

MPEP 804 II B

Nov 2024 804 II B	2022 804 II B	2019 804 II B
<p>B. Nonstatutory Double Patenting</p> <p>A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. <i>In re Goodman</i>, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); <i>In re Longi</i>, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); <i>In re Van Ornum</i>, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); <i>In re Vogel</i>, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); <i>In re Thorington</i>, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); <i>In re White</i>, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); <i>In re Schneller</i>, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); <i>In re Sarett</i>, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964). A double patenting rejection also serves public policy interests by preventing the possibility of multiple suits against an accused infringer by different assignees of patents claiming patentably indistinct variations of the same invention. <i>In re Van Ornum</i>, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982).</p> <p>A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either</p>	<p>B. Nonstatutory Double Patenting</p> <p>A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. <i>In re Goodman</i>, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); <i>In re Longi</i>, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); <i>In re Van Ornum</i>, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); <i>In re Vogel</i>, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); <i>In re Thorington</i>, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); <i>In re White</i>, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); <i>In re Schneller</i>, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); <i>In re Sarett</i>, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964). A double patenting rejection also serves public policy interests by preventing the possibility of multiple suits against an accused infringer by different assignees of patents claiming patentably indistinct variations of the same invention. <i>In re Van Ornum</i>, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982).</p> <p>A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either</p>	<p>B. Nonstatutory Double Patenting</p> <p>A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. <i>In re Goodman</i>, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); <i>In re Longi</i>, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); <i>In re Van Ornum</i>, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); <i>In re Vogel</i>, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); <i>In re Thorington</i>, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); <i>In re White</i>, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); <i>In re Schneller</i>, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); <i>In re Sarett</i>, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964). A double patenting rejection also serves public policy interests by preventing the possibility of multiple suits against an accused infringer by different assignees of patents claiming patentably indistinct variations of the same invention. <i>In re Van Ornum</i>, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982).</p> <p>A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either</p>

anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is: Is any invention claimed in the application anticipated by, or an obvious variation of, an invention claimed in the patent? If the answer is yes, then a nonstatutory double patenting rejection may be appropriate. To decide the question above, the examiner should first construe the claim(s) in the application under examination and the claim(s) in the reference application or patent to determine what are the differences. Then the examiner should determine whether those differences render the claims patentably distinct using an anticipation analysis and/or an obviousness analysis. See *Pfizer, Inc. v. Teva Pharms. USA, Inc.*, 518 F.3d 1353, 1363, 86 USPQ2d 1001, 1008 (Fed. Cir. 2008).

Nonstatutory double patenting also requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent, or a non-commonly owned patent but subject to a joint research agreement as set forth in [35 U.S.C. 102\(c\)](#) or [pre-AIA 35 U.S.C. 103\(c\)\(2\)](#)

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and (3), when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1869 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000).

1. Construing the Claim Using the Reference Patent or Application Disclosure

When considering whether the invention defined in a claim of an application would have been anticipated by or is an obvious variation of the invention defined in the claim of a patent or copending application, no part of the reference patent or application may be used as if it were prior art.

General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1281, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992) ("Our precedent makes clear that the disclosure of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, even where the disclosure is found in the claims"). This does not mean that one is precluded from all use of the reference patent or application disclosure to understand the meaning of the reference claims.

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[In the 2019 MPEP, this next section appears later, after "obviousness analysis" and before "one way test for distinctness". I moved it here for purposes of comparison. – DJF]

(a) Construing the Claim Using the Reference Patent or Application Disclosure

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent or copending application, **the disclosure of the** patent may not be used as prior art.

General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).

This does not mean that one is precluded from all use of the reference patent or application disclosure.

<p>The specification can be used as a dictionary to learn the meaning of a term in the claim. <i>Toro Co. v. White Consol. Indus., Inc.</i>, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999) ("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."); <i>Renishaw PLC v. Marposs Societa' per Azioni</i>, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings."). "The Patent and Trademark Office ('PTO') determines the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" <i>Phillips v. AWH Corp.</i>, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc) (quoting <i>In re Am. Acad. of Sci. Tech. Ctr.</i>, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); see also MPEP § 2111.01. Further, those portions of the specification which provide support for the reference claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the reference patent or application (as</p>	<p>The specification can be used as a dictionary to learn the meaning of a term in the claim. <i>Toro Co. v. White Consol. Indus., Inc.</i>, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999) ("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."); <i>Renishaw PLC v. Marposs Societa' per Azioni</i>, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings."). "The Patent and Trademark Office ('PTO') determines the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" <i>Phillips v. AWH Corp.</i>, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc) (quoting <i>In re Am. Acad. of Sci. Tech. Ctr.</i>, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); see also MPEP § 2111.01. Further, those portions of the specification which provide support for the reference claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the reference patent or application (as</p>	<p>The specification can be used as a dictionary to learn the meaning of a term in the claim. <i>Toro Co. v. White Consol. Indus., Inc.</i>, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."); <i>Renishaw PLC v. Marposs Societa' per Azioni</i>, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings."). "The Patent and Trademark Office ('PTO') determines the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.'" <i>Phillips v. AWH Corp.</i>, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (en banc) (quoting <i>In re Am. Acad. of Sci. Tech. Ctr.</i>, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); see also MPEP § 2111.01. Further, those portions of the specification which provide support for the reference claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the reference patent or application (as</p>
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<p>distinguished from an obvious variation of the subject matter disclosed in the reference patent or application). <i>In re Vogel</i>, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in <i>Vogel</i> recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent or application which provides support for the claim. According to the court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out 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." <i>In AbbVie Inc. v. Kennedy Institute of Rheumatology Trust</i>, 764 F.3d 1366, 112 USPQ2d 1001 (Fed. Cir. 2014), the court explained that it is also proper to look at the disclosed utility in the reference disclosure to determine the overall question of obviousness in a nonstatutory double patenting context. See <i>Sun Pharm. Indus., Ltd. v. Eli Lilly & Co.</i>, 611 F.3d 1381, 95 USPQ2d 1797 (Fed. Cir. 2010); <i>Pfizer, Inc. v. Teva Pharm. USA, Inc.</i>, 518 F.3d 1353, 86</p>	<p>distinguished from an obvious variation of the subject matter disclosed in the reference patent or application). <i>In re Vogel</i>, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in <i>Vogel</i> recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent or application which provides support for the claim. According to the court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out 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." <i>In AbbVie Inc. v. Kennedy Institute of Rheumatology Trust</i>, 764 F.3d 1366, 112 USPQ2d 1001 (Fed. Cir. 2014), the court explained that it is also proper to look at the disclosed utility in the reference disclosure to determine the overall question of obviousness in a nonstatutory double patenting context. See <i>Sun Pharm. Indus., Ltd. v. Eli Lilly & Co.</i>, 611 F.3d 1381, 95 USPQ2d 1797 (Fed. Cir. 2010); <i>Pfizer, Inc. v. Teva Pharm. USA, Inc.</i>, 518 F.3d 1353, 86</p>	<p>distinguished from an obvious variation of the subject matter disclosed in the reference patent or application). <i>In re Vogel</i>, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in <i>Vogel</i> recognized "that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim," but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent or application which provides support for the claim. According to the court, one must first "determine how much of the patent disclosure pertains to the invention claimed in the patent" because only "[t]his portion of the specification supports the patent claims and may be considered." The court pointed out 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." <i>In AbbVie Inc. v. Kennedy Institute of Rheumatology Trust</i>, 764 F.3d 1366, 112 USPQ2d 1001 (Fed. Cir. 2014), the court explained that it is also proper to look at the disclosed utility in the reference disclosure to determine the overall question of obviousness in a nonstatutory double patenting context. See <i>Sun Pharm. Indus., Ltd. v. Eli Lilly & Co.</i>, 611 F.3d 1381, 95 USPQ2d 1797 (Fed. Cir. 2010); <i>Pfizer, Inc. v. Teva Pharm. USA, Inc.</i>, 518 F.3d 1353, 86</p>
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USPQ2d 1001 (Fed. Cir. 2008); *Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC*, 349 F3d 1373, 1385-86, 68 USPQ2d 1865, 1875 (Fed. Cir. 2003).

To avoid improperly treating what is disclosed in a reference patent or copending application as if it were prior art in the context of a nonstatutory double patenting analysis, the examiner must first properly construe the scope of the reference claims.

The portion of the specification of the reference that describes subject matter that falls within the scope of a reference claim may be relied upon to properly construe the scope of that claim. In particular, when ascertaining the scope of the reference's claim(s) to a compound, the examiner should consider the reference's specification, including all of the compound's uses that are disclosed. See *Sun Pharm. Indus.*, 611 F.3d at 1386-88, 95 USPQ2d at 1801-02. If claims to the compound's use and the compound were subject to a restriction requirement, and the compound was elected, a nonstatutory double patenting rejection may not be appropriate in a divisional application claiming the restricted compound's use.

See [MPEP § 804.01](#). However, subject matter disclosed in the reference patent or application that does not fall within the scope of a reference claim cannot be used to support a nonstatutory double patenting rejection as this would effectively be treating

USPQ2d 1001 (Fed. Cir. 2008); *Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC*, 349 F3d 1373, 1385-86, 68 USPQ2d 1865, 1875 (Fed. Cir. 2003).

To avoid improperly **treating what is disclosed in** a reference patent or copending application as **if it were** prior art in the context of a nonstatutory double patenting analysis, the examiner must first properly construe the scope of the reference claims.

The portion of the **specification of the** reference that describes subject matter that falls within the scope of a reference claim may be relied upon to properly construe the scope of that claim. In particular, when ascertaining the scope of the reference's claim(s) to a compound, the examiner should consider the reference's specification, including all of the compound's uses that are disclosed. See *Sun Pharm. Indus.*, 611 F.3d at 1386-88, 95 USPQ2d at 1801-02. If claims to the compound's use and the compound were subject to a restriction requirement, and the compound was elected, a nonstatutory double patenting rejection may not be appropriate in a divisional application claiming the restricted compound's use.

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See [MPEP § 804.01](#). However, subject matter disclosed in the reference patent or application that does not fall within the scope of a reference claim cannot be used to **construe the claim in the context of a** nonstatutory double patenting **analysis** as

the reference patent or application as prior art.
Properly construing the reference claims does not complete the nonstatutory double patenting analysis. It merely provides a determination as to how the earlier issued claim should be understood in making a nonstatutory double patenting rejection. To do a full analysis to determine whether a nonstatutory double patenting rejection should be made, one must go through the "anticipation analysis" and "obviousness analysis" noted below, and consider the "nonstatutory double patenting rejection based on equitable principles" discussed in subsection II.B.6 below. In construing the claims of the reference patent or application, a determination is made as to whether a portion of the specification, including the drawings and claims, is directed to subject matter that is within the scope of a reference claim. For example, assume that the claim in a reference patent is directed to a genus of compounds, and the application being examined is directed to a species within the reference patent genus. If the reference patent discloses several species within the scope of the reference genus claim, that portion of the disclosure should be analyzed to properly construe the reference patent claim and determine whether it anticipates or

the reference patent or application as prior art.
Properly construing the reference claims does not complete the nonstatutory double patenting analysis. It merely provides a determination as to how the earlier issued claim should be understood in making a nonstatutory double patenting rejection. To do a full analysis to determine whether a nonstatutory double patenting rejection should be made, one must go through the "anticipation analysis" and "obviousness analysis" noted below, and consider the "nonstatutory double patenting rejection based on equitable principles" discussed in subsection II.B.6 below. In construing the claims of the reference patent or application, a determination is made as to whether a portion of the specification, including the drawings and claims, is directed to subject matter that is within the scope of a reference claim. For example, assume that the claim in a reference patent is directed to a genus of compounds, and the application being examined is directed to a species within the reference patent genus. If the reference patent discloses several species within the scope of the reference genus claim, that portion of the disclosure should be analyzed to properly construe the reference patent claim and determine whether it anticipates or

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Relying on the disclosure to construe the reference claims does not complete the nonstatutory double patenting analysis. It merely provides a determination as to how the earlier issued claim should be construed in making a nonstatutory double patenting rejection. To do a full analysis to determine whether a nonstatutory double patenting rejection should be made, one must go through the "anticipation analysis" and "obviousness analysis" noted above, and consider the "nonstatutory double patenting rejection based on equitable principles" discussed in subsection II.B.3 below. In analyzing the disclosure of the reference patent or application, a determination is made as to whether a portion of the disclosure is directed to subject matter that is encompassed by the scope of a reference claim. For example, assume that the claim in a reference patent is directed to a genus of compounds, and the application being examined is directed to a species within the reference patent genus. If the reference patent includes a disclosure of several species within the scope of the reference genus claim, that portion of the disclosure should be analyzed to determine whether the reference patent claim, as properly construed in light of that disclosure, anticipates or

renders obvious the claim in the application being examined. Because that portion of the disclosure of the reference patent is an embodiment of the reference patent claim, it may be helpful in determining the full scope and obvious variations of the reference patent claim. As an alternative example, assume that the claim in the reference patent is directed to a genus of compounds, and the application being examined is directed to a method of making compounds within the genus. Further assume that the reference patent discloses a nearly identical method of making compounds within the genus. Here, the disclosed method of making the compounds in the reference patent does not fall within the scope of the genus of compounds claimed in the reference. Thus, the reference disclosure directed to the method of making the compounds cannot be used to construe the claim to the genus of compounds in the context of a nonstatutory double patenting analysis. This would effectively result in treating the reference as prior art. Nevertheless, there may be cases in which permitting claims to a method of making a compound could essentially result in an unjustified timewise extension of the period of exclusivity for the compound itself. In such cases, the "Nonstatutory Double Patenting Rejection Based on Equitable Principles" discussed in paragraph II.B.6 below should be considered. Cf. *Geneva Pharmaceuticals Inc.*

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renders obvious the claim in the application being examined. Because that portion of the disclosure of the reference patent is an embodiment of the reference patent claim, it may be helpful in determining obvious variations of the reference patent claim. As an alternative example, assume that the claim in the reference patent is directed to a genus of compounds, and the application being examined is directed to a method of making compounds within the genus. Further assume that the reference patent discloses a nearly identical method of making compounds within the genus. Here, the disclosed method of making the compounds in the reference patent does not fall within the scope of the genus of compounds claimed in the reference. Thus the reference disclosure directed to the method of making the compounds cannot be used to construe the claim to the genus of compounds in the context of a nonstatutory double patenting analysis. This would effectively result in treating the reference **disclosure** as prior art. Nevertheless, there may be cases in which permitting claims to a method of making a compound could essentially result in an unjustified timewise extension of the period of exclusivity for the compound itself. In such cases, the "Nonstatutory Double Patenting Rejection Based on Equitable Principles" discussed in paragraph **II.B.3** below should be considered. Cf. *Geneva Pharmaceuticals Inc.*

v. GlaxoSmithKline PLC, 349 F.3d 1373, 1385-86, 68 USPQ2d 1865, 1875 (Fed. Cir. 2003) (rejecting claims to methods of use over claims to compound based on unjustified timewise extension rationale).
The result in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) is consistent with the analysis set forth above. In *Schneller*, the examined claims were directed to a clip comprising ABCY and a clip comprising ABCXY; the reference patent claimed a clip comprising ABCX and disclosed an embodiment of a clip having ABCXY. The ABCXY clip disclosed in the reference patent falls within the scope of the reference patent claim to a clip "comprising ABCX." Thus the disclosed embodiment of ABCXY may be relied upon to properly construe the scope of the reference claim and determine the propriety of a nonstatutory double patenting rejection against the examined claim. However, nonstatutory double patenting rejections based on *Schneller* **will be rare**. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate, the examiner should first consult with the examiner's supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made. See

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subsection II.B.6 below for a more detailed discussion.
Each nonstatutory double patenting situation must be decided on its own facts.

2. Anticipation Analysis

A nonstatutory double patenting rejection is appropriate where a claim in an application under examination claims subject matter that is different, but not patentably distinct, from the subject matter claimed in a prior patent or a copending application. The claim under examination is not patentably distinct from the reference claim(s) if the claim under examination is anticipated by the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015-16 (Fed. Cir. 1993). This type of nonstatutory double patenting situation arises when the claim being examined is, for example, generic to a species or sub-genus claimed in a conflicting patent or application, i.e., the entire scope of the reference claim falls within the scope of the examined claim. In such a situation, a later patent to a genus would, necessarily, extend the right to exclude granted by an earlier patent directed to a species or sub-genus. In this type of nonstatutory double patenting situation, an obviousness analysis is not required for the nonstatutory double patenting rejection. The nonstatutory double patenting rejection in this case should explain the fact that the

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<p>species or sub-genus claimed in the conflicting patent or application anticipates the claimed genus in the application being examined and, therefore, a patent to the genus would improperly extend the right to exclude granted by a patent to the species or sub-genus should the genus issue as a patent after the species or sub-genus.</p> <p>The analysis required is different in situations where the claim in the application being examined (1) is directed to a species or sub-genus covered by a generic claim in a potentially conflicting patent or application, or (2) overlaps in scope with a claim in a potentially conflicting claim or claims of the patent or application but the potentially conflicting claims cannot be said to anticipate the examined claims. Both of these situations require an obviousness analysis unless one of ordinary skill in the art would, on reading the potentially conflicting patent or application, at once envisage the invention claimed in the examined application. See <i>AbbVie Inc. v. Kennedy Institute of Rheumatology Trust</i>, 764 F.3d 1366, 112 USPQ2d 1001 (Fed. Cir. 2014). For example, in the genus-species situation, the examiner typically should explain why it would have been obvious to select the claimed species or sub-genus given the genus claimed in the potentially conflicting patent or application. See MPEP § 2131.02 and MPEP § 2144.08 for discussions of genus-species situations with respect to anticipation and obviousness, respectively.</p>	<p>species or sub-genus claimed in the conflicting patent or application anticipates the claimed genus in the application being examined and, therefore, a patent to the genus would improperly extend the right to exclude granted by a patent to the species or sub-genus should the genus issue as a patent after the species or sub-genus.</p> <p>The analysis required is different in situations where the claim in the application being examined (1) is directed to a species or sub-genus covered by a generic claim in a potentially conflicting patent or application, or (2) overlaps in scope with a claim in a potentially conflicting claim or claims of the patent or application but the potentially conflicting claims cannot be said to anticipate the examined claims. Both of these situations require an obviousness analysis unless one of ordinary skill in the art would, on reading the potentially conflicting patent or application, at once envisage the invention claimed in the examined application. See <i>AbbVie Inc. v. Kennedy Institute of Rheumatology Trust</i>, 764 F.3d 1366, 112 USPQ2d 1001 (Fed. Cir. 2014). For example, in the genus-species situation, the examiner typically should explain why it would have been obvious to select the claimed species or sub-genus given the genus claimed in the potentially conflicting patent or application. See MPEP § 2131.02 and MPEP § 2144.08 for discussions of genus-species situations with respect to anticipation and obviousness, respectively.</p>	<p>species or sub-genus claimed in the conflicting patent or application anticipates the claimed genus in the application being examined and, therefore, a patent to the genus would improperly extend the right to exclude granted by a patent to the species or sub-genus should the genus issue as a patent after the species or sub-genus.</p> <p>The analysis required is different in situations where the claim in the application being examined (1) is directed to a species or sub-genus covered by a generic claim in a potentially conflicting patent or application, or (2) overlaps in scope with a claim in a potentially conflicting claim or claims of the patent or application but the potentially conflicting claims cannot be said to anticipate the examined claims. Both of these situations require an obviousness analysis unless one of ordinary skill in the art would, on reading the potentially conflicting patent or application, at once envisage the invention claimed in the examined application. See <i>AbbVie Inc. v. Kennedy Institute of Rheumatology Trust</i>, 764 F.3d 1366, 112 USPQ2d 1001 (Fed. Cir. 2014). For example, in the genus-species situation, the examiner typically should explain why it would have been obvious to select the claimed species or sub-genus given the genus claimed in the potentially conflicting patent or application. See MPEP § 2131.02 and MPEP § 2144.08 for discussions of genus-species situations with respect to anticipation and obviousness, respectively.</p>
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3. Obviousness Analysis

A nonstatutory double patenting rejection, if not based on an anticipation rationale or an "unjustified timewise extension" rationale, is "analogous to [a failure to meet] the nonobviousness requirement of **35 U.S.C. 103**" except that the patent disclosure principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Even though the specification of the applied patent or copending application is not prior art, it may still be used to interpret the applied claims. See paragraph II.B.1, above. The analysis employed with regard to nonstatutory double patenting is "similar to, but not necessarily the same as that undertaken under 35 USC § 103." *In re Braat*, 937 F.2d 589, 592-93, 19 USPQ2d 1289, 1292 (Fed. Cir. 1991) (citing *In re Longi*, 759 F.2d 887, 892 n.4, 225 USPQ 645, 648 n.4 (Fed. Cir. 1985)); see also *Geneva Pharmaceuticals*, 349 F.3d at 1378 n.1, 68 USPQ2d at 1869 n.1 (Fed. Cir. 2003); *In re*

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- (A) Determine the scope and content of a patent claim relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

Any nonstatutory double patenting rejection made under the obviousness analysis should make clear:

- (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

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Any nonstatutory double patenting rejection made under the obviousness analysis should make clear:

- (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

Any secondary reference used to support an obviousness analysis for a nonstatutory double patenting rejection must be prior art under [35 U.S.C. 102](#) or [pre-AIA 35 U.S.C. 102](#). See [MPEP § 2120](#) *et seq.* for more information on determining if a reference is prior art and [MPEP § 2141](#), subsection II.A, for determining the scope and content of the prior art.

4. One-Way Test for Distinctness

If the patent term filing date of an application under examination is the same or later than that of a reference application or patent, only a one-way determination of distinctness is needed in resolving the issue of double patenting, i.e., whether the invention claimed in the application would have been anticipated by, or an obvious variation of, the invention claimed in the reference application or patent. See, e.g., *In re Berg*, 140 F.3d 1428, 1435, 46 USPQ2d 1226, 1231-32 (Fed. Cir. 1998). The court in *Berg* applied a one-way test where an applicant filed two separate applications even though all claims could have been filed in a single application, because the applicant's action could have resulted in an

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- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

(b) One-Way Test for Distinctness

If the application under examination is the later-filed application, or both applications are filed on the same day, only a one-way determination of distinctness is needed in resolving the issue of double patenting, i.e., whether the invention claimed in the application would have been anticipated by, or an obvious variation of, the invention claimed in the patent. See, e.g., *In re Berg*, 140 F.3d 1438, 46 USPQ2d 1226 (Fed. Cir. 1998) (the court applied a one-way test where both applications were filed the same day).

improper timewise extension of rights if one patent expired later than the other. If a claimed invention in the application would have been obvious over a claimed invention in the patent, there would be an unjustified timewise extension of the patent and a nonstatutory double patenting rejection is proper. According to the *Berg* court, improperly extending the patent term "is precisely the result that the doctrine of obviousness-type double patenting was created to prevent." *Id.* See also [MPEP § 804](#), subsection II.B above.

Similarly, even if the application under examination has the earlier patent term filing date, only a one-way determination of distinctness is needed to support a double patenting rejection in the absence of a finding: (A) that "the PTO is solely responsible for any delays" in prosecution of that application (*In re Hubbell*, 709 F.3d 1140, 1150, 106 USPQ2d 1032, 1039 (Fed. Cir. 2013)); and (B) that the applicant could not have filed the conflicting claims in a single (i.e., the earlier-filed) application (*In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986)). In *Kaplan*, a generic invention (use of solvents) was invented by Kaplan, and a species thereof (i.e., use of a specific combination of solvents) was invented by Kaplan and Walker. Multiple applications were necessary to claim both the broad and narrow inventions because at the time the applications were filed, [35 U.S.C. 116](#) did not

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expressly authorize filing a patent application in the name of joint inventors who did not make a contribution to the invention defined in each claim in the patent. Compare *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998), wherein the genus and species claims could have been filed in the same application.

Form paragraph [8.33](#) and the appropriate one of form paragraphs [8.34](#) - [8.37](#) may be used to make nonstatutory double patenting rejections based on anticipation or obviousness analyses. See subsection II.B.6, below, and form paragraphs [8.38](#) and [8.39](#) if the basis for the nonstatutory double patenting rejection is equitable principles.

5. Two-Way Test for Distinctness

If a reference patent has a later patent term filing date than the application under examination, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application *and* the Office is solely responsible for any delays. *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998) ("The two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before

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(c) Two-Way Test for Distinctness

If the patent is the later-filed application,

the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application *and* the Office is solely responsible for any delays. *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998) ("The two-way exception can only apply when the applicant could not avoid separate filings, and even then, only if the PTO controlled the rates of prosecution to cause the later filed species claims to issue before

the claims for a genus in an earlier application In Berg's case, the two applications could have been filed as one, so it is irrelevant to our disposition who actually controlled the respective rates of prosecution." 140 F.3d at 1435, 46 USPQ2d at 1232); *In re Hubbell*, 709 F.3d 1140, 106 USPQ2d 1032 (Fed. Cir. 2013) ("[P]rosecution choices resulted in the foreseeable consequence that the '685 patent issued before the application claims on appeal. Given these circumstances, and because it is undisputed that the PTO was not solely responsible for the delay, Hubbell is not entitled to a two-way obviousness analysis." 709 F.3d at 1150, 106 USPQ2d at 1039.); see also *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993) (in a situation where delayed issuance equated to later expiration, applicant's voluntary decision to obtain early issuance of claims directed to a species and to pursue prosecution of previously rejected genus claims in a continuation is a considered election to postpone by the applicant and not administrative delay). Unless the record clearly shows administrative delay caused solely by the Office and that applicant could not have avoided filing separate applications, the examiner may use the one-way distinctness determination and shift the burden to applicant to show why a two-way distinctness determination is required. When making a two-way distinctness determination, where appropriate, it is

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other hand, the resolution of legitimate differences of opinion in an appeal process or the time spent in an interference proceeding can significantly delay the issuance of a patent. Nevertheless, the reasons for the delay in issuing a patent have been considered in assessing the propriety of a double patenting rejection. Thus, in *Pierce v. Allen B. DuMont Laboratories, Inc.*, 297 F.2d 323, 131 USPQ 340 (3d. Cir. 1961), the court found that administrative delay may justify the extension of patent rights beyond 17 years but "a considered election to postpone acquisition of the broader [patent after the issuance of the later filed application] should not be tolerated." In *Pierce*, the patentee elected to participate in an interference proceeding [after all claims in the application had been determined to be patentable] whereby the issuance of the broader patent was delayed by more than 7 years after the issuance of the narrower patent. The court determined that the second issued patent was invalid on the ground of double patenting. Similarly, in *In re Emert*, 124 F.3d 1458, 44 USPQ2d 1149 (Fed. Cir. 1997), the court found that the one-way test is appropriate where applicants, rather than the Office, had significant control over the rate of prosecution of the application at issue. In support of its finding that the applicants were responsible for delaying prosecution of the application during the

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critical period, the court noted that the applicants had requested and received numerous time extensions in various filings. More importantly, the court noted, after initially receiving an obviousness rejection of all claims, applicants had waited the maximum period to reply (6 months), then abandoned the application in favor of a substantially identical continuation application, then received another obviousness rejection of all claims, again waited the maximum period to reply, and then again abandoned the application in favor of a second continuation application substantially identical to the original filing. On the other hand, in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992), the court did not hold the patentee accountable for a delay in issuing the first-filed application until after the second-filed application issued as a patent, even where the patentee had intentionally refiled the first-filed application as a continuation-in-part after receiving a Notice of Allowance indicating that all claims presented were patentable. Where, through no fault of the applicant, the claims in a later-filed application issue first, a nonstatutory double patenting rejection is improper, in the absence of a two-way distinctness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office. *In re Braat*, 937 F.2d 589, 19 USPQ2d

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6. Nonstatutory Double Patenting

Rejection Based on Equitable Principles

In some circumstances a nonstatutory double patenting rejection is applicable based on equitable principles. Occasionally the fundamental reason for nonstatutory double patenting – to prevent unjustified timewise extension of patent rights – is itself enforceable no matter how the extension is brought about. Examples of this occurred in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); and *Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1385-86, 68 USPQ2d 1865, 1875 (Fed. Cir. 2003).

In *In re Schneller*, 397 F.2d 350, 158 USPQ 210, 216 (CCPA 1968), the court affirmed a double patenting rejection after summing up the situation as follows:

[I]n appellant's own terms: The combination ABC was old. He made two improvements on it, (1) adding X and (2) adding Y, the result still being a unitary clip of enhanced utility. While his invention can be practiced in the forms ABCX or ABCY, the greatest advantage and best mode of practicing the invention as disclosed is obtained by using both inventions in the combination ABCXY. His first application disclosed ABCXY and other matters. He obtained a patent claiming [a clip comprising] BCX and ABCX, . . . so claiming these combinations as to cover them *no matter what other feature is incorporated in them*, thus covering effectively ABCXY. He

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<p>now, many years later, seeks more claims directed to ABCY and ABCXY. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the expiration of his patent, were we to reverse.</p> <p>397 F.2d at 355-56, 158 USPQ at 216 (emphasis in original).</p> <p>The court recognized that "there is no double patenting in the sense of claiming the same invention because ABCX and ABCY are, in the technical patent law sense, different inventions. The rule against 'double patenting,' however, is not so circumscribed. The fundamental reason for the rule is to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about. To . . . prevail here, appellant has the burden of establishing that the invention claimed in his patent is 'independent and distinct' from the invention of the appealed claims.... [A]ppellant has clearly not established the independent and distinct character of the inventions of the appealed claims." 397 F.2d at 354-55, 158 USPQ at 214-15 (emphasis in original). The court observed:</p> <p>The controlling fact is that patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims. Under the circumstance of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or</p>	<p>now, many years later, seeks more claims directed to ABCY and ABCXY. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the expiration of his patent, were we to reverse.</p> <p>397 F.2d at 355-56, 158 USPQ at 216 (emphasis in original).</p> <p>The court recognized that "there is no double patenting in the sense of claiming the same invention because ABCX and ABCY are, in the technical patent law sense, different inventions. The rule against 'double patenting,' however, is not so circumscribed. The fundamental reason for the rule is to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about. To . . . prevail here, appellant has the burden of establishing that the invention claimed in his patent is 'independent and distinct' from the invention of the appealed claims.... [A]ppellant has clearly not established the independent and distinct character of the inventions of the appealed claims." 397 F.2d at 354-55, 158 USPQ at 214-15 (emphasis in original). The court observed:</p> <p>The controlling fact is that patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims. Under the circumstance of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or</p>	<p>now, many years later, seeks more claims directed to ABCY and ABCXY. Thus, protection he already had would be extended, albeit in somewhat different form, for several years beyond the expiration of his patent, were we to reverse.</p> <p>397 F.2d at 355-56, 158 USPQ at 216 (emphasis in original).</p> <p>The court recognized that "there is no double patenting in the sense of claiming the same invention because ABCX and ABCY are, in the technical patent law sense, different inventions. The rule against 'double patenting,' however, is not so circumscribed. The fundamental reason for the rule is to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about. To . . . prevail here, appellant has the burden of establishing that the invention claimed in his patent is 'independent and distinct' from the invention of the appealed claims.... [A]ppellant has clearly not established the independent and distinct character of the inventions of the appealed claims." 397 F.2d at 354-55, 158 USPQ at 214-15 (emphasis in original). The court observed:</p> <p>The controlling fact is that patent protection for the clips, fully disclosed in and covered by the claims of the patent, would be extended by allowance of the appealed claims. Under the circumstance of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or</p>
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<p>equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied. 397 F.2d at 355, 158 USPQ at 215.</p> <p>The decision in <i>In re Schneller</i> did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. The court in <i>Schneller</i> cautioned "against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations." <i>Schneller</i>, 397 F.2d at 355, 158 USPQ at 215. Nonstatutory double patenting rejections based on <i>Schneller</i> will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on <i>Schneller</i>. If an examiner determines that a double patenting rejection based on <i>Schneller</i> is appropriate, the examiner should first consult with the examiner's supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.</p> <p>A fact situation similar to that in <i>Schneller</i> was presented to a Federal Circuit panel in <i>In re Kaplan</i>, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were</p>	<p>equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied. 397 F.2d at 355, 158 USPQ at 215.</p> <p>The decision in <i>In re Schneller</i> did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. The court in <i>Schneller</i> cautioned "against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations." <i>Schneller</i>, 397 F.2d at 355, 158 USPQ at 215. Nonstatutory double patenting rejections based on <i>Schneller</i> will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on <i>Schneller</i>. If an examiner determines that a double patenting rejection based on <i>Schneller</i> is appropriate, the examiner should first consult with the examiner's supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.</p> <p>A fact situation similar to that in <i>Schneller</i> was presented to a Federal Circuit panel in <i>In re Kaplan</i>, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were</p>	<p>equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied. 397 F.2d at 355, 158 USPQ at 215.</p> <p>The decision in <i>In re Schneller</i> did not establish a rule of general application and thus is limited to the particular set of facts set forth in that decision. The court in <i>Schneller</i> cautioned "against the tendency to freeze into rules of general application what, at best, are statements applicable to particular fact situations." <i>Schneller</i>, 397 F.2d at 355, 158 USPQ at 215. Nonstatutory double patenting rejections based on <i>Schneller</i> will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on <i>Schneller</i>. If an examiner determines that a double patenting rejection based on <i>Schneller</i> is appropriate, the examiner should first consult with the examiner's supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.</p> <p>A fact situation similar to that in <i>Schneller</i> was presented to a Federal Circuit panel in <i>In re Kaplan</i>, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were</p>
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A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan and Walker. Since these applications (as the applications in *Braat*) were filed before the Patent Law Amendments Act of 1984 (Public Law 98-622, November 8, 1984) amending [35 U.S.C. 116](#) to expressly authorize filing a patent application in the names of joint inventors who did not necessarily make a contribution

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More recently, in *Geneva Pharmaceuticals Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1385-86, 68 USPQ2d 1865, 1875 (Fed. Cir. 2003), the court applied nonstatutory double patenting to invalidate a claim without analyzing anticipation or obviousness. In this case, the earlier patent claimed a compound and the written description disclosed a single utility of that compound as administration to a human in amounts effective for inhibiting β -lactamase. The later patent claimed nothing more than the earlier patent's disclosed utility as a method of using the compound. Thus, the court found that the claims of the later patent and the claims of the earlier patent were not patentably distinct. The *Geneva* court relied on equitable principles, not an obviousness-type analysis, in reaching its conclusion. *Id.* at 1386, 68 USPQ2d at 1875 (quoting *In re Byck*, 48 F.2d 665, 666 (CCPA 1931)).

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7. Design/Plant — Utility Situations

Double patenting issues may be raised where an applicant has filed both a utility patent application ([35 U.S.C. 111](#)) and either an application for a plant patent ([35 U.S.C. 161](#)) or an application for a design patent ([35 U.S.C. 171](#)). In general, the same double patenting principles and criteria that are applied in utility-utility situations are applied to utility-plant or utility-design situations. Double patenting rejections in utility-plant situations may be made in appropriate circumstances.

Although double patenting is rare in the context of utility versus design patents, a double patenting rejection of a pending design or utility application can be made on the basis of a previously issued utility or design patent, respectively. *Carman Indus. Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983). The rejection is based on the public policy preventing the extension of the term of a patent. Double patenting may be found in a design-utility situation irrespective of whether the claims in the reference patent/application and the claims in the application under examination are directed to the same invention, or whether they are directed to inventions which are obvious variations of one another. *In re*

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<p><i>Thornington</i>, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).</p> <p>In <i>Carman Indus.</i>, the court held that no double patenting existed between a design and utility patent since the claims in the utility patent, drawn to the interior construction of a flow promoter, were not directed to the same invention or an obvious variation of the invention claimed in a design patent directed to the visible external surface configuration of a storage bin flow promoter. The majority opinion in this decision appears to indicate that a two-way distinctness determination is necessary in design-utility cases. 724 F.2d at 940-41, 220 USPQ at 487-88.</p> <p>In <i>Thornington</i>, the court affirmed a double patenting rejection of claims for a fluorescent light bulb in a utility patent application in view of a previously issued design patent for the same bulb. In another case, a double patenting rejection of utility claims for a finger ring was affirmed in view of an earlier issued design patent, where the drawing in both the design patent and the utility application illustrated the same article. <i>In re Phelan</i>, 205 F.2d 183, 98 USPQ 156 (CCPA 1953). A double patenting rejection of a design claim for a flashlight cap and hanger ring was affirmed over an earlier issued utility patent. <i>In re Barber</i>, 81 F.2d 231, 28 USPQ 187 (CCPA 1936). A double patenting rejection of claims in a utility patent application directed to a balloon tire</p>	<p><i>Thornington</i>, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).</p> <p>In <i>Carman Indus.</i>, the court held that no double patenting existed between a design and utility patent since the claims in the utility patent, drawn to the interior construction of a flow promoter, were not directed to the same invention or an obvious variation of the invention claimed in a design patent directed to the visible external surface configuration of a storage bin flow promoter. The majority opinion in this decision appears to indicate that a two-way distinctness determination is necessary in design-utility cases. 724 F.2d at 940-41, 220 USPQ at 487-88.</p> <p>In <i>Thornington</i>, the court affirmed a double patenting rejection of claims for a fluorescent light bulb in a utility patent application in view of a previously issued design patent for the same bulb. In another case, a double patenting rejection of utility claims for a finger ring was affirmed in view of an earlier issued design patent, where the drawing in both the design patent and the utility application illustrated the same article. <i>In re Phelan</i>, 205 F.2d 183, 98 USPQ 156 (CCPA 1953). A double patenting rejection of a design claim for a flashlight cap and hanger ring was affirmed over an earlier issued utility patent. <i>In re Barber</i>, 81 F.2d 231, 28 USPQ 187 (CCPA 1936). A double patenting rejection of claims in a utility patent application directed to a balloon tire</p>	<p><i>Thornington</i>, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).</p> <p>In <i>Carman Indus.</i>, the court held that no double patenting existed between a design and utility patent since the claims in the utility patent, drawn to the interior construction of a flow promoter, were not directed to the same invention or an obvious variation of the invention claimed in a design patent directed to the visible external surface configuration of a storage bin flow promoter. The majority opinion in this decision appears to indicate that a two-way distinctness determination is necessary in design-utility cases. 724 F.2d at 940-41, 220 USPQ at 487-88.</p> <p>In <i>Thornington</i>, the court affirmed a double patenting rejection of claims for a fluorescent light bulb in a utility patent application in view of a previously issued design patent for the same bulb. In another case, a double patenting rejection of utility claims for a finger ring was affirmed in view of an earlier issued design patent, where the drawing in both the design patent and the utility application illustrated the same article. <i>In re Phelan</i>, 205 F.2d 183, 98 USPQ 156 (CCPA 1953). A double patenting rejection of a design claim for a flashlight cap and hanger ring was affirmed over an earlier issued utility patent. <i>In re Barber</i>, 81 F.2d 231, 28 USPQ 187 (CCPA 1936). A double patenting rejection of claims in a utility patent application directed to a balloon tire</p>
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A second significant difference is that a terminal disclaimer cannot be used to obviate a rejection based on prior art under [35 U.S.C. 102](#) or [103](#) prior art, even though it may overcome a nonstatutory double patenting rejection. *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991). The purpose of a terminal disclaimer is to obviate a nonstatutory double patenting rejection by removing the potential harm to the public by issuing a second patent, and not to remove a patent as prior art. See, for example, *Agrizap, Inc. v. Woodstream Corp.*, 520 F.3d 1337, 1344, 86 USPQ2d 1110, 1115 (Fed. Cir. 2008).

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