

Obviousness-type Double Patenting: Best Practices and Current Trends

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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



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Types of Double Patenting

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



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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



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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). ”



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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



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