

Patently Obvious?

BY TEDDY S. GRON

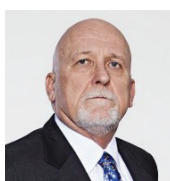
By allowing secondary considerations, such as unexpected results, to overcome obviousness-type double-patenting rejections, is the federal circuit circumventing the purpose for the rejections? If the purpose for court-created rejections is relatively unimportant, perhaps the courts should end the practice.

THE PURPOSE FOR REJECTING AN OBVIOUSNESS-TYPE DOUBLE PATENTING “is to prevent the extension of the term of the patent ... by prohibiting the issuance of [the] claims in a second patent not patentably distinct from the claims of the first patent.”¹

Apparently, however, the timewise extensions that federal circuit courts found “improper” from 1985 to 2011 are no longer improper. That is very good news for patent applicants. But, rather than acknowledge that the intent of the judicially created doctrine of obviousness-type double patenting has been limited, the federal circuit merely advises the public that it may no longer act on the assumption that, upon expiration of the patent, it will be free to use an invention not patentably distinct from the invention claimed when the patentee produces secondary evidence of nonobviousness.

Does this support a legal fiction—that an invention claimed in the second patent would not have been obvious in view of, and therefore is patentably distinct from, the invention claimed in the first patent?

1. *In re Longi*, 759 F.2d 887, 892 (Fed. Cir. 1985).



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Secondary evidence of nonobviousness may take the form of unexpected results, commercial success, long-felt need, etc. By providing secondary evidence of nonobviousness, patentees are able to undermine or circumvent the basic purpose for judicially creating the doctrine of obviousness-type double patenting.

If such a circumvention is not discouraged, the federal circuit should acknowledge that the doctrine of obviousness-type double patenting's basic purpose has been diminished in favor of incentives to improve inventions and to publish those improvements.

Therefore, I propose that rejections for obviousness-type double patenting of inventions claimed in a patentee's second patent that are not patentably distinct from inventions claimed in the patentee's first patent should be discontinued when the invention claimed in the second patent is not anticipated by the claims of the first patent. Legal precedent and common sense support this proposal.

Obviously not

Until recently, courts prioritized the intent of the obviousness-type double patenting doctrine. Consider *In re Longi*, in which the federal circuit stated:

The public should be able to act on the assumption that upon the *expiration* of the patent it will be free to use not only the invention claimed in the patent but modifications or variants 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 in the art and prior art other than the invention claimed in the issued patent.²

And stated by the federal circuit in *In re Braat*: Obviousness-type double patenting is a judicially created doctrine intended to prevent im-

proper timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not "patentably distinct" from the claims of a first patent.³

Finally, in *Ex parte Francis Y.F. Lee*, the Board of Patent Appeals and Interferences, following the relevant legal precedent at the time, concluded:

We agree ... with the Examiner that "while a Declaration showing unexpected results can overcome a 103(a) obviousness rejection, the same Declaration cannot overcome an obviousness double patenting rejection."⁴

Let us try to understand the practical significance of those decisions and of more recent decisions departing from them.

The forest for some trees

Presume that in the year 2000, the king granted Bob the woodcutter a first patent with an exclusive right for no more than 17 years to cut down all the trees in the king's forest and sell them for firewood. Bob cuts down and sells all the trees in a portion of the forest for five years. In 2005, Bob asks the king to grant him a second patent with the exclusive right for no more than 17 years to cut down oak trees in the king's forest and sell them for firewood because Bob discovered that oak trees unexpectedly burn longer and hotter than all other kinds of trees, and firewood from oak trees sells much better than the other firewood.

The king informs Bob that he was granted the exclusive right to cut down and sell wood from any and all trees in the king's forest, including oak trees, for the previous 5 years.

2. *Id.* at 892-93.

3. *In re Braat*, 937 F.2d 589, 592 (Fed. Cir. 1991) (citation omitted).

4. *Ex parte Francis Y.F. Lee*, Appeal 2011-002616 (BPAI 2011).

TAKEAWAYS >>

- Secondary evidence of nonobviousness may take the form of unexpected results, commercial success, long-felt need, etc.
- The rejection of an obviousness-type double patent might turn on the extent to which the innovation of a second patent is anticipated by the claims of the first patent.
- The federal circuit has affirmed that new claims in a second patent limited to the species of a genus were not invalid for obviousness-type double patenting when there would have been no reasonable expectation of the level of success achieved with that species.

BY PROVIDING SECONDARY EVIDENCE OF NONOBVIOUSNESS, PATENTEES ARE ABLE TO UNDERMINE OR CIRCUMVENT THE BASIC PURPOSE FOR JUDICIALLY CREATING THE DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING.

Therefore, any new grant of an exclusive right to cut down and sell oak trees for firewood must terminate upon expiration of the first patent grant, i.e., in 12 years. If the king would grant Bob a new exclusive right to cut down and sell firewood from oak trees for 17 years, Bob will have the exclusive right to cut down and sell wood from oak trees for firewood for a total of 22 years—an extended period of time the king never intended to grant.

Regardless of Bob's presentation of secondary evidence of nonobviousness showing that oak trees unpredictably burn longer and hotter than all other trees and have achieved great commercial success, oak trees were trees and still are trees, and Bob has had the exclusive right to cut down any and all kinds of trees in the king's forest and sell the firewood for the past five years.

This line of reasoning appears to have been taken for granted until 2012,

when the federal circuit decided *Otsuka Pharmaceutical Co. v. Sandoz, Inc.*⁵

On remand of the 2011 decision on appeal in *Ex parte Francis Y.F. Lee*, for reconsideration in light of *Otsuka*, the Patent Trial and Appeal Board reversed the previous holding of obviousness-type double patenting for the following reasons:

Subsequent to our decision, the Federal Circuit decided the case of *Otsuka Pharm. Co. v. Sandoz, Inc.*; the *Otsuka* decision cast doubt on the reading of the case law that we relied on in the Decision. ... The court held that *Geneva* was distinguishable ... because it “involved nonstatutory double patenting based on anticipation, not obviousness For anticipation, of course, motivation in the prior art is unimportant.” ... The *Otsuka* court held that “neither *Geneva* nor *Proctor & Gamble* stands for the proposition that, in considering whether one compound is an obvious variant of another for purposes of nonstatutory double patenting, analyzing the compound of the prior claim for a reason or motivation to modify is irrelevant.” The *Otsuka* court held that, like the analysis under § 103, “an analysis of nonstatutory obviousness-type double patenting ... entails determining, *inter alia*, whether one of ordinary skill in the art would have had reason or motivation to modify the earlier claimed compound to make the compound of the asserted claim with reasonable expectation of success.” ... Based on the *Otsuka* decision, therefore, we conclude that the statements in *Geneva* and *Proctor & Gamble* should not be taken at face value, and should be understood to apply only to instances where the rejection for obviousness-type double patenting is based on anticipation; e.g., a broader claim to a genus being anticipated by an earlier claim to a species within the genus. That is not the case here Thus,

under *Otsuka*, the evidence of unexpected results should be considered with regard to the obviousness-type double patenting rejection.⁶

More recently, and consistent with the Board's final decision and supporting rationale in *Ex parte Francis Y.F. Lee*, the federal circuit concluded in *UCB, Inc. v. Accord Healthcare, Inc.*,⁷ that the secondary evidence of nonobviousness showed that there would have been no reasonable expectation of the level of success achieved using the claimed species even though the claimed species would have been obvious in view of the genus of compounds claimed in the earlier UCB patent filed by the same inventor. Therefore, the federal circuit affirmed the district court's conclusion that the new claims in a second patent limited to the species were not invalid for obviousness-type double patenting.

What the federal circuit held in *UCB*, and what the Board held in *Ex parte Francis Y.F. Lee* on remand from the federal circuit in light of the decision in *Otsuka*, is that consideration of secondary evidence of nonobviousness, including evidence of unexpected results, commercial success, long-felt need, etc., must be considered when determining the merits of rejections of claims for obviousness under 35 U.S.C. § 103 and for obviousness-type double patenting.

Therefore, contrary to the stated purpose of the judicially created doctrine of obviousness-type double patenting in *In re Longi*,⁸ the public is no longer able to act on the assumption that upon the expiration of the first-issued patent that it would be free to use not only the invention claimed in the patent but all modifications or variants that would have been *prima facie obvious* to persons of ordinary skill in the art at the time the invention was made.

ISBA RESOURCES >>

- Kenneth Matuszewich, *Quick Takes for Your Practice: Intellectual Property Basics—Patents*, ISBA Quick Takes (May 22, 2019), youtu.be/VXxG_VMK860.
- Michael J. Weil, *USPTO Gives Patent Examiners New Subject Matter Eligibility Guidelines Following Vanda*, Intellectual Property (Nov. 2018), law.isba.org/2MdnG3z.
- Martin B. Robins, *Patent, Trade Secrets, or Both: A General Practitioner's Guide*, 103 Ill. B.J. 40 (Feb. 2015), law.isba.org/20jKzoH.

5. *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.2d 1280 (Fed. Cir. 2012).

6. *Ex parte Francis Y.F. Lee*, Appeal 2011-002616 (PTAB 2013) (emphasis added) (internal citations omitted).

7. *UCB, Inc. v. Accord Healthcare, Inc.*, No. 2016-2610 (Fed. Cir. May 23, 2018).

8. *In re Longi*, 759 F.2d 887, 892-893 (Fed. Cir. 1985).

The root of the matter

It appears from the federal circuit's decisions starting in 2012 that it is no longer necessary or relatively important to prevent timewise extensions of patent rights for inventions that are not anticipated by the claims of a first patent but otherwise are not patentably distinct from the claims of the first patent. Thus, the primary purpose for judicially creating the doctrine of obviousness-type double patenting now appears to be relatively unimportant.

In that light, let us return to Bob the woodcutter and his claim to the king's forest full of oak trees. If, according to *UCB*, Bob establishes that the oak trees in the king's forest unexpectedly burn longer and hotter than all other trees in the forest and firewood from oak trees has greater commercial value than other firewood, the king must now grant Bob a second patent, which entitles him to cut down and sell oak trees from the king's forest for a period of time greater than the king ever intended to grant, i.e., without filing a terminal disclaimer.

The doctrine of obviousness-type double patenting was judicially created. The courts created it, and the courts can take it away when it no longer serves a useful purpose. But a reasonable explanation by the federal circuit *en banc*

is required to reverse conclusions of the Court of Customs and Patent Appeals.


Bob cut down oak trees and sold them for firewood consistent with the rights awarded to Bob as patentee of the first patent. The federal circuit now says it is acceptable to grant the second patent for an additional 17 years based on the legal fiction that oak trees are not trees and after Bob has cut down and sold for firewood all kinds of trees from at least a portion of the king's forest.

But to summarily conclude that a species is "patentably distinct" from a genus, including the species based on secondary evidence of nonobviousness, does not adequately explain why Bob should be granted an extended right to exclude others from cutting down oak trees from the king's forest for a period of time far beyond the initial period they were excluded from all kinds of trees from the king's forest.

Therefore, if the doctrine of obviousness-type double patenting is archaic, the judicial creator should admit it. If the purpose for the doctrine is now relatively less important than the need to grant extended patent rights to patentees claiming patentably distinct improvements and the doctrine no longer promotes the useful arts, the judicial creator should terminate its application. Otherwise, the courts may

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need to justify their decisions with legal fictions.

As a matter of fact, oak trees are trees. But if the doctrine of obviousness-type double patenting is dead, the courts will better promote and serve the useful arts by burying it, at least to the extent that the species of a first patent does not anticipate the genus of a second patent and the genus of the first patent does not anticipate the species of the second patent. Promotion of the useful arts and clarification of applicable law demand no less. 

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