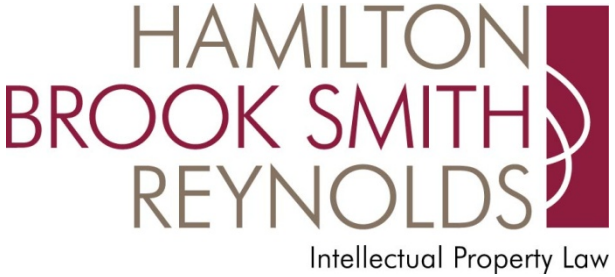
The Past, Present and Future of Obviousness-Type Double Patenting



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Hamilton, Brook, Smith & Reynolds, P.C.
April 7, 2015

Constitutional Basis

Article I

Section 8.

The Congress shall have power . . .

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[8] To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; . . .

35 U.S.C. § 101. Inventions Patentable

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.)

What is "Double Patenting"

Contest:

- Between claims of two patents (courts), two applications (PTO), or an application and a patent (PTO)
- If same inventive entity, common inventor, or common owner

Types:

- Same invention (claims are identical in scope)
  - barred under 35 U.S.C. § 101
- Obviousness-type (claims are not identical in scope)
  - barred for policy reasons
  - can be overcome by terminal disclaimer, disclaiming term extending beyond first patent to expire, ***so long as commonly owned***.

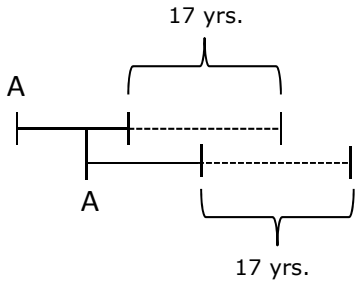
Policies Behind Obviousness-Type Double Patenting

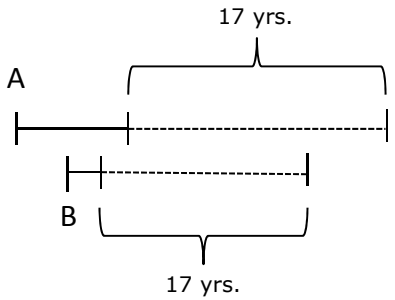
- Unwarranted extension of Patent Term.
- Harassment by multiple assignees.
- Inconvenience to the Patent Office.
- Possibility that one might avoid the effect of file-wrapper estoppel by filing a second application.

In re Robeson, 331 F.2d 610 (CCPA 1964)

How Would an Unwarranted Extension of Patent Term Come About?

Where term of patents extend 17 years from issue (at least)





Both cases are resolved by “a same invention” or “obviousness-type” double patenting rejection based on first patent to issue.

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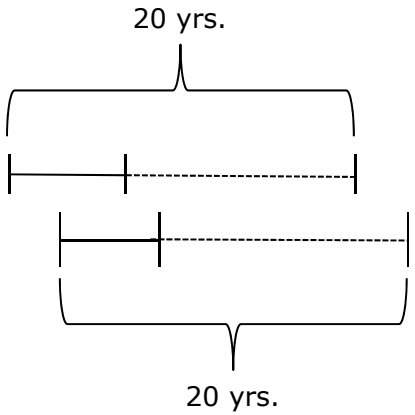
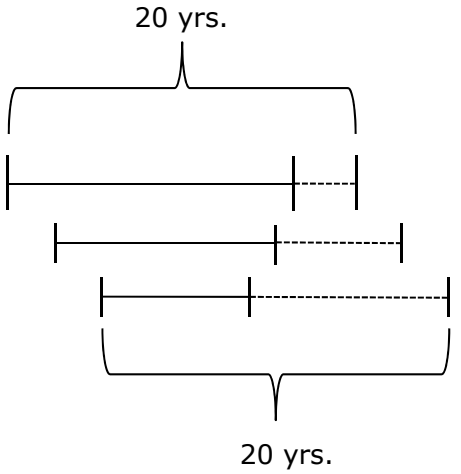
How Would an Unwarranted Extension of Patent Term Come About? (Cont'd.)

When term of patents extends 20 years from filing…



Another way:



Assumption: only an earlier-issued patent can be used as the basis for a double patenting rejection.

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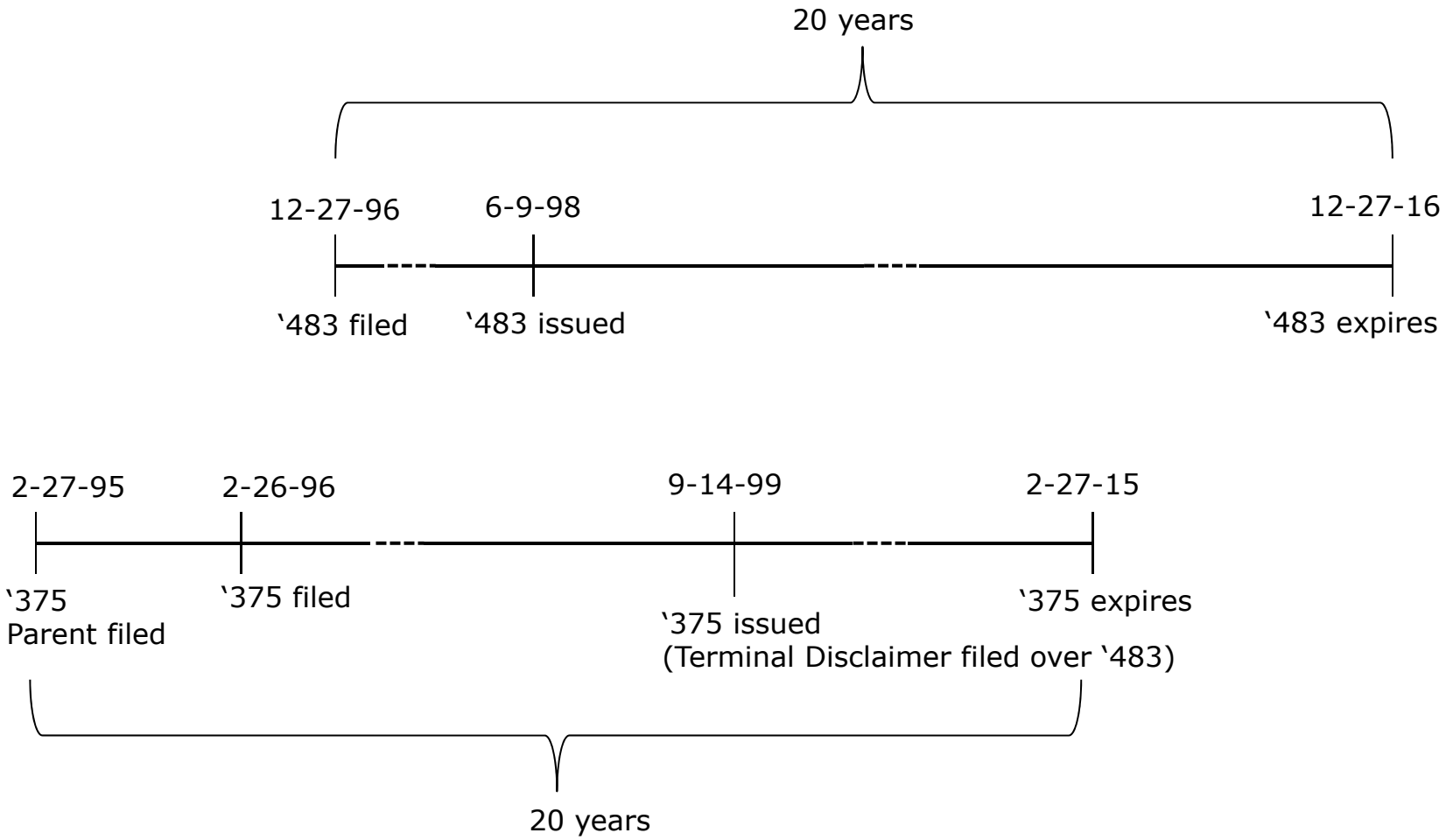
Gilead Scis., Inc. v. Natco Pharma Ltd. 753 F.3d 1208 (Fed. Cir. 2014)

U.S. 5,763,483
U.S. 5,952,375
} Commonly owned } Identical Inventorship entities

- Different filing dates and different issue dates.
- Neither patent claims priority to the other (different families).
- Both patents expire 20 years from filing.

Sequence of Events



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Fed. Cir. Solution in *Gilead*

- Eliminate need to base obviousness-type double patenting rejection on first patent to issue.
- Expiration date is key to determining unwarranted extension of patent term.

Dissent in *Gilead*

- "a primary motivation behind the doctrine -- preventing the effective extension of patent term -- is largely no longer applicable."
- policy concern of harassment not an issue because the '375 Patent (earlier-filed) was subject to terminal disclaimer.
- Gilead would have been entitled to the full term of the later-filed ('483) patent if the earlier-filed ('375) patent never issued.

Larger Issue

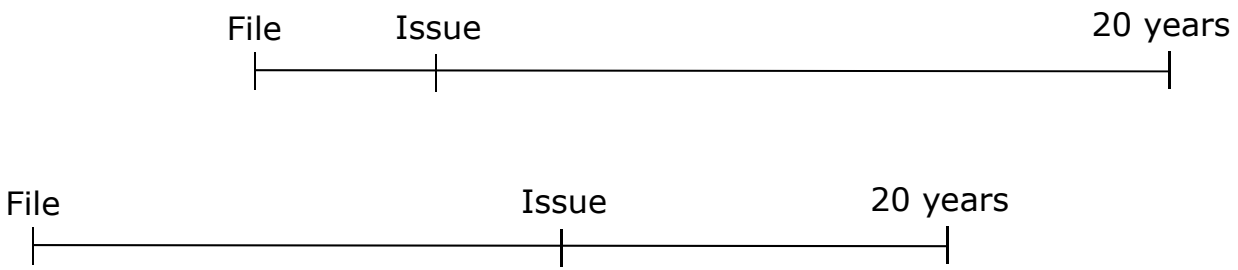
- In view of *Gilead*, term of earlier-issued patent can be cut short if claims are

    1. commonly owned; or
    2. have overlapping inventorship

  with claims of a later-issued application, regardless of when filed.
- Must now be aware of obviousness issues in claims that are commonly owned or have at least one common inventor, regardless of priority date.

Question Presented

"Whether, contrary to this Court's consistent and longstanding precedent and Congress' intent, the double-patenting doctrine can be used to invalidate a properly issued patent before its statutory term has expired using a second, later-issuing patent whose term of exclusivity is entirely subsumed with the first patent's term."



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Consequences

If Gilead wins: limited to rejection of later-issued patents.

If Gilead loses: will apply so long as there is common ownership or common inventor.

Regardless: Twenty year term of earlier-issued patent can be cut short simply by virtue of common ownership, or lost altogether if there is overlap of inventorship but no common owner

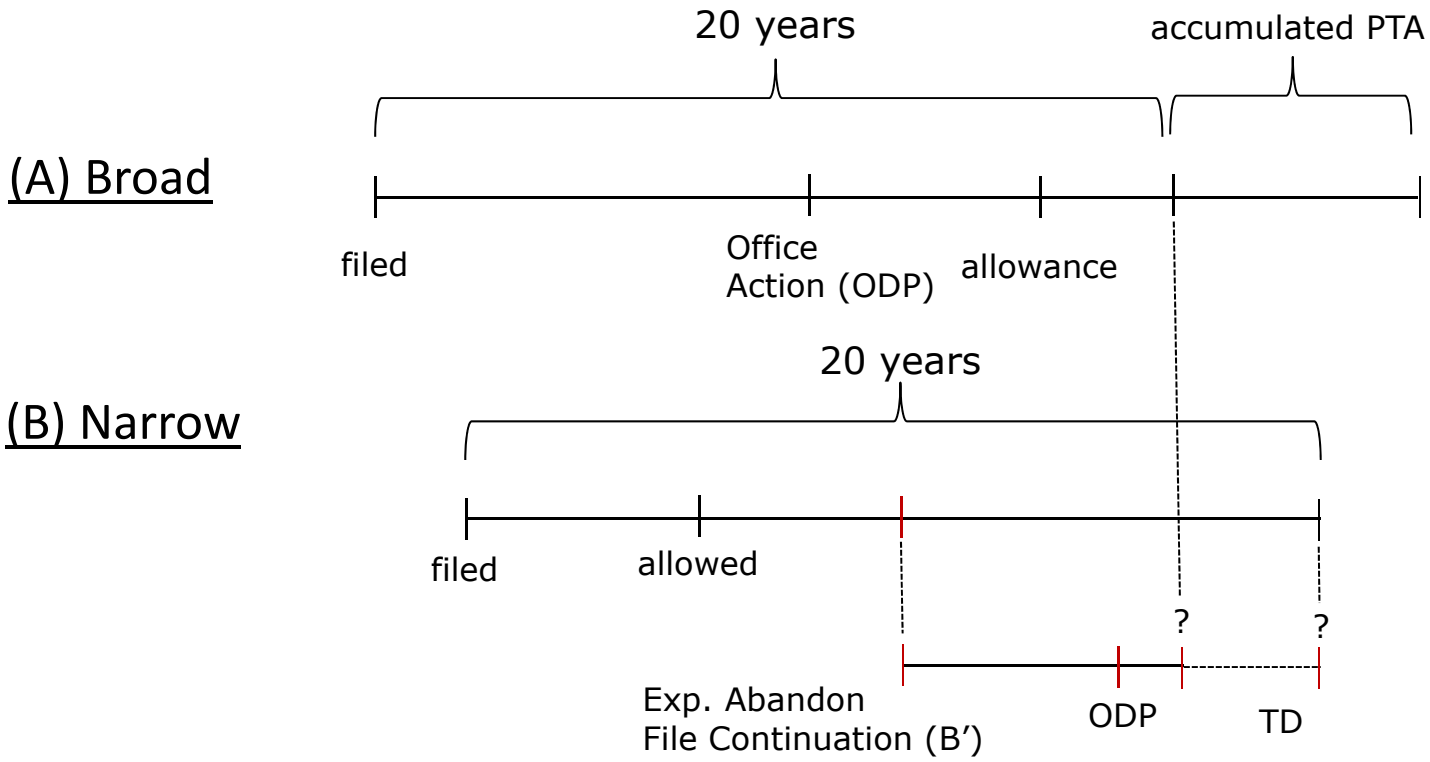
So, what is the solution?

Proposal

Limit obviousness-type double patenting rejection to later *filed* applications, as proposed by the Innovation Act, introduced by Congress in 2014 (proposed 35 U.S.C. § 106).

Hypothetical Scenario

Preservation of PTA in most important application



So far so good, but, under TD, when does (B') expire? Also, under *Gilead*, is A subject to ODP with respect to issued B'?

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Thank you

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