



NEW YORK  
CITY BAR

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*Submitted via [Federal eRulemaking Portal](#)*

Katherine K. Vidal  
Director of the United States  
Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**Re: Comments On U.S. Patent & Trademark Office Proposed Amendment To Terminal Disclaimer Rules (Agency/Docket Number: Docket No. PTO-P-2024-0003)**

Dear USPTO Director Katherine K. Vidal:

The New York City Bar Association (the “City Bar”), through its Committee on Patents, thanks the United States Patent and Trademark Office (“USPTO” or the “Office”) for considering the City Bar’s comments in response to the USPTO’s Proposed Amendment To Terminal Disclaimer Rules, published at 89 Federal Register 40439 (PTO-P-2024-0003, May 10, 2024).

**I. About the City Bar**

The City Bar is a private, non-profit organization of approximately 23,000 members who are professionally involved in a broad range of law-related activities. Founded in 1870, the City Bar is one of the oldest bar associations in the United States. The City Bar seeks to promote reform in the law and to improve the administration of justice at the local, state, federal and international levels, including through the activities of its more than 150 standing and special committees. Among these, the Committee on Patents (“Patents Committee”) is a long-established standing committee of the City Bar, and its membership reflects a wide range of corporate, private practice and academic experience in patent law. The participating members of this committee are dedicated to promoting the City Bar’s objective of improving the administration of the patent laws.

**About the Association**

*The mission of the New York City Bar Association, which was founded in 1870 and has 23,000 members, is to equip and mobilize a diverse legal profession to practice with excellence, promote reform of the law, and uphold the rule of law and access to justice in support of a fair society and the public interest in our community, our nation, and throughout the world.*

## II. Introductory Comments

The City Bar commends the USPTO and the Director for using the mechanism of notice-and-comment rulemaking to ensure compliance with the America Invents Act (AIA) and the Administrative Procedure Act (APA). While the City Bar does not comment on the procedural validity of rules that are informally promulgated without the use of the notice-and-comment process (such as through designation of certain Office decisions as informative or precedential), the use of notice-and-comment rulemaking clearly enhances both the consistency of practice before the Office and the public's trust in the soundness of the patent system.

## III. Comment On Proposed Amendment To Terminal Disclaimer Rules

The USPTO has proposed a rule change to Terminal Disclaimer practice which would require an Applicant to agree that a patent subject to a terminal disclaimer ("TD") would be unenforceable if any claim of a patent tied by the TD is found invalid as anticipated or obvious. The Patents Committee presents the comments below for consideration by the USPTO:

1. The proposed rule change can unfairly impact a patentee's rights since the scope of unenforceability risk is not commensurate with the claims subject to an Obviousness Type Double Patenting ("ODP") rejection. That is, claims of a reference patent that are *not* subject to an ODP rejection are acknowledged as patentably distinct; however, these patentably distinct claims would be at risk of being rendered unenforceable if *any* ODP claim were to be found invalid/unpatentable. Invalidity analyses have always required claim-by-claim treatment; there is no authority (or rationale) for deviating from this paradigm.
2. This risk is particularly unfair as ODP rejections rarely, if ever, include any comparison of the claim scope, or otherwise provide a rationale supporting the ODP rejection, leaving Applicants unable to traverse an Examiner's conclusory ODP contention.
3. Given this significant risk that the proposed TD rule change presents to a portfolio, Applicants may be less inclined to file a TD. Instead, Applicants may be more inclined to appeal ODP rejections. However, such appeals will not reduce USPTO docket workload or pendency. Instead, appeals of ODP will simply "shift" the burden from the Examiner corps to the Administrative Patent Judge corps (which is significantly smaller than the Examiner corps). This will likely increase the pendency of applications, and result in adding significant Patent Term Adjustment where the PTAB reverses the ODP rejection.
4. Alternatively, Applicants may be inclined to present claims of varying scope in a single application instead of filing continuations (which would be at risk of ODP rejections). This could increase Examiner workload and further increase pendency, with Examiners perhaps issuing more Restriction requirements, insulating the non-elected claims from ODP in a Divisional application.
5. Notably, in 2008, the USPTO unsuccessfully attempted to limit Continuation practice – proposing to limit applicants in most instances to filing two continuations in a given patent

family. *See Tafas v. Dudas*, 530 F. Supp. 2d 786 (E.D.Va. 2008). That attempted rule change was ultimately removed by the USPTO. *See* 74 FR 52686 (Oct. 14, 2009). The presently proposed TD rule change appears to be another improper attempt by the USPTO to limit Continuation practice in contravention of 35 U.S.C. § 120.

6. The proposed rule would render an entire patent portfolio only as strong as its weakest claim. That is, an entire patent family, or possibly an entire portfolio, covering a product (or platform or technology), could be rendered invalid if even one claim in the portfolio is found invalid and the patents are tied together by a TD. This bizarre outcome would be even more likely after the Federal Circuit's decision in *In re Collect*, 81 F.4th 1261 (Fed. Cir. 2023), which has caused patent owners to file TDs in edge cases where they might not have previously. This draconian outcome cannot be what the proposed rule was intended to achieve.

Respectfully submitted,

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Patents Committee

Stephen Kenny, Vice-Chair  
Patents Committee