

# ANTI-SELF-COLLISION AND DOUBLE PATENTING IN THE UNITED STATES

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# U.S. System Overview

- “anti-self-collision” system excludes applicant’s own earlier filed patent application from prior art (unless the published version otherwise qualifies as prior art)
- “double patenting” prohibits one applicant/owner from obtaining more than one patent for either:
  - “same invention” (i.e. patent claims have identical scope in each of application and earlier patent)<sup>1</sup>; or
  - obvious modification of the same invention, i.e. **“obviousness-type double patenting”**<sup>2</sup> (patent claims need not overlap)



# U.S. System Overview (cont.)

- Double Patenting issue can arise between two or more patent applications if one or more of:
  - common inventor
    - need only one common inventor, but may have none
    - may have common inventor but two different owners<sup>3</sup>
  - common applicant
  - commonly owned/assigned
    - should be 100% common ownership (not partial ownership)<sup>4</sup>
    - if no common inventor/applicant, applications must have common ownership initially (i.e. by filing dates), but not later after acquiring applications/patents later



# U.S. System Overview (cont.)

- America Invents Act (AIA) became effective in 2013 and included expansion of scope of “secret prior art” (i.e. patent applications effective as prior art as of the filing date, long before the publication date)
- AIA **secret prior art** includes<sup>5</sup>:
  - all U.S. applications
  - all non-U.S. applications tied to a child application filed in the U.S. (Paris route)
  - all non-U.S. applications tied to a PCT application that designated U.S. (i.e. no national phase entry in U.S. required)
- AIA secret prior art used for novelty **and** **inventive step**



# When Does Prior Application Become “Prior Art”?

- File 1<sup>st</sup> application claiming A, B & C
- File 2<sup>nd</sup> Continuation-In-Part (CIP) appln (same inventors and owner) claiming A, B, C & D (new element) less than one year after 1<sup>st</sup> appln published
  - 1<sup>st</sup> appln is not prior art, but priority date of patent claim is 2<sup>nd</sup> appln filing date w.r.t. prior art
- File 2<sup>nd</sup> CIP appln (same as above) more than one year after 1<sup>st</sup> appln published
  - 1<sup>st</sup> appln constitutes “prior art” against 2<sup>nd</sup> appln



# Obviousness-Type Double Patenting (ODP)

- ODP purposes:
  - prevent extension of patent term by prohibiting grant of claims in later-filed application (or 2<sup>nd</sup> patent) if claims are not “patentably distinct” from first patent claims
  - prohibits claims in later-filed application/2<sup>nd</sup> patent if claims define “merely an obvious variation” of first patent claims<sup>6</sup>
- ODP analysis:
  - compare claims of later-filed application/2<sup>nd</sup> patent to claims of first patent in “light of prior art”, i.e. cannot use remaining specification disclosure of first patent
  - determine whether claims of application/2<sup>nd</sup> patent are patentably distinct over claims of first patent based on U.S. obviousness (inventive step) standard (i.e. treat first patent claims as hypothetical prior art) → “one-way obviousness”<sup>7</sup>



# Terminal Disclaimers

- Applicant/Patent Owner can file a Terminal Disclaimer<sup>8</sup> (TD) to remove an ODP issue
- TD requirements:
  - term of patent in which TD is filed cannot extend past term of other patent involved in ODP
  - patents under TD must all be owned by same entity in order to be enforceable
- TD purposes:
  - prevent extension of patent term for obvious modification of invention claimed in earlier patent
  - prevent harassment by multiple owners of patents claiming inventions that are not patentably distinct from each other



# Unity/Restriction Requirement Effect on ODP

- IF US Patent Examiner makes a Unity or Restriction Requirement, e.g. Group I claims 1-5 (product/device) are “patentably distinct” from Group II claims 6-10 (method of use of product/device), THEN Applicant must elect Group I or II
- AND Applicant has the option to cancel the non-elected group, say Group II claims, and submit these claims in a Divisional Application wherein the claims will have impunity against any ODP issue (provided claims remain consonant with U/R Requirement)<sup>9</sup>



# Strategies for ODP Issues

## ODP Rejection in Application at USPTO

- cancel affected claims
- argue against rejection
  - elements in first patent claims fail to suggest a new/modified element in 2<sup>nd</sup> application claims
  - Examiner cannot use patent specification disclosure
- if Unity/Restriction Requirement applies, point this out



# Strategies for ODP Issues (cont.)

ODP issues in 2<sup>nd</sup> Patent about to be enforced:

- can always file a TD in the USPTO before enforcement, but will very likely lose patent term
- if cannot lose patent term, be prepared to argue against ODP
  - Court of Appeals for Federal Circuit appears to favor an interpretation of ODP that is against the patent owner's interest
  - see *Gilhead Sciences v. Natco Pharma*, 110 USPQ2d 1551 (Fed. Cir. 2014)



# Other ODP Situations

- If later-filed improvement patent grants before earlier-filed basic application, then Examiner must show “two-way obviousness” to support ODP rejection<sup>10</sup>
- ODP can arise if same inventor group of first basic patent moves to second company and invents improvement for application owned by second company<sup>11</sup>
  - TD cannot remove ODP since no common ownership



# Patent Thickets and Terminal Disclaimers

- U.S. system (like Canada and Japan) employs anti-self-collision (A-S-C), as opposed to EPC self-collision
- A-S-C systems create a “safe harbor” for the 1<sup>st</sup> applicant to protect incremental improvements, potentially creating a “patent thicket”
- U.S. also allows for a Terminal Disclaimer (TD) which prevents term extension of the thicket patents
- EPC system “novelty only” approach thins out the thicket, but can allow for incremental improvements by all applicants up to 18 months after the filing date of the 1<sup>st</sup> application (a form of term extension)





# QUESTIONS?

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# Notes

1. 35 U.S.C. (United States Code) 101
2. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 USPQ2d 1839 (Fed. Cir. 1992)
3. *In re Hubbell*, 106 USPQ2d 1032 (Fed. Cir. 2013)
4. *Ex parte Brookhart*, No. 2005-2463, 2005 Pat. App. LEXIS 2485 (BPAI Sept. 19, 2005)
5. 35 U.S.C. 102(d) (AIA)
6. *In re Braat*, 19 USP'Q2d 1289 (Fed. Cir. 1991)



# Notes (cont.)

7. *Ortho Pharm. Corp. v. Smith*, 22 USPQ2d 1119 (Fed. Cir. 1992)
8. 35 U.S.C. 253
9. *Gerber Garment Tech. v. Lectra Sys. Inc.*, 16 USPQ2d 1436 (Fed. Cir. 1990)
10. *In re Emert*, 44 USPQ2d 1149 (Fed. Cir. 1997)
11. *In re Hubbell, supra*