

No. 23-1231

In the Supreme Court of the United States

CELLECT, LLC, PETITIONER

v.

KATHERINE K. VIDAL, 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 INARI AGRICULTURE, INC. AS
AMICUS CURIAE IN SUPPORT OF RESPONDENT**

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INTEREST OF AMICUS CURIAE¹

Inari Agriculture, Inc. (“Inari”) was formed in 2016 to develop pioneering technology to selectively edit plant genes to enhance agronomic traits to increase crop yields and decrease inputs such as water and fertilizer. Inari partners with independent seed companies to develop improved seeds using Inari’s technology. Inari respects valid patent rights and has pioneering patents of its own. But Inari also builds upon past advances to create seeds coupling Inari’s own technology with earlier developments once the relevant patents expire.

Double patenting is a critical tool for policing the patent system’s *quid pro quo* and protecting innovators—like Inari—from earlier patentees seeking to leverage legacy technology after their patents expire.

To this end, Inari has filed numerous *ex parte* reexamination requests based on the Federal Circuit’s decision in this case. Those reexaminations target patent thickets cultivated by entrenched incumbents in the seed business. Such incumbents exploit loopholes in the Patent Term Adjustment (PTA) system to perpetuate their monopolies and prevent American farmers from practicing technologies claimed in expired patents.

¹ Pursuant to Supreme Court Rule 37.2, amicus notified both parties on August 8, 2024 of the intention to file this brief. Pursuant to Rule 37.6, *amicus* states that no counsel for any party authored this brief in whole or in part, and that no entity or person other than amicus and their counsel made any monetary contribution toward the preparation and submission of this brief.

INTRODUCTION AND SUMMARY

Echoing the fictional white-collar villain Gordon Gekko, Petitioner and its amici have publicly proclaimed that “greed is good.” They insist that they are entitled to extend a first awarded patent term by virtue of having filed a second patent covering the very same invention. The extended expiration date is assigned by the U.S. Patent & Trademark Office (PTO) as so-called Patent Term Adjustment (PTA) to account for ostensible delays of the agency in issuing the *second filed*, and indisputably indistinct, claim set. But when the patent filer has already secured a patent term via its first filing, PTA for the second filing rewards gamesmanship and upends the fundamental “*quid-pro-quo* premise” underlying patent law since Congress passed the original Patent Act in 1790: once a patent term expires, the public is entitled to “the full benefit” of the invention protected by that patent. *Amgen Inc. v. Sanofi*, 598 U.S. 594, 604-05 (2023) (quoting 1790 Act). Presently, Petitioner and its amici can and do delay the date when the public receives that benefit (after having previously paid the tax of the patent owner’s exclusivity) merely by pursuing multiple patents for the same invention. They likewise follow the advice of patent attorneys who have devised brazen strategies for gaming the PTA system and actively undermining the PTO in its effort to issue patents as quickly as possible. The creation of patent thickets has proliferated for this, and many other reasons.

Obviousness-type double patenting (OTDP) protects the public by policing the fundamental principle “that

after the expiration of a federal patent, the subject matter of the patent passes to the free use of the public.” *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 152 (1989). As soon as a patent expires, in other words, “the right to make the thing formerly covered by the patent becomes public property.” *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169, 185 (1896).

Consistent with this Court’s precedent and 234 years of Congressional enactments, OTDP “enforce[s] the fundamental right of the public to use the invention claimed in the earlier-expiring patent and all obvious modifications of it after that patent’s term expires.” *Gilead Scis., Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1217 (Fed. Cir. 2014), *cert. denied*, 575 U.S. 902 (2015).

The Federal Circuit’s decision herein safeguards the public’s fundamental right, which is critical to American farmers. Once a patent has expired, “any extension past that date constitutes an inappropriate timewise extension for” commonly owned claims that are merely “obvious variations” of the expired claim. Pet. App. 25a.

The Federal Circuit’s decision also tracks this Court’s longstanding precedent concerning “continuation” practice and has rightly encouraged patent attorneys to recommend the use of terminal disclaimers to link patentably indistinct claim sets together—ensuring that all expire at the same time. By contrast, earlier commentaries had highlighted brazen strategies for exploiting loopholes in the PTA system and delaying patent issuance while wrongly attributing such delays to the PTO. Granting certiorari would wrongly roll back the clock and encourage such gamesmanship while undoing the progress the Federal Circuit’s decision has

achieved. The Federal Circuit indeed has consistently shown itself to be a reliable steward of continuation practice and OTDP doctrine. It respects Congressional enactments while harmonizing district court decisions—including those noted by Petitioner and its amici in the wake of the original *Collect* decision.

ARGUMENT

I. The Decision Below Vindicates the Patent System’s *Quid Pro Quo* and the Public’s Right to Use a Claimed Invention Once the Patent Expires

“The disclosure required by the Patent Act is the ‘quid pro quo of the right to exclude.’” *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int’l*, 534 U.S. 124, 142 (2001) (quoting *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 484 (1974)).

The very first Patent Act of 1790 made the *quid pro quo* and included requirements ensuring “***the public may have the full benefit [of the invention], after the expiration of the patent term.***” Act of Apr. 10, 1790, § 1, 1 Stat. 110 (emphasis added). This “*quid-pro-quo* premise of patent law” has endured for the past 234 years. *Amgen*, 598 U.S. at 604-05 (quoting 1790 Act).

Double patenting doctrine has enforced that quid pro quo for nearly as long. See *Odiorne v. Amesbury Nail Factory*, 18 F. Cas. 578 (C.C.D. Mass. 1819) (Story, J.) (rejecting attempt to “perpetuate [inventor’s] exclusive right”). The 1790 Patent Act allowed inventors to seek “***a*** patent” for their inventions—just like § 101 authorizes “***a*** patent” today. See *Abbvie Inc. v. Mathilda &*

Terence Kennedy Inst. of Rheumatology Tr., 764 F.3d 1366, 1372 (Fed. Cir. 2014).

Once that patent expires, the public gains the “fundamental right” to use the claimed invention—including “all obvious modifications”—without fear of suit. *Gilead*, 753 F.3d at 1217. OTDP safeguards that freedom to operate. *Id.* The “fundamental right” reflects the *quid pro quo* underlying the U.S. patent system since it began. But Collect and its amici conveniently never acknowledge it.

A. The Right to Practice Expired Claims is Crucial For Farmers, Who Face Oligopolists Wrongly Suppressing Competition Even After Patents Expire

The fundamental right to practice expired patent claims is vital for American farmers. As the U.S. Department of Agriculture (USDA) recently stressed, “[a]n important feature of the IP system is that after a patent expires, the patented material enters the public domain.”² But an oligopoly of entrenched incumbents dominate seed distribution and suppress competition. “For years, American farmers and independent seed businesses have voiced concerns” regarding this “concentration and the consolidation of market power in agriculture.”³ In particular, the USDA has stressed the risk of “patent-holding firms...delay[ing] competition”

² USDA Agricultural Marketing Service, *More and Better Choices for Farmers* (March 2023) at 53, <https://www.ams.usda.gov/sites/default/files/media/SeedsReport.pdf>

³ *Id.* at 3.

even “*after patents have expired.*”⁴ Multiple federal agencies and state governments are confronting this threat—including the USDA in partnership with the PTO.

Two companies—Corteva and Bayer/Monsanto—control over 70% of the U.S. corn seed market⁵ and 85% of corn-related intellectual property.”⁶ Together with BASF and ChemChina’s Syngenta Group, these oligopolists own 95% of corn-related IP, 97% of canola-related IP, and 84% of soybean-related IP.⁷

The USDA traces this “concentration...to the expansion of intellectual property rights” in “genetically modified (GM) varieties of seed.”⁸ As “biochemistry advanced,” the industry became “highly integrated.”⁹ Corteva, for example, amalgamated over fifty different legacy firms.

The Federal Trade Commission (FTC) and twelve states ranging from Texas to California are responding aggressively. They have collectively sued Corteva and Syngenta for “maintain[ing] monopolies long after their lawful exclusive rights to particular crop-protection

⁴ *Id.* at 53 (emphasis added).

⁵ USDA Economic Research Service, *Two companies accounted for more than half of corn, soybean, and cotton seed sales in 2018–20* (last updated October 2, 2023), <https://www.ers.usda.gov/data-products/chart-gallery/gallery/chart-detail/?chartId=107516>

⁶ USDA, *More and Better Choices for Farmers* at 77.

⁷ *Id.* at 42.

⁸ USDA, *Two companies....*

⁹ *Id.*

products have expired.”¹⁰ One Corteva employee bragged how Corteva had leveraged its position to suppress competition and maintain “a significant brand premium over the generics”—forcing farmers to pay higher prices than would prevail in a competitive market.¹¹ A federal district court recently denied Corteva’s motion to dismiss the complaint and held that the plaintiffs had plausibly alleged “anticompetitive conduct” by Corteva based on evidence such as comments by a Corteva manager that Corteva had “done an A+ job blocking generics” even after patents expired. *Fed. Trade Comm’n et al v. Syngenta Crop Prot. AG et al.*, No. 1:22CV828, 2024 WL 149552, at *22 (M.D.N.C. Jan. 12, 2024).

Given related threats of “concentrated market power” in the seed industry, the President ordered the PTO and USDA to collaborate and ensure that intellectual property does not “unnecessarily reduce competition in seed and other input markets beyond that reasonably contemplated by the Patent Act.”¹² To this end, Director Vidal and Secretary Vilsack jointly announced a working group “to enhance the quality of the patent examination process for innovations related to agricultural products.”¹³ They stressed that the patent laws

¹⁰ *FTC v. Syngenta et al.*, Case No. 1:22-cv-00828-TDS-JEP (M.D.N.C.), Docket No. 79 (Dec. 23, 2022 Amended Complaint), ¶ 1.

¹¹ *Id.*, ¶133.

¹² Executive Order 14036, *Promoting Competition in the American Economy*, 86 Fed. Reg. 36987, 36993 (July 14, 2021).

¹³ Thomas J. Vilsack, Secretary of Agriculture, and Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Direc-

“encourage the disclosure of inventions, and for *others to build on those innovations*.”¹⁴

These Executive Branch efforts to protect seed markets complement broader-based initiatives to crack down on patent thickets, which as the PTO has warned “deter competition.” *Terminal Practice to Obviate Non-statutory Double Patenting*, 89 Fed. Reg. 40439, 40440 (May 10, 2024) (PTO Notice of Proposed Rulemaking). The PTO’s rulemaking efforts recognize OTDP’s role in policing such abuses. And they arise from the same Executive Order underlying the joint PTO-USDA efforts and likewise aim to “reduce[] barriers to market entry.” *Id.* Commenting in support of the PTO’s proposed rule, the FTC stressed “bipartisan Congressional concerns” regarding “patent thickets erected by incumbents.”¹⁵ The FTC noted in particular that the proposed rule will “reduce[] gamesmanship by patent holders, as well as the number, size, and impact of patent thickets.”¹⁶

tor of the U.S. Patent and Trademark Office, *Increasing transparency, boosting competition, and supporting innovation can deliver better choices for farmers in the seed marketplace* (March 3, 2023), <https://www.uspto.gov/subscription-center/2023/increasing-transparency-boosting-competition-and-supporting-innovation-can>

¹⁴ *Id.* (emphasis added).

¹⁵ July 9, 2024 FTC Comment on USPTO Terminal Disclaimer Notice of Proposed Rulemaking at 2, <https://www.regulations.gov/comment/PTO-P-2024-0003-0322>.

¹⁶ *Id.* at 8.

B. Inari is Forced to File Reexamination Requests to Ensure Freedom to Operate and Preserve the Patent System’s *Quid Pro Quo* in the Face of the Oligopoly’s Systematic Double Patenting

Inari is an innovator leveraging earlier technologies while confronting the seed industry’s entrenched incumbents abusing the patent system and cultivating patent thickets. Inari’s pioneering gene editing platform enables Inari to couple existing GM traits (e.g., pest control) with new sustainability-focused benefits of Inari’s unique gene edits (e.g., reduced need for water and fertilizer).

Consistent with the joint PTO-USDA policy (*supra* § I.A), Inari has filed numerous *ex parte* reexamination requests to vindicate the Patent Act’s *quid pro quo* and confirm the public’s freedom to practice expired patent claims—the same right the Federal Circuit upheld but which Petitioner and its amici disregard. For example, Inari has filed eight reexamination requests concerning utility patents controlled by Corteva. Together, these eight claim sets purport to extend Corteva’s monopolies by *more than twenty years*.¹⁷

¹⁷ See Serial Nos. 90/019,130 (explaining why claims in U.S. Patent No. 10,947,555 are obvious variants of claims expiring 257 days earlier); 90/019,131 (explaining why claims in U.S. Patent No. 8,283,522 are obvious variants of claims expiring 907 days earlier); 90/019,132 (explaining why claims in U.S. Patent No. 8,952,223 are obvious variants of claims expiring 686 days earlier); 90/019,306 (explaining why claims in U.S. Patent No. 6,943,282—purporting to exclude others from practicing the claims invention until September 13, 2027—are obvious variants of claims that already expired on June 3, 2020 (i.e., 2658 days earlier)); 90/019,310 (explaining why

Each claim set wrongly deprives the public of the “benefit of the invention after the original period of monopoly expires,” *Abbvie*, 764 F.3d at 1373, and in particular “the fundamental right” to use the claimed invention—including “all obvious modifications”—without fear of suit, *Gilead*, 753 F.3d at 1217.

For example, Corteva’s U.S. Patent No. 6,943,282 purportedly excludes others from practicing the claimed insect-resistant plants until ***September 13, 2027*** even though they are at most obvious variants of different Corteva patent claims that expired no later than ***June 3, 2020***—more than seven years earlier. To add insult to injury, Corteva’s ’282 Patent claims priority to an application filed on September 24, 1983. The forty-four-year period between 1983 (when Corteva disclosed the technology) and 2027 (when Corteva will ostensibly stop threatening farmers with this patent family) exemplifies rampant OTDP gamesmanship in the transgenic seed industry.

Similarly, Corteva’s U.S. Patent 9,596,871 purports to exclude farmers from using the claimed canola seeds and plants until May 1, 2035 despite the claims being obvious variants of others expiring more than three years earlier. Such PTA-based abuse exemplifies the same pattern of illegal conduct the FTC and numerous

claims in U.S. Patent 9,596,871 are obvious variants of claims expiring 1257 days earlier); 90/019,319 (explaining why claims in U.S. Patent 7,838,733 are obvious variants of claims expiring 360 days earlier); 90/019,321 (explaining why claims in U.S. Patent 8,609,935 are obvious variants of claims expiring 1114 days earlier); and 90/019,322 (explaining why challenged claims in U.S. Patent No. 8,598,413 are obvious variants of claims expiring 237 days earlier).

states target in suing Corteva for maintaining monopolies long after its lawful patent rights have expired. *See supra* § 1.A.

Inari requested reexamination of the '282 and '871 Patents to address these unlawful claims—much like those the reexaminations at issue herein found unpatentable and which the Federal Circuit affirmed without dissent.

The existence of such unlawful claims wrongly harms Inari as well as U.S. farmers who rely on patent law's "*quid-pro-quo* premise" and the public's fundamental right to practice expired patent claims. *Amgen*, 598 U.S. at 604-05 (quoting 1790 Act).

By contrast, Petitioner's own purported "investment-backed expectations" (Pet. at 24) ring hollow given that it was Petitioner's own voluntary choice to seek multiple patents for what was indisputably the same invention. Having benefited from those multiple patents, Petitioner cannot escape the consequences of what the earliest expiring of those patents conveyed to the public: once the claims expired, the public was free to practice those claims and "all obvious modifications" without fear of being sued by Petitioner for patent infringement. *Gilead*, 753 F.3d at 1217

Nor do PhRMA and BIO offer any evidence that the Federal Circuit's *Collect* decision "destabilizes the system that is so critical to incentivizing innovators to innovate." (PhRMA Br. at 18). Ten years ago, when unsuccessfully urging this Court to grant certiorari in the *Gilead v. Natco* case that *Collect* echoes, PhRMA and BIO insisted that "this Court's review [was] needed to

prevent this erosion of the incentives that encourage biopharmaceutical innovation by granting review and reversing.” Brief for the Pharmaceutical Research and Manufacturers of America and Biotechnology Industry Organization as Amici Curiae in Support of Petitioners, *Gilead Sciences, Inc. v. Natco Pharma Ltd.*, 575 U.S. 902 (2015) (14-647), 2014 WL 7405884. Notwithstanding PhRMA’s plea, this Court denied review. And as PhRMA now admits, in the subsequent ten years PhRMA’s research and development investments “have more than *doubled*.” PhRMA Br. at 1. PhRMA’s suggestion of destabilization today is no more credible than its suggestion of “erosion” a decade ago.

* * *

There is no reason to grant certiorari as to a decision properly grounded in centuries of precedent and sound patent policy. Review by the Supreme Court would encourage oligopolists like Corteva to continue sowing uncertainty among American farmers. It would also wrongly impede Inari’s efforts to propel the U.S. agricultural industry to a more competitive and sustainable future than the current concentration of market power the Executive Branch and many state governments are now forced to actively confront.

II. Patent Term Adjustment is Fundamentally Different From Patent Term Extension and Rife With Opportunities for Abuse—As Attorneys Openly Touted Before the Decision Below

Petitioner and its amici repeatedly cite *Novartis AG v. Ezra Ventures LLC*, 909 F.3d 1367 (Fed. Cir. 2018), yet neglect critical differences between PTA versus the Patent Term Extension (PTE) regime addressed in *Ezra*. The Federal Circuit emphasized key statutory differences. Pet. App. 11a–21a.

There are also enormous *practical* differences between PTA and PTE, the latter of which does not even impact farmers.¹⁸

PTE’s very nature inoculates it against gamesmanship. No rational actor would try manipulating the PTE regime by delaying its own regulatory approval to start selling the drug, medical device, food additive, or color additive under review.

The PTA regime, by contrast, is rife with opportunities for abuse. Continuation practice tempts applicants to get greedy and double dip—pursuing certain claim sets quickly to allowance while delaying others to reap PTA.

Patent attorneys regularly exploit such loopholes to maximize the amount of ostensible adjustment while avoiding reductions under the letter of section 154.

¹⁸ PTE is limited to “drug product[s]” and “medical device, food additive, or color additive” products. 35 U.S.C. § 156(f). Inari, seed companies, and crop growers can therefore exercise their “fundamental right[s]” under *Gilead* without fear of PTE-related complications.

Some even write articles touting their strategies—illustrating how applicants often welcome “issue date[s]” of their patents to be “*delayed*.”¹⁹ By their own admission, and in their own words, patent prosecutors have long been “*manipulating patent prosecution to maximize PTA*.”²⁰ This belies Petitioner’s assertion that PTA reflects “problems of the Patent Office’s own making.” Petition at 28.

For example, one patent attorney cataloged loopholes in an article entitled *Patent Term Adjustment for Fun and Profit*.²¹ This piece—touted by a leading patent weblog as a “great guide to PTA”²²—recommends strategies such as “filing a continuation-in-part instead of a continuation.”²³ The article explains how internal PTO docketing procedures make the PTO “more likely to violate the fourteen-month-to-first action guarantee” when

¹⁹ Verne A. Luckow, *Complex Interactions Between FDA and PTO Regulations Affecting Exclusivity Periods and the Patent Term of Biopharmaceutical Drug Products*, 2011 WL 5833344.

²⁰ *Maximizing Patent Term Adjustment Under Exelixis* (Jan. 24, 2013), <https://www.foley.com/insights/publications/2013/01/maximizing-patent-term-adjustment-under-exelixis/>

²¹ Scott E. Kamholz, *Patent Term Adjustment for Fun and Profit* at 2, https://cdn.patentlyo.com/media/docs/2006/10/PTA_20for_20Fun_20and_20Profit.pdf

²² Dennis Crouch, *Patent Term Adjustment for Fun and Profit* (Oct. 17, 2006), https://patentlyo.com/patent/2006/10/patent_term_adj.html.

²³ Such designations are purely administrative; they do “not determine [an application’s] legal status.” *Anascope, Ltd. v. Nintendo of Am., Inc.*, 601 F.3d 1333, 1338 n.2 (Fed. Cir. 2010).

applicants file their follow-on applications as continuations-in-part. The *Fun and Profit* article likewise recommends that “applicants seeking to increase PTA” should take the “full five-month extension of time before filing an appeal brief” given loopholes in PTO regulations.²⁴

Other attorneys have touted related strategies such as waiting until the exact “three-month date” after allowance to “pay the issue fee.”²⁵ Still others trumpet strategies for “maximiz[ing]” both A and B delay, including “taking a one-month extension of time and replying to a pre-examination notice or restriction requirement at the three-month deadline.”²⁶

In plain English, these patent lawyers were advising clients how they could delay issuance of patent applications while pretending that it was the PTO’s fault—thereby generating extra patent term via PTA in the process.

Inari’s reexamination requests (*supra* § 1.B) target multiple patents that were prosecuted using such strategies.²⁷

²⁴ Kamholz at 5.

²⁵ N. Nicole Endejann, *Developing Effective Exclusivity Strategies for Clients in the Pharmaceutical and Biotechnology Industries*, 2013 WL 571777.

²⁶ Eric K. Steffe & Lori M. Brandes, *Patent Term Adjustment* (July 2020), <https://www.sterneckessler.com/news-insights/publications/patent-term-adjustment>

²⁷ For example, Corteva filed U.S. Patent No. 8,598,413 as a continuation-in-part rather than a continuation. Similarly, it waited almost the full three months to pay the issue fees for U.S. Patent

III. The Decision Below Changed Behavior for the Better—Incentivizing Strategies Consistent With This Court’s Longstanding Precedent As To Continuation Practice

In stark contrast to the numerous above-noted commentaries advising patent applicants to leverage such loopholes, the patent bar has pivoted in the wake of the Federal Circuit’s decision and now advises strategies consistent with the letter and spirit of the Patent Act as well as this Court’s precedent. These recent commentaries highlight the decision’s salutary impact and the array of different options still available to patent applicants to pursue appropriate protection for their intellectual property. Granting certiorari would delay this transition and wrongly encourage applicants to revert to the gamesmanship patent attorneys had been touting before the Federal Circuit’s decision.

The Federal Circuit’s decision rightly incentivizes applicants to include as many claims as possible in the original patent application while focusing any continuations on claims that are actually “patentably distinct” and therefore do not implicate ODP at all or risk forfeiting any PTA that accrued during prosecution of the original application.²⁸ Such practices also have the separate

Nos. 8,609,935 and 8,952,223. And with the ’935 Patent, Corteva took an extension to respond to a restriction requirement. These choices delayed prosecution, yet under the letter of 35 U.S.C. § 154 did not count against Corteva’s PTA.

²⁸ WilmerHale, *Patent Term Adjustments in Jeopardy After In re Collect* (Aug. 30, 2023), <https://www.wilmerhale.com/insights/client-alerts/20230829-patent-term-adjustments-in-jeopardy-after-in-re-collect>; see also Womble Bond Dickinson, *Navigating the Implications of In re Collect: What You Need to Know About Patent Term*

but related benefit of reducing the total number of applications the PTO must examine—reducing application pendency time and the need for PTA at all.

Of course, applicants retain the right under 35 U.S.C. § 120 to pursue continuations even if the claim sets are *not* patentably distinct and instead concern a single invention. In such circumstances, applicants “can proactively file a terminal disclaimer to ensure that they do not suffer the same fate as *Collect*.”²⁹ Such terminal disclaimers ensure that the two patents expire at the same time—consistent with this Court’s long-standing emphasis that under such circumstances both the original application and the continuation “are to be considered as parts of the same transaction, and both as constituting one continuous application.” *Godfrey v. Eames*, 68 U.S. 317, 325–26 (1863); *see also Nat. Alternatives Int’l, Inc. v. Iancu*, 904 F.3d 1375, 1382 (Fed. Cir. 2018) (citing § 120 and quoting *Godfrey*); *Transco Prod.*

Adjustment & Obviousness-Type Double Patenting (Jan. 26, 2024), <https://www.womblebondnickinson.com/us/insights/alerts/navigating-implications-re-collect-what-you-need-know-about-patent-term-adjustment> (“[A]pplicants/practitioners should consider pursuing more claims in a single application....”)

²⁹ Derrick Carman, *In re Collect’: How Patent Owners Can Protect Themselves From Obviousness-Type Double Patenting Invalidity Determinations*, N.Y. Law Journal (Mar. 22, 2024); *see also* Mintz, *Federal Circuit Puts the Onus on Patent Owners to Disclaim Patent Term or Face Double-Patenting*, <https://www.mintz.com/insights-center/viewpoints/2231/2023-09-07-federal-circuit-puts-onus-patent-owners-disclaim-patent> (“Practitioners are thus well advised to address ODP during prosecution, either by filing a preemptive terminal disclaimer or by ensuring that the claims being prosecuted are not the same or obvious variants of prior issued claims.”).

Inc. v. Performance Contracting, Inc., 38 F.3d 551, 556–57 (Fed. Cir. 1994) (“The legislative history of section 120 does not indicate any congressional intent to alter the Supreme Court’s interpretation of continuing application practice.”); J. Frederico, *Commentary on the New Patent Act*, 35 U.S.C.A. (1954) (citing *Godfrey* when discussing § 120), reprinted in 75 J. Pat. & Trademark Off. Soc’y 161, 192–93 (1993).

Indeed, terminal disclaimers—such as the patent bar now recommends—and this Court’s holding in *Godfrey* work hand in hand to square what would otherwise be two inconsistent provisions of the Patent Act. On the one hand, § 101 dictates that an inventor of a new invention is entitled to “*a* patent”—not multiple patents—for that invention (assuming that all other statutory requirements are meant).³⁰ But at the same time, § 120 authorizes continuation practice and—unlike § 121, which provides a safe harbor from OTDP challenges—does not limit continuations to situations in which “independent and distinct inventions” are involved.

To the extent an applicant elects to pursue multiple applications to a single invention under § 120, this Court’s precedent is clear: both applications must “be considered as parts of the same transaction, and both as

³⁰ Petitioner and its amici wrongly dwell on the ostensible distinction between “same-invention” double-patenting under § 101 versus OTDP while discounting the latter as a merely “judge-made” doctrine. But throughout its history, patent law has recognized that a subsequent claim may technically be different from an earlier one, but nevertheless “so traced” by the earlier claim such that the ostensible “improvement” does not constitute invention. *Hotchkiss v. Greenwood*, 11 How. 248, 267 (1851).

constituting one continuous application.” *Godfrey*, 68 U.S. at 325–26. A single application plainly cannot lead to multiple patents with different expiration dates, as that would unmistakably violate the Patent Act’s admonition that an invention justifies at most “*a* patent,” which necessarily has *a* term. 35 U.S.C. § 101. But there is no such difficulty if multiple claim sets are not only all associated with the same patent application, but also all expire on the same day.

Terminal disclaimers (such as patent lawyers now routinely recommend following the Federal Circuit’s decision) ensure such same-day expiration—returning continuation practice to its origins as this Court set forth in *Godfrey*. Granting certiorari would wrongly arrest this favorable trend while lending aid and comfort to the cottage industry of patent attorneys who had been manipulating patent prosecution and striving to delay patent issuance while making it appear (wrongly) to be the PTO’s fault—reaping extra patent term in the process.

IV. The Federal Circuit is Best Positioned to Continue Refining OTDP Caselaw

Notwithstanding the alleged confusion and uncertainty suggested by Petitioner and its amici in the wake of the *Collect* decision, the Federal Circuit has already addressed the purported district court split concerning the impact of the holding (see Petition at 25) and definitively held that an earlier-issued “parent” patent with PTA is *not* invalid for OTDP in view of a later-issued “child” patent that has less (if any) PTA and therefore expires sooner. *Allergan USA, Inc. v. MSN Lab’s Priv.*

Ltd., No. 2024-1061, -- F.4th --, 2024 WL 3763599, at *8 (Fed. Cir. Aug. 13, 2024).

The *Allergan* decision exemplifies the Federal Circuit’s measured approach to OTDP and confirms that *Collect* stays within the lines Justice Story outlined two centuries ago. *Allergan* considered the “fundamental purposes of [OTDP]” while also recognizing “the benefit Congress intended to bestow on patentees when codifying PTA.” *Id.*

Indeed, *Allergan* confirms that OTDP issues can only arise within a patent family when an applicant obtains an initial “parent” patent with a given expiration date and then *later* obtains a “child” patent with patentably indistinct claims (i.e., no more than “obvious variants” of the parent claims) that nevertheless are scheduled to expire *after* the parent claims. That is precisely the evil Justice Story warned against. Once a patent has issued and taxed the public given the exclusive rights the patent conveys during its term, the applicant cannot “perpetuate his exclusive right” by obtaining a second patent with a later expiration date. *Odiorne*, 18 F. Cas. at 578. Such a later-expiring subsequent patent would “completely destroy the whole consideration derived by the public for the grant of the [original] patent”—that is, “the right to use the invention at the expiration of the term specified in the original grant.” *Id.*

For example, if a plant breeder developed a new and non-obvious corn plant—for instance, one that yielded more corn per acre than either parent plant—the breeder would be entitled to a utility patent on the new variety given the showing that the parent plants had

“worked together in an unexpected and fruitful manner.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416, (2007). The issuance of such patent would allow the breeder to prevent others from using the new plant during the patent’s life—a just reward to incentivize the disclosure of the unexpected discovery. But the issuance of the patent claims on the new and superior new plant would also inform competitors such as Inari that once the patent expires, they will be entitled to use (and indeed, improve upon) the previously patented plant. That is the “*quid-pro-quo* premise” that has animated American patent law since its inception. *Amgen*, 598 U.S. at 604-05 (quoting 1790 Patent Act).

That underlying quid pro quo would be destroyed if the plant breeder could upset Inari’s investment-backed expectations by obtaining a later “child” patent that has insubstantially different claims but nevertheless ostensibly expires later than the parent thanks to PTA—for example, following the playbook outlined by patent attorneys concerning how to game PTA “for fun and profit.” *See supra* § II. Not even Gordon Gekko could defend such a result.

CONCLUSION

The Court should deny certiorari and leave the Federal Circuit's decision in place.

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