

5 Considerations For Obviousness-Type Double Patenting

By **Fabian Koenigbauer** (October 18, 2024)

On Oct. 7, the U.S. Supreme Court denied certiorari for In re: Collect. As it stands, In re: Collect and the Aug. 13 decision in Allergan USA Inc. v. MSN Laboratories Private are the most recent opinions from the U.S. Court of Appeals for the Federal Circuit governing obviousness-type double patenting, or ODP.



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According to the Federal Circuit's 2023 Collect ruling, ODP arises

when the claims of a later-expiring patent [are] obvious over the claims of an earlier-expiring patent owned by the same party. If so, absent a terminal disclaimer, the later-expiring claims are invalid[1] ... [ODP] prevent[s] a patentee from obtaining a timewise extension of patent for the same invention or an obvious modification thereof and prevents an inventor from claiming a second patent for claims that are not patentably distinct from the claims of a first patent.[2]

While ODP can easily be resolved by filing a terminal disclaimer, doing so relinquishes the patent term. ODP appears to be en vogue: 9% of patents issued with terminal disclaimers in 2006 and more than 18% of patents have issued with terminal disclaimers in 2024.[3]

This article provides an overview of the current state of ODP.

1. ODP is not fatal.

A finding of ODP is usually not fatal except when one of patents at issue expire.[4]

The Federal Circuit has indicated that terminal disclaimers might be able to cure an ODP finding post-grant, even during a litigation.[5] In addition, the filing of a terminal disclaimer is not an admission that the invention is obvious.[6]

However, as terminal disclaimers have the potential of reducing patent term and permanently tie patents together, patentees may want to avoid ODP.

2. Divisional applications are protected from ODP.

It is well-established that "[w]hen the PTO requires an applicant to withdraw claims to a patentably distinct invention (a restriction requirement), [35 U.S.C.] § 121 shields those withdrawn claims in a later divisional application against rejection over a patent that issues from the original application," according to the Federal Circuit's 2003 ruling in Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC.[7]

However, the protection is only available when there is consonance, i.e. "the line of demarcation between the 'independent and distinct inventions' that prompted the restriction requirement [is] maintained," according to the Federal Circuit's 1990 ruling in Gerber Garment Technology Inc. v. Lectra Systems Inc.[8]

Thus, a divisional application/patent cannot be subject to ODP. If the claims are amended to no longer encompass the restricted invention, ODP can be raised during prosecution or

post-grant.

3. A parent patent cannot be held invalid for ODP over its child continuation.

While not falling under Title 35 of the U.S. Code, Section 121, a parent patent is protected from ODP over a continuation. According to the Allergan ruling, "a first-filed, first-issued, later-expiring claim cannot be invalidated by a later-filed, later-issued, earlier-expiring reference claim having a common priority date." [9]

Accordingly, there can be no finding of ODP in a parent patent over the child, even if the parent has a longer term due to patent term adjustment, or PTA.

4. Continuation applications can be held invalid for ODP.

The Section 121 protections do not apply to continuations or continuations-in-part. Thus, child continuation patents or continuation-in-part patents can be invalidated for ODP over a parent or sibling sharing the same priority date. [10]

In cases after *In re: Collect*, "the expiration date used for an ODP analysis where a patent has received PTA is the expiration date after the PTA has been added." [11] Thus, "ODP for a patent that has received PTA, regardless of whether or not a terminal disclaimer is required or has been filed, must be based on the expiration date of the patent after PTA has been added." [12]

5. Follow-on applications can create a likelihood of ODP.

Later filed follow-on applications, expanding the subject matter of an earlier filing, create a potential ODP issue.

ODP can arise even if the follow-on application has an earlier expiration date, i.e., the earlier filing has a longer term because of PTA.

It is well-established that a later-filed but earlier-expiring patent can serve as a double patenting reference for an earlier-filed but later-expiring patent. [13]

Thus a follow-on application claiming subject matter initially suggested by the claims in an earlier filing are likely to raise the potential of ODP. For such cases after *In re: Collect*, the patent term for an ODP analysis includes PTA.

Conclusion

Except for divisional applications, any application after an original filing with overlapping claims raises the potential for ODP.

At least, the parent patent is protected. The problem presented by *In re: Collect* is that basing ODP on the total patent term, including PTA, creates a high degree of unpredictability.

A patentee will not know the actual total patent term until grant. As such, while ODP usually is not fatal, because of its ability to reduce patent term and because patent term is unknown until grant, patentees may want to take steps to avoid being in a situation where ODP can arise. The common situations in which ODP may arise are summarized in the table below.

To avoid ODP in continuations, patentees may want to consider avoiding continuation applications and instead include all contemplated claims in the original filing to provoke a restriction requirement.

For continuation applications in which ODP has not been raised applicants many want to consider clarifying the record to confirm that the examiner conducted an assessment for ODP. Doing so may immunize the patent against ODP.[14]

To avoid the potential for ODP in follow-on applications, patentees may want to consider narrowly drafting first filings. For any new application, special attention should be paid to include all claims directed to possible embodiments of interest to provoke a subsequent restriction requirement.

As ODP is usually on a claim-by-claim basis, it may be possible to reissue a patent to delete overlapping claims.

Scenario	ODP Possible	Remarks
Divisionals Applications/Patents	No	Divisionals are protected from ODP under 35 U.S.C. § 121 if consonance is maintained (<i>i.e.</i> the line of demarcation of restriction requirement remains in place)
Parent Continuation	No	“[A] first-filed, first-issued, later-expiring claim cannot be invalidated by a later-filed, later-issued, earlier-expiring reference claim having a common priority date.” <i>Allergan USA Inc. v. MSN Laboratories Private Ltd.</i> , 2024-1061, slip op. at 17 (Fed. Cir. Aug. 13, 2024)
Continuation-Continuation, Continuation-in-part-Continuation, Continuation-Parent	Yes	Continuation applications do not receive § 121 protection. <i>See e.g. Amgen v. Roche</i> , 580 F.3d 1340 (Fed. Cir. 2009). “ODP for a patent that has received PTA regardless of whether or not a terminal disclaimer is required or has been filed, must be based on the expiration date of the patent after PTA has been added.” <i>In re Cellect</i> , 81 F.4th 1216, 1229 (Fed. Cir. 2023)
Follow-on applications	Yes	A later-filed but earlier-expiring patent can serve as a double patenting reference for an earlier-filed but later-expiring patent. <i>Gilead Sciences., Inc. v. Natco Pharma Ltd.</i> , 753 F.3d 1208, 1212 (Fed. Cir. 2014). Expiration needs to include PTA based on <i>In re Cellect</i>

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[1] *In re Collect*, 81 F.4th 1216, 1226 (Fed. Cir. 2023), cert denied *Collect LLC v. Vidal*, 2024 WL 4426602 (U.S. Oct. 7, 2024.).

[2] *Id.* at 1226 (quoting *In re Londardo*, 119 F.3d 960, 965 (Fed. Cir. 1997)).

[3] Dennis Crouch, Terminal Disclaimers: A Growing Concern in Patent Practice (May 10, 2024), [USPTO%20data%20from%20the%20last,the%20prior%20trend%20in%202023](https://patentlyo.com/patent/2024/05/terminal-disclaimers-practice.html#:~:text=USPTO%20data%20from%20the%20last,the%20prior%20trend%20in%202023) (last accessed Oct. 11, 2024).

[4] *Id.* at 1231 ("A terminal disclaimer is not an escape hatch to be deployed after a patent expires."); *Boehringer Ingelheim Intern. GmbH v. Barr Labs., Inc.*, 592 F.3d 1340, 1348 (Fed. Cir. 2010) ("The patentee cannot undo this unjustified timewise extension by retroactively disclaiming the term of the later patent because it has already enjoyed rights that it seeks to disclaim").

[5] *Boehringer*, 592 F.3d at 1347 ("a patentee may file a disclaimer after issuance of the challenged patent or during litigation, even after a finding that the challenged patent is invalid for obviousness-type double patenting.").

[6] See e.g. *Motionless Keyboard Co. v. Microsoft Corp.*, 486 F.3d 1376, 1385 (Fed. Cir. 2007).

[7] *Geneva Pharm., Inc. v. GlaxoSmithKline PLC*, 349 F. 3d 1373, 1378 (Fed. Cir. 2003).

[8] *Gerber Garment Tech., Inc. v. Lectra Sys., Inc.*, 916 F.2d 683, 688 (Fed. Cir. 1990).

[9] *Allergan USA Inc. v. MSN Labs. Private Ltd.*, 111 F.4th 1358, 1369 (Fed. Cir. 2024).

[10] See e.g. *Amgen v. Roche*, 580 F.3d 1340, 1354 (Fed. Cir. 2009) ("Because the ... applications were filed as continuation applications instead of divisional applications, we hold that the [resulting] patents do not receive the protections afforded by § 121's safe harbor.").

[11] *In re Collect*, 81 F.4th at 1226.

[12] *Id.* at 1229.

[13] *Gilead Sciences., Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1212 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 1530 (2015).

[14] See *In re Collect*, 81 F.4th at 1231 ("The examiner's willingness to issue ODP rejections of claims in other Collect-owned patent applications but not in the challenged

patents and his knowledge of the reference patents do not affirmatively indicate tha the considered ODP here.")