



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



What is Double Patenting?

- An applicant (or assignee) is prohibited from obtaining two patents for the same invention.
- An applicant (or assignee) is also prohibited from obtaining a patent for an invention that is an obvious variation of an invention for which the applicant (or assignee) already has a patent (unless certain conditions are met).

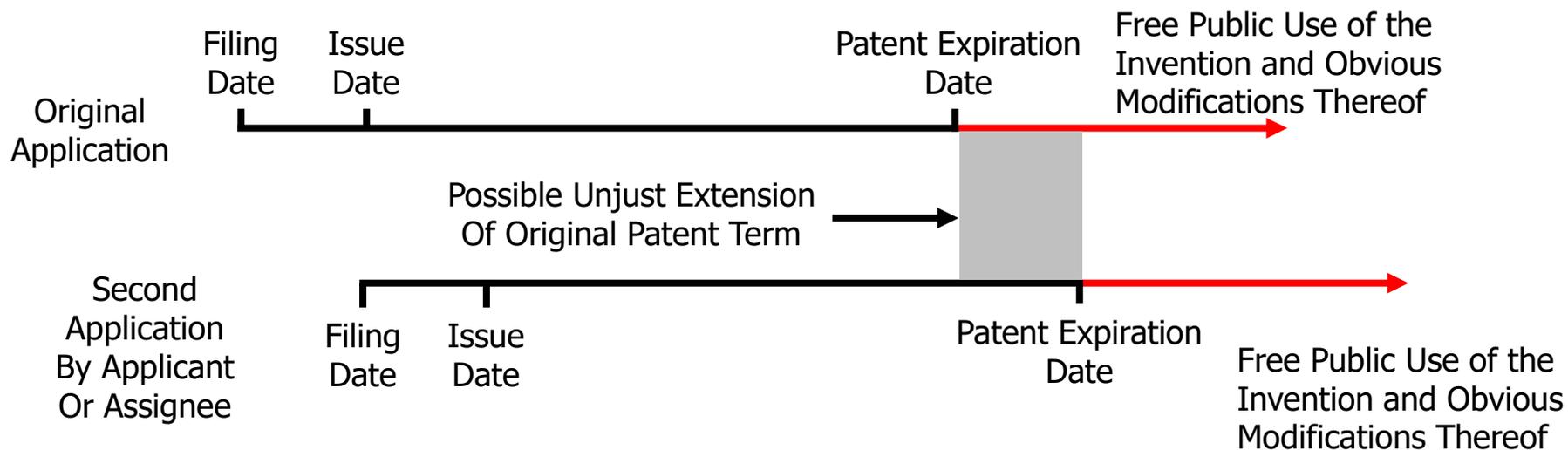


The Purpose Behind the Policy

- 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



Possible Double Patenting Situations

- Examined Application vs. Another Copending Application (Provisional Rejection)
 - Examined Application vs. Published Application (Provisional Rejection)
- Examined Application vs. Issued Patent



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.



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

- Two or more applications filed – No restriction requirement made
- Claims amended such that they are not commensurate with the restriction

requirement-See Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC, 68 USPQ2d 1865 (CA FC 2003)



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

- Lack of Unity made in PCT application-No restriction in US application
- Examiner withdraws restriction before patent issues
 - Linking claim practice followed and generic claim allowed
- Claims are directed to identical subject matter-Statutory Double Patenting



Domination and Double Patenting

- Domination: Broad or generic claims in one patent fully encompass narrower claims in another patent
- Domination by itself cannot support a double patenting rejection
- Domination does not preclude a double patenting rejection



Types of Double Patenting Rejections

- Statutory (35 U.S.C. 101) Double Patenting
- Non-Statutory Double Patenting
 - Obviousness-Type Double Patenting
 - Rejection based on obviousness analysis
 - Rejection based on anticipation analysis
 - Non-Statutory Double Patenting Based Solely on Improper Timewise Extension of Patent Rights



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

- Is the same invention being claimed twice?
- Identical subject matter



A Reliable Test

- Is there an embodiment that falls within the scope of one claim, but not the other?
- Could one claim be literally infringed without literally infringing the other claim?



Non-Statutory Obviousness-Type Double Patenting: Rejection Based on Obviousness Analysis ODP-Obviousness



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 for concluding 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
 - 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



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



Non-Statutory Obviousness-Type Double Patenting: Rejection Based on Anticipation Analysis ODP-Anticipation



ODP-Anticipation Situation

- Examined Claims
 - Generic to (fully encompasses) a claim in the potentially conflicting patent or application
 - Anticipated by the claim in the potentially conflicting patent or application
- Written Rejection
 - No *Graham v. Deere* analysis needed
 - Explain how the examined claim is anticipated



ODP-Anticipation - !!CAUTION!!

- Examined claim - species/subgenus of generic claim in potentially conflicting patent or application-a generic claim does not usually anticipate a species
- Domination without anticipation-Overlapping generic claims does not usually anticipate one another
- ODP-Obviousness analysis required where ODP-Anticipation does not apply



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



Double Patenting vs. Art Rejection

- Double Patenting
 - Compares claims
 - With limited use of the disclosure of the potentially conflicting patent or application
 - Can be overcome by a terminal disclaimer (ODP only)
 - TD removes potential harm to public



Double Patenting vs. Art Rejection

- Art Rejection
 - Reference used for all it fairly teaches
 - Cannot be overcome with a terminal disclaimer



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.*, 66 USPQ2d 1801 (CA FC 2003)
- Copending Applications-Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications which are "material to patentability" of the application in question. MPEP 2001.06(b)



Terminal Disclaimers

One Avenue for Overcoming ODP
Rejections



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
 - Requires common ownership between the examined application and the conflicting patent or a patent granted on the conflicting application



Some Interesting Things about Terminal Disclaimers

- It “must operate with respect to all claims in the patent.”
- It “is not an admission of the propriety of the rejection.”
- It 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



Some Interesting Things about Terminal Disclaimers

- 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



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



Questions?

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