Obviousness-type Double Patenting: Best Practices and Current Trends

By Whitney Remily

15th Annual Advanced Patent Law Institute
USPTO, Alexandria, VA
March 13, 2020

Birch Stewart Kolasch Birch LLP

© 2017 BIRCH, STEWART, KOLASCH & BIRCH, LLP

Outline

- Impact of Double Patenting
  - Rejection of claims during prosecution
  - Reexamination
  - Invalidity Defense
  - Patent Term Extension (PTE) under 35 USC §156
- Best practices and pitfalls to avoid
  - Prosecution, Portfolio Management, Validity, and Enforcement

© 2017 BIRCH, STEWART, KOLASCH & BIRCH, LLP

Types of Double Patenting

- Statutory-Type Double Patenting
- Non-Statutory Obviousness-Type Double Patenting

© 2017 BIRCH, STEWART, KOLASCH & BIRCH, LLP

Statutory-Type Double Patenting

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.

Options:

- Amend or cancel claims so that they are not coextensive in scope
- Terminal Disclaimers not permitted

© 2017 BIRCH, STEWART, KOLASCH & BIRCH, LLP

Responding to a Statutory-Type Double Patenting Rejection

Two-prong analysis:

- Compare application and patent claims to determine differences.
- Determine whether those differences render the claims patentably distinct.

- MPEP §804: "A reliable test for double patenting under 35 U.S.C. §101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). "

© 2017 BIRCH, STEWART, KOLASCH & BIRCH, LLP

Non-Statutory Obviousness-Type Double Patenting

- Non-Statutory
- Analysis
  - Scope/content of the potentially conflicting **claims** are compared
- In the OTDP analysis:
  - OTDP can be based on anticipation and/or obviousness arguments
  - Other prior art can be combined with a patent claim to support conclusion of OTDP

© 2017 BIRCH, STEWART, KOLASCH & BIRCH, LLP

UT LAW CLE THE UNIVERSITY OF TEXAS TEXASLAW

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the UT Law CLE eLibrary (utcle.org/elibrary)

Title search: Obviousness-Type Double Patenting Issues: Best Practices and Current Trends

Also available as part of the eCourse
2020 Advanced Patent Law (USPTO) eConference

First appeared as part of the conference materials for the
15th Annual Advanced Patent Law Institute session
"Obviousness-Type Double Patenting Issues: Best Practices and Current Trends"