



Double Patenting



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Overview

- Double Patenting-The Basics
 - 35 U.S.C. 121 Exclusions
 - Two types
 - Statutory Double Patenting
 - Non-Statutory Obviousness-type Double Patenting
 - Duty to Disclose
- Terminal Disclaimers and other ways to overcome a double patenting rejection

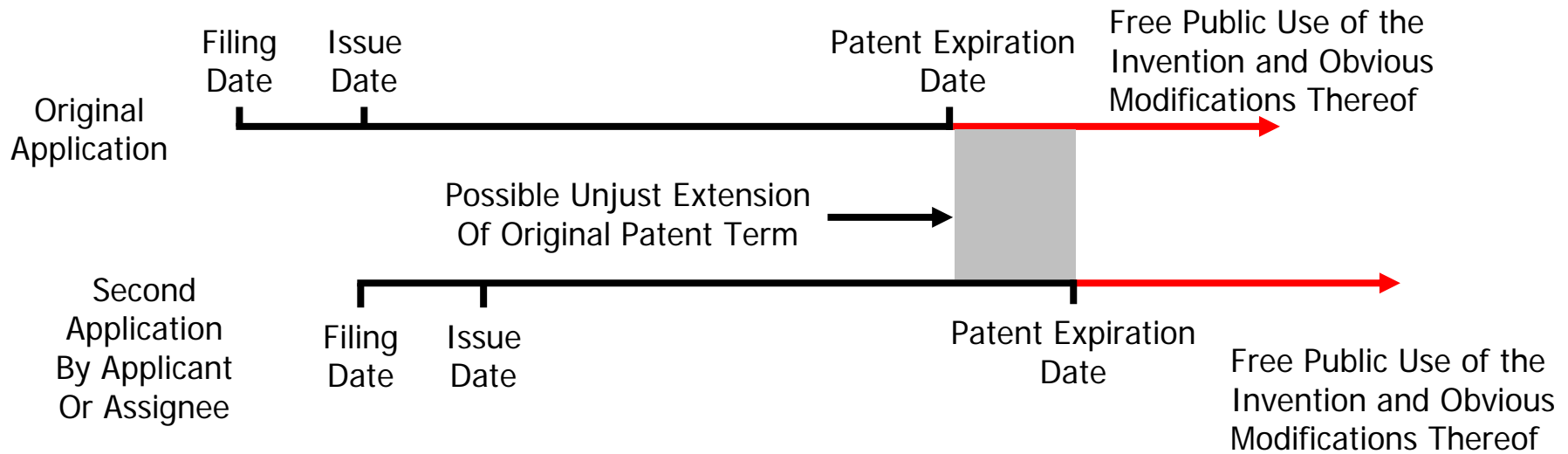


The Purpose Behind the Policy

- The Constitution
 - Promote the progress of science and useful arts
 - Limited exclusive right in exchange for disclosure
 - Benefits the public
- Double Patenting Prohibition
 - Prevents unjustified extension of exclusive rights
 - After expiration, public should be able to:
 - Freely use the claimed invention
 - Freely use obvious modifications of the claimed invention



A Graphical Representation of the Problem





Focus on the Claims

- Claims of the potentially conflicting patent or application vs. examined claims
- Use of specification of the potentially conflicting patent or application is generally prohibited
 - Limited exception – to be discussed more fully later





What is a Double Patenting Rejection?

- Rejection of Claims
- Of Common Inventor or Assignee
- Not Entitled to a Patent Because:
 - Claimed invention is the same as the invention claimed in another patent/application
 - Claimed invention is an obvious variation of the invention claimed in another patent/application of common assignee/inventor



Types of Double Patenting Rejections

- Statutory (35 U.S.C. 101) Double Patenting
 - same invention
- Non-Statutory Double Patenting
 - Obviousness-Type Double Patenting
 - Rejection based on anticipation analysis
 - Rejection based on obviousness analysis



Possible Double Patenting Situations

- Examined application vs. another copending application (provisional rejection)
- Examined application vs. issued patent



General Analysis

- Double Patenting Rejection Prohibited by 35 U.S.C. 121?
- Statutory Basis Exists (35 U.S.C. 101)?
- Nonstatutory Basis Exists?



Double Patenting and 35 U.S.C. 121

- The Third Sentence of 35 U.S.C. 121 Provides:
 - A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.



Double Patenting and 35 U.S.C. 121

- MPEP § 804.01
 - This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.



When Prohibition Under 35 U.S.C. 121 Does Not Apply

- Two or more applications filed – No restriction requirement made
- Claims in later application are not commensurate with the restriction requirement
 - *Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 68 USPQ2d 1865 (Fed. Cir. 2003)
 - *Bristol-Myers Squibb Co. v. Pharmachemie B.V.*, ___ F.3d___, 70 USPQ2d 1097 (Fed. Cir. 2004)



When Prohibition Under 35 U.S.C. 121 Does Not Apply

- Lack of Unity determination made by ISA in international (PCT) application
 - No restriction in US application
- Examiner withdraws restriction before patent issues
- Claims are directed to identical subject matter
 - Statutory Double Patenting



Statutory Double Patenting

35 U.S.C. 101



The Statute

- 35 U.S.C. 101
- Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain **a patent** therefor, subject to the conditions and requirements of this title.
(Emphasis added)



“Same Invention” Test

- Is the same invention being claimed twice?
 - Is there an embodiment that falls within the scope of one claim, but not the other?
 - Could one claim in the application be literally infringed without literally infringing a corresponding claim in the patent?



Non-Statutory Obviousness-Type Double Patenting

- ODP – Anticipation analysis
- ODP – Obviousness analysis



ODP-Anticipation Situation

- Examined Claim
 - Fully encompasses a claim in the potentially conflicting patent or application
 - Claim to a species anticipates a claim to a genus
- *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001)
- *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)



ODP-Anticipation - !!CAUTION!!

- **NOT** for These Situations
 - Examined claim is a species/subgenus of generic claim in potentially conflicting patent or application
 - Mere overlap without anticipation
- ODP-Obviousness analysis required



ODP – Obviousness Analysis

Question raised: Does any claim in the application define an invention which is merely an obvious variation of an invention claimed in the reference patent/copending application?



One-Way Obviousness

- Claim A – Examined Application
- Claim B – Potentially Conflicting Patent or Application
 - Would Claim A Have Been Obvious Given Claim B?



Two-Way Obviousness

- Claim A – Examined Application
- Claim B – Potentially Conflicting Patent or Application
 - Would Claim A Have Been Obvious Given Claim B?

AND

- Would Claim B Have Been Obvious Given Claim A?



General Rule – One-Way vs. Two-Way

- Apply One-Way Test Unless All Three Apply
 - The examined application has an effective U.S. filing date before that of a potentially conflicting patent
 - There is sufficient evidence of record that the claims could not have been filed in the same application
 - There is sufficient evidence of record that there was administrative delay on the part of the Office in the application being examined



ODP – Obviousness Analysis

- Analogous to 35 U.S.C. 103 Analysis
- Determine the Scope and Content of the “Prior Art”
- Ascertain the Differences Between the “Prior Art” and the Claim in Issue
- Resolve the Level of Ordinary Skill in the Art
- Evaluate Evidence of Secondary Considerations
- Motivation to combine teachings
- Reasonable expectation of success



Written Rejection

- Any Obviousness-Type Double Patenting rejection based on an obviousness analysis should make clear:
 - The differences between a claim in the examined application compared to a claim in the reference patent (or copending application)
 - The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent (or copending application)



Differences Between 35 U.S.C. 103 and ODP-Obviousness Analysis

- “Prior Art”
 - 35 U.S.C. 103 Analysis
 - Prior art within the meaning of 35 U.S.C. 102
 - Reference used for all it fairly teaches
 - ODP-Obviousness Analysis
 - Claims of a potentially conflicting patent or application
 - Alone or with prior art within the meaning of 35 U.S.C. 102
 - Reliance on specification of a potentially conflicting patent or application is generally prohibited
 - Limited exceptions (see *In re Vogel*)



Proper Uses of Disclosure

- Exceptions to the general prohibition of using the disclosure of a potentially conflicting patent or application
 - Dictionary for claim terminology
 - Portions of the disclosure which provide support for the claims in the potentially conflicting patent or application



Reference Disqualified under 35 U.S.C. § 103(c)

- Consistent with USPTO policy since the AIPA added 35 U.S.C. 103(c), 37 CFR § 1.78(c) was amended to emphasize that double patenting rejections should still be made, when appropriate, even if a reference is disqualified from being used in a rejection under 35 U.S.C. § 103(a) via the prior art exclusion under 35 U.S.C. § 103(c).
 - Changes to Support Implementation of the USPTO 21st Century Strategic Plan, Final Rule, 69 *Fed. Reg.* 56481 (September 21, 2004); 1287 *Off. Gaz. Pat. Office* 67 (October 12, 2004)



37 CFR § 1.78(c)

- New final sentence

“Even if the claimed inventions were commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made, the conflicting claims may be rejected under the doctrine of double patenting in view of such commonly owned or assigned applications or patents under reexamination.”



Duty to Disclose

- Applicants have a duty to disclose to the U.S. Patent and Trademark Office all material information they are *aware* of regardless of the source of or how they become aware of the information. ... The duty to disclose material information extends to information such individuals are aware of prior to or at the time of filing the application or become aware of during the prosecution thereof. MPEP 2001.06 (emphasis added)



Duty to Disclose

- Prior rejections
 - See *Dayco Products Inc. v. Total Containment Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003)
- Applicants, pursuant to 37 CFR § 1.56, must disclose all relevant applications for which a double patenting rejection would be appropriate, and should disclose any related application(s) if there is any doubt.
 - MPEP § 2001.06(b)
 - Changes to Support Implementation of the USPTO 21st Century Strategic Plan Final Rule, 69 *Fed. Reg.* 56481 (September 21, 2004); 1287 *Off. Gaz. Pat. Office* 67 (October 12, 2004)



How to Overcome a Proper Double Patenting Rejection

- Statutory (35 U.S.C. 101) Double Patenting
 - Amend the claim(s)
 - Cancel the claim(s)
 - A terminal disclaimer is **NOT** sufficient to overcome such a rejection
 - Declarations under 37 CFR 1.131 are **NOT** sufficient to overcome such a rejection



How to Overcome a Proper Double Patenting Rejection

- Non-Statutory Double Patenting (All Types)
 - Amend the claim(s)
 - Cancel the claim(s)
 - File argument and/or documentary evidence
 - File a proper terminal disclaimer
 - Declarations under 37 CFR 1.131 are **NOT** sufficient to overcome such a rejection



What is a Terminal Disclaimer?

- Legal Document
 - Ensures that the term for a patent granted on the examined application will not extend past the expiration of the term of the conflicting patent or a patent granted on a conflicting application
 - Ensures common ownership between the examined application and the conflicting patent or a patent granted on the conflicting application



Terminal Disclaimer

- “must operate with respect to all claims in the patent.”
- “is not an admission of the propriety of the rejection.”
- is “effective only with respect to the application identified in the disclaimer, unless by its terms it extends to continuing applications.”
 - Effective with respect to each application having the identified application number
- See 37 CFR § 1.321 and MPEP § 1490



Terminal Disclaimer

- A terminal disclaimer fee is required for each terminal disclaimer filed.
- A terminal disclaimer is required even in applications filed on or after June 8, 1995
 - as a result of patent term adjustment provisions, patents and conflicting claims would not necessarily expire on the same day
 - even if patents with conflicting claims would expire on the same day, ensuring enforceability only as long as they are commonly owned is still required



Questions?

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