Vincent Shier, Joseph Matal in Law360 Article, 'PTAB Ruling Shows Need to Split Terminal Disclaimer'

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Partners Vincent Shier and Joseph Matal authored an article in *Law360* titled “PTAB Ruling Shows Need to Split Terminal Disclaimer.” Read an excerpt below.

The recent decision by the U.S. Patent and Trademark Office's Patent Trial and Appeal Board in Ex Parte Cellect LLC illustrates the overreach in current terminal disclaimer practice.

The mechanical application of the USPTO's pre-Uruguay Round Agreements Act rules to post-URAA applications has transformed an equitable judicial doctrine into one that is having unintended punitive impacts, especially for same-family patents. Terminal disclaimer requirements need to be modified to serve equity by splitting the patent term disclaimer from the common ownership disclaimer.

In addition, the patent term disclaimer needs to focus on whether differences in patents' expiration dates cause an unjust extension of term or are otherwise the result of gamesmanship.

In the U.S., patent exclusivity is achieved in a number of ways, including the standard statutory patent term under Title 35 of the U.S. Code, Section 154(a), patent term adjustment under its Section 154(b), patent term extension, or PTE, under its Section 156 and via strategic portfolio management.

Obviousness-type double patenting, or ODP, serves as an important safeguard against abusive and unjustified extensions of the patent term beyond that which is granted under the quid pro quo of the U.S. patent system.

Excerpted from *Law360*. To read the full article, click here.

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