

IN RE: CELLECT, LLC, Appeal Nos. 2022-1293, 1294, 1295, 1296 (Fed. Cir. August 28, 2023). Before Lourie, Dyk, and Reyna. Appealed from the Patent Trial and Appeal Board.

Background:

Collect owns four related patents directed to devices, such as phones, including image sensors. These patents all claim priority to a single parent application and each patent received differing amounts of patent term adjustment (PTA) under 35 USC §154. The PTAB found claims in Collect's patents invalid for obviousness-type double patenting (ODP) over earlier expiring patents in the same family during an *ex parte* reexamination requested by Samsung, whom Collect had brought suit against. Because the obviousness of the claims was undisputed, the key issue was whether ODP should be considered based on the expiration date before or after any patent term adjustment (PTA) is added.

Collect argued, among other things, that ODP should be considered without PTA because the Federal Circuit considered ODP in a patent that had received patent term extension (PTE) under 35 U.S.C. §156 based on the expiration date before PTE was added. Collect also argued that ODP is a judicially created doctrine that cannot cut off a statutorily authorized time extension, i.e., PTA. The PTAB found that ODP should be based on the patent's expiration date including any PTA granted, reasoning that the text of §154 and the Federal Circuit's past decisions support its conclusion. Collect appealed.

Issue/Holding:

Did the PTAB err in considering ODP based on the expiration date including the granted PTA? No, affirmed.

Discussion:

On appeal, the Federal Circuit held ODP is properly considered based on the expiration date including any PTA granted under §154. The Federal Circuit first noted that ODP depends on assessing obviousness between earlier and later expiring commonly owned patents. Thus, determining which patent expires later is critical in the ODP analysis.

The Federal Circuit acknowledged that both the PTA and PTE statutes state that the modifications of patent term *shall* be provided. The Federal Circuit then opined that while Collect argued PTA and PTE should be treated the same with regard to ODP analysis, these statutes have distinct purposes and frameworks. Specifically, the Federal Circuit noted that §154 directly addresses terminal disclaimers, which are inextricably intertwined with ODP. §154 states that PTA cannot extend a patent's term past a terminal disclaimer date and, in contrast, §156 does not address terminal disclaimers. The Federal Circuit viewed this as evidence of congressional intent to treat ODP analysis of PTA and PTE differently.