disclaimer of term under 35 U.S.C. §325(a), notwithstanding that no regulation would have rendered such a disclaimer necessary before a patent could be issued.

Conclusions

The USPTO is to be commended for proposing rules to address practices and procedures in connection with disclaimers in situations where obviousness-type double patenting is present. Such rulemaking is sorely needed to conform the regulations of the Office to the extant patent statute.

That said, the Office should select a different starting point for the present effort. The statutory mandates in AIA §3(b)(2) and URAA §532(a)(1) should be prioritized—moved front and center in this rulemaking effort. Were that to be done, it should prove to be all that needs doing to address all the policy issues arising in cases of obviousness-type double patenting.

Respectfully submitted,

[Signature]

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