

Cantor Colburn Client Alert:

USPTO Withdraws Proposed Rule Regarding New Terminal Disclaimer Practice

On December 4, 2024, the United States Patent and Trademark Office (“USPTO”) withdrew a proposed rule that would have added a new requirement for terminal disclaimers that are filed to overcome non-statutory double patenting rejections. [89 F.R. 69152 \(Dec 4, 2024\)](#).

Earlier this year, the USPTO proposed changes to terminal disclaimer practice to purportedly promote innovation and competition. [89 F.R. 40439 \(May 10, 2024\)](#). Terminal disclaimers have long been used to overcome double patenting rejections by tying the expiration date of a later-filed application to an earlier patent or application. This prevents a patentee from improperly extending the term of patent rights where claims of co-owned patents are not patentably distinct from one another.

The USPTO’s proposed changes to disclaimer practice would have required a patentee to declare that the patent with the terminal disclaimer will be enforceable only if the patent is not tied to and has never been tied to a patent in which any claim has been finally held unpatentable or invalid as anticipated or obvious. The USPTO suggested that this new rule would promote innovation and competition, reduce litigation and administrative proceeding costs, and increase predictability. *Id.*

Now, the USPTO has withdrawn the proposed rule, citing “resource constraints” as its reason not to move forward. Indeed, one of the more controversial aspects of the proposed rule related to whether the USPTO actually has the authority to implement such a rule, or if such a rule would instead require legislative action by Congress given the fundamental changes to substantive patent rights that would be affected. During the rule’s comment period, stakeholders provided about [350 comments](#) on the rule.

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For Further Information and Assistance

[Cantor Colburn attorneys](#) have substantial experience representing clients in these types of matters. We welcome your questions regarding this matter and any other regarding your IP in general: contact@cantorcolburn.com.

Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.