

Non-Statutory Double Patenting Rejections and Terminal Disclaimers

by Dana Tangren

Patent applicants who are seeking to broadly protect an invention will often file multiple patent applications on the same invention, each application having claims of different scope. In this case, a non-statutory double patenting rejection may be issued to reject one or more of the claims of one of the pending patent applications (“examined claims”) as failing to be “patentably distinct” from the claims of one of the other applications (or patents issued thereon) (“referenced claims”), even if the applications are commonly owned. The most common type of non-Statutory double patenting rejection is the “obviousness type,” i.e., the examined claims are deemed “obvious” in view of the referenced claims. Several considerations should be made when addressing a non-statutory double patenting rejection (NSDPR).

Initially, a NSDPR can only be issued where there is some commonality between the applications. For example, generally for an NSDPR to issue the applications must have at least one common inventor, be commonly assigned, be filed by a common applicant, or be subject to a joint research agreement. When issuing the rejection, the examiner has the burden of showing the differences between examined claims and the referenced claims and providing a reason why a person of ordinary skill in the art would conclude that the invention defined by the examined claims would have been an obvious variation of the invention defined by the referenced claims.

If the rejection is properly made, the applicant can attempt to overcome the rejection by presenting arguments that support that the examined claims are patentably distinct from the referenced claims, i.e., the examined claims are not obvious. Alternatively, the applicant can cancel the conflicting claims, amend the claims so as not to conflict, or, if both applications are still pending, move all of the conflicting claims to one application.

Another option to overcome a NSDPR is to file a terminal disclaimer. By filing a terminal disclaimer, the applicant agrees: (1) that the patent that issues from the application having the examined claims will have the same term as the patent that issues from the application having the referenced claims; and (2) that the two issued patents can only be enforced as long as they are jointly owned. A terminal disclaimer is an easy and simple way to address a

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NSDPR. However, depending on the facts, filing a terminal disclaimer can potentially have undesirable consequences.

When filing a terminal disclaimer, the following considerations should be given. (1) Will filing a terminal disclaimer significantly shorten the length of the entitled patent term? If so, you may first wish to try to rebut the rejection before filing the terminal disclaimer. (2) Remember that a terminal disclaimer operates against all claims within a patent, i.e., you cannot disclaim the term of only specified claims. (3) A filed terminal disclaimer can be withdrawn prior to issuance of the patent by submitting a petition under 37 CFR 1.182. This may be desirable if the rejected claims are later cancelled, are shown to be patentably distinct or if the examiner later withdraws the double patenting rejection. However, once the patent issues, the terminal disclaimer cannot be withdrawn. (4) There is no requirement that both patents be jointly owned when filing a terminal disclaimer. Accordingly, because the patents can only be enforced when they are jointly owned and because the terminal disclaimer cannot be withdrawn after the patents have issued, it is critical to ensure that the patents are jointly owned prior to filing a terminal disclaimer and that they stay commonly owned after filing. See *In re Dinsmore*, 757 F. 3d 1343 (Fed. Cir. 2014). (5) In some situations, a terminal disclaimer can be filed after issuance of the patents to prospectively overcome a double patenting rejection. See *Perricone V. Medicis Pharmaceutical Corp.*, 432 F. 3d 1368 (Fed. Cir. 2005).

In conclusion, when a NSDPR is issued, depending on the facts, there may be a variety of different options for responding to the rejection. To avoid the loss of patent term, and because of the requirement that the patents always be jointly owned, consideration should first be given to trying to overcome the rejection before filing a terminal disclaimer. If a terminal disclaimer is filed, care should be taken to first ensure common ownership between the patents. Likewise, facts should be reviewed to determine whether the terminal disclaimer should be withdrawn prior to payment of the issue fee.