

# Obviousness-type Double Patenting: Best Practices and Current Trends

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## Outline

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- 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

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



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## Statutory-Type Double Patenting

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### 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

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## 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

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

Also available as part of the eCourse

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