

SAWSTOP HOLDING LLC v. VIDAL, Appeal Nos. 2021-1537, 2021-2105 (Fed. Cir. September 14, 2022). Before Newman, Linn, and Chen. Appealed from E.D. Va. (Judge Brinkema).

Background:

Sawstop held two patents that had gone through appellate review during prosecution. Sawstop sought additional patent term for the pendency periods of those appellate reviews under 35 U.S.C. § 154(b)(1)(C) (i.e. "(C) delay"). This provision reads (in relevant part): "Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to... (iii) appellate review by the Patent Trial and Appeal Board or by a Federal court in a case in which the patent was [1] *issued under a decision in the review* [2] *reversing an adverse determination of patentability*."

In the first patent, the examiner's § 103 rejection was overturned on appeal, but the Board remanded with a new rejection under § 103. Sawstop ultimately obtained a patent for a much narrower claim than was at issue in the appeal. The Patent Office denied patent term adjustment for the appeal to the Board.

In the second patent, the Board overturned the examiner's § 102 rejection of claim 2, but maintained the examiner's rejections of claim 1 under § 102 and for provisional double patenting. Sawstop thereafter petitioned the district court for the District of Columbia to reverse the Board's maintaining of the § 102 rejection of claim 1. The district court reversed the § 102 rejection of claim 1, but the double patenting rejection was not at issue in that proceeding and was maintained. Sawstop ultimately amended claim 1 to recite all of the features of claim 2 in order to overcome the double patenting rejection. The Patent Office granted patent term adjustment for the appeal to the Board, but denied patent term adjustment for the district court appeal.

Sawstop filed complaints in the Eastern District of Virginia to obtain patent term adjustment for the periods denied by the Patent Office. The Eastern District of Virginia affirmed the Patent Office's denial of patent term adjustment. Sawstop appealed.

Issue/Holding:

Did the district court err in denying patent term adjustment for appeals that overturned rejections but did not directly result in allowance? No, affirmed.

Discussion:

The Federal Circuit unanimously decided that under the plain language of § 154(b)(1)(C), neither of Sawstop's patents were eligible for additional patent term adjustment. For the first patent, the Federal Circuit held that the Board did not "reverse an adverse determination of patentability" under the statute, because the claims were unpatentable both before and after the appeal. For the second patent, the Federal Circuit applied similar reasoning, stating that claim 1 was still subject to the double patenting rejection after the district court reversed the § 102 rejection.