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

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*, VALENCIA MARTIN WALLACE, *Acting Commissioner for Patents*, and KALYAN K. DESHPANDE, *Chief Administrative Patent Judge*.

Amicus Brief of The Intellectual Property Section of The Bar Association of the District of Columbia

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Pursuant to the Order Convening Appeals Review Panel and Granting *Sua Sponte* Rehearing of March 5, 2026 ("the Order"), which authorized the submission of a brief by any *amicus curiae*, the Bar Association of the District of Columbia Intellectual Property Section submits the following remarks.

INTEREST OF *AMICUS CURIAE*

Founded in 1871, the Bar Association of the District of Columbia ("BADC") is one of the oldest and largest bar associations in the United States. The BADC's Intellectual Property Section ("IP Section"), established in 1958, is a community of patent attorneys and other intellectual property practitioners. IP Section members represent a cross-section of IP practitioners and represent the interests of both patent owners and patent challengers. Members frequently represent clients in patent matters before the U.S. District Courts, the United States Patent and Trademark Office, and the Court of Appeals for the Federal Circuit.

A major focus of the IP Section is to proactively help maintain fair and effective patent laws and policies that stimulate and reward meritorious inventions while serving the public interest of fostering fair and open competition in the marketplace. The IP Section has no client or economic interest in this case other than a professional interest in maintaining the integrity and predictability of the patent system. The Order requested comment on the following three questions as follows: (1) the applicability, if any, of *Allergan USA, Inc. v. MSN Laboratories Private Ltd.*, 111 F.4th 1358 (Fed. Cir. 2024), to the facts of this appeal, and consideration of what constitutes "first-filed" for obviousness-type double patenting ("OTDP") purposes under facts different than those presented in *Allergan*; (2) whether examiners should determine projected expiration dates to support OTDP rejections during prosecution; and (3) whether the risk of separate ownership and preventing potential harassment by separate owners of claims to

obvious variants of an invention is an independent basis that supports an OTDP rejection during prosecution. The IP Section responds to these questions in turn, as follows.

I. *Allergan* Intends to Prevent an Unjustified Extension of Patent Term for a *First* Patent by a *Second* Patent of a Patentably Indistinct Invention

In *Allergan USA, Inc. v. MSN Laboratories Private Ltd.*, the Federal Circuit held that:

> [T]he first-filed, first-issued patent in its family . . . is the patent that sets the maximum period of exclusivity for the claimed subject matter and any patentably indistinct variants. We therefore hold 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.

See, 111 F.4th 1358, 1369 (Fed. Cir. 2024). The Federal Circuit described this holding as "the only conclusion consistent with the purpose of OTDP analysis, 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." *See*, *id.* (italics in original). The *first* patent is the first-filed, first-issued patent for the shared subject matter; a later-filed, later-issued patent that expires earlier cannot serve as an OTDP reference to truncate the first patent's patent term adjustment. Therefore, even if there are factual differences to those found in *Allergan*, any OTDP analysis must be consistent with preventing an unjustified extension of the patent term of a *first* patent by claims in a *second* patent for a patentably indistinct invention. This is essential to ensure that a first patent receives the proper benefit of patent term adjustment caused by USPTO delay.

As discussed by the Federal Circuit in *Allergan*:

> When seeking patent protection, 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.). And it is unsurprising that prosecution of a first-of-its-kind invention can be protracted, requiring greater time and effort by the applicant and examiner alike, such that any eventual patent on that invention is awarded some amount of PTA. Nor is it surprising that, for one reason or another (e.g., the examiner's newfound familiarity with the subject matter), a subsequently filed continuing application claiming the same priority date and covering a modification of that invention proceeds much more efficiently through prosecution such that any patent awarded to that modification receives little to no award of PTA. As a result, that later-filed, later-issued continuing, or 'child,' patent, whether subject to a terminal disclaimer over the parent or not, generally expires no later than the parent patent. That child patent does not, then, result in any extension of patent term of the invention claimed in the parent patent given that it expires first. Nor can the parent patent be said to result in an extension of patent term of the invention claimed in the child patent when, as here, the claims in the child patent did not even exist until after the parent patent issued.

See, *id.*, at 1372. The Federal Circuit concludes:

> [T]hat a first-filed, first-issued parent patent having duly received PTA can be invalidated by a later-filed, later-issued child patent with less, if any, PTA—would not only run afoul of the fundamental purposes of ODP, but effectively abrogate the benefit Congress intended to bestow on patentees when codifying PTA. That is because such a holding would require patent owners, in order to preserve the validity of the parent patent, to file a terminal disclaimer disclaiming any term of the parent that extends beyond that of the child, which, given that the patents share a priority date, would amount to the disclaimer of *only* PTA. That parent patent, then, would not receive the benefit of its congressionally guaranteed patent term, *see* 35 U.S.C. § 154(b), and would instead be limited to the, presumably shorter, term of its own child. Such a result would be untenable.

See, id. Therefore, the Federal Circuit in *Allergan* articulated a clear doctrine with which any OTDP analysis must be consistent.

Accordingly, in this case, which concerns OTDP-type rejections of earlier-filed, earlier-expiring applications over later-filed, later-expiring applications, then the OTDP-type rejections are in error because in this instance the *first* patent, which is subject to terminal disclaimers, is not going to receive any extended patent term over the *second* patents. The conditions that trigger the policy concerns underlying OTDP-type rejections simply do not exist in this instance.

Furthermore, should OTDP-type rejections be upheld in such circumstances, that raises the possibility of serious inequity for patent owners for the term granted on their first-filed patents if patent term adjustment on such patent is cut short. As cited above, the Federal Circuit has already found such a result untenable. The effect would be to significantly reduce the ability to monetize the most likely commercially significant claims in a patent family by denying them their fully entitled term. As such, the Patent Trial and Appeal Board's analysis and application of the case law in the Decision on Appeal issued November 8, 2024 is correct, and its decision to reverse the OTDP-type rejections should be upheld.

II. Examiners Should Determine Likely Expiration Dates to Determine If Obviousness-Type Double Patenting Applies

As discussed above, *Allergan* requires that any OTDP analysis performed by the USPTO be consistent with preventing patentees from obtaining a *second* patent on a patentably indistinct invention to effectively extend the life of a *first* patent to that subject matter. Therefore, in performing an OTDP analysis, a USPTO examiner must necessarily first determine whether or not a second patent on a patentably indistinct invention can extend the patent term on that invention beyond that permitted by the first patent. Although the patent term adjustment to which a patent application may be ultimately entitled cannot be determined during the prosecution of that patent application itself, the 20-year term from the earliest effective filing date, limited by any on-file terminal disclaimer, can be determined. Calculation of the prospective statutorily determined patent term of a patent application is expressly permitted under USPTO guidelines as "an examination of a non-reissue patent application where determination of the expiration date of a patent is necessary to conduct examination of the non-reissue patent application." *See*, M.P.E.P. § 1701.

Accordingly, in the present case, the determination that the present application, which is subject to terminal disclaimers, is an earlier-filed, earlier-expiring application than the later-filed, later-expiring patents asserted in the OTDP rejections should have ended any further OTDP analysis. To do otherwise would create a situation in which applicants cannot be certain that they will receive their fully entitled term on their first patent because at any point terminal disclaimers may be required due to later-filed patents being applied, thus potentially denying the first patent its duly entitled patent term adjustment. Ultimately, this would alter the calculus when deciding whether or not to file a first patent application and thereby undercut the incentives for public disclosure that underpin the patent system.

III. The Risk of Separate Ownership Cannot Be a Basis for an Obviousness-Type Double Patenting Rejection

There is no Federal Circuit decision that holds that there is a separate basis for an OTDP-type rejection due to "risk of separate ownership and preventing potential harassment." Indeed, such a basis for OTDP-type rejections would introduce profound uncertainty into patent prosecution since the effect of a terminal disclaimer, if filed, would be undermined by the chance, however negligible, that at some unknown point in the future a separate owner might in theory seek to have the disclaimer removed. If such a basis existed for OTDP-type rejections, the impact would be to disincentivize the use of the patent system because there would be no apparent means of resolving such uncertainty other than a determination that the inventions are patentably distinct. However, if inventions are patentably distinct, there is also no basis for an OTDP-type rejection. Accordingly, the proposition that "risk of separate ownership and preventing potential harassment" provides a basis for an OTDP-type rejection, even in cases such as here where the present application is subject to terminal disclaimers, would substantially

increase the cost and uncertainty of patent prosecution. There would be a strong incentive to resist filing any terminal disclaimers as such filings would not provide any certainty of benefit and could needlessly result in the loss of patent term adjustment. Accordingly, any suggestion that "risk of separate ownership and preventing potential harassment" should be the basis for OTDP-type rejections should be dismissed.

Therefore, it is respectfully recommended that the Appeal Panel should find that a USPTO Examiner, when performing an OTDP analysis, should:

(1) Identify the *first* patent, which is the first-filed, first-issued patent for the invention in question;

(2) Calculate the apparent patent terms for the *first* patent and any putative *second* patent, where the terms are based on the standard twenty-year term from the earliest claimed priority date, and accounting for any terminal disclaimers already on-file;

(3) Determine whether the putative *second* patent would extend the patent term for the allegedly patentably indistinct invention claimed by the *first* patent. If not, then no further OTDP analysis regarding indistinctness is required.

These steps will ensure that improper OTDP-type rejections are avoided, unnecessary terminal disclaimers will not be filed, and the inequitable reduction of patent term adjustment on a *first* patent will not occur.

CONCLUSION

The Appeal Panel should endorse the Board's approach and clarify that *Allergan* governs here: a later-filed, later-expiring patent to a distinct invention is not a proper OTDP reference to truncate the term of an earlier patent. Examiners must perform an expiration-aware, *Allergan* threshold step before making OTDP rejections, and "separate-ownership" concerns cannot independently justify OTDP where no proper reference exists.

Date: March 25, 2026

Respectfully Submitted:

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