

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

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

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

A patent is invalid for obviousness-type double patenting if its claims are not patentably distinct from the claims of an earlier-expiring reference patent. Patent-term adjustment extends the length of a patent term when the United States Patent and Trademark Office fails to take particular administrative actions within specified periods of time at various stages of patent examination. 35 U.S.C. 154(b). The question presented is as follows:

Whether the ban on obviousness-type double patenting applies when patent-term adjustment causes a challenged patent to remain in force after the reference patent expires.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-29a) is reported at 81 F.4th 1216. The opinions of the Patent Trial and Appeal Board (Pet. App. 30a-54a, 55a-79a, 80a-104a, 105a-128a) are not reported but are available at 2021 WL 5755316, 2021 WL 5755319, 2021 WL 5755327, and 2021 WL 5755329. The findings of the patent examiner (Pet. App. 129a-161a, 162a-241a, 242a-281a, 282a-311a) are not reported but are available at 2020 WL 4196646, 2020 WL 4196648, 2020 WL 4197398, 2020 WL 4197402, 2020 WL 4197522, 2020 WL 4198373, and 2020 WL 5900064.

JURISDICTION

The judgment of the court of appeals was entered on August 28, 2023. A petition for rehearing was denied on

January 19, 2024 (Pet. App. 312a-314a). On April 8, 2024, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including May 20, 2024, and the petition was filed on that date. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. “[S]ince the inception of our patent laws,” courts have recognized a “prohibition on double patenting.” *Abbvie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust*, 764 F.3d 1366, 1372 (Fed. Cir. 2014). Under that “well-settled” prohibition, “two valid patents for the same invention cannot be granted either to the same or to a different party.” *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 197 (1894). In such a case, “the later [patent] must be declared void.” *Ibid.* As Justice Story explained, if patentees could “successively take out at different times new patents for the same invention, [they] may perpetuate [their] exclusive right during a century,” thus “completely destroy[ing] the whole consideration derived by the public for the grant of the patent, viz. the right to use the invention at the expiration of the term specified in the original grant.” *Odiorne v. Amesbury Nail Factory*, 18 F. Cas. 578, 579 (C.C.D. Mass. 1819) (No. 10,430) (Story, J.).

The Patent Act of 1952 (Patent Act), ch. 950, 66 Stat. 792 (35 U.S.C. 1 *et seq.*) codifies the prohibition against double patenting. It provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a *patent* therefor.” 35 U.S.C. 101 (emphasis added). By using the singular “a patent,” *ibid.*, the statute “forbids an individual from

obtaining more than one patent on the same invention,” *Abbvie Inc.*, 764 F.3d at 1372.

The “bar against double patenting” applies not only to an inventor’s attempt to patent “the exact invention” more than once, but also to “obvious modifications of that invention that are not patentably distinct improvements.” *Gilead Scis., Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1212 (Fed. Cir. 2014), cert. denied, 575 U.S. 902 (2015). Under that framework, “the invention covered by the later patent” must be “a separate invention, distinctly different and independent from that covered by the first patent; in other words, it must be something substantially different from that comprehended in the first patent.” *Miller*, 151 U.S. at 198. This doctrine is known as “obviousness-type double patenting.” *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 967 (Fed. Cir. 2001), cert. denied, 534 U.S. 1109 (2002).

The Patent Act allows an inventor to avoid double-patenting objections by filing a terminal disclaimer. See 35 U.S.C. 253(b). Section 253(b) provides that “any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.” *Ibid.*; see 37 C.F.R. 1.321. Through a terminal disclaimer, a patentee may “combat[] a defense of double patenting” by “cut[ting] back the term of a later issued patent so as to expire at the same time as the earlier issued patent and thus eliminate any charge of extension of monopoly.” *Application of Robeson*, 331 F.2d 610, 614 n.4 (C.C.P.A. 1964) (citation and emphases omitted). If “the second patent expires simultaneously with the first, the right to fully utilize the patented discovery at the expiration date remains unimpaired.” *Id.* at 614. Accordingly, a terminal disclaimer is “a permissible means to

overcome the prohibition on double patenting when it aligns the expiration dates of an inventor's several patents that claim mere obvious variations of the same invention to create a single term of limited exclusivity." *Gilead*, 753 F.3d at 1213.

2. a. Historically, patent terms ran for a set number of years from the date on which a patent was *issued* by the United States Patent and Trademark Office (USPTO). See *Novartis Pharm. Corp. v. Breckenridge Pharm. Inc.*, 909 F.3d 1355, 1362 (Fed. Cir. 2018). In the Uruguay Round Amendments Act (URAA), Pub. L. No. 103-465, 108 Stat. 4809, however, Congress altered that regime by establishing patent terms of "20 years from the date on which the application for the patent was *filed*." 35 U.S.C. 154(a)(2) (emphasis added).

To account for the possibility of USPTO delay during prosecution of patent applications, Congress provided for Patent Term Adjustment (PTA) in the American Inventors Protection Act of 1999, Pub. L. No. 106-113, Div. B, Tit. IV, 113 Stat. 1501A-552. Under PTA, "if the issue of an original patent is delayed due to the failure of" the USPTO to take certain administrative actions in a timely manner, then "the term of the patent shall be extended 1 day for each day" of delay beyond specified periods. 35 U.S.C. 154(b)(1)(A). Similarly, "if the issue of an original patent is delayed due to the failure of the [USPTO] to issue a patent within 3 years after the actual filing date of the application," then "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued." 35 U.S.C. 154(b)(1)(B).

Both of those PTA provisions, however, are "[s]ubject to the limitations under paragraph (2)." 35 U.S.C. 154(b)(1)(A) and (B). One of the limitations under

paragraph (2)—entitled “disclaimed term”—states that “[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.” 35 U.S.C. 154(b)(2)(B) (capitalization omitted).

b. The Drug Price Competition and Patent Term Restoration Act of 1984, Pub. L. No. 98-417, 98 Stat. 1585, commonly known as the Hatch-Waxman Act, “established a patent term extension [PTE] for patents relating to certain products”—such as pharmaceutical drugs—that were “subject to regulatory delays” and “could not be marketed prior to regulatory approval,” *Merck & Co. v. Hi-Tech Pharmacal Co.*, 482 F.3d 1317, 1320 (Fed. Cir. 2007); see 35 U.S.C. 156. Under PTE, the term of an eligible patent “shall be extended by the time equal to the regulatory review period for the approved product which period occurs after the date the patent is issued,” subject to certain exceptions. 35 U.S.C. 156(c). Unlike PTA, PTE contains no limitation for terminal disclaimers.

3. a. This case concerns the validity of four interrelated patents owned by petitioner, each of which is directed to “devices (e.g., personal digital assistant devices or phones) comprising image sensors.” Pet. App. 2a (emphasis omitted). Petitioner filed the applications for each of the four patents between July 2000 and July 2002. *Id.* at 3a. Each of the four patents claims the prior filing date of a related patent application filed in October 1997, which resulted in a patent not directly at issue here. *Id.* at 2a-3a; see 35 U.S.C. 120 (providing that applications for continuations of earlier inventions

are treated “as though filed on the date of the prior application”).¹

Each of the four patents at issue was granted PTA based on USPTO delay in examining and processing the applications. Pet. App. 3a. Without that PTA, the patents would have expired simultaneously in October 2017—20 years after the filing of the October 1997 priority application. *Id.* at 3a-4a. Because of the PTA, however, the patents extended beyond that date. *Id.* at 3a. Petitioner never filed a terminal disclaimer, and the challenged patents have now expired. *Id.* at 3a-4a.

b. Petitioner sued Samsung Electronics in the United States District Court for the District of Colorado, alleging that Samsung had infringed the four patents at issue. Pet. App. 3a. Samsung then sought *ex parte* reexamination of those patents before the USPTO, contending that certain claims of the patents were unpatentable due to obviousness-type double patenting. *Ibid.*; see 35 U.S.C. 302 (“Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301.”).

In each proceeding, the USPTO examiner determined that the challenged claims in the relevant patents were obvious variants of claims in patents that had expired earlier. Pet. App. 4a; see *id.* at 129a-161a, 162a-241a, 242a-281a, 282a-311a. The asserted claims were therefore deemed invalid under obviousness-type double patenting doctrine. *Id.* at 4a.

c. The Patent Trial and Appeal Board (Board) affirmed. Pet. App. 30a-128a. The Board explained that

¹ The patent applications for each of the four patents at issue were either continuations or continuations-in-part of one of the other four applications or of the October 1997 application. Pet. App. 2a-3a.

petitioner did “not dispute” that the challenged claims in each of the four patents at issue were not patentably distinct from claims in earlier-expiring patents. *Id.* at 33a. Instead, petitioner principally argued that obviousness-type double patenting “cannot take away statutorily guaranteed” PTA. *Ibid.*

The Board rejected petitioner’s argument, concluding that “it ignore[d] the plain text” of the PTA provision. Pet. App. 34a, 41a; see 35 U.S.C. 154. The Board emphasized that “the statutory language in § 154 is clear” that “a PTA cannot adjust a term beyond the expiration date in any [terminal] disclaimer.” Pet. App. 42a. And “given that terminal disclaimers arise almost exclusively to overcome obviousness-type double patenting,” the Board reasoned, “Congress expressly addressing terminal disclaimers in § 154 is tantamount to addressing obviousness-type double patenting.” *Ibid.* The Board concluded that the “same rule” that applies to “terminal disclaimers in § 154” must apply “to double patenting as a logical extension.” *Id.* at 43a.

The Board rejected petitioner’s proposed analogy to the PTE procedure set forth in 35 U.S.C. 156. The Board noted that whereas Section 154(b)(2)(B) “expressly excludes patents in which a terminal disclaimer was filed from the benefit of a term of adjustment for PTO delays,” “there is an ‘absence of any such prohibition regarding Hatch-Waxman extensions’ under § 156.” Pet. App. 41a (quoting *Merck*, 482 F.3d at 1322). The Board explained that, in light of that “contrast between PTE and PTA,” the rules “for when to apply a PTE do[] not apply to a PTA.” *Id.* at 42a.

Finally, the Board disagreed with petitioner’s alternative contention that applying obviousness-type double patenting here would be “inequitable” because

petitioner did not engage in “any ‘gamesmanship.’” Pet. App. 51a. “[T]he inequity here,” the Board observed, is petitioner’s “enjoyment of a second patent’s term beyond the expiration of the first patent.” *Ibid.* The Board concluded that, “[b]y permitting the later patent to remain in force beyond the date of the earlier patent’s expiration,” petitioner was “wrongly purport[ing] to inform the public that it is precluded from making, using, selling, offering for sale, or importing the claimed invention during a period after the expiration of the earlier patent.” *Id.* at 52a (citation omitted).

d. The court of appeals affirmed. Pet. App. 1a-29a. Petitioner argued that obviousness-type double patenting “cannot cut off” the “statutorily authorized extension of patent term” through PTA. *Id.* at 13a. The court rejected that argument, emphasizing that Section 154(b)(2)(B)’s “provision regarding terminal disclaimers” is “critical in [the] analysis.” *Id.* at 21a. Because obviousness-type double patenting and terminal disclaimers are “two sides of the same coin,” the court explained, “the statutory recognition of the binding power of terminal disclaimers in § 154(b)(2)(B) is tantamount to a statutory acknowledgement that [obviousness-type double patenting] concerns can arise when PTA results in a later-expiring claim that is patentably indistinct.” *Id.* at 22a (citation omitted).

The court of appeals further observed that, under Section 154, “when a terminal disclaimer has been entered in a patent subject to PTA, no patent (or claim) may be extended beyond the disclaimed expiration date.” Pet. App. 22a-23a. “Accordingly,” the court continued, “in the absence of such disclaimers, it would frustrate the clear intent of Congress for applicants to benefit from their failure, or an examiner’s failure, to

comply with established practice” of filing a terminal disclaimer “as a solution to avoid invalidation of patents claiming obvious inventions, as we have here.” *Id.* at 23a.

The court of appeals rejected petitioner’s proposed analogy to PTE as “an unjustified attempt to force disparate statutes into one.” Pet. App. 17a. The court explained that Section 154 “contains requirements separate and distinct from those in § 156 that indicate a congressional intent to speak to terminal disclaimers and [obviousness-type double patenting] in the context of PTA.” *Id.* at 18a-19a. Specifically, the court observed that Section 154(b)(2)(B) “expressly excludes patents in which a terminal disclaimer was filed from the benefit of” PTA, but “no similar prohibition exist[s] in § 156.” *Id.* at 18a.

Finally, the court of appeals found no merit in petitioner’s contention that “the equitable concerns underlying” the ban on obviousness-type double patenting “do not exist in this case.” Pet. App. 23a. The court emphasized that petitioner does not “dispute[] that the asserted claims in the challenged patents would have been obvious variations of the respective claims” in the earlier-expiring patents. *Id.* at 24a. Accordingly, the court concluded that petitioner had “received unjustified extensions of patent term,” regardless of its alleged “intent” or “good faith.” *Id.* at 24a-25a.

e. The court of appeals denied panel rehearing and rehearing en banc, with no recorded dissenting votes. Pet. App. 313a.

ARGUMENT

Petitioner contends (Pet. 13-21) that, when Congress enacted the PTA scheme under 35 U.S.C. 154, it displaced the longstanding bar against obviousness-type

double patenting. The court of appeals correctly rejected that contention as inconsistent with Section 154's plain terms, which make clear that PTA does not alter terminal disclaimers—and thus correspondingly does not alter ordinary application of obviousness-type double-patenting doctrine. The decision below was unanimous and generated no recorded votes for rehearing en banc. And petitioner vastly overstates the practical importance of the question presented, which can arise only in a small class of cases in which numerous independent conditions are met. This Court's review therefore is not warranted.

1. The court of appeals correctly held that Section 154 does not preclude ordinary application of obviousness-type double-patenting doctrine. To the contrary, Section 154's language contemplates that the doctrine will apply in the same circumstances it otherwise would in the absence of PTA.

a. Section 154 sets forth the rules that govern PTA. Subsections (b)(1)(A) and (B) state that “the term of [a] patent shall be extended 1 day for each day” of certain forms of USPTO delay. 35 U.S.C. 154(b)(1)(A) and (B). Both of those provisions, however, are “[s]ubject to the limitations under paragraph (2).” *Ibid.* And one limitation under paragraph (2) is that “[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.” 35 U.S.C. 154(b)(2)(B). Thus, under Section 154(b)(2)(B), PTA does not displace the ordinary operation of a terminal disclaimer.

Obviousness-type double patenting and terminal disclaimers are “two sides of the same coin: the problem and the solution.” Pet. App. 22a (citation omitted). When a later-expiring patent is not patentably distinct

from an earlier-expiring patent—and is thus susceptible to a claim of obviousness-type double patenting—the patent owner may avoid invalidation of the later patent through a terminal disclaimer. That is, the owner “may disclaim or dedicate to the public * * * any terminal part of the term” of the later-expiring patent, 35 U.S.C. 253(b), so that the later patent expires simultaneously with the earlier one. And as noted, when that occurs, Section 154(b)(2)(B) makes clear that the expiration date established by the terminal disclaimer controls over the expiration date that PTA would otherwise prescribe.

It follows, then, that just as Section 154 does not displace ordinary application of obviousness-type double patenting when a terminal disclaimer *is* filed, it does not displace ordinary application of that doctrine when (as here) a terminal disclaimer is *not* filed. “If terminal disclaimers had been filed in this case,” Section 154(b)(2)(B) “would have come into play” and precluded PTA “beyond the disclaimed expiration date.” Pet. App. 22a-23a. Yet on petitioner’s view, “in the absence of such disclaimers,” PTA *does* apply—thus allowing concededly indistinct patents to extend beyond the expiration date of the earlier-expiring patent. *Id.* at 23a. That result would permit applicants like petitioner “to benefit from their failure * * * to comply with established practice concerning [obviousness-type double patenting], which contemplates terminal disclaimers as a solution to avoid invalidation of patents claiming obvious inventions.” *Ibid.* Congress did not create such an incongruous scheme.

Section 154’s history and context confirm that PTA does not displace obviousness-type double-patenting doctrine. Before the URAA, patent terms ran from the

date a patent issued—thereby implicitly incorporating USPTO examining and processing times. In that regime, double-patenting doctrine applied based on the relevant patent-expiration dates, regardless of the extent to which USPTO examination and processing times affected those dates. For instance, in *Suffolk Co. v. Hayden*, 70 U.S. (3 Wall.) 315 (1866), this Court held that a later-expiring patent was invalid for double patenting over an earlier-expiring patent, even though the patentee had applied for the later-expiring patent first. *Id.* at 319; see, e.g., *In re Berg*, 140 F.3d 1428, 1435 (Fed. Cir. 1998) (similar). Nothing in Section 154 suggests that Congress intended to deviate from those longstanding principles when it explicitly required consideration of USPTO examination and processing times through the PTA mechanism.

b. Petitioner’s contrary arguments lack merit. Petitioner relies (Pet. 13) on the “plain text” of Section 154(b)(1)(A) and (B), emphasizing the statutory directive that “the term of the patent *shall* be extended 1 day” for each day of specified delay, 35 U.S.C. 154(b)(1)(A) and (B) (emphasis added). But petitioner largely disregards the fact that this directive is “[s]ubject to the limitations under paragraph (2),” *ibid.*, one of which is that “[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,” 35 U.S.C. 154(b)(2)(B).

Although petitioner ultimately acknowledges (Pet. 14) that Section 154 limits the availability of PTA when a terminal disclaimer has been filed, petitioner asserts (*ibid.*) that Section 154 “says nothing about” obviousness-type double patenting. As already explained, however, obviousness-type double patenting and terminal

disclaimers “are ‘two sides of the same coin: the problem and the solution.’” Pet. App. 22a (citation omitted). So by expressly referencing terminal disclaimers, Congress correspondingly “acknowledge[d] that [obviousness-type double patenting] concerns can arise when PTA results in a later-expiring claim that is patentably indistinct.” *Ibid.* And petitioner identifies no plausible reason that Congress would have limited PTA when a terminal disclaimer *is* filed but adopted the opposite approach when a terminal disclaimer is *not* filed—thus privileging applicants who obtain indistinct later patents and fail “to comply with [the] established practice” of terminal disclaimers. *Id.* at 23a.

Petitioner relies in part (Pet. 14) on a different Patent Act provision (Section 156) that governs the separate scheme of PTE. According to petitioner (Pet. 15), because “[t]he Federal Circuit has correctly held that [obviousness-type double patenting] does *not* apply as between related patents whose terms are different only because of certain patents’ PTE resulting from [Food and Drug Administration]-approval delay,” the same rule should apply to PTA. Petitioner is mistaken.

A critical textual distinction between Section 154 and Section 156 shows that Congress intended the two schemes to operate differently. Whereas Section 154 precludes the use of PTA to extend a patent’s expiration date beyond the “date specified in [a terminal] disclaimer,” 35 U.S.C. 154(b)(2)(B), Section 156 contains no comparable carveout. Indeed, the principal Federal Circuit authority upon which petitioner relies, *Novartis AG v. Ezra Ventures LLC*, 909 F.3d 1367 (2018), recognizes that distinction. There, the court held that “obviousness-type double patenting does not invalidate a validly obtained PTE.” *Id.* at 1373. But in so holding, the

court emphasized “the contrast between § 156 for PTE with the language of § 154 for [PTA]: § 154 ‘expressly excludes patents in which a terminal disclaimer was filed from the benefit of a term adjustment for PTO delays,’ but § 156 contains ‘no similar provision that excludes patents in which a terminal disclaimer was filed from the benefits of Hatch-Waxman extensions.’” *Id.* at 1373-1374 (citation omitted). In arguing (Pet. 14) that Sections 154 and 156 should be read “*in pari materia*,” petitioner elides (Pet. 14) that textual contrast.

Petitioner is also wrong in asserting (Pet. 20) that the court of appeals “elevate[d] a judge-made doctrine over clear statutory text.” As an initial matter, while sometimes “described as a court-created doctrine, obviousness-type double patenting is grounded in the text of the Patent Act.” *Abbvie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust*, 764 F.3d 1366, 1372 (Fed. Cir. 2014). The “prohibition on double patenting” dates back to “the inception of our patent laws.” *Ibid.*; see *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 197 (1894). Because “Congress legislates against the backdrop of existing law,” *Parker Drilling Mgmt. Servs., Ltd. v. Newton*, 587 U.S. 601, 611 (2019) (citation omitted), the Patent Act is naturally read to incorporate the bedrock double-patenting prohibition. By authorizing an inventor to “obtain *a patent*” for an invention, 35 U.S.C. 101 (emphasis added), the Act “forbids an individual from obtaining more than one patent on the same invention,” *Abbvie Inc.*, 764 F.3d at 1372.

In any event, regardless of the source of the prohibition against double patenting, the court of appeals held that Section 154’s text *encompasses* it. Contra Pet. 21 (claiming that the court “amend[ed] or supplement[ed]” Section 154). As noted, the court determined that “the

statutory recognition of the binding power of terminal disclaimers in § 154(b)(2)(B) is tantamount to a statutory acknowledgment” that the bar against obviousness-type double patenting supersedes PTA. Pet. App. 22a. Rather than “elevat[ing] a judge-made rule,” the court simply followed “Congress’s clear instructions.” Pet. 21.

c. Finally, petitioner contends that the court of appeals “expan[ded]” obviousness-type double-patenting doctrine beyond its equitable roots. Pet. 21 (emphasis omitted). That is incorrect. Petitioner does not “dispute[] that the asserted claims in the challenged patents would have been obvious variations of the respective claims” in earlier-expiring patents. Pet. App. 24a. Nor does petitioner dispute that the challenged patents remained in force after October 2017—the date they would have expired if petitioner had filed a terminal disclaimer. *Id.* at 25a. Thus, the “inequity here,” *id.* at 51a, is that, “[b]y failing to terminally disclaim [its] later patent prior to the expiration of [its] earlier related patent,” petitioner “enjoy[ed] an unjustified advantage—a purported time extension of the right to exclude from the date of the expiration of the earlier patent.” *Boehringer Ingelheim Int’l GMBH v. Barr Labs., Inc.*, 592 F.3d 1340, 1348 (Fed. Cir. 2010). Petitioner acknowledges that a central “purpose” of obviousness-type double-patenting doctrine is to “bar[] unjustified extension of patent terms,” Pet. 23 (citation omitted), and that purpose is squarely implicated here.

Petitioner suggests that the court of appeals erred by applying double-patenting doctrine without a finding of “gamesmanship” in the form of “laches or fraud.” Pet. 23 (citation omitted). But petitioner identifies no authority that requires such a finding. This Court has

described the rule against double patenting not as a mechanism to prevent gamesmanship, but as a means to ensure that “the power to create a monopoly is exhausted by the first patent,” so that “a new and later patent for the same invention” does not “operate to extend or prolong the monopoly beyond the period allowed by law.” *Miller*, 151 U.S. at 198; see *Odiorne v. Amesbury Nail Factory*, 18 F. Cas. 578, 579 (C.C.D. Mass. 1819) (No. 10,430) (Story, J.) (similar). The Federal Circuit has likewise described the “crucial purpose” of the “ban on double patenting” as “ensur[ing] that the public gets the benefit of the invention after the original period of monopoly expires”—regardless of any “abuse[.]” by the patent owner. *Abbvie Inc.*, 764 F.3d at 1373 (citation omitted). Petitioner’s failure to file a terminal disclaimer directly implicated that purpose, whether that failure was calculated or inadvertent.

2. The petition should be denied for the independent reason that the question presented is not sufficiently important to warrant this Court’s intervention.

a. The decision below was unanimous, and the court of appeals denied rehearing en banc without any recorded dissents. Pet. App. 313a. The decision followed logically from an earlier unanimous Federal Circuit precedent emphasizing “the contrast between § 156 for PTE with the language of § 154 for patent term adjustments,” *Novartis AG*, 909 F.3d at 1373; see Pet. App. 21a—*i.e.*, the very textual contrast that petitioner glosses over (Pet. 17) when claiming that PTE and PTA must “be treated alike.” While it is true that no other circuit will have occasion to address the question presented here, see Pet. 12-13, that question has not generated disagreement even within the Federal Circuit. There is consequently no sound reason for the Court to

devote its scarce resources to resolving the question presented.

b. The question presented lacks substantial practical importance. The question can arise in only a limited category of cases in which: a patent owner obtains a later-expiring patent that has claims that are not patentably distinct from those of an earlier-expiring patent; the USPTO's delay in examining and processing the later patent is sufficient to trigger PTA; the USPTO examiner does not recognize the indistinct nature of the claims of the later patent and does not reject them based on double patenting; and the patent owner does not follow the usual practice of filing a terminal disclaimer with respect to the later-expiring patent (taking into account PTA) before that patent expires.

Certain amici emphasize that approximately half of all granted patents have been awarded PTA. See, *e.g.*, Intellectual Prop. Owners Ass'n Amicus Br. 3. But that is largely beside the point, since the Court's resolution of the question presented would likely affect only a small subset of the patents for which PTA is granted.

Petitioner asserts (Pet. 24) that the decision below "upsets investment-backed expectations." But it is not clear why inventors would have expected Section 154's limited grant of PTA to override the bedrock prohibition against obviousness-type double patenting. Particularly given Section 154(b)(2)(B)'s express carve-out of terminal disclaimers from that grant, any such expectation would have been unreasonable. Nor does the decision below "generate[] uncertainty" for inventors. Pet. 25. Indeed, petitioner's asserted "diverg[ence]" (*ibid.*) between trial courts on application of the decision below is no longer present following the Federal Circuit's recent reversal of the trial court in *Allergan USA, Inc. v.*

MSN Laboratories Private Ltd., No. 24-1061, 2024 WL 3763599 (Fed. Cir. Aug. 13, 2024). See *id.* at *6-*8.

It is also not clear why the decision below would suddenly “requir[e] patentholders to review all of their issued patents” to gauge the risk of invalidity based on obviousness-type double patenting. Pet. 25. Double-patenting challenges have existed since the inception of the patent laws. And in 1952, Congress allowed patentholders to file terminal disclaimers to mitigate the risk of such challenges. See 35 U.S.C. 253(b) (1952). Under that status quo, patentholders *already* have an incentive to review their issued patents, so that they can file terminal disclaimers before those patents expire.

Petitioner’s concerns (Pet. 27) about disrupting “well-established continuation practice” are likewise misplaced. Petitioner contends (Pet. 27-28) that the decision below will deter inventors from “fil[ing] an initial application that discloses, but does not claim, a variety of related inventions” and then later claiming the related inventions “through continuation applications,” because the inventors will be “afraid of losing patent term” if the initial patent expires after the subsequent ones based on PTA. After the certiorari petition in this case was filed, however, the Federal Circuit “h[e]ld 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.” *Allergan*, 2024 WL 3763599, at *7. Thus, the question of how obviousness-type double patenting would apply to the fact pattern at issue in *Allergan* has now been addressed by the Federal Circuit.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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