

# THE LAW OF DOUBLE PATENTING IN THE CCPA

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### Introduction

As the court from which applicants dissatisfied with Patent and Trademark Office decisions most often seek review, the Court of Customs and Patent Appeals (CCPA) has had ample opportunity over the years to deal with the subject of double patenting in many different factual situations. Moreover, during a period of explosive development extending roughly from Judge Rich's 1963 concurring opinion in *In re Zickendraht*<sup>1</sup> to Judge Lane's 1970 opinion for a unanimous court in *In re Vogel*,<sup>2</sup> the CCPA has established an integrated body of case law which, besides being intellectually satisfying to most patent attorneys, has the indisputable virtues (particularly when compared to prior case law) of being easy to apply and relatively predictable of result.<sup>3</sup>

### Historical Development of Double Patenting Law in the CCPA

At the effective date of the 1952 Patent Act and for several years thereafter, the CCPA did not have a distinct body of case law on the subject of double patenting. A representative and formerly influential opinion from that period is *In re Siu*,<sup>4</sup> a 1955 opinion by Judge O'Connell which treated the rejection as one for common-assignee double patenting even though the reference was available

1. 319 F.2d 225, 229 (CCPA 1963).

2. 422 F.2d 438 (CCPA 1970).

3. In preparing this article, seventy-nine CCPA opinions dating from the period 1952-1976 and containing extended analyses of various facets of double patenting law have been analyzed. The importance of the 1963-1970 period in the development of the CCPA's law on the subject is shown by the following chronological distribution of the decisions:

1952	2	1960	0	1968	11	1976	2
1953	2	1961	1	1969	8		
1954	1	1962	1	1970	5		
1955	2	1963	3	1971	1		
1956	3	1964	5	1972	0		
1957	1	1965	9	1973	0		
1958	2	1966	9	1974	0		
1959	0	1967	8	1975	3		

This table includes utility patent v. design patent "double patenting" cases, but it does not include cases involving analogous conflicts or alleged conflicts between other forms of intellectual property.

4. 222 F.2d 267 (CCPA 1955).

5. *Id.* at 268 and 270.

6. In *In re Robeson*, the court went even further, preceding a re-quotation of the passage from the Solicitor's brief with the introduction "this court said," thereby adopting the quoted language as its own. 331 F.2d 610, 615 (CCPA 1964).

under 35 USC 102(e).<sup>5</sup> In the course of its opinion, the court quoted approvingly the following passage from the Solicitor's brief<sup>6</sup> dealing with a terminal disclaimer submitted by appellant:<sup>7</sup>

. . . section 253 was intended to remedy certain difficulties under the prior law encountered when an applicant, due to factors beyond his control, could not cause related applications to issue on the same day. . . .

However, while the disclaimer has the effect of permitting less close scrutiny of the distinction between claims issuing to an applicant in separate patents, it was not, and could not have been[,] the legislative intent to permit indiscriminate issuance of numerous patents directed to mere colorable variations of the same idea. Nothing in the statute or its legislative history suggests abandonment of the settled rule of *Underwood v. Gerber*, 149 U.S. 224, 13 S. Ct. 854, 37 L. Ed. 710, forbidding more than one patent for what is obviously only one invention, whether or not the grants expire on the same day.<sup>[8]</sup>

The three themes intertwined in the above passage, one patent for "one invention," "mere colorable variations," and "factors beyond . . . [the applicant's] control," were often reprised, elaborated on, and played against other themes in the court's opinions for at least the next fifteen years.

7. Terminal disclaimers are submitted under the following provision of 35 USC 253: any patentee or applicant may disclaim or dedicate to the public . . . any terminal part of the term, of the patent . . . to be granted.

Terminal disclaimers submitted to overcome double patenting rejections are of the portion of the term of the subject patent or application which would otherwise extend beyond the expiration of the reference patent or application. For the rather scanty legislative history of this provision, which was new to the 1952 Patent Act, see the report of the hearings of June 13-15, 1951, before Subcommittee No. 3 of the Committee of the Judiciary, House of Representatives, Eighty-Second Congress, on H.R. 3760. That report quotes the "Report of the Laws and Rules Committee of the American Patent Law Association on H.R. 3760, Eighty-Second Congress" as follows with respect to §203 of that bill, to which the above provision of 35 USC 253 traces back:

Section 203—in the second paragraph introduces a new thought in providing for a disclaimer of the entire or any terminal [portion] of the term of a patent. *This last provision should be of value in eliminating questions of double patenting.* See also Federico, "Commentary on the New Patent Act", printed before 35 U.S.C.A., at p. 49, which states from personal knowledge that the "proponents [of this provision] contemplated that it might be effective in some instances, in combating a defense of double patenting, to permit the patentee to cut back the term of a later issued patent so as to expire at the same time as the earlier issued patent and thus eliminate any charge of extension of monopoly," but also erroneously states that "No specific reason for this provision appears in the printed record [i.e., in the legislative history]."

8. 222 F.2d at 270 n. 2.

The foundation stone of the modern law of double patenting in the CCPA is Judge Rich's concurring opinion in *In re Zickendraht*,<sup>9</sup> a case in which the named inventors in the application on appeal and in the reference patent were the same, in which the claims in the application on appeal and in the reference patent were non-overlapping,<sup>10</sup> and in which no terminal disclaimer had been filed. In the course of that lengthy opinion, Judge Rich reasoned as follows:

"Double patenting" is a loose phrase meaning many different things. In addition to the pure sense of meaning two patents claiming the *same* invention, it has also for a long time included a *second patent claiming an invention which differs from an already patented invention only in some unpatentable particular*. It is only in the latter sense that we have double patenting here; and in that sense it assumes the existence of a *second invention* which, however, is *unpatentable over the invention previously patented*. There is an important difference between the situation where there is *one* invention being twice claimed and the situation, as here, where there are *two* inventions and one is unpatentable over the other. They should not be confused. Different principles of law apply[,] and it is important to recognize and to maintain the distinction.

\* \* \*

[I]t is clear that it has been a firmly established rule in this court for over thirty years that when an applicant *takes out a patent* on one of two or more copending applications on closely related inventions, he shall not be allowed claims in the other applications except on subject matter which is patentably different from the subject matter *claimed* in his patent.

\* \* \*

The rule is not only one of very long standing[,] but it is, I believe, a rule which operates in the public interest.

\* \* \*

To sum it up, the operation of the rule is that claims to inventions closely related to the invention claimed in a patent and not patentably distinguishable therefrom must be in-

9. 319 F.2d 225, 229 (CCP9 1963).

10. Since the word "overlapping" was given several distinct meanings at various times by the Patent Office in its efforts to distinguish successive CCPA's opinions on the subject of double patenting, I will say at the outset that what I mean by "non-overlapping" is that no claims in the reference reads literally on any subject matter read on by any claim in the application. See also text accompanying footnotes 27-31, *infra*.

cluded in the same patent unless the applicant has been forced to make them in a separate application by a requirement of restriction, in which case section 121 of the statute acts to waive the rule.<sup>[11]</sup> It is possible that the operation of the rule may also be avoided by so using the terminal disclaimer provision of section 253 as to assure that any later issued patent will expire on the same day as the earlier patent; but in such a case two questions remain to be answered. Should not the file of the earlier patent contain a notice to advise the public that there is a later issued patent which must be considered, just as there is a warning in a file wherein restriction was required? And is the matter of possible divided ownership of two patents on independent but patentably indistinguishable subject matter of any real importance?<sup>[12]</sup>

The next important case in the development of CCPA double patenting law was *In re Robeson*,<sup>13</sup> a same-inventor double patenting case involving non-overlapping claims where a terminal disclaimer *had* been filed. There Chief Judge Worley for the unanimous court reasoned as follows:

Where the claims of a second application are substantially the same as those of the first patent, they are barred under 35 U.S.C. 101. . . .

Where, as here, the claimed subject matter is an obvious modification of what has already been claimed, a second patent is contrary to one of the fundamental principles underlying the patent system, namely, that when the right to exclude granted by a patent expires at the end of the patent term, the public shall be free to use the invention as well as obvious modifications thereof or obvious improvements thereon. Thus, to grant a second patent for an obvious variation deprives the public of those rights. If, however, the second patent expires simultaneously with the first, the right to fully utilize the patented discovery at the expiration date remains unimpaired. Thus the terminal disclaimer here precludes any extension of monopoly.

\* \* \*

As noted in *Siu*, extension of monopoly is not the only objection to double patenting. Others include possible harassment by multiple assignees, inconvenience to the Patent Office.

11. Concerning this point, see the article by John McIntyre, Jr., in this issue.

12. 319 F.2d at 230-32; footnote omitted; emphasis in the original.

13. 331 F.2d 610 (CCPA 1964).

and the possibility that one might avoid the effect of file wrapper estoppel by filing a second application. We do not minimize these possibilities, but we must decide this case on the facts before us. We are not here confronted by a situation where any abuse of the terminal disclaimer is suggested. . . . [T]hus we are obliged to *reverse* the rejection of claim 7, 8, 9, 13 to 15 and 30.<sup>[14]</sup>

There followed a period of considerable turmoil, during which the Patent Office sought assiduously to distinguish successive CCPA pronouncements on the subject of double patenting and the CCPA repeatedly rejected the proffered distinctions. During this period, the CCPA rejected the contention that terminal disclaimers were only available to obviate differences in patent terms which were due to factors beyond the applicant's control,<sup>15</sup> discarded the contention that the filing of a second application could be used to avoid the effect of file wrapper estoppel,<sup>16</sup> minimized the significance of possible harassment of infringers made possible by divided ownership of overlapping patents,<sup>17</sup> and repeatedly emphasized that the only significant evil of double patenting is temporal extension of monopoly and that that evil is overcome by the filing of an appropriate terminal disclaimer.<sup>18</sup> Most importantly, however, the CCPA gradually did away with the "mere colorable variation" test spawned by *Siu*, first criticizing it repeatedly,<sup>19</sup> ignoring it on occasion,<sup>20</sup> and finally doing away with it altogether in what is still the leading opinion in the CCPA on the subject of double patenting. *In re Vogel*.<sup>21, 22</sup>

14. 331 F.2d at 614-15; footnotes omitted.

15. *In re Geiger*, 425 F.2d 1276, 1280 n. 10 (CCPA 1970).

16. *In re Jentoft*, 392 F.2d 633, 640-41 (CCPA 1968).

17. *In re Jentoft*, 392 F.2d 633, 641 (CCPA 1968). See also *In re Sarett*, 327 F.2d 1005, 1011 n. 10 (CCPA 1964).

18. See, e.g., *In re Braithwaite*, 379 F.2d 594, 601 (CCPA 1967), and *In re Christensen*, 330 F.2d 652, 656 (CCPA 1964).

19. See, e.g., *In re Plank*, 399 F.2d 241, 244 n. 5 (CCPA 1968), and *In re Eckel*, 393 F.2d 848, 856 (CCPA 1968).

20. See, e.g., *In re Boylan*, 392 F.2d 1017, 1021 (CCPA 1968), and *In re Waller*, 366 F.2d 786, 789 (CCPA 1966).

21. 422 F.2d 438 (CCPA 1970).

22. The court has not, however, again directly addressed the first question raised at the end of the above quotation from Judge Rich's concurring opinion in *Zickendraht*, namely, "Should not the file of the earlier patent contain a notice to advise the public that there is a later issued patent which must be considered . . . ?," although dictum in *In re Conix*, 405 F.2d 1315, 1319 (CCPA 1969), indicates that the court may still be induced to give weight to this consideration. Accordingly, it is believed to be a good practice to file such a notice prior to the issuance of the second patent — although, practically speaking, it would indeed be an incautious infringer who was aware of the earlier patent but did not find the later patent on its own before commencing activities falling just outside the scope of the claims of the earlier patent. Perhaps the fear is really that the infringer will begin its activities falling just outside the scope of the claims of the earlier before the later issues. If so, then perhaps the notice should be filed in the file of the earlier patent concurrently with the filing of the terminal disclaimer during prosecution of the related application. But cf. *In re Gibbs*, 437 F.2d 486 (CCPA 1971), particularly at 493 n. 6.

*Vogel* involved same-inventor, obviousness-type double patenting rejections of dominating and of non-overlapping claims in the absence of a terminal disclaimer. However, the opinion is of primary importance because of (1) its didactic exposition of the CCPA law of double patenting, and (2) its relatively simple facts, which can be understood by almost anyone. Those facts, in simplified form, were that the appellants had previously patented a method of preparing *pork* products and that one of their claims on appeal recited essentially the same method of preparing *beef* products and two others recited essentially the same method of preparing *meat* products. On those facts, the court affirmed the rejection of the claims reciting the method as applied to meat generally and reversed the rejection of the claim reciting the method as applied to beef, reasoning as follows:

The first question in the analysis is: Is the same invention being claimed twice? 35 U.S.C. §101 prevents two patents from issuing on the same invention. See, e.g., *In re Boylan*, 392 F.2d 1017, 55 CCPA 1041 (1968). As we have said many times, "invention" here means what is defined by the claims, whether new or old, obvious or unobvious; it must *not* be used in the ancient sense of "patentable invention," or hopeless confusion will ensue. By "same invention" we mean identical subject matter. Thus the invention defined by a claim reciting "halogen" is not the *same* as that defined by a claim reciting "chlorine," because the former is broader than the latter. On the other hand, claims may be differently worded and still define the same invention. Thus a claim reciting a length of "thirty-six inches" defines the same invention as a claim reciting a length of "three feet," if all other limitations are identical. In determining the meaning of a word in a claim, the specification may be examined. It must be borne in mind, however, especially in non-chemical cases, that the words in a claim are generally not limited in their meaning by what is shown in the disclosure. Occasionally the disclosure will serve as a dictionary for terms appearing in the claims, and in such instances the disclosure may be used in interpreting the coverage of the claim. *In re Baird*, *supra*. A good test, and probably the only objective test, for "same invention," is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention. This is essentially the test applied in *In re Eckel*, 393 F.2d 848, 55 CCPA 1068 (1968). There the court rejected the idea of "colorable variation" as a comparison category and stated that inventions were

either the same, or obvious variations, or unobvious variations. The court's holding in *Eckel* was that same invention means identically same invention.

If it is determined that the same invention is being claimed twice, 35 U.S.C. §101 forbids the grant of the second patent, regardless of the presence or absence of a terminal disclaimer. If the same invention is not being claimed twice, a second question must be asked.

The second analysis question is: Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent? In considering the question, the patent disclosure may not be used as prior art. In *re Boylan*, *supra*; In *re Aldrich*, 398 F.2d 855, 55 CCPA 1431 (1968). This does not mean that the disclosure may not be used at all. As pointed out above, in certain instances it may be used as a dictionary to learn the meaning of terms in a claim. It may also be used as required to answer the second analysis question above. We recognize that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim. A claim is a group of words defining only the boundary of the patent monopoly. It may not describe any physical thing and indeed may encompass physical things not yet dreamed of. How can it be obvious or not obvious to modify a legal boundary? The disclosure, however, sets forth at least one tangible embodiment within the claim, and it is less difficult and more meaningful to judge whether that thing has been modified in an obvious manner. It must be noted that this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. §103, since only the disclosure of the invention claimed in the patent may be examined.

If the answer to the second question is no, there is no double patenting involved and no terminal disclaimer need be filed. If the answer is yes, a terminal disclaimer is required to prevent undue timewise extension of monopoly.<sup>[23]</sup>

The court then applied its analysis of the law of double patenting to the facts before it, concluding that the appealed claims did not recite the same invention as the patent claims because "meat . . .

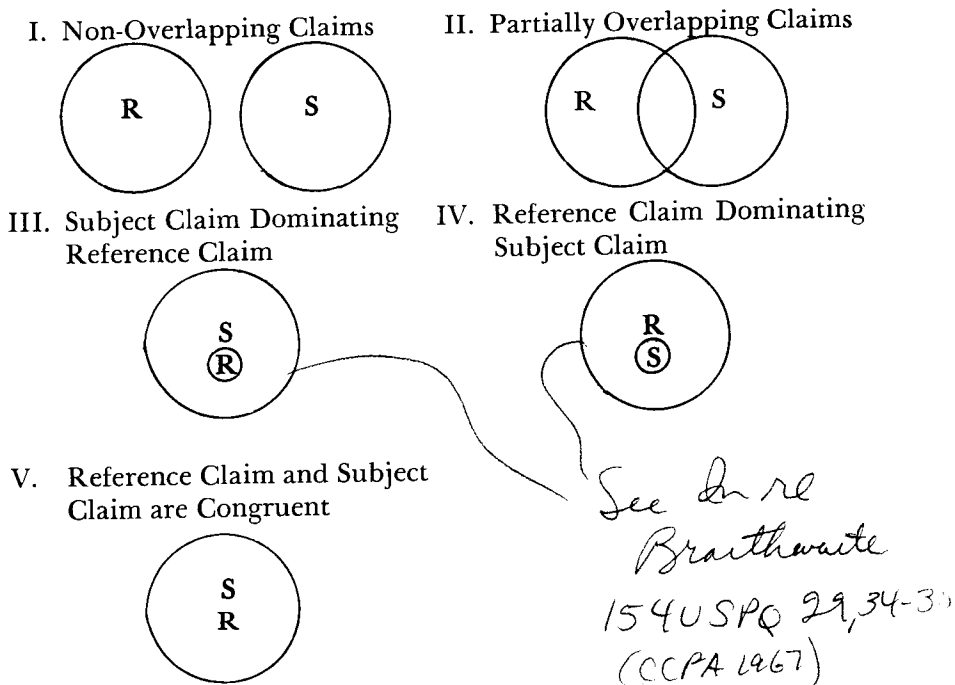
23. 422 F.2d at 441-42.

is not the same thing [as pork]" and "[b]eef is not the same thing as pork,"<sup>24</sup> but affirming the rejection of the generic claims because "[m]eat reads literally on pork," the only additional limitation was "merely an obvious variation as shown by . . . [a secondary reference]," and no terminal disclaimer had been filed.<sup>25</sup>

With the foregoing as a brief historical introduction to the development of the law of double patenting in the CCPA and a statement of the general principles which it now applies, it is now appropriate to turn to its holdings on specific questions.

### *Types of Situations Involved in Double Patenting Cases*

There are only five possible relationships between the scope of a claim rejected on the ground of double patenting and the scope of the reference claim.<sup>26</sup> Those relationships may be illustrated as follows in diagram form, the R space standing for the scope of the reference claim and the S space standing for the scope of the subject claim:



24. 422 F.2d at 442.

25. *Id.*

26. A double patenting rejection entails a claim-by-claim analysis in which each individual rejected claim must be compared with the or each reference claim individually. See, e.g., *In re Sarett*, 327 F.2d 1005, 1012 (CCPA 1964), and *In re Vogel*, 422 F.2d 438, 442 (CCPA 1970).



One further factor is relevant to the CCPA's analysis of double patenting cases: whether or not the S space encompasses a specific disclosure contained in the *specification* of the patent or application containing the reference claim.

### *Non-Overlapping Claims*

The reference and the subject claim need not overlap for double patenting to exist.<sup>27</sup> If no terminal disclaimer has been filed, the test for determining whether or not obviousness-type double patenting exists has been variously stated as "whether or not the claimed invention is merely an obvious modification of the *invention defined in the claims of the patent*,"<sup>28</sup> whether or not "the claimed subject matter is an obvious modification of what has already been claimed,"<sup>29</sup> and whether the rejected claims "fall within a penumbra of obviousness surrounding the . . . [reference] claims, as evidenced by other references cited of record."<sup>30</sup> It is of course clear that same invention double patenting as it is now defined by the court cannot exist in this situation, and accordingly the filing of a terminal disclaimer automatically overcomes any double patenting rejection.<sup>31</sup>

27. *In re Wetterau*, 356 F.2d 556 (CCPA 1966), and *In re Zickendraht*, 319 F.2d 225, 229 (CCPA 1963), *In re Oockert*, 245 F.2d 467, 469 (CCPA 1957), *In re Russell*, 239 F.2d 387, 388 (CCPA 1956) (design patent case), and *In re Ward*, 236 F.2d 428, 432 (CCPA 1976). Cf. also *Moore v. McGrew*, 170 USPQ 149, 152 (POBPI 1971), but cf. *In re Stanley*, 214 F.2d 151, 155 (CCPA 1954). As stated *supra* n. 10, in this article the term "non-overlapping" is used to mean that the reference claim does not read literally on any subject matter read on by the subject claim.

28. *In re Conix*, 405 F.2d 1315, 1319 (CCPA 1969) (emphasis in the original). *In re Conix* states that the "sound reason supporting this rule" is that, "Upon issuance of the patent, if there is no restriction requirement or cross-reference in the record to show that other related applications may be pending, the public should be able to assume that on expiration of the patent there is freed from its monopoly not only what is embraced by the patent claims but as well all *obvious* modifications thereof and that the latter are free of protection through any *later issued, full-term* patents of the patentee." 405 F.2d at 1319; footnote omitted; emphasis in the original. However, it may be asked (1) what interest the public has in knowing immediately upon issuance of the first patent whether or not it will be free to use related subject matter when that patent expires, usually seventeen years later, (2) whether filing a cross-reference in the record of the first patent avoids the necessity of filing a terminal disclaimer in the second patent, and (3) why it is so important for the public to know that the related subject matter is free of protection via another patent "of the patentee" when it has no such protection as to other patents issued to third parties. Moreover, the entire thrust of this rationale is directly contrary to the rationale of *In re Gibbs*, 437 F.2d 486 (CCPA 1971), a later case in which much the same argument was sharply rejected in a different context.

29. *In re Robeson*, 331 F.2d 610, 614 (CCPA 1964).

30. *In re Dunn*, 349 F.2d 433, 436 (CCPA 1965). See also *In re Kaye*, 332 F.2d 816 (CCPA 1964), *In re Zickendraht*, 319 F.2d 225 (CCPA 1963), *In re Eckel*, 317 F.2d 401 (CCPA 1963), and *In re Keim*, 229 F.2d 466 (CCPA 1956).

31. Cf. *In re Schneller*, 397 F.2d 350, 354 (CCPA 1968) (so as to partially overlapping claims). But see *In re Dunn*, 349 F.2d 433, 440 (CCPA 1965), which treats this as an open question.

*Partially Overlapping Claims*

It would seem that the second of the four possible situations, where the reference and the subject claim each read on some of the same subject matter and each reads on some subject matter not read on by the other, could logically be resolved into two components. Since "claims are unpatentable when they are so broad as to read on obvious subject matter even though they likewise read on non-obvious subject matter,"<sup>32</sup> the relationship of the non-overlapping subject matter to the reference claim and the relationship of the overlapping subject matter to the reference claim could be considered separately. The rule set forth in the previous section could be applied to the former and one of the rules set forth in the next section applied to the latter. However, that has not been how the CCPA has analyzed cases of this type.<sup>33</sup>

The two most thoughtful opinions on this factual situation are both by Judge Rich, and both apply a test modeled after the "independent and distinct" test set forth in 35 USC 121 as the basis for a restriction requirement.<sup>34</sup> In the earlier of the two cases, *In re Sutherland*,<sup>35</sup> the CCPA reversed an obviousness-type double patenting rejection because, "Though the two inventions relate to the same basic process and even though they are capable of conjoint use, they are independent and distinct inventions."<sup>36</sup> In the later, *In re Schneller*,<sup>37</sup> the court affirmed an obviousness-type double patenting rejection on the ground that "appellant . . . [had failed to carry] the burden of establishing that the invention claimed in his patent is 'independent and distinct' from the invention of the appealed claims."<sup>38</sup>

Again, it is clear that same invention double patenting cannot exist in this situation, and accordingly the filing of a terminal disclaimer automatically overcomes any double patenting rejection.<sup>39</sup>

32. *In re Mraz*, 455 F.2d 1069, 1072-73 (CCPA 1972). *Mraz* is a §103 case, but the same principle is applied in *In re Christensen*, 330 F.2d 652, 656 (CCPA 1964), an obviousness-type double patenting case.

33. But cf. *In re Christensen*, 330 F.2d 652, 656 (CCPA 1964), and *In re Greenlee*, 222 F.2d 739, 743 (CCPA 1955), which come close.

34. Concerning the relationships between double patenting and restriction requirements, see the article by John McIntyre, Jr., in this issue.

35. 347 F.2d 1009 (CCPA 1965).

36. *Id.* at 1016.

37. 397 F.2d 350 (CCPA 1968).

38. *Id.* at 554. See also *In re Rogers*, 394 F.2d 566, 569 (CCPA 1968), *In re Bridgeford*, 357 F.2d 679, 683 (CCPA 1966), and *In re Greenlee*, 222 F.2d 739, 742-43 (CCPA 1955).

39. See, e.g., *In re Schneller*, 397 F.2d 350, 354 (CCPA 1968) (dictum).

*Reference Claim Dominates Subject Claim or Vice-Versa*

These two situations can be profitably compared with the analogous situations where the reference is a prior-art disclosure. There, a prior-art disclosure of subordinate subject matter is an absolute bar to subsequent patenting of dominant claims,<sup>40</sup> but prior disclosure of dominant subject matter can be, at most, the basis of a holding that subordinate claims are *prima facie* obvious.<sup>41</sup> In the analogous situations where the reference is a claim, not a disclosure, if the reference is a subordinate claim, a terminal disclaimer must be filed regardless of whether or not the subordinate subject matter is obvious in view of the dominant subject matter.<sup>42</sup> If the reference is a dominant claim, however, no double patenting exists if the subject matter of the subordinate claim is non-obvious in view of the reference claim, and no terminal disclaimer need be filed;<sup>43</sup> if the subject matter of the subordinate claim is obvious in view of the reference claim, the rejection can be overcome by the filing of an appropriate terminal disclaimer.<sup>44</sup> In determining whether or not the subject matter of a subordinate claim is obvious in view of the reference claim, the same kind of arguments and objective evidence of non-obviousness used in §103 cases may be used.<sup>45</sup> In *In re Vogel*, quoted at length *supra*, the court attacked the problem of determining whether or not the subject matter of a subordinate claim is obvious in view of a dominant reference claim as follows:

We recognize that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim. A claim is a group of words defining only the boundary of the patent monopoly. It may not describe any physical thing and indeed may encompass physical things not yet dreamed of. How can it be obvious or not obvious to modify a legal

40. E.g., prior-art disclosure of a species is an absolute bar to subsequent patenting of a genus encompassing the species. See, e.g., *In re Lukach*, 442 F.2d 967, 970, and *In re Ruscetta*, 255 F.2d 687, 689-90 (CCPA 1958).

41. E.g., prior disclosure of a genus can be, at most, the basis of a holding that a species encompassed by the genus is *prima facie* obvious. See, e.g., *In re Petering*, 301 F.2d 676, 681 (CCPA 1962).

42. *In re Vogel*, 422 F.2d 438, 442 (CCPA 1970) (as to claim 10). However, there are older cases to the contrary: *In re Heinle*, 342 F.2d 1001 (CCPA 1965), *In re Allen*, 343 F.2d 482 (CCPA 1965), *In re Borah*, 354 F.2d 1009 (CCPA 1966), *In re Walles*, 366 F.2d 786 (CCPA 1966) and *In re Stanley*, 214 F.2d 151, 159 (CCPA 1954).

43. *In re Dunn*, 349 F.2d 433, 440 (CCPA 1965), and *In re Baird*, 348 F.2d 974, 979-81 (CCPA 1965). *In re Kaplan*, F.2d 215 (1958), 681-82 (F.2d 1958).

44. *In re Jentoft*, 392 F.2d 633, 640 (CCPA 1968), *In re Eckel*, 393 F.2d 848 (CCPA 1968) and *In re Avery*, 518 F.2d 1228, 1233, (CCPA 1975) (dictum). See also *In re Braithwaite*, 379 F.2d 594, 601 (CCPA 1967).

45. See, e.g., *In re Dunn*, 349 F.2d 433 (CCPA 1965), and *In re Gladrow*, 406 F.2d 1376, 1384-85 (CCPA 1969).

boundary? The disclosure, however, sets forth at least one tangible embodiment within the claim, and it is less difficult and more meaningful to judge whether that thing has been modified in an obvious manner.<sup>[46]</sup>

However, it is clear that, under modern CCPA §112 law, the disclosure does not have to "[set] forth at least one tangible embodiment within the claim"<sup>47</sup> so long as it otherwise complies with §112, and, besides, claims of different scope can be predicated on the identical disclosure,<sup>48</sup> so it is submitted that *Vogel's* "less difficult and more meaningful" test is hardly likely to be the CCPA's last word on this subject.

*Reference Claim and Subject Claim are Congruent*

In *In re Vogel*<sup>49</sup> the CCPA said that

A good test, and probably the only objective test, for "same invention" [double patenting], is whether one of the claims could be literally infringed without literally infringing the other. If it could be, the claims do not define identically the same invention.<sup>[50]</sup>

The court did note that "claims may be differently worded and still define the same invention,"<sup>51</sup> but it is clear that it would be highly unusual for two claims presented by a sane patent attorney in two different patent applications to define the same invention under this test,<sup>52</sup> — except, of course, for a possible clerical error

46. 422 F.2d at 422.

47. See, e.g., *In re Honn*, 364 F.2d 454 (CCPA 1966).

48. See, e.g., *In re Newton*, 414 F.2d 1400 (CCPA 1969), and *In re White*, 405 F.2d 904 (CCPA 1969).

49. 422 F.2d 438 (CCPA 1970).

50. *Id.* at 441.

51. *Id.* See also *In re Plank*, 399 F.2d 241, 244 (CCPA 1968), and *In re Skriwan*, 427 F.2d 801, 803 (CCPA 1970). As an example of this, the court in *Vogel* stated that "a claim reciting a length of 'thirty-six inches' defines the same invention as a claim reciting a length of 'three feet' if all the other limitations are identical." 422 F.2d at 441. However, it may be asked whether this would be so in view of standard practice in measuring tolerances, which would suggest that the first claim would be literally infringed by an element measuring thirty-six inches plus or minus one-half inch, while the second claim would be literally infringed by an element measuring three feet plus or minus one-half foot.

52. Two situations where the PTO might still argue that two claims were drawn to the same invention under this test would be where one was in product-by-process form and the other was in conventional product form (see e.g., *In re Bridgford*, 357 F.2d 679 (CCPA 1966)), and where both claims were in product-by-process form, the recited processes were different, but the product produced was physically identical. Despite the physical identity of the products, it is submitted that the latter situation should be treated as one involving non-overlapping claims in view of the holdings in several courts that product-by-process claims are only infringed by products produced by the recited process.

in adding chains of dependent claims to different base claims until ultimately two dependent claims recited all the same elements, either directly or by incorporation by reference.<sup>52a</sup> However, if they did, a double patenting rejection of the second claim would be proper regardless of the presence or absence of a terminal disclaimer.<sup>53</sup>

### *Authority for Double Patenting Rejections*

The statutory basis for same-invention type double patenting rejection in cases involving only utility claims is said to be 35 USC 101, which "provides that an inventor may obtain a patent for his invention,"<sup>54</sup> and the statutory basis for same-invention type double patenting rejections in cases involving only design claims is said to be 35 USC 171.<sup>55</sup> The only authority for obviousness-type double patenting rejections in both utility-utility and design-design cases and for both same-invention and obviousness-type double patenting rejections in utility-design cases is acknowledged to be case law.<sup>56</sup> However, obviousness-type double patenting rejections must employ the same standards as obviousness rejections under 35 USC 103.<sup>57</sup>

52a. 37 CRR 1.78 (b) provides that applicants can retain "conflicting claims" in two or more applications on a showing of "good and sufficient reason" for doing so. As examples of such reasons, see *In re Mott*, 539 F.2d 1291 (CCPA 1976), where the appellant had copied claims from a third party's patent into two different applications, presumably to avoid a §135(b) bar if no support for the copied claim was found in the preferred application, *In re Wetterau*, 356 F.2d 556 (CCPA 1966), and *Ex parte Apgar*, 66 USPQ 370 (POBA 1944).

53. *In re Vogel*, 422 F.2d 438, 441 (CCPA 1970).

54. *In re Ockert*, 245 F.2d 467, 469 (CCPA 1957) (emphasis in the original). See also *In re Zickendraht*, 329 F.2d 225, 231 n. 4 (CCPA 1963) (concurring opinion of Judge Rich), and *In re White*, 405 F.2d 904, 906 (CCPA 1969). But see 1 USC 1, "Words denoting number, gender, and so forth," which states in relevant part that, "In determining the meaning of any Act of Congress, unless the context indicates otherwise—words importing the singular include and apply to several persons, parties, or things. . . ." The court apparently met that type of argument in *In re Ockert* by stating that "There is no statutory provision for the granting of a plurality of patents on a single invention. . . ." 245 F.2d at 469.

55. *In re Geiger*, 425 F.2d 1276, 1279 (CCPA 1970). Cf. also *In re Thorington*, 418 F.2d 528, 534 n. 5 (CCPA 1969), and accompanying text.

56. *In re Zickendraht*, 319 F.2d 225, 231 n. 4 (CCPA 1963) (concurring opinion of Judge Rich) (utility-utility case); *In re Land*, 368 F.2d 866, 870 n. 1 (CCPA 1966) (utility-utility case); *In re Braithwaite*, 379 F.2d 594, 600 n. 4 and 601 (CCPA 1967) (utility-utility case); *In re Purdy*, 393 F.2d 1010, 1012 (CCPA 1968) (utility-utility case); *In re Rogers*, 394 F.2d 566, 570 n. 7 (CCPA 1968) (utility-utility case); *In re Aldrich*, 398 F.2d 855, 859 (CCPA 1968) (utility-utility case); and *In re Geiger*, 425 F.2d 1276, 1279 (CCPA 1970) (design-design case). As for utility-design cases, see the article by Richard Killworth in this issue.

57. *In re Zickendraht*, 319 F.2d 225, 231 n. 4 (CCPA 1963) (concurring opinion of Judge Rich), and *In re Allen*, 343 F.2d 482, 490 n. 1 (CCPA 1965) (dissenting opinion of Judges Almond and Martin). And compare *In re Braithwaite* 379 F.2d 594, 602 (CCPA 1967) (concurring opinion of Judge Smith).

*Reference to Prior Art in Obviousness-type Double Patenting Cases*

As the CCPA said in *In re Ockert*,<sup>58</sup> "It is . . . well settled that, in determining whether the claims of an application are patentably distinct from those of a patent[,] it is proper to consider what is disclosed by the prior art."<sup>59</sup>

*Relevance of Filing Dates and Reduction to Practice Dates*

Since the law of double patenting is concerned with impermissible extensions of exclusionary rights, the CCPA has held irrelevant both the dates of actual reduction to practice of the subject matter recited in the claims in question<sup>60</sup> and their effective filing dates.<sup>61</sup> This is, however, subject to the caveat that, if the respective filing and issue dates are such that the reference is available under §102 or §103, they must be so employed rather than as the basis of double patenting rejections.<sup>62</sup>

*Common Assignee Double Patenting*

The present status of common-assignee double patenting rejections in the common, invention cases is very unsettled in view of the CCPA's recent decision concerning 35 USC 102(g) in *In re Bass*,<sup>63</sup> discussed at length in Examiner-in-Chief Witherspoon's article in this issue. It was long the rule in the CCPA that commonly assigned cases in which inventorship was different could be treated exactly the same way for double patenting purposes as cases in which the inventorship was the same,<sup>64</sup> and many of the cases cited in other sections of this article are common-assignee, rather than same-inventor cases. However, while it is now questionable

58. 245 F.2d 467 (CCPA 1957).

59. 245 F.2d at 469. See also *In re Russell*, 239 F.2d 387, 388 (CCPA 1956), *In re Eckel*, 317 F.2d 401, 403 (CCPA 1963), *In re Ornitz*, 347 F.2d 586, 589 (CCPA 1965), *In re Land*, 368 F.2d 866, 870 n. 1 (CCPA 1966), and *In re Purdy*, 393 F.2d 1010, 1012 (CCPA 1968).

60. *In re Borchardt*, 197 F.2d 550, 552 (CCPA 1952), *In re Sutherland*, 347 F.2d 1009, 1013 (CCPA 1963) (semble), and *In re Cole*, 373 F.2d 532, 534 (CCPA 1967) (semble). But cf. *In re Borah*, 354 F.2d 1009, 1018 (CCPA 1966).

61. *In re Ockert*, 245 F.2d 467, 469 (CCPA 1957), *In re Bowers*, 359 F.2d 886, 891 (CCPA 1966), *In re Cole*, 373 F.2d 532, 534 (CCPA 1967), *In re Borg*, 392 F.2d 642, 644-45 (CCPA 1968); but see *In re Schneller*, 397 F.2d 350, 355 (CCPA 1968), and cf. *In re Borah*, 354 F.2d 1009, 1018 (CCPA 1966).

62. *In re Land*, 368 F.2d 866, 868 (CCPA 1966) (dubitante), *In re Ornitz*, 376 F.2d 330, 334 (CCPA 1967), and *In re Braithwaite*, 379 F.2d 594, 603 n. 5 (CCPA 1967) (concurring opinion of Judge Smith).

63. 474 F.2d 1276 (CCPA 1973).

64. *In re Borchardt*, 197 F.2d 550, 552 (CCPA 1952), *In re Stanley*, 214 F.2d 151, 153 (CCPA 1954), *In re Keim*, 229 F.2d 466, 469 (CCPA 1956), *In re Dunn*, 349 F.2d 433, 436 (CCPA 1965), *In re Bowers*, 359 F.2d 886, 889 (CCPA 1966), and *In re Rogers*, 394 F.2d 566, 567 n. 4 (CCPA 1968).

whether such a rejection would be proper where the invention recited in the reference claim was made in the United States early enough to be a reference,<sup>65</sup> it seems clear in view of the presence of the statutory limitation of the applicability of 35 USC 102(g) to inventions "made in this country" that such a rejection would still be proper where the invention recited in the reference claim was *not* made in this country (by actual reduction to practice, filing of an application supporting the claim, or by conception plus diligence) in time to be available as a §102(g) reference. Similarly, it would seem that a common assignee double patenting rejection would still be proper where the reference was a patent (i.e., beyond the powers of the PTO) and the invention recited in the reference claim was made in the United States *after* the invention recited in the subject claim, notwithstanding the assertion in the MPEP to the contrary.<sup>66</sup>

*Effect of Change in Assignment During Pendency on Common Assignee Double Patenting*

Of course, the fact of common assignment is subject to change — that is, the common assignee can transfer one of the cases to another entity. However, at least if the reference claim is in a patent and the transfer is of the application, the transferee takes subject to the transferor's limitation, and the application is treated as if it were still commonly assigned.<sup>67</sup> Presumably the same result would obtain if the common assignee transferred the patent and retained the application, but it is far from clear what would happen if the common assignee transferred one of the cases while both were still applications.<sup>68</sup>

*Effect of a Relationship Between the Assignees Less than Common Assignment*

It seems clear that there must be, at the least, a very considerable community of interest between the assignees of two cases for the common-assignee double patenting rules to apply, but just how much community is required is far from clear. In *In re Dinwiddie*<sup>69</sup>

65. See text accompanying footnote 63, *supra*.

66. §804 of the MPEP (3rd ed.) states that "The term 'double patenting' should not be applied to situations involving commonly owned cases of different inventive entities," and §804.03 sets forth a procedure for dealing with such cases which is entirely different from traditional common-assignee double patenting law.

67. *In re Hession*, 296 F.2d 930, 931-32 (CCPA 1961).

68. Cf. *In re Borg*, 392 F.2d 642, 645 (CCPA 1968) (concurring opinion of Judge Almond).

69. 347 F.2d 1016, 1017 (CCPA 1965).

the court seems to assume that some relationship less than common assignment is sufficient to trigger double patenting consequences, but Judge Smith's concurring opinion in *In re Braithwaite*,<sup>70</sup> argues that a common licensee (whether the license was exclusive or non-exclusive is not stated, but it was probably the latter since the licensee was the U.S. Government and the license was royalty free) is not enough and seems to argue that only common assignment is enough. Thus, questions about assignments to related companies, as well as about exclusive licenses rather than assignments, appear to remain open.

*Requirement That Common Ownership Be Maintained Where One Patent Is to Be Issued as the Result of the Filing of a Terminal Disclaimer*

One of the traditionally listed evils of obviousness-type double patenting, and the only one other than extension of monopoly that the CCPA now appears to give much weight to,<sup>71</sup> is the possibility that, if the two patents come into different hands, third parties may be sued by both assignees for the same activities.<sup>72</sup> Apparently in order to overcome Patent Office arguments based on that evil, the assignee in *In re Griswold*<sup>73</sup> filed a terminal disclaimer which elicited the following footnote from the court:

The terminal disclaimers which have been filed are ingenious. The pertinent portion of the disclaimer in the Griswold application file reads:

\*\*\*Johnson & Johnson hereby disclaims the terminal part of any patent granted on the above identified application, which would extend beyond the expiration date of said patent 3,081,514, and hereby covenants that any patent so granted on the above identified application, together with any right to recover for its violation[,] shall be enforceable only for and during such period that the legal title to said patent and to such right to recover shall be the same respectively as the legal title to United States Patent 3,081,514 and to any corresponding right to recover for its violation, this covenant to run with any patent granted on the above identified application and to be binding upon the grantee, its successors, or assigns.

70. 379 F.2d 594, 604 (CCPA 1967).

71. See text accompanying note 18, *supra*. But see note 22 *supra*.

72. See, e.g., *In re Robeson*, 331 F.2d 610, 614-15 (CCPA 1964) (quoted *supra* in text accompanying footnote 14).

73. 365 F.2d 834 (CCPA 1966).



The above language includes an imaginative solution to one of the more theoretical objections to double patenting, split ownership of two patents and potential harassment. Cf. *In re Sarett*, 327 F.2d 1005, 1011, 51 CCPA 1180, 1190; *In re Robeson*, 331 F.2d 610, 51 CCPA 1271.<sup>74</sup>

Thereafter and in reliance on *In re Griswold*,<sup>75</sup> the Patent Office promulgated 37 CFR 1.321(b), which reads as follows:

A terminal disclaimer, when filed in an application to obviate a double patenting rejection, 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.

After *Griswold* but before promulgation of 37 CFR 1.321(b), the CCPA continued to give effect to terminal disclaimers which did not contain an undertaking to maintain common ownership of the two cases.<sup>76</sup> Whether or not the CCPA would do so now apparently remains an open question, but its treatment of other Patent Office rules in comparable circumstances suggests that it would not, despite the lack of statutory support for 37 CFR 1.321(b).<sup>77</sup>

*Requirement That a Terminal Disclaimer Be as to All Claims*

Section 1403 of the MPEP (3rd ed.) states that,

Since the claims of pending applications are subject to cancellation, amendment or renumbering, a terminal disclaimer directed to a particular claim or claims will not be accepted; the disclaimer must be of a terminal portion of the term of the entire patent to be granted.

Although this practice by the Patent Office has been noted by the CCPA,<sup>78</sup> the reference to it was neutral, rather than positive as was the reference in *In re Griswold*<sup>79</sup> to the undertaking to main-

74. 365 F.2d at 840 n. 5.

75. 365 F.2d 834 (CCPA 1966). See 35 F.R. 20011 (1970), which makes express this reliance.

76. See, e.g., *In re Wright*, 393 F.2d 1001, 1002 n.2 (CCPA 1968).

77. *In re Rubinfeld*, 270 F.2d 391, 395 (CCPA 1959); *In re Hession*, 296 F.2d 930, 932 n. 2 (CCPA 1961); and *In re Fee*, 397 F.2d 329 (CCPA 1968). But see the cases dealing with 37 CFR 1.71(b), discussed in Gholz, *Recent Developments in the CCPA Relating to the First Paragraph of 35 USC 112*, 55 JPOS 4, 5-9 (1973), and *In re Moore*, 444 F.2d 572, 580 n. 10 (1971), dealing with 37 CFR 1.131.

78. *In re Jentoft*, 392 F.2d 633, 638 n. 4 (CCPA 1968).

79. Quoted *supra* in text accompanying footnote 74.

tain common ownership of the two cases. This requirement does not seem to have been challenged as yet, probably because it is usually not worth the effort. On the one hand, it can be argued that if and when it is challenged, it will not be upheld in view of (1) the fact that it is embodied in the MPEP rather than 37 CFR,<sup>80</sup> (2) the fact that it would be perfectly possible under the CCPA's claim-by-claim analysis of double patenting rejections for a double patenting rejection to be maintainable as to some claims in an application but not as to others,<sup>81</sup> and (3) the fact that Patent Office arguments based solely on its administrative convenience have fared very poorly in the CCPA in the past.<sup>82, 83</sup> On the other hand, it can be argued that the fact that the first paragraph of 35 USC 253, which authorizes complete disclaimers, states that "[a] patentee . . . may . . . make disclaimer of any complete *claim*," while the second paragraph of that section, which authorizes terminal disclaimers, states that "any patentee or applicant may disclaim . . . any terminal part of the term . . . of the *patent* granted or to be granted" (emphasis supplied) implies that, whereas complete disclaimers can be on a claim-by-claim basis, terminal disclaimers can only be of entire patents (i.e., of all claims in each patent). However, (1) the purpose of the quoted language from the first paragraph of 35 USC 253 was to preclude the former practice of revising a claim by disclaimer (i.e., of disclaiming part of the scope of a claim),<sup>84</sup> not to restrict complete disclaimers to individual claims as opposed to entire patents, and (2) the second paragraph of 35 USC 253 also provides that "any patentee or applicant may disclaim . . . the entire term . . . of the patent granted or to be granted", so the two paragraphs of that section are not as mutually exclusive as is sometimes supposed.

80. Concerning the difference in judicial treatment of administrative rules of the type embodied in the MPEP and of the type embodied in 37 CFR, see generally 1 Davis, *Administrative Law Treatise*, Chapt. 5, "Interpretative, Legislative and Retroactive Rules," particularly §5.03, "The Nature of the Distinction Between Interpretative and Legislative Rules." Concerning the CCPA's treatment of the MPEP in the reverse situation (i.e., where it is the PTO which seeks to ignore the admonitions of the MPEP), see *In re Kagham*, 387 F.2d 398 (CCPA 1967).

81. See, e.g., *In re Sarett*, 327 F.2d 1005, 1012 (CCPA 1964), and *In re Vogel*, 422 F.2d 438, 442 (CCPA 1970).

82. For instance, the difficulties faced by the Office in adequately searching applications for patents on computer programs was repeatedly advanced unsuccessfully by the Patent Office as a ground for holding claims directed to computer programs non-statutory.

83. The rationale for the requirement as expressed in the MPEP is also arguably inconsistent with the CCPA's holding to the effect that double patenting rejections can be based on claims in pending applications, *In re Hammell*, 332 F.2d 796, 797-98 (CCPA 1964), which are equally "subject to cancellation, amendment or renumbering."

84. See Federico, *Commentary on the New Patent Act*, printed at the front of Title 35 in the United State Code Annotated published by West Publishing Company, at p. 47, and Federico, *Statutory Disclaimers in Patent Law* (Paul Pearlman, Washington, D.C., 1935).

*Requirement That a Terminal Disclaimer Be Absolute Rather Than Conditional*

Section 1403 of the MPEP (3rd ed.) states that

The statute does not provide for conditional disclaimers and accordingly, a proposed disclaimer which is made contingent on the allowance of certain claims cannot be accepted.

That requirement is inconsistent at least in thrust with *Ex parte Fertig*,<sup>85</sup> referred to approvingly in *In re Jentoft*.<sup>86</sup> However, like the previously discussed requirement, it does not seem to have been challenged as yet. If and when it is challenged, it is predicted that it will not be upheld in view of the court's approving reference to *Ex parte Fertig* in *In re Jentoft* and in view of the first and third factors mentioned in the previous section as arguing against the validity of the complete patent requirement.

*Effect of a Complete Disclaimer of Earlier Claims*

The classic case on the effect of complete disclaimer of earlier claims is in *In re Hession*,<sup>87</sup> wherein a bare majority of a bitterly divided court held that the complete disclaimer of the earlier claims would not avoid a double patenting rejection in the later case.<sup>88</sup> However, whether the PTO itself would follow *Hession* today is somewhat questionable in view of *In re Hyman*.<sup>89</sup> It should also be noted that the complete disclaimer in *Hession* was filed *after* issuance of the first patent, and it is arguable that a complete disclaimer of the earlier claims filed *before* issuance of the first patent (as where it is decided to file a continuation too close to issuance of the first patent to get it withdrawn from issue under 37 CFR 1.313) would be effective to avoid a double patenting rejection in the later case.

85. 155 USPQ 475, 476-77 (POBA 1967).

86. 392 F.2d 633, 639 n. 6 (CCPA 1968). See also *In re Hession*, 296 F.2d 930, 931 and 932 (CCPA 1961) (treating "an offer . . . to file a disclaimer" much in the fashion of a conditional disclaimer), and *In re Purdy*, 393 F.2d 1010, 1014 (CCPA 1968) (dissenting opinion of Judges Smith and Rich).

87. 296 F.2d 930 (CCPA 1961).

88. Cf. also *In re Fischel*, 136 F.2d 254 (CCPA 1943), relied on by the *Hession* majority.

89. 185 USPQ 441 (PTO Solicitor 1975).

### *Double Patenting Rejections Based on Applications Rather Than Patents*

Actually, the term "double patenting" is somewhat deceptive, for it is clear that a double patenting rejection can be based on a claim in an application as well as a claim in a patent.<sup>90</sup>

### *Double Patenting Between Different Statutory Classes*

The leading case on double patenting between different statutory classes<sup>91</sup> is *In re Freeman*,<sup>92</sup> wherein the CCPA spoke as follows:

The claims of appellant's patent are process claims, whereas the claims here involved are product claims. However, since the product in each of the appealed claims is defined essentially in terms of the method by which it is made, the fact that the claims of the patent and the application are, technically, in different statutory classes, is not in itself, enough to avoid a rejection on the ground of double patenting.<sup>[93]</sup>

### *Double Patenting Between Design Claims*

Double patenting may be found between design claims just as it can be found between utility claims.<sup>94</sup> The leading case is *In re Geiger*,<sup>95</sup> which contains the following statement of the applicable general principles:

What . . . [previous double patenting cases involving utility claims] hold is that 35 U.S.C. §101 prohibits the granting of two or more patents *only* where the scope of protection de-

90. *In re Wetterau*, 356 F.2d 556 (CCPA 1966), and *In re Hammell*, 332 F.2d 796, 797-98 (CCPA 1964).

91. As used herein, the different "statutory classes" are those recited in 35 USC 101. Double patenting between the statutory classes recited in 35 USC 101 and the statutory class recited in 35 USC 171 is covered separately in the article by Richard Killworth in this issue. Also, statutory classes recited in 35 USC 101 should, of course, be distinguished from the PTO's prior-art classes, which were formerly thought relevant to the question of double patenting. *In re Coleman*, 189 F.2d 976, 980 (CCPA 1951).

92. 166 F.2d 178 (CCPA 1948).

93. 166 F.2d at 180. See also *In re Coleman*, 189 F.2d 976, 981 (CCPA 1951), *In re Horneman*, 194 F.2d 108, 113 (CCPA 1952), *In re Taylor*, 360 F.2d 232 (CCPA 1966), *In re Lyons*, 364 F.2d 1005, 1016 (CCPA 1966), and *In re Boylan*, 392 F.2d 1017, 1023 (CCPA 1965). But see *In re Sarett*, 327 F.2d 1005, 1007 (CCPA 1964) ("The claims [in the reference] define both processes and compounds. Only process claims are germane to the instant appeal, as the solicitor has made clear, since appellant claims processes."), and cf. *In re Bridgeford*, 357 F.2d 679, 683 n. 6 (CCPA 1966) (overruling *Freeman* on a different point).

94. *In re Ferguson*, 208 F.2d 366 (CCPA 1953), and *In re Russell*, 239 F.2d 387, 388 (CCPA 1956), and *In re Fee*, 397 F.2d 329 (CCPA 1968).

95. 425 F.2d 1276 (CCPA 1970).

fined by the claims is limited to the *identical subject matter*. That holding also applies to 35 U.S.C. §171. Thus, if the claims of a patent define a scope of protection which extends over *different* subject matter than those of an application, and such patent is *not* prior art within the sense of 35 U.S.C. §102, then there is no *statutory* bar to the granting of a patent on those claims. A terminal disclaimer would then be necessary to obviate a double patenting rejection (which would necessarily be predicated on case law) *only* when the differences are such as would make the subject matter claimed in the application a mere obvious variation of what is claimed in the patent taking prior art into consideration.<sup>[96]</sup>

*Effect of the Date of Filing of a Terminal Disclaimer*<sup>97</sup>

One of the most persistent misconceptions concerning double patenting law in the CCPA is that the CCPA has somehow authorized filing of terminal disclaimers at any time during prosecution, including after final rejection and even after affirmance of a double patenting rejection on appeal to the Board of Appeals. This misconception is founded on *In re Tanner*,<sup>98</sup> a double patenting case decided less than a year after the precedent-shattering cases of *In re Robeson*<sup>99</sup> and *In re Kaye*.<sup>100</sup> In *Tanner*, the majority of the court (over the dissent of two judges) remanded to the Board of Appeals "to determine the effect of . . . [a terminal disclaimer filed after appeal to the CCPA] on the issues presented by the appeal, taking into consideration *In re Robeson* . . . and *In re Kaye* . . ." However, it is clear that that case should be treated as an example of a "remand . . . to avoid an unnecessary appeal where the law has changed subsequent to the board's decision,"<sup>101</sup> rather than as a case stating a special rule for terminal disclaimers. After adopting a similar course one more time in *In re Dunn*,<sup>102</sup>

96. 425 F.2d 1279; footnotes omitted; emphasis in the original.

97. This section deals only with the effect of the date of filing a terminal disclaimer during prosecution of an application. The effect of the date of filing a terminal disclaimer after issuance of a patent is dealt with in the article by Kenneth Kufner in this issue.

98. 343 F.2d 1018 (CCPA 1965) (per curiam).

99. 331 F.2d 610 (1964).

100. 332 F.2d 816 (CCPA 1964).

101. Dunner, *Court Review of Patent Office Decisions: CCPA* §4.11 at p. 4-85. See particularly *In re Heyl*, 379 F.2d 1018, 1021 (CCPA 1967).

102. 349 F.2d 433, 440 (CCPA 1965) (again over the dissents of two judges). See also Judge Baldwin's concurrence in *In re Jursich*, 410 F.2d 803, 807 (CCPA 1969).

the court has consistently refused either to consider or to order the Patent Office to consider untimely filed terminal disclaimers.<sup>103</sup>

*Filing a Continuation Application in Order to Get a Terminal Disclaimer into the Record*

So what is an applicant who wants to challenge a double patenting rejection on the merits but who wants to get at least the shortened term if he loses to do, if he can't file a conditional terminal disclaimer and can't file an unconditional terminal disclaimer after final rejection, much less after decision by the board or the court on appeal? Clearly, his remedy is to file a continuation application and to file the terminal disclaimer in the continuation application.<sup>104</sup>

*Conclusion*

The factual situations in which a double patenting question can arise during prosecution are extremely diverse, and surely we have not heard the last word from the CCPA concerning many of them. However, the work which it has done to date has gone far towards bringing order out of the chaos which prevailed before in this important area of the law. As the leading modern commentators on patent law wrote in 1970 of the then-recent opinions of the CCPA on this subject:

They bear witness to the painstaking care the CCPA has exercised in the finest tradition of the common law. As a consequence, patent practitioners, despite the complexity of the subject, can know with reasonable certainty what results their acts and omissions in prosecution will produce in the double-patenting realm insofar as the prospects for issuance are concerned.<sup>[105]</sup>

103. *In re Heyl*, 379 F.2d 1018, 1021 (CCPA 1967) (containing a good discussion on this point), *In re Purdy*, 393 F.2d 1010, 1011 (CCPA 1968), *In re Rogers*, 394 F.2d 566, 571 (CCPA 1968), *In re Aldrich*, 398 F.2d 855, 856 (CCPA 1968), *In re Jursich*, 410 F.2d 803, 807 (CCPA 1969), *In re Thorington*, 418 F.2d 528, 533-34 (CCPA 1969), and *In re Deters*, 515 F.2d 1152, 1156 (CCPA 1975). The CCPA's analogizing of the late filing of a terminal disclaimer to the late filing of a Rule 131 affidavit, 515 F.2d at 1156, is, however, less than compelling in view of the gross disparity in the time required for an examiner to check a terminal disclaimer for compliance with the rule and the time required for an examiner to determine whether a Rule 131 declaration is sufficient to carry a claim (or, usually, many claims) back of a reference date. And compare *In re Rinehart*, 531 F.2d 1048, 1050, n. 5, 189 USPQ 143, 145 n. 5 (CCPA 1976), wherein the CCPA apparently did consider an express abandonment of the reference patent filed after the board's decision.

104. *In re Jursich*, 410 F.2d 803, 807 (CCPA 1969) (semble), *In re Irish*, 433 F.2d 1342, 1344 (CCPA 1970) (good authority), and *In re Swett*, 451 F.2d 631, 634 n. 3 (CCPA 1971).

105. Pat. L. Persp. §A.6 (1969-70 A/R) at A.6-1.