

No. 23-1231

IN THE
Supreme Court of the United States

CELLECT, LLC,

Petitioner,

v.

KATHERINE K. VIDAL, UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR, UNITED STATES PATENT AND
TRADEMARK OFFICE,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF TEIGE P. SHEEHAN AS *AMICUS*
CURIAE IN SUPPORT OF CERTIORARI**

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TABLE OF CONTENTS

	<i>Page</i>
TABLE OF CITED AUTHORITIES	ii
I. INTERESTS OF THE <i>AMICUS CURIAE</i>	1
II. SUMMARY OF ARGUMENT	1
III. ARGUMENT	5
A. THE FEDERAL CIRCUIT'S CIRCULAR REASONING YIELDS AN UNFOUNDED CONSTRUCTION OF § 154	7
B. § 154 REQUIRES RESOLUTION OF AN OBVIOUSNESS-TYPE DOUBLE PATENTING ANALYSIS BEFORE PATENT TERM ADJUSTMENT IS AWARDED	10
IV. CONCLUSION	19

TABLE OF CITED AUTHORITIES

	<i>Page</i>
Cases	
<i>Bilski v. Kappos</i> , 561 U.S. 593 (2010)	5, 12, 15
<i>Chevron, U.S.A., Inc. v.</i> <i>Nat. Res. Def. Council, Inc.</i> , 467 U.S. 837 (1984)	9, 10
<i>In re: Collect, LLC</i> , 81 F.4th 1216 (Fed. Cir. 2023)	2, 3, 8, 10, 11, 14, 15, 17
<i>King v. St. Vincent’s Hosp.</i> , 502 U.S. 215 (1991)	8
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	15
<i>Merck & Co. v. Hi-Tech Pharmacal Co.</i> , 482 F.3d 1317 (Fed. Cir. 2007)	12
<i>Morse v. Republican Party of Virginia</i> , 517 U.S. 186 (1991)	8
<i>Nationwide Mut. Ins. Co. v. Darden</i> , 503 U.S. 318 (1992)	8
<i>Novartis AG v. Ezra Ventures LLC</i> , 909 F.3d 1367 (Fed. Cir. 2018)	11

Cited Authorities

	<i>Page</i>
<i>Octane Fitness, LLC v. ICON Health & Fitness, Inc.,</i> 572 U.S. 545 (2014).....	15
<i>Procter & Gamble Co. v. Teva Pharms. USA, Inc.,</i> 566 F.3d 989 (Fed. Cir. 2009)	2
<i>SAS Inst., Inc. v. Iancu,</i> 584 U.S. ___, 138 S. Ct. 1348 (2018).....	12, 17
<i>SCA Hygiene Prod. Aktiebolag v. First Quality Baby Prod., LLC,</i> 580 U.S. 328 (2017).....	5, 17
<i>Application of Vogel,</i> 422 F.2d 438 (C.C.P.A. 1970).....	4

Statutes

35 U.S.C. § 100.....	14
35 U.S.C. § 101	4
35 U.S.C. § 103.....	2, 14
35 U.S.C. § 154.....	2-15, 17, 18
35 U.S.C. § 156.....	3, 10, 11, 12, 17

Cited Authorities

Page

Administrative Materials

Manual of Patent Examining Procedure § 27337

Other Authorities

Kazhdan, *Obviousness-Type Double Patenting:
Why It Exists And When It Applies*, 53 Akron
L. Rev. 1017 (2019)16

I. INTERSTS OF THE *AMICUS CURIAE*¹

Amicus curiae is a patent attorney who counsels clients in intellectual property matters, including in connection with the obtention and protection of patents and patent rights before the U.S. Patent and Trademark Office and federal courts. His interest in this case in particular derives from a desire for a properly and well functioning patent system that provides sufficient and predictable support for rights of inventors and other stakeholders, as provided for by law, to promote progress of science and useful arts.

II. SUMMARY OF ARGUMENT

A patent term adjustment (PTA) award is a statutorily mandated addition of time to the end of a patent's term to compensate a patentee for administratively delayed patent issuance, thereby preventing such a delay from depriving a patentee of the full term to which she is entitled. Separately, if deemed to confer an unjustifiably extended duration of patent term, a patent may be invalid under the judicial doctrine of obviousness-type double patenting (ODP). In resolving a perceived conflict between postponing a patent's expiration date by an award of PTA

1. Counsel of record for all parties received notice of *amicus curiae*'s intention to file this brief at least 10 days before the deadline for its filing. Rule 37.2. Counsel for *amicus curiae* certifies that this brief was not authored in whole or in part by counsel for any party and that, other than the law firm of Heslin Rothenberg Farley & Mesiti P.C., which paid all costs for printing, filing, and serving this brief, no person or entity other than *amicus curiae* has made a monetary contribution to the preparation or submission of this brief. Rule 37.6.

and alleged ODP-invalidity due to an unjustified extension of patent term, Respondent came down in favor of ODP, finding Petitioner's patents invalid for ODP because they had received statutorily required PTA awards consequent to administratively delayed patent issuance. But in so doing, Respondent misinterpreted the statutory scheme prescribed for administering PTA, creating a conflict between PTA and ODP where none exists, and the Court of Appeals for the Federal Circuit ("Federal Circuit") applied faulty reasoning and ignored statute in upholding Respondent's decision. This Court is urged to grant a writ certiorari to correct such errors.

Two faults in statutory construction central to the Federal Circuit's decision are responsible for the incorrect holding. First, the court held that reference to a terminal disclaimer in 35 U.S.C. § 154, the statute that sets out the scheme for calculating and awarding PTA, was "tantamount" to an expression of Congress's intent that a PTA award can cause invalidity for ODP. *In re: Collect, LLC*, 81 F.4th 1216, 1228 (Fed. Cir. 2023). A terminal disclaimer is a cure for an ODP defect, truncating a patent's term by setting an expiration date earlier than it would otherwise have enjoyed. *Id.* at 1226. If an application's claims are found unpatentable for ODP,² a

2. This can occur, for example, if its claims are deemed obvious variants over those of an earlier-expiring, reference patent that is excluded from being citable against it for statutory obviousness under 35 U.S.C. § 103, such as a patentee's own reference patent that had not issued, and arose from application that had not published, before the priority date to which the patent is entitled. *Procter & Gamble Co. v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 999 (Fed. Cir. 2009) ("[S]tatutory obviousness compares claimed subject matter to the prior art, while non-statutory

patentee can request a terminal disclaimer, which cures the ODP defect by removing such portion of term as was deemed an unjustified extension. *Id.* Section 154 states that a PTA award cannot yield an expiration date later than one set by a terminal disclaimer (if present). § 154(b)(2)(B) (“No patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.”). The Federal Circuit concluded that, because § 154 states that a terminal disclaimer—the *cure* for ODP—limits a PTA award, a PTA award itself can confer unpatentability for ODP in the absence of a terminal disclaimer. *In re: Collect, LLC*, 81 F.4th at 1229. This is a classic instance of circular reasoning, an illogical basis for analysis repeatedly dismissed by this Court and which provides no insight at all into whether Congress intended for a PTA award to confer ODP invalidity.

On the basis of such faulty reasoning, the Federal Circuit agreed with Respondent and held that ODP for a patent that received a PTA award is assessed based on its later expiration date resulting from application of PTA, not on when the patent would have expired had no PTA been awarded, resulting in invalidity for ODP. *Id.* To reach this conclusion, the court compared § 154 with a different statute, 35 U.S.C. § 156, which postpones patent expiration in compensation for a different kind of administrative delay. *In re: Collect, LLC*, 81 F.4th at 1223-24. But the comparison between §§ 154 and 156 for this purpose is not only of no help in revealing Congress’s intent as to an effect of PTA on ODP, it is also unnecessary. The scheme

[obviousness-type] double patenting compares claims in an earlier patent to claims in a later patent or application.”).

by which PTA is calculated according to the terms of § 154 itself requires that ODP be determined before PTA is awarded. To interpret the statutory scheme otherwise is to require Respondent to compensate a patentee for an administrative delay in a patent's issuance by attaching to it a new defect in validity *on the very day the patent issues*. This absurd result cannot accurately reflect Congress's intent.

Thus, the Federal Circuit drew an unfounded conclusion as to whether Congress intended for PTA to cause ODP based on circular reasoning and an inapt comparison while overlooking statutory indications of Congress's intent to the contrary, forcing an absurd operation of § 154 that cannot be correct. It seems unlikely in the extreme that Congress would have used a statutory scheme intended to compensate a patentee for administrative delays in patent issuance by compelling³ Respondent to issue patents rendered invalid on their day of issue by the very "compensation" dispensed according to the statutory scheme.

The doctrine of ODP is judicial in provenance, not statutory.⁴ Courts should therefore not endorse Respondent's attempt to expand its application in

3. "The Director *shall* proceed to grant the patent after completion of the Director's determination of a patent term adjustment under the procedures established under this subsection" 35 U.S.C. § 154(b)(3)(D) (emphasis added).

4. In contrast, the prohibition of statutory double patenting is based on the statement in 35 U.S.C. § 101 that an inventor "may obtain *a* patent" (emphasis added). *Application of Vogel*, 422 F.2d 438, 440 (C.C.P.A. 1970).

contradiction of Congress’s expressed intent. *See, e.g., SCA Hygiene Prod. Aktiebolag v. First Quality Baby Prod., LLC*, 580 U.S. 328, 335 (2017) (refusing to expand application of a judicially created defense to patent infringement in contradiction of statute because doing so would “give judges a ‘legislation-overriding’ role that is beyond the Judiciary’s power”); *Bilski v. Kappos*, 561 U.S. 593, 603 (2010) (rejecting a rule that would characterize all business methods as falling within the judicial exceptions to statutory patent eligibility, stating “[t]his Court has not indicated that the existence of these well-established exceptions gives the Judiciary *carte blanche* to impose other limitations that are inconsistent with the text and the statute’s purpose and design.”). These reasons, at least, militate in favor of granting a writ of certiorari.

III. ARGUMENT

The Federal Circuit’s untenable interpretation of § 154 both deviates from this Court’s guidance for construing statutes and extracts irrational results from the statute’s congressionally prescribed operation. Because § 154 limits the effect of PTA in the presence of a terminal disclaimer, the court concluded that a PTA award must produce a *need* for a terminal disclaimer, as if PTA creates the defect (ODP) so that a terminal disclaimer could cure it. But that is circular logic. Though the statute refers to how to calculate PTA when a terminal disclaimer has been applied, a terminal disclaimer is not likely to have been applied in the absence of ODP, such as if PTA does not create a risk of ODP. That is, the statute stating what would be the result for PTA if a terminal disclaimer had been applied is not the same as the statute stating that PTA gives rise to ODP necessitating a terminal disclaimer.

To jump from noting a reference to a terminal disclaimer in § 154 to the conclusion that PTA causes ODP is begging the question. The Federal Circuit thereby presupposed a construction of § 154 in the process trying to construe it, an analytical process disfavored by this Court, devoid of persuasiveness, and ultimately without a sound foundation in reason or law.

Moreover, the conclusion that ODP validity is ascertained after PTA is awarded frustrates the scheme Congress set out in § 154 for how to calculate accrual of PTA. Section 154 lists various deadlines by which Respondent is to take certain actions during examination of an application. § 154(b)(1)(A)-(C). For each day by which such a deadline is exceeded, one day of PTA accrues (offset by days of delay attributable to the applicant). *Id.*, § 154(b)(2)(C). When a patent is set to issue after completion of examination, net PTA accrual is calculated and, if it is greater than zero, the patent's expiration date is postponed by the net number of days of PTA accrued. § 154(b)(3)(b)(i). Notably, one day of PTA accrues for each day in excess of three years between an application's filing date and issuance of a patent and for each day in excess of four months it takes Respondent to issue a patent after an applicant pays the issue fee.⁵ § 154(b)(1). Both of these bases of potential PTA span administrative processing that occurs *after* allowance of an application. § 154(b)(1)(A)(iv), (b)(1)(B). A PTA award therefore cannot be conclusively determined until patent issuance and, accordingly, § 154 provides for notifying a patentee of a PTA award when a patent is granted. § 154(b)

5. § 154(b)(2)(A) provides that, if two types of delay overlap, only one day for each day of overlap accrues as PTA.

(3)(B)(i).⁶ The order of operations prescribed by § 154 therefore contemplates examination of an application and determining that claims are free from defects (including, for example, for ODP), followed by patent issuance and awarding PTA.

Thus, if Congress's scheme for calculating and awarding PTA as laid out in § 154 is followed, PTA is not awarded until after claims are deemed free of ODP, which can hardly mean that PTA was to have been considered when ODP was assessed during examination. On the contrary, according to § 154, the expiration date as postponed by an award of PTA simply cannot be taken into consideration when ODP is assessed, because it cannot be known until a patent's issue date is established following administrative action that occurs after completion of examination. It would be extremely irrational if, by this sequence of events, Congress intended for Respondent to find claims valid right up until patent issuance, only to poison the patent with a new, ODP defect in the form of PTA awarded on the very day the patent is granted.

A. THE FEDERAL CIRCUIT'S CIRCULAR REASONING YIELDS AN UNFOUNDED CONSTRUCTION OF § 154

Section 154 does not state that a PTA award would render a patent invalid for ODP if the award would cause the patent to expire after another, reference patent over

6. In turn, Respondent currently provides a first, "preliminary [PTA] calculation" in an issue notification mailed after payment of the issue fee, but the "official" notification of PTA does not occur until it is printed on the patent when issued thereafter. Manual of Patent Examining Procedure § 2733.

which it claims an obvious variant. Thus, on its face, § 154 does not require the result urged by Respondent. Nevertheless, the Federal Circuit was troubled by the provision of § 154 that states “[n]o patent the term of which has been disclaimed beyond a specified date may be adjusted under this section beyond the expiration date specified in the disclaimer.” § 154(b)(2)(B); *In re: Collect, LLC*, 81 F.4th at 1228 (“§ 154(b)(2)(B)’s provision regarding terminal disclaimers . . . remains critical in our analysis of the statute.”). The court concluded that § 154’s explicitly delimiting a PTA award according to the terms of a terminal disclaimer was equivalent to requiring that a PTA award can *cause* ODP invalidity: “Given the interconnection of ODP and terminal disclaimers as ‘two sides of the same coin,’ . . . the statutory recognition of the binding power of terminal disclaimers in § 154(b)(2)(B) is tantamount to a statutory acknowledgement that ODP concerns can arise when PTA results in a later-expiring claim that is patentably indistinct.” *In re: Collect, LLC*, 81 F.4th at 1228. But the basis for this interpretation is contrary to this Court’s precedent regarding rules for statutory construction and does not withstand scrutiny.

This Court consistently rejects use of circular reasoning in interpreting statutes. *See, e.g., Nationwide Mut. Ins. Co. v. Darden*, 503 U.S. 318, 327 (1992) (rejecting a statutory interpretation “infected with circularity” because it “begs the question”); *King v. St. Vincent’s Hosp.*, 502 U.S. 215, 222 (1991) (rejecting a proposed construction because it “rests on quite circular reasoning”); *Morse v. Republican Party of Virginia*, 517 U.S. 186, 233 n.43 (1991) (rejecting construction because it was “circular to rely” on the conclusion underlying it). The Federal Circuit’s interpretation of § 154 is infected

with circularity because it relies on a conclusion that the statutory delimitation of PTA that results if a terminal disclaimer had been applied to cure it of an ODP defect is equivalent to a PTA award itself giving rise to the defect. But the *effect* of a cure is not equivalent to a *defect* giving need of it, and such an interpretation should be rejected.

Similarly incorrect reasoning was rejected in *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. 837 (1984). There, whether a permitting program required by statute would apply to a given source of pollution depended on what the statute meant when referring to a pollution “source.” The respondent argued that the interpretation of the term given by the Court of Appeals was correct because to interpret it otherwise allowed for a permitting program that was explicitly prohibited by the statute. *Id.* at 862 n.34. This Court rejected what it called the respondent’s “classic example of circular reasoning” that “proves nothing.” *Id.* Finding that the statutory “waiver” from permitting requirements relied on by the respondent did not pertain unless permitting of the purported “source” was required to begin with, this Court rejected the statutory interpretation proffered by the respondent, stating “the statute merely deals with the consequence of the definition of the term ‘source.’” *Id.*

The Federal Circuit’s interpretation of § 154 suffers from the same infirmity, confusing statutory language as to the consequences of a terminal disclaimer with a definition of whether PTA could result in the need for one. Congress’s statutorily limiting PTA *if* a terminal disclaimer has been entered does not mean Congress intended that an award of PTA means a terminal disclaimer *should have been entered*, or that PTA can

cause ODP. Rather, reference to a terminal disclaimer and its effect on PTA simply means what it says: if an applicant has entered a terminal disclaimer, such as to disclaim patent term beyond the expiration of a reference patent over which the application's claims are obvious variants, administrative delay in granting a patent on the application cannot give rise to PTA that extends beyond the date set in the terminal disclaimer. In other words, the statute explains the *consequence* on PTA of a terminal disclaimer having been entered to overcome ODP. It does not mean, as the Federal Circuit would have it, PTA creates the need for the terminal disclaimer by causing ODP invalidity. *See In re: Collect, LLC*, 81 F.4th at 1228 (“If terminal disclaimers had been filed in this case, the provisions of § 154(b)(2)(B) would have come into play.”). Such circular reasoning, in the words of the *Chevron* Court, “proves nothing” at all as to Congress’s intent. *Chevron, U.S.A., Inc. v. Nat. Res. Def. Council, Inc.*, 467 U.S. at 862 n34.

B. § 154 REQUIRES RESOLUTION OF AN OBVIOUSNESS-TYPE DOUBLE PATENTING ANALYSIS BEFORE PATENT TERM ADJUSTMENT IS AWARDED

Because ODP functions to prevent an unjustifiably extended duration of patent coverage, ODP invalidity is more likely if a patent in question is considered to have a later expiration date (e.g., more likely to be considered to expire after, and thereby unjustifiably extend the term of, a reference patent). To that point, the Federal Circuit made much of a comparison between the language of § 154 in relation to PTA and the language of § 156 in relation to another example of postponing a patent’s

expiration to compensate for an administrative delay, patent term extension (“PTE”). *In re: Collect, LLC*, 81 F.4th at 1223-24. The former statute mentions an effect of a terminal disclaimer while the latter statute does not. *Id.* at 1225. However, this comparison is misplaced and was given undue, outsized import by the court. As argued above, the mention of terminal disclaimers in § 154 is not informative as to whether a PTA award affects ODP, so whether or not it is referred to in a different statute pertaining to postponed patent expiration is of no moment. Moreover, reliance on this analysis overlooks the directly relevant and revealing language of § 154 itself, which establishes that PTA cannot finally be awarded until after assessment of ODP during examination. The expiration date yielded by a PTA award can therefore hardly be taken into consideration when assessing ODP. Moreover, a contrary conclusion requires perverse results contrary to the statutory purpose of PTA and divorced from the purported justifications for ODP.

For a patent with a PTE award, ODP is assessed based on when the patent would have expired without PTE having been awarded. *Novartis AG v. Ezra Ventures LLC*, 909 F.3d 1367, 1375 (Fed. Cir. 2018). Because § 154 states that a terminal disclaimer limits the extent of a PTA award while § 156 is silent as to terminal disclaimers, the Federal Circuit concluded that Congress intended different ODP analyses for PTA and PTE. *In re: Collect, LLC*, 81 F.4th at 1227. Unlike for PTE, the court concluded that ODP for a patent that received an award of PTA is assessed based on its later expiration date, after application of PTA, not the earlier date on which it would have expired in the absence of PTA. *Id.* at 1226-27 (“We conclude that, while the expiration date used for an ODP

analysis where a patent has received PTE is the expiration date before the PTE has been added, the expiration date used for an ODP analysis where a patent has received PTA is the expiration date after the PTA has been added.”) As a result, the court concluded that PTA awards rendered Petitioner’s patents invalid for PTA. *Id.* at 1229. But, as argued above, the mention of terminal disclaimers in § 154 is of no assistance in determining whether Congress intended for PTA to generate ODP invalidity, and silence of § 156 as to terminal disclaimers does not change that analysis.⁷

The correct approach is to derive from § 154 itself whether Congress intended for an ODP analysis to be based on the expiration date of a patent before or after PTA is awarded.⁸ The scheme set out in § 154 for calculating

7. Of course, an interpretation of §§ 154 and 156 that yielded no difference between how PTA and PTE are applied despite reference to a terminal disclaimer in the former statute but not the latter could be criticized as “violating the canon against interpreting any statutory provision in a manner that would render another provision superfluous.” *Bilski v. Kappos*, 561 U.S. at 130. However, because PTA and PTE are applied differently as a result of this statutory difference, it is not rendered superfluous: unlike for PTA, an award of PTE can yield an expiration date later than one set by a terminal disclaimer. *Merck & Co. v. Hi-Tech Pharmacal Co.*, 482 F.3d 1317, 1322 (Fed. Cir. 2007).

8. Although Congress provided Respondent with authority to establish procedures for applying PTA (§ 154(b)(3)(A)), the absence of uncertainty as to Congress’s intent here leaves no room for deference to Respondent. *SAS Inst., Inc. v. Iancu*, 584 U.S. ___, 138 S. Ct. 1348, 1359 (2018) (in declining to defer to an agency’s preferred interpretation in the absence of statutory ambiguity, stating “[o]ur duty is to give effect to the text that 535 actual legislators (plus one President) enacted into law.”).

PTA accrual includes consideration of administrative delays of patent issuance that occur after examination for patentability is completed, meaning PTA cannot have been conclusively determined by the time evaluation of patentability, including for ODP, is completed. For example, if more than three years elapses between the filing of a patent application and patent issuance, or more than four months elapses between when an applicant pays the patent issue fee and patent issuance, PTA accrues. § 154(b)(1)(A)(iv), (b)(1)(B). In turn, § 154 provides for notifying a patentee of PTA *when a patent issues*. § 154(B)(3)(b)(i). In other words, § 154 dictates that at least some contributions to PTA, and possibly all in some cases, can occur after examination for patentability is completed (i.e., between the close of examination and the issuance of a patent), which in turn is completed before PTA is awarded. Simply put, according to § 154 ODP is evaluated during patent examination and patent examination concludes before PTA can be finally determined. Obviousness-type double patenting for a pending application therefore *cannot* be based on the expiration date of a patent that results from the application of PTA because such date is not conclusively determined by the time assessment of ODP is completed according to § 154. Obviousness-type double patenting therefore must instead be assessed based on when the patent would expire before accounting for an effect of PTA.

If Congress instead intended for ODP to be assessed based on a patent's expiration date after application of PTA, then the operation of § 154 would be perverse indeed. In that case, examination of an application could come to a close with a conclusion that it is allowable for patenting. Until the patent's issue date, PTA would not yet have

been conclusively determined. If, subsequent to the close of examination and by the time the patent issues, a PTA award is deemed deserved (e.g., perhaps PTA accrued, but only after payment of the issue fee), it is applied on the date the patent issues. Under this counterfactual where the PTA expiration date is used for assessing ODP, only then, for the first time, on the very day the patent issues, would it become invalid for ODP. Deriving this intent from Congress's scheme set out in § 154 would be unreasonable.

There is another odd result of the Federal Circuit's interpretation of § 154. According to the Federal Circuit's decision, a patent can validly issue with a PTA award and its corresponding expiration date publicized, only to be rendered invalid for ODP later, when *another* patent subsequently issues. By way of illustration, Petitioner's U.S. Patent No. 6,424,369 ("the '369 Patent") issued with an award of 45 days of PTA. Over two-and-a-half years later, another patent was issued to Petitioner, U.S. Patent No. U.S. 6,862,036 ("the '036 Patent"), without receiving a PTA award. *See In re: Collect, LLC*, 81 F.4th at 1220-21, figure and table. Both patents descended from and claimed priority to the same prior patent application⁹ so both would have had the same expiration date as each other, not including the PTA awarded to the '369 Patent. *Id.* at 1219. However, Respondent held that issuance of

9. The '036 and '369 Patents therefore have the same "effective filing date," meaning the '036 Patent is not relevant in evaluating the '369 Patent for statutory obviousness. *See* 35 U.S.C. § 100(i)(1), defining a patent's "effective filing date" as "the filing date of the earliest application for which the patent . . . is entitled . . . to a right of priority," and § 103, requiring that obviousness be assessed as of "the effective filing date of the claimed invention."

the '036 Patent, more than two-and-a-half years after the '369 Patent issued, suddenly rendered the '369 Patent invalid for ODP. The '369 Patent's 45 days of PTA meant it was set to expire after the '036 Patent did, resulting in a supposedly unjust extension of patent term, according to Respondent. *Id.* at 1226, 1229 (stating that a “crucial purpose of ODP is to prevent an inventor from securing a second, later-expiring patent for non-distinct claims. This purpose applies equally to situations in which the later patents have received grants of PTA resulting from examination delays at the USPTO” and agreeing with Respondent that “Collect received an unjustified timewise extension of its patent terms and that it does not matter how the unjustified extensions are obtained.”).

This inflexible application of ODP¹⁰ is not only contrary to Congress's intent that ODP should be determined based on a patent's expiration date absent PTA, as expressed in § 154, but also serves none of the purported purposes of ODP doctrine while delivering an inequitable result to a patentee. Obviousness-type double patenting is supposed to prevent a patentee from obtaining an unjustified extension of patent term, either because the public should be able to rely on an expiration date of a patent so

10. This Court has repeatedly rejected proposed rules deemed too rigid or inflexible for analyzing patent-related issues. *See, e.g., Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 553 (2014) (“The framework established by the Federal Circuit . . . is unduly rigid . . .”); *Bilski v. Kappos*, 561 U.S. at 604 (declining to endorse the Federal Circuit's “machine-or-transformation test” as “the sole test for deciding whether an invention is a patent-eligible ‘process’”); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007) (“We begin by rejecting the rigid approach of the Court of Appeals.”).

as to be able to practice its claims and obvious variants thereof after it expires, because the applicant engaged in gamesmanship in obtaining unjustified extension of patent term, or some combination of both. *See* Kazhdan, *Obviousness-Type Double Patenting: Why It Exists And When It Applies*, 53 Akron L. Rev. 1017 (2019), at 1026, summarizing justifications for ODP doctrine. But neither goal is aided by a rule where, for example, a patent can issue having a known expiration date and exist for years without ODP invalidity, then suddenly become invalid for ODP because another patent issues having an earlier expiration date.

The public was made aware of the date of expiration of the '369 Patent, including with its PTA award conferred as required by statute, on the day it issued. There is no reason why the lack of PTA awarded to the '036 Patent when it issued over two-and-a-half years later should suddenly have given the public the expectation that the '369 Patent should expire 45 days sooner than had long been expected. That is, the '369 Patent validly issued, with a publicized expiration date including PTA. Years later, a different patent issued, then expired. Somehow, according to Respondent, expiration of this other, subsequently issued patent deprived the public of an expectation of being able to practice supposedly obvious variants of its claims covered by the claims of the '369 Patent, even though the public had known the '369 Patent's expiration date all along. There was therefore no deprivation of public expectations that justifies finding that the '036 Patent rendered the '369 Patent invalid for ODP because the '369 Patent previously issued with a PTA award.

And there is no allegation that gamesmanship on Petitioner's part resulted in an unjustified extension of

patent term. *In re: Collect, LLC*, 81 F.4th at 1230. The entire basis for the ODP allegation is that the '369 Patent received a PTA award and had claims that were obvious over those of a reference patent, the '036 Patent, which did not receive PTA. Patent term adjustment is applied by Respondent as required by § 154 to compensate for administrative delays in patent issuance and Congress imposed safeguards against manipulation of PTA by a patent applicant. Whereas days of PTA accrue when Respondent takes longer to accomplish various tasks than as prescribed in § 154, days of PTA are deducted for delays in patent issuance attributable to the applicant. § 154(b)(2)(C). Thus, § 154 requires Respondent to confer a PTA award, which is insulated from applicant manipulation. No gamesmanship by Petitioner could have been involved in the awarding of PTA to the '369 Patent that required a remedy of holding the '369 Patent invalid for ODP over the '036 Patent. And in any event, Respondent cannot pursue a policy-based objective in contravention of Congressional intent as expressed in statute. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. at 1359 (“The Director may (today) think his approach makes for better policy, but policy considerations cannot create an ambiguity when the words on the page are clear.”); *see also SCA Hygiene Prod. Aktiebolag v. First Quality Baby Prod., LLC*, 580 U.S. at 345 (rejecting a judicially created patent infringement defense that supposedly solved a problem left unsolved by, and in contradiction of, statute, because Congress provided the statutory remedy, stating that this Court “cannot overrule Congress’s judgment based on our own policy views.”).

Thus, Respondent and the Federal Circuit looked in the wrong place, an inapt comparison between § 154 and § 156, to determine what expiration date Congress

intended to be used when evaluating a patent with a PTA award for ODP. Properly relying instead on the text of § 154 itself yields the correct conclusion that the pertinent date for assessing when ODP may apply is the date the patent would have expired without application of PTA. Respondent's contrary conclusion yields a rule that compels irrational and unfair results and creates problems where none need solving. This Court is urged to grant a writ of certiorari to correct these significant errors.

IV. CONCLUSION

This Court is urged to grant a writ for certiorari to rectify Respondent's misapplication of Congress's statutorily expressed intent in applying PTA. The wanting and strained reasoning used by the Federal Circuit in approving Respondent's approach is devoid of sound analytical basis and, moreover, ignores the result the straightforward application Congress's text would yield. The dissonance between Congress's intended compensatory purpose for PTA and PTA's toxic effect on patents required by the Federal Circuit's circular reasoning supports jettisoning it in favor of the sensible outcome that follows naturally from the statute's prescribed scheme. To permit otherwise would be to allow an expansion of a judicial exception to patent validity in contrast to a Congressional mandate, without any corresponding public benefit yet with significant detriment to the patent system.

Respectfully submitted,

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