

Insights: Alerts

First-filed, Later-Expiring Patent Protected from Obviousness-Type Double Patenting Post *In re Collect*

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The recent *In re Collect* decision by the Federal Circuit¹ is significant for patent owners who have obtained patent-term adjusted patents in the same patent family. The court held that term-adjusted patents can be potentially invalidated by patentably indistinct claims in earlier-expiring patents in the same patent family under the obviousness-type double patenting (ODP) doctrine. For the first time, patent term adjustment (PTA) was introduced into the ODP analysis.

In the *Collect* decision, the Federal Circuit called into question a routine patent practice for patent families having multiple continuations that have patentably indistinct claims and different awards of PTA. In the wake of the decision, some Applicants made changes to their patent practice. These changes included 1) reviewing soon-to-expire patent families to preemptively file terminal disclaimers, and 2) filing “reverse” terminal disclaimers—disclaiming the patent term of the parent application (first filed application) to the earliest expiring child application. The theory behind the “reverse” terminal disclaimers was to disclaim patent term to the earliest-expiring patent in the patent family to prevent challenges in view of *Collect*.

Yesterday, the Federal Circuit provided some clarity as to the application of the ODP doctrine—particularly as it relates to a first-filed, first issuing patent in a patent family. In *Allergan USA, Inc. v. MSN Laboratories Pvt. Ltd.*, No. 2024-1061, (Fed. Cir. August 13, 2024), the Federal Circuit found 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.²

The Federal Circuit overturned a District of Delaware decision that interpreted the *Collect* decision as finding that the “first-filed, first issued” distinction was immaterial when analyzing ODP. The Federal Circuit rejected the District of Delaware’s analysis of *Collect* and clarified that *Collect* only addressed a single question—whether the patent expiration date should be taken into account for ODP analysis. Here, the Federal Circuit found that the ODP analysis concerned a different issue—under what circumstances can a claim properly serve as an ODP reference.

The Federal Circuit’s decision was ultimately rooted in the policy and purpose of the ODP doctrine—to prevent

patentees from obtaining a *second* patent on an obvious variant to effectively extend the life of the *first* patent. At the heart of the issue is the balance between improperly extending patent rights beyond a period allowed by law and granting a patentee the maximum term for a patent rightfully owed to a patentee. As the law currently stands, 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. While this decision effectively immunizes the first-filed, first-issued patent within a family against ODP challenges, the decision also restricts the maximum patent term in a patent family to the expiration date of the first-filed, first-issued patent. Patent owners should be careful to review patent families to determine if terminal disclaimers are needed for later-filed, later-issuing patents that recite patentably indistinct claims and were granted PTA that extends the patent term past the expiration date of the first-filed, first-issued patent.

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¹*In re Collect, LLC*, 81 F.4th 1216 (Fed. Cir. 2023), (en banc denied); Petition for Certiorari filed.

²Allergan sued Sun Pharmaceuticals under the Hatch Waxman Act alleging that Sun's Abbreviated New Drug Application (ANDA) directed to a generic version of Viberzi infringed claim 40 of U.S. Patent No. 7,741,356 ("the '356 patent"). Sun Pharmaceuticals argued that claim 40 of the '356 patent was invalid for ODP over later-filed, later-issued patents in the same patent family that expired before the '356 patent. The '356 patent was awarded 467 days of PTA that extended its term past the expiration date of two later-filed child applications.

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