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Double Patenting Drama: Recent Cases and USPTO Proposals

September 3, 2024

The legal framework for obviousness-type double patenting (ODP) and its relationship to patent term adjustment (PTA) continues to evolve. In *Gilead*, the Federal Circuit held that a later-issued but earlier-expiring patent is a proper ODP reference against an earlier-issued, later-expiring patent (at least when different priority chains are involved), but left open the question of an extra patent term due to statutorily granted PTA or patent term extension (PTE). In *Novartis*, the Federal Circuit held that ODP cannot truncate the PTE portion of another patent, stating that ODP must be considered *before* PTE is added to the patent term. Many assumed a similar rule would prevail for PTA. However, in *In re Cellect*, the Federal Circuit held that key differences in statutory language meant that an ODP reference *can* truncate PTA. In other words, the expiration date used for an ODP analysis is the expiration date *after* the PTA is added, which leaves PTA of a later-expiring patent subject to ODP attack.

Cellect left certain questions unanswered – primarily whether a later-filed but earlier-expiring patent could be used to truncate the term of an earlier-filed but later-expiring (because of PTA) patent in the same priority chain. Notably, this scenario is very common: an earlier patent often involves Patent Office delays while subsequent continuations move through quickly. Subsequent district court cases came out on different sides of this question. Recently, in *Allergan*, the Federal Circuit clarified that a first-filed, first-issued, later-expiring claim cannot be invalidated under ODP by a later-filed, later-issued, earlier-expiring reference patent with a shared priority date. Even though this was essentially the same fact pattern as in *Cellect*, the Court noted that this specific issue wasn't fully raised in *Cellect* and reached a different conclusion. In sum, while *Cellect* holds that PTA can indeed be truncated by ODP, *Allergan* helpfully clarifies that PTA of an earlier-filed, earlier-issued, later-expiring patent is not put at risk by earlier-expiring continuation applications that do not have as much PTA.