UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE APPEALS REVIEW PANEL OF THE PATENT TRIAL AND APPEAL BOARD

Ex parte NICOLAS BAURIN, CHRISTIAN BEIL, CARSTEN CORVEY, CHRISTIAN LANGE, DANXI LI, VINCENT MIKOL, ANKE STEINMETZ, and ERCOLE RAO

Appeal 2024-002920
Application 17/135,529
Technology Center 1600

BRIEF OF CANON INC., H. LUNDBECK A/S, NAGRA KUDELSKI GROUP, NOKIA CORPORATION, RINGCENTRAL, INC., SONOS, INC., AND SUTRO BIOPHARMA, INC. AS AMICI CURIAE

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I. INTEREST OF THE AMICI CURIAE

Amici Canon Inc., H. Lundbeck A/S, Nagra Kudelski Group, Nokia Corporation, RingCentral, Inc., Sonos, Inc., and Sutro Biopharma, Inc. are industry leaders operating across technology sectors, including imaging, audio equipment, telecommunications, digital security, pharmaceuticals, and biotechnology. Because a material portion of the value created by the amici flows from their investments into research, development, and the creation of technology, amici have an interest in a well-run, predictable patent system that fairly rewards investments in innovation.

II. INTRODUCTION AND SUMMARY OF THE ARGUMENT

The Board correctly concluded—twice now—that later-filed, later-expiring patents cannot serve as proper obviousness-type double patenting ("OTDP") references to invalidate earlier-filed, earlier-expiring patents. This conclusion flows directly from the Federal Circuit's reasoning in *Allergan USA, Inc. v. MSN Laboratories Private Ltd.*, 111 F.4th 1358 (Fed. Cir. 2024), and is the only interpretation consistent with the fundamental purpose of the OTDP doctrine: preventing unjustified timewise extensions of patent exclusivity. The Examiner's argument to the contrary asks this Panel to turn the OTDP doctrine on its head, wielding a tool designed to prevent extensions of patent term as a weapon to destroy lawfully earned patents. This result would destabilize patent portfolios across every technology sector, chill investment in research and development, and punish the very innovation the patent system exists to promote. Amici present two primary arguments in support of their position:

First, the underlying principles of OTDP set forth in *Allergan* control the outcome here, even though there are factual differences between the cases. The Federal Circuit grounded its analysis in OTDP's bedrock purpose—preventing a patentee from obtaining a *second, later-*

expiring patent to extend the life of a *first* patent to that subject matter—and that purpose must control the outcome of this case. Despite the Examiner's cries of impossibility, *Allergan* and its progeny teach that the PTO must consider both a patent's expiration date and its filing date when determining whether a patent is a proper OTDP reference.

Second, the Examiner's speculative policy concern of harassment via litigation by separate patent owners is not an independent basis for OTDP, and no court has ever held otherwise. Furthermore, the practical consequences of permitting later-filed, later-expiring patents to invalidate earlier-filed, earlier-expiring patents would be devastating for innovators. Such a rule would create investment uncertainty leading to portfolio devaluation and ultimately disincentivize investment in innovation, far outweighing the Examiner's hypothetical harassment concern.

III. ARGUMENT

A. *Allergan's* Reasoning Applies to Patents with Different Patent Term Filing Dates and Controls the Outcome Here

In *Allergan*, the Federal Circuit held that a "first-filed, first-issued, later-expiring claim cannot be invalidated by a later-filed, later-issued, earlier-expiring reference claim having a common priority date." 111F.4th at 1369. Here, the question presented is whether a patent with a later patent term filing date and a later expiration date may serve as a proper reference patent to invalidate a patent with an earlier patent term filing date and an earlier expiration date than the reference patent. Under the fundamental principles of the OTDP doctrine explained in *Allergan*, the answer is clear: no.

1. The Purpose of OTDP Governs the Reference-Patent Inquiry

The OTDP doctrine is a judicially created doctrine whose "primary goal is to prevent an unjustified timewise extension of patent exclusivity beyond the life of a patent" *Id.* at 1367. This goal "is grounded in the principle that 'the public should be able to act on the assumption that upon

expiration of the patent it will be free to use not only the invention claimed in the patent but also any modifications or variants thereof which would have been obvious to those of ordinary skill in the art at the time the invention was made.'" *Id.* (quoting *In re Zickendraht*, 319 F.2d 225, 232 (C.C.P.A. 1963) (Rich, J., concurring) (cleaned up)).

That purpose—preventing an unjustified timewise extension of patent protection—is the guiding principle for determining whether a reference qualifies as a proper OTDP reference. *Allergan* made this explicit. The Federal Circuit held that the claims of the later-filed, later-issued reference patents "are not proper ODP references" because "[t]hat is the only conclusion consistent with ***the purpose of the ODP doctrine***, which is to prevent patentees from obtaining a *second* patent on a patentably indistinct invention to ***effectively extend the life*** of a *first* patent to that subject matter." *Id.* at 1369 (bolded emphases added). In doing so, the court refused to accept a contrary position that it believed would be "antithetical to the principles of ODP." *Id.* There is no reason why the "fundamental purpose" of OTDP would apply only in the precise factual context of *Allergan*. The only reasonable conclusion to be drawn from *Allergan* is that the fundamental purpose of the OTDP doctrine should always serve as the guiding principle for determining whether a reference qualifies as a proper OTDP reference. To blindly assert OTDP while jettisoning the underlying purpose of the doctrine is error.

2. Examiners Must Consider Patent Term Filing Dates and Expiration Dates When Determining Whether a Reference Patent Is Proper

The Examiner has argued that *Allergan* applies only where the challenged patent and the reference patent share a common priority date, that OTDP analysis should only consider the actual filing date, and that it would be impossible for an Examiner to consider expiration dates in an OTDP analysis. *See generally* Appeal No. 2024-002920, Examiner Request for Rehearing, at 3–8 (Jan. 3, 2025). All of these arguments are wrong.

The Board correctly recognized that although the factual circumstances in *Allergan* involved patents sharing a common priority date where the actual filing date was relevant, the Federal Circuit's reasoning was not so limited. *See* Appeal No. 2024-002920, PTAB Decision on Request for Rehearing, at 5 (Dec. 18, 2025) ("[I]n contrast to the Examiner's suggestion, the *Allergan* court in looking at what claims were 'first-filed,' did not ignore the effective filing dates in favor of actual filing dates; it took note of both the effective filing dates and the expiration dates to determine if certain claims could serve as reference patents.").

The critical question under the OTDP doctrine is not a rigid analysis of which application was actually filed first, but whether, taking into account all of the relevant information—which might include priority date, patent term filing date, actual filing date, or expiration date, depending on the case—the challenged patent constitutes "a second, later expiring patent for the same invention." *Abbvie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Tr.*, 764 F.3d 1366, 1373 (Fed. Cir. 2014). Both the patent term filing dates and expiration dates must be considered to answer that question and any argument to the contrary simply ignores the caselaw.

Furthermore, the Examiner's position that an examiner cannot determine and analyze the projected expiration date in making an OTDP rejection is untenable. In most cases, patent term is straightforward to calculate under 35 U.S.C. § 154(a)(2): twenty years from the patent term filing date. The Board again correctly noted that an examiner can determine the "apparent expiration date" from the statutory term and "make a preliminary determination of whether the potential reference patent's term would be extended by the issuance of the application under examination." Appeal No. 2024-002920, PTAB Decision on Request for Rehearing, at 14 (Dec. 18, 2025). That the task may be administratively difficult or require estimation of uncertain dates does not excuse

the PTO from performing it. Determining whether something qualifies as a proper OTDP reference is no more complex than the prior-art determinations examiners make every day.

Without question, this administrative responsibility belongs to the Patent Office. The MPEP itself provides that "the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent." MPEP § 804(I)(A). That determination necessarily requires comparing filing dates and expiration dates. An approach that refuses to make this comparison—and instead applies OTDP rejections to every patent with similar subject matter and common ownership, regardless of the directional relationship between filing dates and expiration dates—is an inexcusable shortcut and imposes unjustified burdens on applicants.

Here, the application at issue has a patent term filing date of March 28, 2012, which is *years* before the April 13, 2017 patent term filing date of the asserted reference patent. And any patent issuing from that application will expire no later than March 28, 2032; again, *years* before the "reference patent's" June 22, 2037 expiration. In this case, the patent term filing date is the relevant date for considering the "filing date" of the patents. For the PTO to disregard the patent term filing dates and expiration dates and instead issue an OTDP rejection solely because the reference patent was *actually filed* before the pending application is nonsensical. On these facts, the application would not extend any period of exclusivity on the claimed subject matter. It does not violate any of the fundamental principles of OTDP. Under *Allergan*'s analytical framework, the alleged reference patent—and other later-filed, later-expiring references—simply are not proper OTDP references.

B. The Practical Consequences of the Examiner's Proposed Rule Would Harm Innovation and Destabilize the Patent System

The Examiner's proposed rule would allow a later-filed, later-expiring patent to invalidate an earlier-filed, earlier-expiring patent through an OTDP rejection. As discussed above, that outcome is precisely the opposite of what the OTDP doctrine exists to prevent. And where the application under examination would expire before the reference patent, there is no extended patent term to truncate: a terminal disclaimer in such a scenario would not actually disclaim any patent term, it would merely impose common ownership. Thus, the Examiner's sole justification for the OTDP rejection boils down to a policy argument that common ownership must be ensured to prevent the risk of harassment by separate owners of patents claiming obvious variants. But no court has ever held that the risk of separate ownership is a stand-alone justification for making an OTDP rejection. Weighing the policy considerations, the disruptive and destabilizing effect of allowing later-filed patents to potentially invalidate earlier-filed patents far outweigh the hypothetical threat of divided litigation.

1. The Examiner's Rule Would Create Unprecedented Unpredictability for Patent Holders

Patents exist "[t]o promote the Progress of Science and useful Arts," U.S. CONST. ART. I, § 8, cl. 8, by encouraging innovation. The Supreme Court has cautioned against "changes that disrupt the settled expectations of the inventing community." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 739 (2002). So too has the current leadership of the PTO placed an emphasis on avoiding disruption of the settled expectations of patent owners facing PTAB challenges. *See* Coke Morgan Stewart, Memorandum re *Interim Processes for PTAB Workload Management*, 2 (Mar. 26, 2025), https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-

20250326.pdf. It is hard to envision an OTDP rule that would upset the settled expectations of patent owners more than the Examiner's proposed rule.

Indeed, other panels of the PTAB have done just that and rejected claims for OTDP on analogous facts—finding claims unpatentable for OTDP in view of later-filed, later-expiring patents. *See Ex parte Baumeister*, Appeal No. 2026-000193, PTAB Decision on Appeal (Nov. 21, 2025). In *Ex parte Baumeister*, the panel declined to follow the well-reasoned opinion in this case, stating that it was not precedential, and instead held that potential harassment by multiple assignees provides a separate justification for OTDP. *See id.* at 15–16. That case is now pending before the Federal Circuit. This inconsistent decision and disruption of patent owners' settled expectations makes the ARP's review all the more important here.

Under the Examiner's approach, as in *Ex parte Baumeister*, a patent that claims priority to a much earlier-filed, earlier-expiring patent could be rendered invalid by a later-filed, later-expiring patent. This creates a backwards-looking OTDP problem that is entirely unprecedented. Today, patent holders understand their risk profile at the time of filing: they know when they are filing a continuation or obvious variant of an earlier-filed patent, they can expect that an OTDP rejection may occur, and can take appropriate steps by filing a terminal disclaimer. But under the Examiner's rule, the mere act of continuing to innovate by filing new patent applications that stand on their own could retroactively threaten the validity of a company's *existing* patents. A backwards-looking OTDP rule creates a massive predictability problem and does not allow applicants to make straightforward, logical decisions regarding their patent portfolios.

The Examiner's proposed solution that the parties could resolve the rejection at hand by filing a terminal disclaimer is no true recourse. In many scenarios, such filing is impossible. OTDP can apply between patents with a common inventor even if they are not commonly owned, yet a

terminal disclaimer is unavailable when patents are not commonly owned. *In re Hubbell*, 709 F.3d 1140, 1146, 1148–49 (Fed. Cir. 2013); *see also In re Fallaux*, 564 F.3d 1313, 1319 (Fed. Cir. 2009). This creates a trap: a later-expiring patent by a co-inventor at a different company could potentially invalidate an earlier patent, and the earlier patent holder would have no mechanism to cure the defect. This risk alone necessitates rejection of the Examiner's proposed solution.

The consequences for investment decisions are stark. Companies invest billions of dollars in research and development on the strength of the patent protection they expect to receive. If later-filed patents can invalidate earlier-filed ones, the value of every patent in a portfolio becomes contingent on what the patent holder (or a co-inventor) might file in the future. Patent holders would not be able to accurately value their portfolios, which could result in lower valuations, reduced willingness to invest in innovation, and reluctance to enforce patent rights for fear that the very patents being asserted could be challenged based on OTDP over patents that did not even exist when the earlier patents were filed.

2. *The Examiner's Rule Would Discourage Follow-On Innovation and Collaborative Research*

The Examiner's proposed rule would directly disincentivize the development of follow-on technologies and is out of sync with how modern-day innovation is structured. Modern research and development, for all sectors of technology, is inherently iterative. As the Federal Circuit itself recognized in *Allergan*, "it is not atypical for a patent applicant to first seek to protect the most valuable inventive asset (*e.g.*, a pharmaceutical genus claim) before filing continuing applications on enhancements or modifications to that inventive asset (*e.g.*, a particular compound in that genus, a method of using the compounds of that genus, etc.)." 111 F.4th at 1371. That is precisely how the patent system is designed to function: a company invests heavily in early-stage research, patents its foundational discovery, and then continues to invest in follow-on research that refines

the science by identifying specific species within a broader initial invention, developing new methods of use, and exploring related therapeutic applications. Each successive discovery may warrant its own patent application, filed with a later priority date.

This foundational-to-specific or genus-to-species development pattern is not gamesmanship. It is the natural and expected progression of scientific research. The patent system encourages this progression by rewarding each stage of investment with patent protection. But the Examiner's proposed rule turns this incentive structure on its head. If patenting improvements on prior inventions could retroactively invalidate earlier patents covering foundational technologies, patent holders face a perverse choice: continue innovating and risk destabilizing their existing portfolio, or stop innovating to protect the status quo. That outcome is antithetical to the purpose of the patent system.

The chilling effect extends beyond a single company's portfolio. In modern research and development, collaboration between companies, universities, and research institutions is commonplace. Joint inventorship is a routine feature of such collaboration. Under the Examiner's approach, a company might hesitate to engage in collaborative research if the collaborator's later-filed patents—over which the company has no control—could create OTDP problems for the company's hard-earned patents from their previous collaborative efforts. Similarly, companies seeking to pay for the use of an innovator's technology might become reluctant to license or acquire patents if the seller could subsequently obtain a later-filed patent that invalidates the licensed or purchased patent. Patents are not fungible goods; their value depends on their enforceability. If that enforceability is contingent on the unpredictable future actions outside the control of the buyer, the entire market for patent transactions suffers.

3. Anti-Harassment Policy Concerns Cannot Sustain the Examiner's Approach

The Examiner's argument ultimately rests on the policy against harassment by separate owners of patents claiming obvious variants. But that policy interest has been recognized only in dicta and no court has ever held it to be a stand-alone basis for making an OTDP rejection, much less a basis for invalidating patents based on improper OTDP references. The speculative risk of harassment simply cannot bear the weight of the consequences the Examiner's rule would impose. The disruption to settled expectations, the disincentive to innovate, the destabilization of patent portfolio valuation, and the chilling of collaborative research are concrete, real-world harms that vastly outweigh a theoretical concern raised by the Examiner.

IV. CONCLUSION

The Board correctly reversed the Examiner's OTDP rejections, and the Panel should affirm that decision. The OTDP doctrine exists to prevent unjustified extensions of patent term. Where, as here, the application under examination has an earlier patent term filing date and will expire earlier than the purported reference patent, there is no extension of patent term to prevent. The Examiner's attempt to use the OTDP doctrine in reverse—to invalidate an earlier-filed, earlier-expiring patent based on later-filed, later-expiring references—is inconsistent with the doctrine's purpose, unsupported by binding precedent, and would inflict serious harm on the innovation economy.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 41.106(e), I hereby certify that on this 27 day of March, 2026, I caused to be served a true and correct copy of the foregoing by first class mail on the following counsel:

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