

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

**SYNGENTA LIMITED,
SYNGENTA PARTICIPATIONS AG
(d/b/a SYNGENTA CROP PROTECTION AG)**

Plaintiffs,

v.

HON. KATHERINE K. VIDAL,
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark
Office

Office Of General Counsel,
United States Patent and Trademark Office
Madison Building East, Rm. 10B20
600 Dulany Street, Alexandria, 22314

Defendant.

Civil Action No.: 1:24-cv-2186

COMPLAINT

Plaintiffs Syngenta Limited and Syngenta Participations AG (“Syngenta” or “Plaintiffs”) for their complaint against the Honorable Katherine K. Vidal, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, (“Director” or “Defendant”), state as follows:

NATURE OF THE ACTION

1. This is an action by Syngenta, the owner and assignee of United States Patent No. 11,608,323 (“the ’323 patent”) (attached as Exhibit A), titled “HERBICIDAL COMPOUNDS”, for review of the determination by the Director, pursuant 35 U.S.C. § 154(b)(4)(A), of the Patent Term Adjustment of the ’323 patent. Syngenta seeks a judgment that the patent term adjustment

for the '323 patent be changed from 401 days to 471 days.

2. Syngenta seeks a judgment that the Director erred in applying 37 C.F.R. § 1.704(c)(10) to the instant case, and that the Director's application of Rule 37 C.F.R. § 1.704(c)(10) to the facts of this case is arbitrary and capricious in view of the straightforward and unambiguous language of 35 U.S.C. § 154(b)(2)(C).

3. This action arises under 35 U.S.C. § 154 and the Administrative Procedure Act, 5 U.S.C. §§ 701-706.

THE PARTIES

4. Syngenta Limited is a United Kingdom corporation with its principal place of business in Guilford, England. Syngenta Participations AG is a Switzerland corporation with its principal place of business in Basel, Switzerland. On June 20, 2024, Syngenta Participations AG merged with Syngenta Crop Protection AG and is now doing business as Syngenta Crop Protection AG.

5. Defendant Katherine K. Vidal is named in her official capacity as the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office ("PTO"). The Director is the head of the PTO and is responsible for superintending or performing all duties required by law with respect to the granting and issuing of patents. As such, Director Vidal is designated by statute as the official responsible for determining the period of Patent Term Adjustments under 35 U.S.C. § 154. 35 U.S.C. § 154(b)(4)(A).

JURISDICTION AND VENUE

6. This Court has jurisdiction to hear this action and is authorized to issue the relief sought under 28 U.S.C. §§ 1331, 1338(a), and 1361, 35 U.S.C. § 154(b), and 5 U.S.C. §§ 701-706.

7. Venue is proper in this district under at least 35 U.S.C. § 154(b)(4)(A).

8. This Complaint is timely filed in accordance with 35 U.S.C. § 154(b)(4)(A) because it is being filed within 180 days after the date of the Director's decision on Syngenta's request for reconsideration, June 7, 2024 (attached as Exhibit B).

BACKGROUND

The Relevant Prosecution History

9. On February 10, 2014, Syngenta filed PCT application PCT/EP2014/071167 ("the '167 application"). The '167 application correctly included both Syngenta Limited and Syngenta Participations AG as Applicants. The '167 application correctly included a declaration including both Syngenta Limited and Syngenta Participations AG as entitled to apply for and be granted a patent pursuant to PCT Rules 4.17(ii) and 51bis. 1(a)(ii) as either an employer of the inventor or an assignee of the inventor's rights.

10. On July 4, 2016, the '167 application entered the National Stage in the United States as application 15/027,768 ("the '768 application"). The '768 application included an Application Data Sheet ("ADS") filed on July 4, 2016, indicating Syngenta Limited as the Applicant and indicating Syngenta Participations AG as an Assignee. A Corrected ADS indicating Syngenta Limited as both the Applicant and an Assignee and Syngenta Participations AG as both the Applicant and an Assignee was filed on October 17, 2017.

11. Syngenta filed a continuation application of the '768 application with the PTO on December 17, 2018, designated as United States patent application number 16/222,900 ("the '900 application"), which issued as the '323 patent on March 21, 2023. The initial ADS filed with the '900 application indicated Syngenta Limited as the Applicant and indicating Syngenta Participations AG as an Assignee.

12. On November 23, 2022, the PTO mailed a Notice of Allowance in the '900 application.
13. On December 2, 2022, the PTO mailed a Notice to File Corrected Application Papers requiring Syngenta to provide legible text for chemical structures in claims 18 and 19.
14. On January 18, 2023, and before payment of the issue fee, Syngenta timely filed a legible copy of the claims addressing the Notice to File Corrected Application Papers and a corrected ADS indicating Syngenta Limited as both the Applicant and an Assignee and Syngenta Participations AG as both the Applicant and an Assignee, consistent with that of the parent '768 application as previously filed on October 17, 2017.
15. On January 31, 2023, the PTO, on its own accord and absent a request from Syngenta, mailed a corrected Filing Receipt.
16. On February 9, 2023, Syngenta timely paid the issue fee.
17. On March 1, 2023, the PTO mailed an Issue Notification stating the PTA for the issued '323 patent would be 341 days.
18. On June 2, 2023, Syngenta filed its first Petition to the Director for review of the initial electronic PTA determination of 341 days, requesting a PTA of 472 days.
19. On October 5, 2023, the PTO mailed its decision indicating a PTA of 401 days, which included a delay of 70_days attributed to Syngenta for filing a corrected ADS along with the required legible copy of the claims.
20. On March 5, 2024, Syngenta filed its second Petition to the Director for review of the PTA determination of the October 5 decision of 401 days, requesting a PTA of 471 days.
21. On June 7, 2024, the PTO mailed the Director's final determination of PTA as 401 days.

Congress's Patent Term Guarantee

22. The Patent Term Guarantee Act of 1999, a part of the American Inventors Protection Act (“AIPA”), amended 35 U.S.C. § 154(b) to address concerns that delays by the PTO during the prosecution of patent applications could result in a shortening of the effective life of the resulting patents to less than seventeen years. The amendments created patent term adjustment, commonly referred to as PTA, a means of adjusting patent terms to account for delays at the PTO.

23. Patent term adjustment applies to original utility patent applications (including continuations, divisional applications, and continuations-in-part) filed on or after May 29, 2000.

24. In calculating PTA, the Director must take into account PTO delays under 35 U.S.C. § 154(b)(1), any overlapping periods in the PTO delays under 35 U.S.C. § 154(b)(2)(A), and any applicant delays under 35 U.S.C. § 154(b)(2)(C).

25. Under 35 U.S.C. § 154(b)(1)(A), an applicant is entitled to PTA for the PTO’s failure to carry out certain acts during processing and examination within defined deadlines (“A Delay”).

26. Under 35 U.S.C. § 154(b)(1)(B), an applicant is entitled to additional PTA attributable to the PTO’s “failure ... to issue a patent within 3 years after the actual Filing Date of the application in the United-States,” but not including “any time consumed by Continued Examination of the application requested by the applicant under section 132(b)” (“B Delay”).

27. 35 U.S.C. § 154(b)(2)(A) provides that “to the extent that periods of delay attributable to grounds specified in paragraph [154(b)(1)] overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.”

28. Reduction of period of adjustment is subject to limitations under 35 U.S.C. §154(b)(2), including 35 U.S.C. § 154(b)(2)(C)(i), which states “[t]he period of adjustment of the term of a patent under paragraph [154(b)(1)] shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.” (“Applicant Delay”).

29. 35 U.S.C. § 154(b)(2)(C)(iii) states that “[t]he Director shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application.”

30. The PTO promulgated 37 C.F.R § 1.704(c)(10) establishing that the filing of “an amendment under § 1.312 or other paper, other than ... expressly requested by the Office ... after a notice of allowance has been given” would constitute a failure of an applicant to engage in reasonable efforts to conclude prosecution.

31. The PTO initially calculates PTA automatically by a computer program that retrieves information electronically from the Patent Application Location and Monitoring system. The current system requires an applicant who files a paper after a notice of allowance to petition to adjust PTA because “the Office needs to have the calculation performed by a computer program using the Office’s records of papers mailed and received as recorded in its PALM system. The PALM system is simply not capable of making value judgments concerning papers filed after allowance.” Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 56370, 56380-81 (September 18, 2000) (final rule).

32. An Applicant may request manual review by way of petition with an associated fee, which is the PTO’s determination under § 154(b)(3)(B)(i).

33. The Applicant may then request review of the Director's decision under § 154(b)(3)(B)(ii), which that determination is considered the Director's decision under § 154(b)(4)(A).

34. Under 35 U.S.C. § 154(b)(4)(A), “[a]n applicant dissatisfied with the Director's decision on the applicant's request for reconsideration under paragraph (3)(B)(ii) shall have exclusive remedy by a civil action against the Director filed in the United States District Court for the Eastern District of Virginia within 180 days after the date of the Director's decision on the applicant's request for reconsideration. Chapter 7 of title 5 shall apply to such action.”

The Director's Abrogation of the Patent Term Guarantee

35. Under 35 U.S.C. § 154(b)(2)(C)(i), “[t]he period of adjustment of the term of a patent under [154(b)(1)] shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.” Syngenta's filing of the corrected ADS with the requested documents from the PTO before payment of the issue fee did not constitute a failure to engage in reasonable efforts to conclude prosecution of the application.

36. Syngenta is entitled to PTA beyond the 401 days because the Director's application of the law, regulations, and PTO policy to this case is arbitrary and capricious in view of and directly contrary to 35 U.S.C. § 154(b)(2)(C)(i).

37. In this case, the Director's final PTA decision asserted that the corrected ADS with changes to Applicant and Assignee information is “most closely related to” a category of papers that constitute applicant delay (i.e., a request to change or correct inventorship) without looking into whether the submission of the corrected ADS meets the definition of the type of delay proscribed by Congress (i.e., purposeful manipulation of the system to delay issuance of

the patent/the most egregious and obvious of delay tactics). *Compare* Final Decision 4-9 with H.R. Rep. No. 106-287, at 50 (1999); H.R. Rep. No. 104-784, at 67 (1996).

38. The PTO has not explicitly enumerated whether filing a corrected ADS is an “other paper” under § 1.704(c)(10) that constitutes a failure to engage in reasonable efforts to conclude prosecution.

39. Moreover, Congress has not defined what is “the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application” and has given the Director the authority to “prescribe regulations establishing the[se] circumstances.” 35 U.S.C. § 154(b)(2)(C)(iii). In doing so, Congress intended “[o]nly those who purposely manipulate the system to delay the issuance of their patents will be penalized.” H.R. Rep. No. 106-287, at 50 (1999). That is, “[t]he ‘reasonable efforts’ clause is an effort to avoid the submarine patent problem. The intent of the Committee is that only the most egregious and obvious delay tactics will go unrewarded by this provision.” H.R. Rep. No. 104-784, at 67 (1996). Further, the Director is not entitled to any deference as courts “may not defer to an agency interpretation of the law simply because a statute is ambiguous.” *Loper Bright Enterprises v. Raimondo*, 144 S. Ct. 2244, 2273 (2024). Congress explicitly intended the provisions of the Patent Term Guarantee to “compensate applicants fully for USPTO-caused administrative delays, and, for good measure, includes a new provision guaranteeing diligent applicants at least a 17-year term.” H.R. Rep. No. 106-465, at 125 (1999).

40. In 2000, the PTO published its final rule of 37 C.F.R. § 1.704(c)(10). Several comments indicated concern that the filing of various papers for routine corrections after notice of allowance would constitute applicant delay, such as correcting an examiner’s amendment or requesting a PTO-1449 for an unreviewed Information Disclosure Statement. In response, the

PTO stated that “all papers filed after allowance of an application substantially delay the Office’s ability to process an application” and emphasized that its internal computer system, PALM, which calculates PTA, “is simply not capable of making value judgments concerning papers filed after allowance.” Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. 56387, 56393 (Sept. 18, 2000).

41. The PTO has not promulgated any rule under its Congressionally mandated rulemaking authority of what constitutes such “other papers” under § 1.704(c)(10).

42. Instead, the PTO has, over time and without proper notice and comment, enumerated certain filings that constitute failure to engage in reasonable efforts to conclude prosecution under § 1.704(c)(10) as a matter of policy in the Official Gazette and the Manual for Patent Examining Procedure (“MPEP”).

43. For example, without notice and comment, the PTO in 2001 changed its position from its final rule in 2000 that all papers after allowance delay the ability to process an application. In doing so, the PTO indicated in the Official Gazette that some papers will constitute applicant delay, while others will not. Clarification of 37 C.F.R. § 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. 111 (May 29, 2001). For example, the PTO announced “other papers” that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include, but are not limited to: (1) a request for a refund; (2) a status letter; (3) amendments under 37 C.F.R. § 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) oaths or declarations. *Id.* The PTO also stated the following papers would not be considered a failure to engage in reasonable efforts including, but not limited to: (1) Fee(s)

Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (micro/small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability"; and (7) letters related to government interests (e.g., those between NASA and the Office). *Id.*

44. Thereafter, without notice and comment, the PTO established Section 2732 of the MPEP in May 2004 incorporating the statements from the 2001 Official Gazette notice. MPEP § 2732 (May 2004).

45. Since the 2001 Official Gazette notice, the PTO has published Notice of Proposed Rulemaking relating to the PTA regulations for Applicant Delay nine times. *See* 68 Fed. Reg. 53816 (Sept. 12, 2003); 68 Fed. Reg. 66648 (Nov. 26, 2003); 71 Fed. Reg. 48 (Jan. 3, 2006); 76 Fed. Reg. 18990 (Apr. 6, 2011); 76 Fed. Reg. 81432 (Dec. 28, 2011); 77 Fed. Reg. 442 (Jan. 5, 2012); 78 Fed. Reg. 21788 (Apr. 11, 2013); 79 Fed. Reg. 34681 (June 18, 2014); 84 Fed. Reg. 53090 (Oct. 4, 2019). The PTO has also amended the PTA regulations for Applicant Delay twelve times. *See* 69 Fed. Reg. 21711 (Apr. 22, 2004); 69 Fed. Reg. 50002 (Aug. 12, 2004); 72 Fed. Reg. 46843 (Aug. 21, 2007); 74 Fed. Reg. 52691 (Oct. 14, 2009); 76 Fed. Reg. 74702 (Dec. 1, 2011); 77 Fed. Reg. 46628 (Aug. 6, 2012); 77 Fed. Reg. 49360 (Aug. 16, 2012); 78 Fed. Reg. 19420 (Apr. 1, 2013); 78 Fed. Reg. 62408 (Oct. 21, 2013); 80 Fed. Reg. 1356 (Jan. 9, 2015); 87 Fed. Reg. 30818 (June 16, 2020); 88 Fed. Reg. 39177 (June 15, 2023).

46. However, the PTO has not solicited public commentary on what constitutes "other papers" under 37 C.F.R. § 1.704(c)(10).

47. In contrast, after its establishment in May 2004, the PTO has made changes to Section 2732 of the MPEP five separate times in January 2013, October 2015, June 2020, in July 2022, and in July 2023 without notice and comment.

48. Without proper notice and comment through reference to the statements from the 2001 Official Gazette notice and MPEP § 2732, the PTO changed what it considers to be an “other paper” under 37 C.F.R. § 1.704(c)(10) in its final rule notice in 2015. The PTO decided it “no longer considers submission of a written (or other type of) status inquiry, request for refund, or an inventor’s oath or declaration to be a failure to engage in reasonable efforts to conclude processing and examination of the application under § 1.704(c)(10) due to the changes that have been brought about by the electronic filing and processing of patent applications.” 80 Fed. Reg. 1354 (Jan. 9, 2015). The Notice for Proposed Rulemaking did not discuss or seek commentary on “other papers” constituting Applicant Delay. *See* 79 Fed. Reg. 34681 (June 18, 2014).

49. The PTO then amended Section 2732 of the MPEP in October 2015 to revise the list of papers that would and would not be considered a failure to engage in reasonable efforts. Pursuant to the 2015 amendments, papers that would be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include, but are not limited to: (1) an amendment under 37 C.F.R. § 1.312; (2) a paper containing a claim for priority or benefit or request to correct priority or benefit information (e.g., a new or supplemental application data sheet filed to correct foreign priority or domestic benefit information); (3) a request for a corrected filing receipt; (4) a certified copy of a priority document; (5) drawings; (6) a letter related to biologic deposits; (7) a request to change or correct inventorship; and (8) an information disclosure statement not accompanied by a statement in compliance with 37 C.F.R. § 1.704(d). Further, filings that do not constitute a failure to engage in reasonable efforts to

conclude prosecution under § 1.704(c)(10) include, but are not limited to: (1) Fee(s) Transmittal (PTOL-85B); (2) power of attorney; (3) power to inspect; (4) change of address; (5) change of status (micro/small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability"; (7) status letters; (8) requests for a refund; (9) an inventor's oath or declaration; (10) an information disclosure statement with a statement in compliance with 37 C.F.R. § 1.704(d); (11) the resubmission by applicant of unlocatable paper(s) previously filed in the application (37 C.F.R. § 1.251); (12) a request for acknowledgment of an information disclosure statement in compliance with 37 C.F.R. § 1.97 and 1.98, provided that the applicant had requested that the examiner acknowledge the information disclosure statement prior to the notice of allowance, or the request for acknowledgement was applicant's first opportunity to request that the examiner acknowledge the information disclosure statement; (13) comments on the substance of an interview where the applicant-initiated interview resulted in a notice of allowance; and (14) letters related to government interests (e.g., those between NASA and the Office).

50. In 2020, the PTO again changed course and amended 37 C.F.R. § 1.704(c)(10) 'to exclude "an amendment under § 1.312 or other paper expressly requested by the Office" from the amendments under § 1.312 or other papers filed after a notice of allowance that will result in a reduction of patent term adjustment under § 1.704(c)(10).' Patent Term Adjustment Reductions in View of the Federal Circuit Decision in *Supernus Pharm., Inc. v. Iancu*, 85 Fed. Reg. 36337 (June 16, 2020). However, in its Notice for Proposed Rulemaking, the PTO only referenced the term "other paper" in relation to 37 C.F.R. § 1.704(c)(8), which applies to replies or other papers made during examination, not after examination has concluded and an allowance has been

mailed as under 37 CFR 1.704(c)(10). Patent Term Adjustment Procedures in View of the Federal Circuit Decision in *Supernus Pharm., Inc. v. Iancu*, 84 Fed. Reg. 20344 (May 9, 2019). This adjustment came after the Federal Circuit’s decision in *Supernus Pharm.*, which held PTA adjustment reductions for applicant delay must be equal to the period of time the applicant failed to engage in reasonable efforts to conclude prosecution. *Id.* at 36335; see *Supernus Pharm. Inc. v. Iancu*, 913 F.3d 1351, 1360-61 (Fed. Cir. 2019).

51. As for the “other papers” and what does or does not constitute failure to engage in reasonable efforts to conclude prosecution under § 1.704(c)(10), the PTO has stated these enumerated categories of filings are submissions that are known to “cause[] substantial interference and delay in the patent issue process” based on the PTO’s computer program’s inability to make “value judgments concerning papers filed after allowance.” Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 Fed. Reg. 56365, 56370, 56380-81 (September 18, 2000) (final rule). Clarification of 37 CFR 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. Pat. Office 111 (May 29, 2001).

52. The PTO has further stated the current issuance process occurs mostly after payment of the issue fee and “encourages applicants to file any necessary ... assignments ... or other papers ... well prior to payment of the issue fee and shortly after mailing of a Notice of Allowance.” *Id.*

53. The PTO has also stated assignee information is taken from the issue fee transmittal form, PTOL-85B, *when the issue fee is paid*. Patents to Issue More Quickly After Issue Fee Payment, 1220 Off Gaz. Pat. Office 42 (Mar. 9, 1999) (emphasis added). Again, the PTO has enumerated filing a PTOL-85B form after a Notice of Allowance does not constitute

applicant delay in Section 2732.III.J of the MPEP. *Id.* Further, the PTO has explained that after allowance, the inventors' names, the title of the invention, and any priority information are captured by a data capture contractor from documents within the file wrapper. *Id.* Under current PTO policy, the Office of Data Management will begin electronic capture of most of the information to be printed in a patent "immediately after the Notice of Allowance has been mailed". M.P.E.P. § 1309. Later, "when the issue fee is paid ... the application is then electronically exported to the Final Data Capture ... [which] makes any updates necessary to the electronic file." *Id.* The PTO requires all applications claiming priority to include an ADS and "prefers its use in all applications to help facilitate the electronic capturing of important data." 37 C.F.R. § 1.76; M.P.E.P. § 601.05. The PTO also allows applicants to correct the ADS during the prosecution of a patent application no later than the payment of the issue fee. 37 C.F.R. § 1.76(c). For any inconsistent information, the ADS controls. 37 C.F.R. § 1.76(d). This rule change was implemented as part of the American Invents Act. Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, Reg. 48776, 48780 (August 14, 2012).

54. Additionally, Congress has expressly allowed the correction of patents for errors of a mistake of a clerical or typographical nature, or of minor character if the correction would not constitute new matter or require reexamination. 35 U.S.C. § 255. Congress also has expressly allowed correction of inventorship after a patent is issued. 35 U.S.C. § 256. While silent to applicant corrections, the PTO expressly allows certificates of correction to fix the name of an assignee after issuance. 37 C.F.R. § 3.81(b). Notably, reissue applications do not affect the unexpired term of the original patent, including PTA. 35 U.S.C. § 251.

55. Given the above, Syngenta's filing of a corrected ADS *before paying the issue fee* to update the Applicant and Assignee information in the '900 application as correctly filed in the original '167 PCT application and corrected in the parent '768 application does not "cause[] substantial interference and delay in the patent issue process." This action is not a failure to engage in reasonable efforts to conclude prosecution because the Applicant and Assignee information would be pulled after the payment of the issue fee or by a data capture contractor.

56. Moreover, for the '323 patent to have the appropriate assignee and applicant information, Syngenta was compelled to file a corrected ADS before paying the issue fee because inconsistent information would be controlled by the ADS, not the parent applications. 37 C.F.R. § 1.76(d). Here, Syngenta had already corrected the ADS in the parent applications prior to the filing of the '900 continuation application that issued as the '323 patent and simply filed a conforming corrected ADS in the '900 application *before paying the issue fee*. This behavior certainly does not constitute the "most egregious and obvious delay tactics" Congress intended to punish. H.R. Rep. No. 106-287, at 50 (1999); *see also* H.R. Rep. No. 104-784, at 67 (1996).

57. Moreover, Syngenta's correction of the applicant and assignee information in the ADS did not include new matter or require reexamination. The PTO requires Examiners to review all parent applications for pertinent prior art, including prior art with common inventors, applicants, and/or assignees, in assessing patentability and to consider applications with common inventors, applicants, and/or assignees for evaluating double patenting. *See* MPEP §§ 804, 904. Because the originally filed ADS of the '900 application included Syngenta Limited as the Applicant and Syngenta Participations AG as an Assignee, the Examiner would have been aware of both parties during examination of the '900 application. Moreover, because the parent '768 application indicated both Syngenta Limited and Syngenta Participations AG as applicants and

assignees of the application and the parent '167 application indicated both Syngenta Limited and Syngenta Participations AG as applicants, the Examiner would have been aware of both parties during examination of the '900 application. As such, a corrective reissue would likely have been granted, which would have had no effect on PTA.

58. Additionally, Syngenta understands that if the PTO had not requested the submission of a legible copy of the claims, and Syngenta had simply filed the corrected ADS, as it did, before payment of the issue fee as required by 37 C.F.R. § 1.76(d), there would have been no delay attributed to Syngenta's filing. Further, had Syngenta filed a corrected ADS with the PTO's request for a legible copy of the claims with a change of address or change of entity status, there would have been no delay attributed to Syngenta's filing. *See* MPEP § 2732.III.J. Yet, because Syngenta filed a corrected ADS fixing applicant and assignee information at the same time as the information expressly requested by the PTO, the PTO arbitrarily attributed a reduction of the PTA of the '323 patent by 70 days as Applicant Delay. *See e.g.*, H.R. Rep. No. 106-287, at 49, 50 (1999) (explaining "Title III removes the 10-year caps from the existing provisions, adds a new provision to compensate applicants fully for PTO-caused administrative delays"); *Novartis AG v. Lee*, 740 F.3d, 593, 595-96 (Fed. Cir. 2014) (recognizing Congress intended to compensate applicants for PTO caused delays).

59. Moreover, because Congress allows certificates of correction to remedy such errors after a patent has issued, the Director's interpretation to view filing a corrected ADS as a failure to engage in reasonable efforts to conclude processing or examination is contrary to 35 U.S.C. § 154(b)(2)(C)(i). *See* 35 U.S.C. §§ 255, 256.

60. Finally, the PTO has also stated that corrected filing receipts after allowance require applications to be "taken out of the printing cycle" and that corrected filing receipts are

“NOT needed to ensure that the patent is printed without the errors” because biographical information is “separately captured by the data capture contractor from documents within the application file wrapper.” Patents to Issue More Quickly After Issue Fee Payment, 1220 Off Gaz. Pat. Office 42 (Mar. 9, 1999). Moreover, filing a corrected ADS does not necessitate a corrected filing receipt. Section 601.05(a).II of the MPEP expressly allows applicants to file a corrected ADS without filing a request for a corrected filing receipt when requesting to change the applicant. That is precisely what Syngenta did in this case: Syngenta filed a corrected ADS in accordance with 37 C.F.R. § 1.46(c) without filing a request for a corrected filing receipt. Therefore, any delay which may have resulted was because the PTO, of its own accord and not requested by Syngenta, issued a corrected filing receipt on January 31, 2023, after the Notice of Allowance. Because Congress intended applicants to be compensated fully for PTO-caused delays and the PTO caused the delay here when issuing the corrected filing receipt of its own accord, Syngenta is entitled to 471 days of patent term.

61. Thus, the Director’s reduction of PTA by 70 days as applicant delay is arbitrary and capricious in view of the clear and unambiguous language under 35 U.S.C. § 154(b)(2)(C)(i), which only permits the reduction “by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application.”

62. The correct PTA for the ’323 patent is 471 days, consisting of the current PTA of 401 days plus the additional 70 days which was improperly deducted by Director.

63. Director has improperly calculated the PTA for the ’323 patent in a manner that deprives Syngenta of the full amount of A and B Delay, because Director reduced Syngenta’s

accrued PTA by an amount that exceeded the general limitation on PTA reduction as set forth at 35 U.S.C. § 154(b)(2)(C)(i).

64. Director has inappropriately relied upon 37 C.F.R. § 1.704(c)(10) to support its flawed calculation of PTA. This subsection is silent with respect to a Corrected ADS, and Director's improper application of this subsection led to a patent term reduction that is plainly contrary to the clear and unambiguous language of 35 U.S.C. § 154(b)(2)(C)(i).

65. Because Director's application of 37 C.F.R. § 1.704(c)(10) conflicts with the clear and unambiguous language of 35 U.S.C. § 154(b)(2)(C)(i) and judicial interpretation of 37 C.F.R. § 1.704(c)(10), 37 C.F.R. § 1.704(d), and *Supernus*, Syngenta seeks correction of the Director's PTA determination to reflect 471 days of PTA.

66. To the extent that 35 U.S.C. § 154(b)(2)(C)(i) or related statutory language is ambiguous, the Director is entitled to no deference as courts "may not defer to an agency interpretation of the law simply because a statute is ambiguous." *Loper Bright Enter. v. Raimondo*, 144 S. Ct. 2244, 2273 (2024); *see, Allen v. United States*, 2024 WL 4002305, at *1 (Fed. Cir. Aug. 30, 2024) (recognizing the Supreme Court overruled *Chevron*); *Pac. Gas and Elec. Co. v. Fed. Energy Regul. Comm'n*, 113 F.4th 943, 947-48. (D.C. Cir. 2024) (finding the Federal Energy Regulation Commission is not entitled to deference); *Utah v. Su*, 109 F.4th 313, 317-18 (5th Cir. 2024). Consistent with Congress' intent to only penalize the most egregious and obvious delay tactics, Syngenta seeks correction of the Director's PTA determination to reflect 471 days of PTA. H.R. Rep. No. 106-287, at 50, 67 (1999).

CLAIMS FOR RELIEF

**COUNT ONE
(Patent Term Adjustment Under 35 U.S.C. § 154)**

67. The allegations of paragraphs 1-66 are incorporated in this claim for relief as if fully and expressly set forth herein.

68. The Director did not comply with 35 U.S.C. § 154(b)(2)(C)(i) in determining the patent term adjustment for the '323 patent, and thus unfairly deprived Syngenta of the full amount of PTA it is entitled to pursuant to 35 U.S.C. § 154(b)(1)(A).

69. At no time did Syngenta exhibit conduct to purposely manipulate the patent system to delay the issuance of the '323 patent, which Congress intended to be the only behavior to be defined as "Applicant Delay." H.R. Rep. No. 106-287, at 50 (1999).

70. Syngenta made reasonable efforts to conclude prosecution by filing the corrected ADS before payment of the issue fee along with the corrected papers requested from the Director.

71. The Director inappropriately applied 37 C.F.R. § 1.704(c)(10) when calculating the PTA for the '323 patent, resulting in an incorrect calculation of PTA that deprived Syngenta of the full and appropriate term of the '323 patent, and in a manner contrary to 35 U.S.C. § 154(b)(2)(C)(i).

72. The Director is entitled no deference under *Loper Bright* for its interpretation of the law.

73. Reduction of the PTA by 70 days as applicant delay is inconsistent with 35 U.S.C. § 154(b)(2)(C)(i).

74. The Director's reduction of PTA by 70 days as applicant delay is also arbitrary and capricious in view of the clear and unambiguous language of 35 U.S.C. § 154(b)(2)(C)(i).

75. Syngenta is entitled to an additional 70 days of patent term for the '323 patent such that the 401 days of PTA granted by the Director should be changed to 471 days.

COUNT TWO
(Declaratory Judgment Under The Administrative Procedures Act, 5 U.S.C. § 702 et seq.)

76. The allegations of paragraphs 1-75 are incorporated in this claim for relief as if fully and expressly set forth herein.

77. The Director's promulgation of 37 C.F.R. § 1.704(c)(10), the regulatory subsection interpreting 35 U.S.C. § 154(b)(2)(C)(i), and its improper calculation of Applicant Delay for the '323 patent were contrary to law.

78. The Director's promulgation of 37 C.F.R. § 1.704(c)(10), and determination of PTA for the '323 patent is arbitrary, capricious, an abuse of discretion or otherwise not in accordance with law within the meaning of 5 U.S.C. § 706(2)(A); contrary to Plaintiffs' constitutional rights within the meaning of 5 U.S.C. § 706(2)(B); and in excess of statutory authority within the meaning of 5 U.S.C. § 706(2)(C).

79. The Director's application of 37 C.F.R. § 1.704(c)(10) and 35 U.S.C. § 154(b)(2)(C)(i) to the facts of this case is arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law within the meaning of 5 U.S.C. § 706(2)(A) because it produces the unfair and irrational result of depriving an applicant the entire A and B Delay accrued, including all the PTA accrued after the mailing of the Notice of Allowance and before Issuance of the '323 patent. The Director's interpretation and application of the law is inconsistent with the express language of 35 U.S.C. § 154(b)(2)(C)(i) to limit a reduction of period of adjustment "to the period of time during which the applicant failed to engage in

reasonable efforts to conclude prosecution of the application” and undermines Congress’ intent to only punish the most egregious and obvious delay tactics.

80. Further, the Director’s application of 37 C.F.R. § 1.704(c)(10) and 35 U.S.C. § 154(b)(2)(C)(i) to the facts of this case is arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law within the meaning of 5 U.S.C. § 706(2)(A) because it produces the unfair and irrational result of depriving an applicant the entire A and B Delay accrued when correcting information after a Notice of Allowance that would otherwise be correctable with a reissue application with no reduction in PTA.

81. The Director’s erroneous application of 37 C.F.R. § 1.704(c)(10) resulted in an incorrect calculation of PTA that deprived Syngenta of the full and appropriate term of the ’323 patent. The Director’s reduction of PTA by 70 days as applicant delay is arbitrary and capricious, and unlawful pursuant to 5 U.S.C. § 706(2)(A).

82. The Director is entitled no deference under *Loper Bright* for its interpretation of the law.

83. Syngenta has exhausted all available administrative remedies under 35 U.S.C. § 154(b)(3)(A)-(B) or, in the alternative, pursuit of any further administrative remedies is futile.

84. The Director’s determination of PTA for the ’323 patent on June 7, 2024, under 35 U.S.C. § 154(b)(3)(B)(ii), is the final agency action and is reviewable by a district court in accordance with 35 U.S.C. § 154(b)(4)(A) and 5 U.S.C. § 704. Syngenta has been afforded no adequate remedy at law for the Director’s determination of PTA for the ’323 patent.

85. The Director’s action caused Syngenta to suffer legal wrong and adversely affected the rights of Syngenta under the ’323 patent. Syngenta will suffer irreparable injury if the Director is not ordered to recalculate PTA for the ’323 patent.

86. An order requiring the Director to recalculate PTA for the '323 patent would not substantially injure any other interested parties, and the public interest will be furthered by correcting a procedural action that is contrary to law.

87. Syngenta is entitled to additional patent term for the '323 patent such that the 401 days of PTA granted by the Director should be changed to 471 days.

WHEREFORE, Plaintiffs respectfully pray that this Court:

A. Issue an Order changing the period of PTA for the '323 patent from 401 days to 471 days, deemed in accordance with 35 U.S.C. § 154(b)(2)(C) and requiring Defendant to alter the term of the '323 patent to reflect such additional PTA;

B. Declare pursuant to 35 U.S.C. § 154(b)(2)(C) that 37 C.F.R. § 1.704(c)(10), as applied by the Director to the '323 patent, is invalid and contrary to law; and

C. Grant such other and further relief as the nature of the case may admit or require and as may be just and equitable.

Dated: December 4, 2024

Respectfully submitted,

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