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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte NICOLAS BAURIN, CHRISTIAN BEIL, CARSTEN CORVEY, CHRISTIAN LANGE, DANXI LI, VINCENT MIKOL, ANKE STEINMETZ, and ERCOLE RAO

Appeal 2024-002920
Application 17/135,529
Technology Center 1600

Before DONALD E. ADAMS, JOHN E. SCHNEIDER, and RACHEL H. TOWNSEND, *Administrative Patent Judges.*[1]

Opinion for the Board filed by Administrative Patent Judge TOWNSEND.

Opinion Dissenting filed by Administrative Patent Judge ADAMS

TOWNSEND, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

The Examiner filed a Request for Rehearing (Req.) under MPEP § 1214.04, requesting that we reconsider our Decision of November 8, 2024, where we reversed the Examiner's numerous rejections of the claims pending on appeal for non-statutory double patenting, also known as

[1] Former Administrative Judge Eric B. Grimes participated in the original decision, but is not available for the rehearing decision. Administrative Judge Donald E. Adams has replaced Judge Grimes on the panel.

obviousness-type double patenting (ODP).[2] We have reconsidered our Decision in light of the Examiner's arguments, and are not persuaded that we misapprehended the law or overlooked arguments presented by the Examiner.

We DENY the Examiner's requested relief.

ANALYSIS

A request for rehearing is limited to matters overlooked or misapprehended by the Panel in rendering the original decision. *See* 37 C.F.R. § 41.52; *see also Ex parte Quist*, 95 USPQ2d 1140, 1141 (BPAI 2010) (precedential) (quoting Manual of Patent Examining Procedure (MPEP) § 1214.03). It may not rehash arguments originally made in the briefs on Appeal, neither is it an opportunity to merely express disagreement with a decision. The proper course for one dissatisfied with a Board decision is to seek judicial review, not to file a request for rehearing to reargue issues that have already been decided. *See* 35 U.S.C. §§ 141, 145. The Examiner

[2] There were six rejections in all and they involved the following reference patents or patent applications: US Patent 10,882,922, US Patent 11,186,649, US Patent 11,530,268, US Patent 11,613,576, US Patent 11,192,960, and US Patent Application 18/183,107, which has since issued as US Patent 12,227,573 on February 18, 2025. (Decision 3–4.) Our Decision focused on the rejection of claims 1–18 for non-statutory double patenting over US Patent 10,882,922 in view of US 2009/0162359, noting that the same determinative issue was present with respect to all of the rejections. (*Id.* at 4.) The Examiner's request likewise limits its arguments to that rejection, but asks "that the five nonstatutory double patenting rejections and the provisional nonstatutory double patenting rejection under review be sustained." (Req. 13.) We note that some of the reference patents, besides being commonly owned, share some of the same inventors as the application on appeal, but others have no overlap of inventors.

requests rehearing stating that the decision misapprehends the holding of *Allergan USA, Inc. v. MSN Laboratories Private Ltd.*, 111 F.4th 1358 (Fed. Cir. 2024) ("*Allergan*") (Req. 2–5), the decision is not consistent with USPTO guidance in MPEP §§ 804 and 804.02, (Req. 6–9), and the conclusion "that the risk of separate ownership is 'immaterial' is not supported by case law or USPTO guidance." (Req. 10–12).

We address each of these arguments in turn.

I. The Examiner's Allergan argument

The Examiner contends that we misapprehended the holding in *Allergan* because the case is limited to an ODP analysis which takes into consideration only the actual filing dates of the alleged reference patent and the patent or patent application at issue to determine what patent is the first patent of the patent family. (Req at 3.)

As the Examiner recognizes (Req. 1–2), and Appellant notes (Resp.[3]2), our decision relied on the *reasoning* in *Allergan*. Decision 9. We agree with Appellant, that "the Examiner at no point in the Request for Rehearing discusses the ***reasoning*** in Allergan, let alone provides a reason why the Decision is inconsistent with the reasoning underlying the holding in Allergan." (*Id.* at 4.)

And in any event, as to the Examiner's argument regarding effective filing dates versus actual filing dates, we note that our reviewing court in *Allergan* made clear that both effective filing dates and expiration dates are to be considered in determining whether claims are proper reference patents.

[3] We refer to Appellant's Response to Request for Rehearing by Examiner Under M.P.E.P. § 1214.04, filed January 29, 2025.

The court recognized that with post-URAA[4] patents, such as those filed in that case, "a patent's term is now measured from its effective filing, or priority, date, *i.e.*, the earlier of (1) the filing date of the application and (2) the filing date of an application from which the patent claims priority. 35 U.S.C. § 154(a)(2)." *Allergan*, 111 F.4th at 1367.[5] The court noted that

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[4] URAA stands for the Uruguay Round Agreements Act of 1994, Pub. L. No. 103-465, 108 Stat. 4809. The URAA

> changed how patent terms were determined. Instead of measuring from issuance date, a patent's term is now measured from its effective filing, or priority, date, *i.e.*, the earlier of (1) the filing date of the application and (2) the filing date of an application from which the patent claims priority. 35 U.S.C. § 154(a)(2).

Allergan, 111 F.4th 1367.

[5] That is not surprising as both *Abbvie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Tr.*, 764 F.3d 1366 (Fed. Cir. 2014) and *In re Cellect, LLC*, 81 F.4th 1216 (Fed. Cir. 2023), two cases referenced in *Allergan*, noted the same. In *Abbvie*, our reviewing court stated:

> So too where, as here, the applicant chooses to file separate applications for overlapping subject matter and to claim different priority dates for the applications, the separate patents will have different expiration dates since the patent term is measured from the claimed priority date. . . . We now make explicit what was implicit in *Gilead [Scis., Inc. v. Natco Pharma Ltd.,* 753 F.3d 1208, 1215–17 (Fed. Cir. 2014)] *:* the doctrine of obviousness-type double patenting continues to apply where two patents that claim the same invention have different expiration dates.

Abbvie, 764 F3d. at 1373–74. In *Cellect*, our reviewing court stated:

> Here, we have related patents that claim priority from the same application that, as conceded by Cellect, claim overlapping subject matter and that have different expiration dates only because of PTA[, Patent Term Adjustment for USPTO delay during prosecution under 35 U.S.C. § 154(b)]. Thus, under *AbbVie,* ODP still applies to ensure that the applicant is not receiving an unjust extension of time.

Cellect, 81 F.4th at 1229.

because of that, "there is little risk of an unjustified extension of term subject to ODP because all patents to an invention that share a priority date are expected to expire on the same day." *Id.* But the court recognized that because of the Patent Term Guarantee Act of 1999[6] and the potential for extended expiration dates beyond 20 years from the effective filing date due to patent office delay in examining patents, one has to also look at expiration dates, as well as effective filing dates, when considering patentably indistinct inventions to determine if a claim can properly serve as an ODP reference. *Id.* at 1367–1368. In applying the foregoing to the facts of the case before them, the court made clear that both effective filing dates and expiration dates matter in determining whether claims are proper reference patents, noting that the '356[7] patent's expiration due to PTA[8] was the only reason it would have expired later than the claims of the '011 and '709 patents[9] that shared a common filing date. *Id.* at 1363, 1368–69. Thus, in contrast to the Examiner's suggestion, the *Allergan* court in looking at what claims were "first-filed," did not ignore the effective filing dates in favor of actual filing dates; it took note of both the effective filing dates and the expiration dates to determine if certain claims could serve as reference patents.

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[6] Pub. L. No. 106-113, § 4402, 113 Stat. 1501, 1501A-557 (codified as amended at 35 U.S.C. § 154(b)).
[7] U.S. Patent 7,741,356, the patent alleged to be invalid under ODP. *Allergan*, 111 F.4th at 1362.
[8] PTA stands for patent term adjustment pursuant to 35 U.S.C. § 154(b) for USPTO delay during prosecution of a patent application to issuance.
[9] U.S. Patents 8,344,011 and 8,609,709, the asserted reference patents. Allergan, 111 F.4th at 1363, 1365.

We also disagree with the Examiner that the *Allergan* decision is only applicable to first-issued patents in a patent family. The case law is clear that an ODP analysis seeks to determine whether a reference patent is claiming a patentably indistinct invention from the patent-at-issue and is extending or prolonging a monopoly on the invention claimed in the non-reference patent, irrespective of their position as a first patent ever in a patent family. As the court in *Abbvie* explained, a "crucial purpose of the doctrine [of ODP]: It is designed to prevent an inventor from securing a second, later expiring patent for the same invention. *See Miller[v. Eagle Mfg. Co.]*, 151 U.S. [186,] 197–98 [(1894)]; *Singer [Mfg. Co. v. June Mfg. Co.]*, 163 U.S. [169,] 185 [1896]." *Abbvie*, 764 F.3d at 1373. Similarly, the court in *Gilead Sciences, Inc. v. Natco Pharma Limited*, 753 F.3d 1208 (Fed. Cir. 2014) stated:

> it is a bedrock principle of our patent system that when a patent expires, the public is free to use not only the same invention claimed in the expired patent but also obvious or patentably indistinct modifications of that invention. *See* discussion *supra*.
> . . .
> And that principle is violated when a patent expires and the public is nevertheless barred from practicing obvious modifications of the invention claimed in that patent because the inventor holds another later-expiring patent with claims for obvious modifications of the .invention

Gilead, 753 F.3d at 1214. *Allergan* did not change the law in that regard. Indeed, the court in *Allergan* expressly noted that

> The doctrine's primary goal is to prevent an unjustified timewise extension of patent exclusivity beyond the life of *a* patent. That goal is grounded in the principle that:
>
> > [t]he public should ... be able to act on the assumption that upon expiration of the patent it will be free to use not only the invention claimed in the patent but also any modifications or variants

> thereof which would have been obvious to those of ordinary skill in the art at the time the invention was made, taking into account the skill of the art and prior art other than the invention claimed in the issued patent.
>
> *In re Zickendraht,* 319 F.2d 225, 232 (CCPA 1963) (Rich, J., concurring).

Allergan, 111 F.4th at 1367 (emphasis added). The court then applied that fundamental purpose to the undisputed facts in that case; namely,

> The '356 patent is undoubtedly the "first" patent to cover eluxadoline, whether we measure by filing date or by issuance date. And each of the '011 and '709 patents is unquestionably "second" to that patent[.]

Id. at1369. The court then explained that

> the claims of the '356 patent do not "extend or prolong the monopoly [on eluxadoline] beyond the period allowed by law," *Miller,* 151 U.S. at 198, and therefore are not subject to ODP over the '011 and '709 patents. Put otherwise, the fact that the '356 patent expires later is of no consequence here because it is not a "*second,* later expiring patent for the same invention." *Abbvie,* 764 F.3d at 1373(emphasis added).

Id. Thus, whether or not the '356 patent was the first in the eluxadoline patent family, was not dispositive: what mattered was whether the reference patents were, with respect to time, claiming patentably indistinct subject matter from a first filed patent to that subject matter, and if so, whether, with respect to time, the reference patents were second filed patents that were effectively extending the life of the first filed patent to that subject matter. As the court stated:

> Here, we conclude that the claims of the '011 and '709 reference patents are not proper ODP references that can be used to invalidate claim 40 of the '356 patent. That is the only conclusion consistent with the purpose of the ODP doctrine, which is to prevent patentees from obtaining a *second* patent on

> a patentably indistinct invention to effectively extend the life of a *first* patent to that subject matter.

Id.

In this case, the Examiner does not dispute that the application at issue here was published well before the earliest effective filing date of the reference patent, the '922 patent. Moreover, the Examiner "acknowledged that the claims of the later-filed now issued patents were non-obvious over the instant disclosure and could not have been presented in the instant application." (Decision at 9 (quoting from Ans. 12).) In short, the reference patent claims are necessarily to a patentably distinct invention from the application at issue and stem from later filed patent applications to inventions that could not be claimed in the patent application at issue.

The Examiner also urges that the fact that the patents at issue in *Allergan* had a common priority date, somehow, precludes our reliance on the reasoning in *Allergan*. We disagree. It is certainly true that in *Allergan* it was undisputed that the applications had a common priority date. However, it is clear that the court recognized other filing date scenarios could exist that might result in an unjustified timewise extension of patent exclusivity, as it cited to and distinguished the facts of *Gilead*. *Allergan*, 111 F.4th at 1370. In particular, the *Allergan* court stated:

> Unlike here, the challenged claims of the asserted patent in *Gilead* were filed after, claimed a later priority date than, *and* expired after the reference claims, which resulted in an unwarranted extension of patent term for an invention that had already been the subject of an earlier-filed, earlier-expiring claim.

Id. The court explained that the cases were different because unlike in *Gilead*, claim 40 of the '356 patent claim, which was not a second claim in terms of effective filing date, "did not *extend* any period of exclusivity on

the claimed subject matter." *Id.* Based on the foregoing, the court's reasoning, which we relied upon to reach our conclusion in this case, i.e., preventing an unwarranted extension of patent term for a first-filed invention, cannot be said to be limited to situations in which the alleged reference patent claims and the claims at issue have a common priority date.

In our opinion, we acknowledged that there were factual differences between *Allergan* and the case before us. What we found compelling was the Federal Circuit's position that the fundamental purpose of the nonstatutory double patenting doctrine is preventing patentees from obtaining a second filed patent on a patentably indistinct invention to effectively extend the life of a first filed patent to that subject matter. (Decision at 9.) As Appellant noted:

> the Board found that each of the asserted references is a later-filed patent *(i.e.,* has a later patent term filing date relative to the application at issue) having claims that are patentably distinct from the claims of the instant application - and relate, therefore, to distinct inventions:
>
> > The application at issue here was filed before the application leading to the '922 patent, and was published well before the earliest effective filing date of the '922 patent. (Appeal Br. 15–16.) The Examiner allowed the claims of the '922 patent over this publication, thus determining that the '922 claims are not obvious from that disclosure. (*Id.* at 16; see also Ans. 12 ("It is acknowledged that the claims of the later-filed now issued patents were non-obvious over the instant disclosure and could not have been presented in the instant application.").) In other words, the claims at issue would be a first patent to cover the antibody-like binding protein comprising two polypeptide chains that form two antigen binding sites, wherein a first polypeptide chain comprises the structure VL1-Ll-VL2-L2-CL, and a second polypeptide chain comprises the structure VH2-

> L3-VH1-L4-CH1 as claimed. It is not a second, later expiring patent for the same invention as the '922 patent, and as such does not extend a period of exclusivity on the claimed subject matter.
>
> Decision, pages 9–10.

(Resp. 3.) The Examiner's request for rehearing based on *Allergan* is simply a disagreement with our conclusion that the reasoning of that decision is compelling with respect to the appealed rejection. That is not a proper basis to request rehearing; the proper course for one dissatisfied with a Board decision is to seek judicial review. *See* 35 U.S.C. §§ 141, 145.[10]

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[10] The Examiner urges us to compare the facts to the decision in "*In re Hubbell*, 709 F.3d 1140 (Fed. Cir. 2013) where the Federal Circuit upheld a nonstatutory double patenting rejection over a reference patent made during examination of an ordinary application." (Req. 5.) Not only is that request an improper new argument because that case, which is not a recent relevant decision from our reviewing court, was not raised in the Examiner's briefing to us in the original appeal, *see* M.P.E.P. § 1214.04 ("Arguments not raised in the answers before the Board and evidence not previously relied upon in the answers are not permitted in the request for rehearing except that the examiner may present a new argument based upon a recent relevant decision of either the Board or a Federal Court."), whatever the factual situation was regarding the filing dates and issue dates of the application on appeal and the reference patent in *Hubbell* is simply immaterial to our decision here. That is because the *Hubbell* court was only asked to address "whether obviousness-type double patenting applies where an application and a conflicting patent have one or more inventors in common but the inventive entities are not identical and the applications were never commonly owned." *Hubbell*, 709 F.3d at 1146. Therefore, under the principle of party presentation, *see Allergan*, 111 F.4th 1369 fn 6, the court did not consider the question of whether the USPTO's reliance on a particular patent as a reference patent for the ODP rejection was appropriate. Thus, *Hubble* "does not address, let alone resolve any variation of the question presented here. *Id.* (explaining that the district court erred in finding itself bound by the decision in *Cellect* because *Cellect* did not address or resolve under what circumstances a claim

II. The Examiner's MPEP §§ 804 and 804.02 arguments

The Examiner argues that the decision is not consistent with USPTO guidance in MPEP § 804 "which does not instruct examiners to compare filing dates and expiration dates, as a threshold question." (Req. 6.) Even if true, as Appellant indicated in the Response (Resp. 5), we must decide cases in accordance with the law, just as our reviewing court must. *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1291 (Fed. Cir. 2015) ("[w]e are bound by prior Federal Circuit precedent unless relieved of that obligation by an en banc order of the court or a decision of the Supreme Court.") The MPEP foreword states that, the MPEP is a guidance document for reference regarding practice and procedure relative to patent prosecution and other proceedings before the USPTO and "does not have the force and effect of law or the force of the rules in Title 37 of the Code of Federal Regulation." MPEP Foreword. The MPEP cannot create new law or ignore the law. *See, e.g., id.* at Introduction: Rules ("The USPTO is authorized by statute, subject to the policy direction of the Secretary of Commerce, to establish regulations, *not inconsistent with law*, for the conduct of proceedings in the USPTO.") (emphasis added).

The Federal Circuit has made clear that in making a rejection based on ODP, not only must a determination of whether claims are patentably indistinct be made, but a determination of whether the reference claims are "proper ODP reference" claims needs to also be made. *Allergan*, 111 F.4th at 1369. And for the reasons discussed in the Decision and reiterated above,

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can properly serve as an ODP reference, "and therefore has little to say on the precise issue before us.").

this latter determination requires looking at effective filing dates and expiration dates.

As Appellant noted, determining expiration dates is not inconsistent with USPTO guidance in this regard. (Resp. 7.) As Appellant noted MPEP § 1701, which refers to an employee of the USPTO refusing to express any opinion as to the expiration date of any patent, specifically states that the refusal must give way "to the extent necessary to carry out (A) an examination of a non-reissue patent application where determination of the expiration date of a patent is necessary to conduct examination of the non-reissue patent application." MPEP § 1707.

Moreover, as Appellant also noted (Resp. 7), MPEP § 804 expressly states that "[when] the inventor/applicant/patent owner has already secured the issuance of a first patent, the examiner must determine whether the grant of a second patent would give rise to an unjustified extension of the rights granted in the first patent." MPEP § 804. As discussed above, the question is whether there is an unjustified term extension of the rights granted in the first patent. As discussed above, determining the term requires a comparison of expiration dates as well as filing dates.

Our decision is not asking examiners to be gatekeepers for an unknown scenario. In this case, we note that PTA cannot extend the patent term for the application at issue because terminal disclaimers have been filed such that the expiration date of the pending claims cannot extend beyond March 28, 2032. PTA cannot extend patent term beyond a terminal disclaimer's stated date. *See Merck & Co., Inc. v. Hi-tech Pharmacal Co., Inc.*, 482 F.3d 1317, 1322 (Fed. Cir. 2007) ("§ 154(b)(2)(B) expressly

excludes patents in which a terminal disclaimer was filed from the benefit of a term adjustment for PTO delays.").

The Examiner notes that "terminal disclaimers do not take effect until the patent is granted and USPTO guidance permits withdrawal of a terminal disclaimer before patent grand under appropriate circumstances." (Req. 8.) Thus, the Examiner urges that it is not necessarily the case that the application at issue will expire before the '922 patent, "[i]f the Appellant were to withdraw the two terminal disclaimers filed in the instant application." (*Id.*) We do not find the Examiner's hypothetical persuasive. As Appellant explains, withdrawing a terminal disclaimer is only possible "if the claims at issue are 'canceled or otherwise shown to be patentably distinct from the reference claims,' see M.P.E.P. § 804.02, in which case any double patenting issue would be rendered moot." (Resp. 8.) Moreover, as Appellant also points out the "M.P.E.P. § 14[90] states that '[p]etitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer ***have not been favorably considered.*** ' (Emphasis added)." (*Id.*; MPEP § 1490 VIII.)[11]

In general, we note that although exact expiration dates may not be able to be determined for a pending application because PTE[12] and PTA

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[11] As Appellant also notes, the Examiner has not provided any evidence of an instance where an applicant has relied on a terminal disclaimer to obviate an ODP rejection "only to later have that terminal disclaimer withdrawn." (Resp. 9 fn 6.)

[12] PTE stands for patent term extension for delays in FDA approval under 35 U.S.C. § 156. "Section 156 allows a term extension of up to five years, equal to the regulatory review period, on a patent covering a product subject to regulatory review. *See* 35 U.S.C. §§ 156(a), (c), (g)(6)" *Novartis AG v. Ezra*

might be awarded after substantive prosecution before the Examiner is closed, an examiner can determine the apparent expiration date, the statutory term provided for by 35 U.S.C. § 154 (a)(2)[13], i.e., 20 years from the earliest effective filing date, shortened by any terminal disclaimer in the file, such as in this case. In a similar manner, the examiner can determine the apparent statutory term of a potential reference patent. Thus, the examiner can make a preliminary determination of whether the potential reference patent's term would be extended by the issuance of the application under examination, taking into consideration any terminal disclaimers that may have been filed in that potential reference patent.[14] Where the potential reference patent has

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Ventures LLC, 909 F.3d 1367, 1369 (Fed. Cir. 2018). The court in *Novartis* explained that

> A patent owner often owns multiple patents that cover the same product that has been subject to regulatory review, *but only one patent's term can be extended*. *See* 35 U.S.C. § 156(c)(4). The patent owner makes a choice among its qualifying patents.

Id. (emphasis added). The patent owner must file an application with the USPTO for this statutory change of the patent's term under 35 U.S.C. 154(a). 35 U.S.C. § 156(d). The conditions for approval are provided in 35 US.C. § 156. If approved, a "certificate of extension [is] 'recorded in the official file of the patent and ... considered as part of the original patent.' 35 U.S.C. § 156(e)(1)." *Id.* at 1373.

[13] "Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, 365(c), or 386(c), from the date on which the earliest such application was filed." 35 U.S.C. § 154(a)(2).

[14] An Examiner is able to determine if a terminal disclaimer has been filed by the asterisk on the cover page of the patent next to the Date of Patent and the notification below the Inventors and Assignee that states "Notice: The portion of the term of this patent subsequent to [date] has been disclaimed."

a later effective filing date than the application at issue, and is filed post-URAA, as is the case here, the answer will be no. If those determinations are altered because the patentee is granted PTA or PTE after substantive prosecution is over, the onus should rest with the patentee to voluntarily file a terminal disclaimer prior to the expiration of the patent, *see Cellect*, 81 F.4th at 1226, if they want to avoid a litigation based ODP challenge that could potentially invalidate any issued patent. *See Allergan*, 111 F. 4th at 1368 (noting that a terminal disclaimer can be filed voluntarily by a patentee or applicant). Applicants should be aware of their patent portfolio, especially regarding patents having a common inventor or the same inventive entity.

Furthermore, there is no conflict with MPEP § 804.02 IV, as urged by the Examiner (Req. 9). That section simply states that "**if** multiple conflicting patents and/or pending applications are applied in nonstatutory double patenting rejections made in a single application, then prior to issuance of that application, it is necessary to disclaim the terminal part of any patent granted on the application which would extend beyond the expiration date of each one of the conflicting patents and/or applications." MPEP § 804.02 IV. This section of the MPEP does not contemplate what "conflicting patents and/or pending applications" are. It is true that this section of the MPEP indicates that the terminal disclaimer must include each of the commonly owned conflicting nonstatutory double patenting references to avoid the problem of dual ownership. *Id.* However, it should not be read to stand for the fact that preventing dual ownership alone is justification for applying a commonly owned application or patent as a reference against application claims, just that when an ODP rejection is properly made, a terminal disclaimer is only effective when it includes each

of the commonly owned conflicting nonstatutory double patenting references. We address cases that mention harassment as a purpose for ODP in section III below.

MPEP § 804.02 VI also does not provide for preventing harassment by common owners of patents or patent applications as a basis for obviousness-type double patenting. (Req. 11.) Rather, it states that harassment is one of two reasons "for insisting upon a terminal disclaimer to *overcome* a nonstatutory double patenting rejection." MPEP § 804.02 VI (emphasis added). In other words, a nonstatutory double patenting rejection must have a proper reference patent applied in the first instance, and then to overcome the rejection, the terminal disclaimer for that properly applied commonly owned reference patent has to have a statement that "any patent granted on the application being examined will be enforceable only for and during the period that it and the reference patent or any patent granted on the reference application are commonly owned." *Id.* As MPEP § 804.02 VI explains, by including such a phrase, the terminal disclaimer prevents harassment for a patent that was properly subject to nonstatutory double patenting.

III. The Examiner's immateriality of the risk of separate ownership argument

According to the Examiner, we misread *In re Cellect* (Req. 10) to mistakenly conclude that "the risk of separate ownership is immaterial where the '922 patent is not a proper nonstatutory double patenting reference." (Dec. 10 fn 6.) According to the Examiner, "*Cellect* expressly identified the risk of separate ownership as a reason to *uphold* the double patenting rejections." (Req. 11) We do not agree. Cellect had argued to the court that there is no risk of divided ownership of the patentably indistinct

inventions because it "has not engaged in actions that resulted in divided ownership in the past, and it has promised that it will not do so in the future." *Cellect*, 81 F.4th at 1230. In rebutting that argument, the court stated: "Promises do not substitute for sound applications of rules of law," and noted that unlike a terminal disclaimer which "ensure[s] common ownership," the promise and historical action fail "to abrogate the potential future risk of multiple owners or assignees." *Cellect*, 81 F.4th at 1230. For these reasons, the court determined that the Board did not err in determining equitable concerns of "a risk of separate ownership existed." *Id.* The court did not, as the Examiner suggests, hold that the risk of separate ownership is a policy reason sufficient in and of itself to support an ODP rejection irrespective of whether the references are proper ODP references.

The Examiner further suggests that *In re Hubbell* supports a conclusion that the risk of separate ownership as "the basis for making a nonstatutory double patenting rejection" (Req. 11.) We do not agree. In *Hubbell*, there was no dispute that the reference patent, which was filed post-URAA, was filed prior to the application at issue. *Hubbell*, 709 F.3d 1140, 1142–43 (Fed. Cir. 2013) Moreover, there was no dispute that the claim of the reference patent was a species of the invention claimed in the application. *Id.* at 1145 ("On appeal, Hubbell does not dispute that Claim 1 of the '685 patent anticipates representative Claim 18 of the '509 application.). Thus, there can be no dispute that the issuance of genus claim of the application would extend the term of the reference patent species claim. The only dispute was whether an ODP rejection could issue "where an application and a conflicting patent have one or more inventors in common but the inventive entities are not identical and the applications were

never commonly owned." *Hubbell*, 709 F.3d at 1146. It was with this factual foundation that the court discussed the harassment issue that could arise from separate ownership, with overlapping inventorship to admittedly patentably indistinct inventions. *Hubbell* did not hold, because it was not an issue in the case, that the risk of separate ownership is a singular basis for making a nonstatutory double patenting rejection. *Accord Allergan*, 111 F.4th at 1369 fn 6 (explaining that the district court erred in finding itself bound by the decision in *Cellect* because *Cellect* did not address or resolve under what circumstances a claim can properly serve as an ODP reference, "and therefore has little to say on the precise issue before us.").

As our reviewing court recently explained, it would be error for us to find ourselves bound by a decision that did not address or resolve under what circumstances, with respect to filing dates and expiration dates, a claim can properly serve as an ODP reference. *Allergan*, 111 F.4th at 1369 fn 6. To the extent that any of the cases cited by the Examiner made reference to a policy regarding identifying the risk of separate ownership in their decisions, none hold that it is **the** basis for making a nonstatutory double patenting rejection and requiring a terminal disclaimer to overcome the rejection, much less in a situation where a reference patent is filed later than and expires later than the application to which it is applied against.

In *In re Van Ornum*, (Req. 11 fn 34), there was no dispute as to whether a reference was a "proper" reference patent. In *Van Ornum*, the appellant was admittedly seeking broader generic claims in a continuing application and during prosecution had filed a terminal disclaimer seeking to overcome a double patenting rejection. *Van Ornum*, 686 F.2d at 938–939. The examiner had "criticized" the first disclaimer "as not [being] in proper

form and a second one was filed." *Id.* However, that second one did not comply with paragraph (b) of 37 C.F.R. 1.321, requiring that a terminal disclaimer, when filed, "must include a provision that any patent granted on that application shall be enforceable only for and during *such period that said patent is commonly owned with the application or patent* which formed the basis for the rejection." *Id.* at 939. The appellant could not comply with paragraph (b) because one of the reference patents issued to General Motors Corporation as the result of an assignment, whereas the application on appeal (as well as the one from which it was filed as a voluntary divisional, which was another reference patent (the '799 patent)) had been assigned to Rocket Research Corporation. *Id.* at 940, 944.

On appeal, the Federal Circuit was tasked with (1) determining whether it was appropriate for the USPTO to reject in the *voluntarily filed divisional* application the claimed generic subject matter for double patenting over the admittedly narrower subject matter claimed in the reference patents, *id.* at 942–44, and if so, (2) determining whether the regulation regarding terminal disclaimers to overcome an ODP rejection, 37 C.F.R. § 1.321(b), which requires that the terminal disclaimer have the enforceability period tied to a nonalienation requirement was a valid regulation, *id.* at 944 ("Since appellants cannot comply with the regulation, they have, perforce, taken the only course left open to them short of surrender and challenge the validity of the regulation."), *see also id.* at 945.

As to the first issue the court held:

> the double patenting rejection of the appealed claims was fully justified. Appellants, in the course of expanding their first application to disclose enough more by way of details, alternatives, and additional uses to *support* the broad, dominating, "generic" *claims* here on appeal, have disclosed no

> additional *invention or discovery* other than what has already been *claimed* in patent '799, as above explained. There is a significant difference between justifying the broadening of claims and disclosing additional inventions.

Id. at 944. As to the second issue, the court determined that 37 C.F.R. § 1.321(b) was a valid regulation because "the drafters of the 1952 Patent Act provided a possible remedy [to the "serious obstacle" of the judge-made law of double patenting to bringing improvement inventions within the protection of the patent system while also giving an incentive for their disclosure] in the terminal disclaimer, 35 U.S.C. § 253" that was "merely permissive and it was left to the courts to work out its application on a case-by-case basis." *Id.* at 948. The court, after reviewing some prior cases, stated "we consider it desirable to tie both the termination and the ownership of the two patents together, as is required by § 1.321(b), and, seeing no substantial obstacle to doing so, hold it to be a valid regulation." *Id.*

Thus, while the court may have mentioned non-alienation in *Van Ornum*, it was not as **the** basis for making a nonstatutory double patenting rejection *ab initio*, but rather as a sound permissible manner when tied to the other provisions of a terminal disclaimer, to overcome a properly made obviousness-type double patenting rejection. On the other hand, the *Van Ornum* court recognized that the unjustified timewise extension of the right to exclude is "[t]he fundamental reason for the rule" against double patenting. *Id.* at 943.

Likewise, in *In re Fallaux*, 564 F.3d 1313 (Fed. Cir. 2009), (Req. 11 fn 34), there was no dispute before the court as to whether the reference patents were proper reference patents. Indeed, the court was clear on that point stating:

> Neither party raised or argued the question of whether a patent may be used as a reference for an obviousness-type double patenting rejection where the patent shares only a common inventor with the application, rather than an identical inventive entity or a common assignee. . . . This opinion should not be read to decide or endorse the PTO's view on this issue.

Id. at 1315 fn 1. The only issue the Federal Circuit was asked to address was whether it was appropriate for the USPTO in making the ODP rejection to apply the one way test rather than the two-way test. 564 F.3d at 1315–16 ("On appeal to the Board, Dr. Fallaux argued only that he was entitled to the two-way test. . . Dr. Fallaux timely appealed, arguing that he is entitled to rely on the two-way test."). The court found that it was appropriate to use the one way test because substantial evidence supported that "Dr. Fallaux was entirely responsible for the delay." *Id.* at 1316–17. The court in arriving at this conclusion also distinguished *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991), which the appellant argued was controlling. The court explained that the issue of fault was not raised, and no fact finding was made in that regard by the Board of Patent Appeals and Interferences (the "Board"). *Id.* at 1318. The court stated:

> Unlike this case, in *Braat* the PTO did not argue or dispute the issue of fault for delay, and the Board did not make a finding of fault for delay in issuance. . . Nor did the Board make any finding of fault.

Id. Because fault was not raised, the court concluded that

> *Braat* cannot be read as a sweeping proclamation that, as a matter of law, where an applicant *chooses* to delay filing an application until after the issuance of a reference patent, he can still rely on the two-way test to overcome a double patenting rejection, especially in the absence of any discussion or analysis of such in *Braat*.

Id.

In rebutting Fallaux's arguments that it was "not seeking an unjustified patent term extension," the court recognized that the unjustified patent term extension justification for ODP has limited force in this case. *Id.* at 1318. The court next conjectured that "[i]n some cases there may still be the possibility of an unjust time-wise extension of a patent arising from patent term adjustment under § 154 or patent term extension under § 156." *Id.*

The court also explained that appellant had allowed the reference patents to be assigned to a different entity than the application, and in so doing created the situation requiring the examiner to reject the terminal disclaimer filed during prosecution, as 37 C.F.R. § 1.321 requires common ownership. *Id.* at 1319 fn 5. The court indicated that because of this separate ownership and undisputed fact that the claims of the application were not patentably distinct from the reference patents "[t]he harassment justification for obviousness-type double patenting is particularly pertinent here." *Id.* Because it was not necessary to resolve the specific dispute before the court, this statement that there is a harassment justification for ODP is dicta at best. As our reviewing court said in *Van Ornum*: "Precedents are of value for what they decide, not for every sentence they contain." *Van Ornum*, 686 F.2d at 946.

Moreover, the cases the court in *Fallaux* cited for the proposition that harassment by multiple assignees "is a second justification for obviousness-type double patenting" (*id.* (citing *In re Van Ornum*, 686 F.3d 937 (CCPA 1982) and *In re Griswold*, 365 F.2d 834 (CCPA 1966)), do not stand for the proposition that it is a stand-alone justification. Indeed, as we noted above, the *Van Ornum* decision merely stands for the fact that tying both the

termination and the ownership of two patents together that are not patentably distinct was a sound permissible manner to provide for overcoming a properly made obviousness-type double patenting rejection. In *In re Griswold*, the court simply observed that the language in a terminal disclaimer that tied the termination and the ownership of two patents together that are not patentably distinct was "an imaginative solution to one of the more theoretical objections to double patenting, split ownership of two patents and potential harassment." *In re Griswold*, 365 F.2d 834, 840 fn5 (CCPA 1966).

While there may be a policy concern of risk of separate ownership underlying the non-alienation provision for terminal disclaimers, no court has held that risk of common ownership is a sole justification for upholding an ODP rejection that is not based on a proper reference patent.

In summary, we are not persuaded by the Examiner that the Board misapprehended the law or overlooked arguments and evidence in support thereof. We therefore deny the Examiner's Request and decline to modify our original Decision of November 8, 2024.

DECISION SUMMARY

Outcome of Decision on Rehearing:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/ Basis	Denied	Granted
1–18		Nonstatutory Double Patenting: US Patent 10,882,922, Klein	1–18	
1–4, 6–18		Nonstatutory Double Patenting: US Patent 11,186,649, Klein	1–4, 6–18	

1–4, 6–18		Nonstatutory Double Patenting: US Patent 11,530,268, Klein	1–4, 6–18	
1–4, 6–18		Nonstatutory Double Patenting: US Patent 11,613,576, Klein	1–4, 6–18	
1–18		Nonstatutory Double Patenting: US Patent 11,192,960, Klein	1–18	
1–18		Provisional Nonstatutory Double Patenting: US Patent Application 18/183,107, Klein	1–18	
Overall Outcome			1–18	

Final Outcome of Appeal after Rehearing:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed
1–18		Nonstatutory Double Patenting: US Patent 10,882,922, Klein		1–18
1–4, 6–18		Nonstatutory Double Patenting: US Patent 11,186,649, Klein		1–4, 6–18
1–4, 6–18		Nonstatutory Double Patenting: US Patent 11,530,268, Klein		1–4, 6–18
1–4, 6–18		Nonstatutory Double Patenting: US Patent 11,613,576, Klein		1–4, 6–18
1–18		Nonstatutory Double Patenting: US Patent 11,192,960, Klein		1–18
1–18		Provisional Nonstatutory Double Patenting: US Patent Application 18/183,107, Klein		1–18
Overall Outcome				1–18

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

ADAMS, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority decision for the reasons set forth in the Request for Rehearing, with the exception of the discussion of *In re Hubbell*, 709 F.3d 1140 (Fed. Cir. 2013) at page 5 of the Request for Rehearing, which I find unnecessary on this record (*see* Req. 5 ("To the extent that the Board believes that it is useful to compare the facts of the rejection . . . with the facts in a prior Federal Circuit decision, the Examiner submits that a more relevant comparison could be made with *In re Hubbell*, 709 F.3d 1140 (Fed. Cir. 2013).")).