ANNOUNCEMENTS | 03.30.2026

Choate Submits Amicus Brief on Behalf of BIO in PTAB Appeals Review Panel Proceeding for Ex parte Baurin

Amicus Brief Addresses PTAB Review of Obviousness-Type Double Patenting and Patent Term Issues Affecting Biotech Innovation

Choate submitted an amicus curiae brief on behalf of the Biotechnology Innovation Organization (BIO) to the U.S. Patent and Trademark Office's Patent Trial and Appeal Board (PTAB) Appeals Review Panel (ARP) in *Ex parte Baurin* (Appeal No. 2024-002920). The brief addresses questions presented by the USPTO Director regarding how the doctrine of obviousness-type double patenting (OTDP) should be applied during patent prosecution to protect foundational biotechnology inventions and promote predictability in patent rights.

Following a March 5, 2026 order, the ARP is reconsidering examiner use of OTDP in light of recent Federal Circuit decisions, including *Allergan USA, Inc. v. MSN Laboratories Private Ltd.* (Fed. Cir. 2024). The outcome is expected to have broad implications for biotechnology companies, particularly those dependent on early-filed patents that undergo lengthy prosecution and later receive patent term adjustments (PTA).

BIO is the world's largest biotechnology advocacy organization, representing biotech companies and institutions—from startups to global biopharmaceutical firms—that rely on strong, predictable patent protection. In its amicus brief, BIO urges the ARP to reaffirm that:

- Later-filed patents should not be used to shorten the term of first-filed applications under OTDP, consistent with *Allergan* and the core purpose of the doctrine.
- Examiners should not rely on speculative or "projected" patent term adjustment when evaluating OTDP rejections during prosecution.
- Separate ownership alone should not justify OTDP rejections, as doing so would undermine collaboration, licensing, and innovation—particularly in the biotechnology sector.

BIO also emphasizes that misapplication of OTDP risks eroding patent term for foundational inventions, discouraging investment and follow-on innovation. By applying OTDP consistently with Supreme Court and Federal Circuit precedent, the ARP can preserve settled expectations and maintain incentives for breakthrough biotechnology research.

Sophie F. Wang and Natalie A. Phillips represented BIO in the amicus filing.

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