Articles + Publications | June 12, 2024

# Locke Lord QuickStudy: Former USPTO Directors and Officials ?Call for Withdrawal of USPTO Proposed Rule on Continuations ?and Terminal Disclaimers (89 FR 40439)?

Locke Lord LLP

**WRITTEN BY**

Gabrielle Gelozin | Gabriella D'Angelo

**RELATED OFFICES**

Stamford

In the Notice, the USPTO proposed adding a new requirement for acceptable terminal disclaimers to obviate nonstatutory double patenting. The stated goal for this rule change is “to promote competition by lowering the cost of challenging groups of patents tied by terminal disclaimers.” Under the proposed rule, the USPTO will not issue a patent to a common owner or inventor with a claim that conflicts with a claim of a second patent *unless the terminal disclaimer includes an additional agreement that the patent with the terminal disclaimer will not be enforced if any claim of the second patent is invalidated by prior art*.

The USPTO provides, as an example of how the proposed rule would further the stated goal, a litigation in which a patent owner is enforcing a patent along with several other patents that are tied by one or more terminal disclaimers to that patent, wherein a competitor could seek to have the court narrow any validity disputes to address only that patent. The USPTO believes this will lower the litigation costs for parties alleged to have infringed a number of patents within a single family, since there would be only a single infringement action brought against the infringer, rather than an action for each patent in the family.

Since the publication of this notice, the Office has received numerous comments, both in favor and challenging the proposed rule for a number of reasons. In particular, critics have said this proposed rule change will increase the cost of obtaining a patent and would make it easier to invalidate patent families linked by a single invention. The USPTO has answered some of the comments by suggesting a terminal disclaimer is voluntary. While this is true, a terminal disclaimer can sometimes be the only reasonable means for an applicant to overcome a double patenting rejection.

Notable critics of the proposed rule include former USPTO directors and deputy directors, who have called for the USPTO to withdraw the proposed rule altogether. Should the rule be adopted, the change could have serious implications for continuation practice and applicants looking to protect their inventions using continuation applications.

The time for submitting comments on the proposed rulemaking ends July 9, 2024.

## RELATED INDUSTRIES + PRACTICES

- Intellectual Property
- Patent Prosecution, Counseling + Portfolio Management