

Wolfson and Lorch in Law360: Practical Pointers After Fed. Circ. Double-Patenting Decision

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PRACTICES Patent Office Trials, Intellectual Property Litigation, Patent Litigation

Haynes Boone Partner [Jeff Wolfson](#) and Associate [Austin Lorch](#) authored an article for *Law360* with advice for patent family holders following a Federal Circuit decision.

Read an excerpt below.

It is generally understood that divisional patents and patents with patent term extension cannot be invalidated based on obviousness-type double patenting, or ODP.

It has long been questioned, however, whether the same is true for a patent with patent-term adjustment. The U.S. Court of Appeals for the Federal Circuit decided this issue last year in *In re: Collect LLC* by ruling that term-adjusted patents are susceptible to ODP-based invalidity challenges.

With the Federal Circuit denying the en banc review in January, now is a good time to take stock of the significance for patent family holders, who may want to evaluate their rights through both patent prosecution and future litigation lenses to consider practical approaches to minimize the risks and protect their patents.

For those not conversant with *Collect*, the Federal Circuit held that the ODP analysis for a term-adjusted patent is based on the expiration date of the patent after adding any PTA.

In contrast, the ODP analysis for a term-extended patent is based on the expiration date of the patent before adding any PTE. As such, *Collect* draws a clear distinction between PTA and PTE on ODP invalidity. Patents with PTA are not provided the same protections as those with PTE.

Moving forward, patent challengers may invalidate a term-adjusted patent by showing that the claims are an obvious variant of the claims of a related application where the term of the term-adjusted patent is not disclaimed by the patent owner.

To read the full article on *Law360*, click [here](#).