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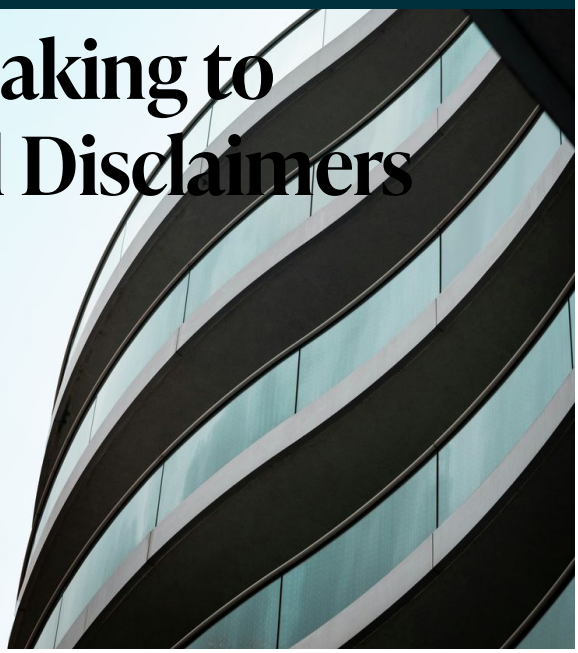
Notice of Proposed Rulemaking to Expand Reach of Terminal Disclaimers



1 MIN READ

May 13, 2024, 7:49 PM
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On May 10, 2024, the USPTO posted a notice of proposed rulemaking (NPRM) soliciting comments regarding a proposed change concerning terminal disclaimers used to overcome non-statutory double patenting. The proposed change adds a requirement that the filer of the terminal disclaimer agree that the patent subject to the disclaimer (or any patent issuing from the application subject to the disclaimer) will be unenforceable if a claim of a patent directly or indirectly tied by that terminal disclaimer is found unpatentable, anticipated, or obvious. That finding can be made by a federal court or the USPTO, and all appeal rights must have been exhausted. The unenforceability term would also apply if a claim is statutorily disclaimed in response to an anticipation or obviousness challenge.

The proposed change is aimed at reducing litigation costs by preventing serial assertions of patent infringement based on obvious variants of a claim already found invalid. The proposed change also allows one *inter partes* review (IPR) petition to result in the unenforceability of multiple patents related by terminal disclaimers. The NPRM points out that these changes may make it easier for a District Court to streamline litigation of claim construction and invalidity. It also may enable Courts to more broadly stay litigation of multiple patents related by terminal disclaimers even when only one is subject to post-grant proceedings before the USPTO.

Comments can be submitted until July 9, 2024, via the Federal eRulemaking Portal. The NPRM notes that in response to previous comments, the proposed change does not require the

disclaimer to include an agreement by the filer that the claims are obvious variants of previously issued claims and the disclaimer does not address the validity or patentability of the claims. The NPRM also acknowledged concerns that the change might increase prosecution costs, as it would encourage patent applicants to address non-statutory double patenting rejections on their merits or pursue them in another application rather than bypassing them with a disclaimer.

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