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ABSTRACT

At least since 1819, courts have prohibited double patenting—where an inventor has two patents on the same or obvious variations of the same invention. There have always been two basic justifications for prohibiting double patenting. The first focused on the patentee: bad actors might try to improperly extend their patent monopoly by filing serial applications. The second focused on the public's rights: the bargain of the patent is that in exchange for the inventor getting a term-limited patent, the public is entitled to use the claimed invention (and its obvious variations) once the patent expires. This public-rights rationale is broader, and it applies independent of whether the patentee's filing of serial applications allows her to extend the patent term.

The patentee-based justification had more purchase in the olden days—when a patent's term was determined by its issue date. Every new patent that issued would get a new term. Since 1995, though, a patent's term is 20 years from the earliest effective filing date—a date that stays the same independent of whether the inventor strings out her patent applications—so the inventor cannot really game the system. On the other hand, the public still cannot receive the fruit of its bargain if it cannot use a claimed invention as soon as a patent expires.

The previously low-stakes debate about the reason for prohibiting double patenting now matters. Most significantly, is there a double-patenting problem for a parent patent where the parent gets patent-term adjustment, but the child does not? On the patentee-based justification, there may well not be a problem for the parent, but on the public-rights based justification, there would be. Inventors that receive patent-term adjustment on a parent patent have to decide whether to pursue continuation applications, as continuation applications are likely to not receive the same amount of adjustment. Depending on how the law on double patenting evolves, the continuation patents may cut short the term of the parent patent—what this article will call patent patricide. For

patents on pharmaceutical drugs, the question of patent patricide can be worth billions of dollars.

INTRODUCTION

At least since 1819,[1] courts have prohibited "double patenting"—where an inventor has two patents on the same or obvious variations of the same invention. There have always been two basic justifications for prohibiting double patenting. The *first* focuses on the patentee: bad actors may try to improperly extend their monopoly by filing serial applications. The *second* focuses on the public's rights: the bargain of the patent is that in exchange for the inventor getting a term-limited patent, the public is entitled to use claimed inventions (and obvious variations thereof) once patents expire. This public-rights rationale is broader, and it applies independent of whether double patenting allows a patentee to extend her term.

However justified, the prohibition on double patenting was particularly important back when a patent's term was tied to its *issue* date. If an inventor kept getting patents on the same subject matter—each one expiring later and later—the patentee would be able to extend her patent monopoly beyond its statutory term, and the public would not be able to reap the benefits of its bargain.

The patentee-based justification for prohibiting double patenting nowadays, when a patent's term is twenty years from *filing*, is of more "limited force."[2] Bad-acting patentees are generally unable to extend their exclusivity by filing more and more patents since the new patents' terms will be limited by the filing dates of the original patents. On the other hand, the public still cannot receive the fruits of its bargain if it cannot use a claimed invention as soon as a patent expires. Thus, the previously inconsequential ivory-tower debate about why obviousness-type double patenting (ODP) is prohibited now matters. Most significantly, inventors that receive a patent-term adjustment on a parent patent have to decide whether to pursue continuation applications,[3] as continuation applications are likely not going to receive patent-term adjustments. Depending on

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1. Odiorne v. Amesbury Nail Factory, 18 F. Cas. 578, 579 (C.C.D. Mass. 1819) (No. 10,430).
2. *In re* Fallaux, 564 F.3d 1313, 1318 (Fed. Cir. 2009).
3. *See infra* Section I.C.

how the law on double patenting evolves, the continuation patents may cut short the term of the parent patent—what this article will call "patent patricide." For patents on pharmaceutical drugs, the question of patent patricide can be worth billions of dollars.

This article proceeds as follows. Section I provides a primer on patent prosecution and double patenting. In Section II, the article describes the various reasons courts have given for prohibiting double patenting: some courts believe that double patenting would extend the patentee's monopoly beyond her permitted term, while others believe it would violate the public's right to freely use inventions claimed in expired patents. As this article will show, the Patent Act assumes a patentee-based reason, but the Code of Federal Regulations has provisions that make sense only with a public-rights justification. Section III explains that the choice of rationale has significant implications for earlier-issued but later-expiring patents—particularly for cases of patent patricide—and different tribunals have come to different conclusions. Finally, Section IV concludes that allowing patent patricide creates strange and unnecessary problems. Instead, a patent's term should be set when it issues—so a later-issuing continuation application should not be able to cut short the term of the parent.

I. A PRIMER ON DOUBLE PATENTING

Sections II through IV assume an understanding of patent terms, patent prosecution, and double patenting. This section explains those concepts.

A. Patent Term

From 1790 to 1994, a patent's term was keyed to when the patent *issued*: patents that issued between 1790 and 1835 were valid for 14 years from issuance; patents that issued between 1836 and 1860 were valid for 21 years from issuance; and patents that issued between 1861 and 1994 were valid for 17 years from issuance.[4] The nice thing about patent terms being keyed to the patent's issue date was that an inventor would get the same patent term no matter how long it took the Patent Office to issue the patent.

In 1994, Congress passed the Uruguay Round Agreements Act (URAA). Under the URAA, patents filed in 1995 or later expire 20 years

4. Neel U. Sukhatme, *Regulatory Monopoly and Differential Pricing in the Market for Patents*, 71 WASH. & LEE L. REV. 1855, 1895–96 n.146 (2014).

from when the patent was *filed* (or its effective filing date—as described below).[5] If it takes three years for the Patent Office to issue a patent, then that works out to be the same term—17 years from issuance—as before. However, if the Patent Office takes much longer, then the inventor will not get a reasonable term. As an extreme example, if the Patent Office takes 20 years to issue a patent, the patent will expire before it is even issued. Congress therefore enacted various bases for adjusting a patent's term to account for Patent Office delay. Already in 1994, with the enactment of the URAA, Congress provided patent-term adjustment (PTA) to account for the time lost during review by the Patent Office's Board of Appeals and Interferences.[6] Since then, Congress has allowed for PTA based on other Patent Office delays as well.[7]

The Patent Act also provides for extending a patent to make up for delay at the U.S. Food and Drug Administration (FDA). Before an innovator company can market a new drug, it needs approval from the FDA.[8] Sometimes, the FDA-approval process can interfere with a company's ability to recoup the money it invested in developing a drug. As the Supreme Court has explained, "the 'clock' on [an inventor's] patent term will be running even though he is not yet able to derive any profit from the invention" because the government has not yet approved it.[9] Consider, for example, a company that invents a new drug and files both a patent application and a request for FDA approval of that drug in 2000. If the Patent Office issues the patent promptly, but the FDA does not approve the product until 2020, the company would have no patent-based market exclusivity. In 1984 (even before the URAA), Congress enacted the Hatch-Waxman Act, which provides for Patent Term Extension (PTE) to make up for this delay.[10]

B. How Patents are Prosecuted

To receive a patent, an inventor files a patent application with the Patent Office. There are two kinds of applications: provisional and nonprovisional. Provisional applications are not relevant to this article.

An inventor who files a nonprovisional application must include a "specification" that describes and enables the invention.[11] The application

5. 35 U.S.C. § 154(a)(2) (Supp. V 2017).
6. *Id.*
7. *Id.* § 154(b).
8. *See* 21 U.S.C. § 355(a) (2012).
9. Eli Lilly & Co. v. Medtronic, Inc., 496 U.S. 661, 669–70 (1990).
10. 35 U.S.C. § 156 (Supp. V 2017).
11. 35 U.S.C. § 111(a)(2)(A) (2012); MPEP § 601 (9th ed. Rev. 08.2017, Jan. 2018).

receives a "filing date," which is the date the Patent Office receives the application.[12] The filing date of the application is important for several reasons, including that: (1) it defines the world of prior art that can be raised against the patent[13] and (2) the patent expires 20 years from the filing date.[14]

However, in some circumstances, the effective filing date of an application is not the date the application itself was filed, but rather the date of an earlier-filed application.[15] These situations involve one of the three types of applications: (1) continuation applications, (2) divisional applications, and (3) continuation-in-part applications.[16]

Continuation Applications

Sometimes, a specification will support numerous different claims. For a variety of reasons, the inventor might not want to pursue all the possible claims in a single application. For example, the inventor might worry that prosecuting all the claims may be expensive or that prosecution of more-ambitious claims might hold up the issuance of the less-ambitious claims. Consequently, the inventor might choose to prosecute one set of claims first. Before the Patent Office issues the patent with the first set of claims, the *parent patent*, the inventor can file a continuation application. Even though the continuation application is, technically, filed later, it is accorded the same effective filing date as the parent patent. However, the disclosure in the continuation application cannot contain new matter.[17]

Divisional Applications

Divisional applications are like continuation applications and also cannot include new matter.[18] The difference is that an inventor files a divisional application to claim an invention that is independent of the invention claimed in the parent patent. Sometimes, an inventor will decide to file a divisional application on her own based on an independent determination that the claims she seeks to pursue in the divisional application are distinct from the claims in the parent. For purposes of this

12. 35 U.S.C. § 111(a)(4) (2012).
13. *Id.* § 103; *see* MPEP § 2141.
14. 35 U.S.C. § 154(a)(2) (Supp. V 2017).
15. *Id.* §§ 120–121, 154(a)(2).
16. MPEP § 201.02 (9th ed. Rev. 08.2017, Jan. 2018).
17. MPEP § 201.07 (9th ed. Rev. 08.2017, Jan. 2018).
18. MPEP § 201.06 (9th ed. Rev. 08.2017, Jan. 2018).

article, this type of applicant-initiated divisional application is no different than a standard continuation application.

However, the Patent Office often forces a divisional application.[19] Specifically, if an applicant files numerous claims in a first application, the examiner might decide that the claims cover distinct inventions, and the examiner can then insist that the applicant restrict the claims in the first application to a single invention. The inventor can fight this restriction requirement, but she can just file a divisional application to prosecute the non-elected claims.[20]

Continuation-in-Part Applications

A continuation-in-part application is like a standard continuation application, but an inventor is permitted to add new matter to the disclosure of a continuation-in-part application. The tradeoff is that the claims in the continuation-in-part application are afforded the filing date of the parent application only if the parent application contained a disclosure that supports the claims in the continuation-in-part application.[21]

C. The Two Types of Double Patenting

The Patent Act entitles an inventor to only "a patent," singular, for an invention.[22] Accordingly, an inventor cannot have two patents on the "same invention."[23]

Even where an inventor is not trying to get two patents on exactly the same invention, courts nonetheless forbid an inventor from getting two patents with claims to obvious variants of the same invention—ODP.[24] There are several rationales for the prohibition on ODP, and they will be discussed at length below. For now, suffice it to make the intuitive point that someone who invents one new idea should not be able to both get a patent that expires in 2020 and get a second patent on the same or an obvious variation of that invention that does not expire until 2030. The public is getting cheated out of using the invention (or its obvious variant) in an expired patent, and the inventor is getting more patent term than she deserves. Another reason, albeit less significant, for prohibiting ODP is

19. 35 U.S.C. § 121 (2012).
20. *See* MPEP § 201.06.
21. *See* MPEP § 201.08 (9th ed. Rev. 08.2017, Jan. 2018).
22. 35 U.S.C. § 101 (2012).
23. MPEP § 804 (9th ed. Rev. 08.2017, Jan. 2018).
24. *Id.*

that if an inventor could get multiple patents on the same invention, she might sell some patents and keep others. An accused infringer could be subject to multiple lawsuits from the owners of the different patents with no collateral estoppel on judgments from one to the other—because the patent owners would be different.[25]

Importantly, Congress forbids ODP rejections for divisional applications that an inventor files in response to a Patent Office restriction requirement. The parent and divisional patents cannot be used as ODP references against one another.[26]

Aside from this congressionally enacted safe harbor, courts developed a simple ODP workaround for inventors who want to receive a second patent for an obvious variation of a previously patented invention. The inventor can file a "terminal disclaimer" in which she disclaims the term of the second patent that would otherwise extend beyond the term of the first patent[27]—often called the *reference patent*. So, say the reference patent expired on January 1, 2020, the inventor would disclaim the term of the second patent on the same or an obvious variant that extended beyond that date. To avoid the multiple-lawsuit problem, the Patent Office requires that the terminal disclaimer also include a provision that the disclaimed patent will not be enforceable if the challenged and reference patents are not commonly owned.[28]

The interaction between double patenting and PTA/PTE is interesting: the Patent Act is explicit that PTA cannot extend a patent's term beyond the date in a terminal disclaimer.[29] The Patent Act does not say whether PTE can extend the term of a patent beyond a terminally disclaimed date, but the Federal Circuit has ruled that it can.[30]

II. THE REASON FOR PROHIBITING ODP

Although double patenting has been prohibited for two centuries, courts have never settled on a single rationale. Instead, there are two types of justifications. One is patentee based: were an inventor allowed to receive multiple patents with different expiration dates, the inventor would receive more than their congressionally allotted exclusivity. The second justification is based on the public's rights: the public should be

25. *See* Blonder-Tongue Labs., Inc. v. Univ. Ill. Found., 402 U.S. 313, 329, 350 (1971).
26. 35 U.S.C. § 121 (2012).
27. 37 C.F.R. § 1.321 (2018).
28. *Id.* § 1.321(c).
29. *See* 35 U.S.C. § 154(b)(2)(B) (2012).
30. Novartis AG v. Ezra Ventures LLC, 909 F.3d 1367, 1375 (Fed. Cir. 2018); Merck & Co. v. Hi-Tech Pharmacal Co., 482 F.3d 1317, 1318 (Fed. Cir. 2007).

free to use claimed inventions (and their obvious variations) once a patent expires. The rationale matters. In some cases, the second patent does not improperly extend the patentee's term, but the public is still blocked from using an invention in an expired patent.

A. Courts Give Multiple Reasons for Prohibiting ODP

Courts have been offering these two different justifications for almost as long as the prohibition on double patenting has existed. Perhaps the first discussion of double patenting came in dicta in an 1818 case. Justice Story (riding circuit) addressed a patentee-based concern over double patenting: allowing an inventor to obtain serial patents might create "double recompense" and "the term of the exclusive right might be prolonged for a great length of time."[31] He therefore expressed "very great doubts" whether an inventor could get two patents for the same invention.[32]

The next year, Justice Story addressed double patenting directly in *Odiorne v. Amesbury Nail Factory*, again riding circuit.[33] He held that an inventor cannot "have in use at the same time two valid patents for the same invention."[34] Justice Story began by again focusing on the patentee-based problem: Congress awarded inventors a set patent term, but, if an inventor "can successively take out at different times new patents for the same invention, he may perpetuate his exclusive right during a century."[35] Justice Story concluded, though, with a public-rights justification: double patenting would defeat "the public['s] . . . acquired . . . inchoate interest" in using the invention after the first patent expired.[36]

The Supreme Court adopted the prohibition on double patenting at least by the middle of the 19th century.[37] For example, in *O'Reilly v. Morse*, the Supreme Court explained that Morse could not have two patents that "embraced" the same invention—in that case, an 1840 patent claiming any method of transmitting information through electromagnets and an 1846 patent claiming a specific method.[38] However, it was only

31. Barrett v. Hall, 2 F. Cas. 914, 924 (C.C.D. Mass. 1818) (No. 1,047).

32. *Id.*

33. Odiorne v. Amesbury Nail Factory, 18 F. Cas. 578, 579 (C.C.D. Mass. 1819) (No. 10,430).

34. *Id.*

35. *Id.*

36. *Id.*

37. *See, e.g.*, McCreary v. Pennsylvania Canal Co., 141 U.S. 459, 467–68 (1891); Suffolk Co. v. Hayden, 70 U.S. (3 Wall.) 315, 319 (1865).

38. O'Reilly v. Morse, 56 U.S. (15 How.) 62, 114 (1853); *cf.* Douglas L. Rogers, *Double Patenting: Follow-on Pharmaceutical Patents that Suppress Competition*, 14 NW. J. TECH. & INTELL. PROP. 317, 337–38 (2017).

with its 1894 decision in *Miller v. Eagle Manufacturing Co.* that the Court gave any justification.[39] Citing Justice Story's *Odiorne* decision, the Supreme Court listed both problems with double patenting: (1) the public's rights: "the power to create a monopoly is exhausted by the first patent," and (2) the "further," patentee-based reason: "a new and later patent for the same invention would operate to extend or prolong the monopoly beyond the period allowed by law."[40] According to one scholar, by 1916 most courts were relying on the patentee-based rationale.[41]

The Court of Customs and Patent Appeals (C.C.P.A.), one of the Federal Circuit's two predecessor courts, likewise mixed and matched between these two justifications. In one opinion it declared that "[d]ouble patenting is . . . primarily intended to prevent prolongation of monopoly" by the patentee; otherwise, the patentee could file a first patent with a "sketchy forecast" of an invention and continue to file continuations-in-part to prolong the monopoly.[42] But in another opinion it justified ODP based on the public's rights: "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."[43]

The Federal Circuit continued providing both justifications. For example, the Federal Circuit in *Longi* quoted Judge Rich for the proposition that double patenting exists to ensure that the "public should be [free] to assum[e] that upon the *expiration* of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious."[44] On the other hand, Judge Rich himself cited *Longi* and emphasized that ODP exists "to prevent *improper* timewise *extension* of the patent right" by the patentee.[45]

39. Miller v. Eagle Mfg. Co., 151 U.S. 186, 198 (1894); *see* EMERSON STRINGHAM, DOUBLE PATENTING § 2800, 25 (*Miller* is considered "the most famous decision" on double patenting); *see also* RUSSELL WILES, EFFECT ON A LATER BROAD PATENT OF AN EARLIER NARROW PATENT TO THE SAME INVENTOR, ON A COPENDING APPLICATION (1905), *reprinted in* EMERSON STRINGHAM, DOUBLE PATENTING 501, 507 (1933) *(Miller* "is and always has been the leading case upon the subject.").

40. *Miller*, 151 U.S. at 198 (citing *Odiorne*, 18 F. Cas. at 579).

41. CHARLES H. SHAFFER, DOUBLE PATENTING (1916), *reprinted in* EMERSON STRINGHAM, DOUBLE PATENTING 516, 517 (1933).

42. *In re* Braithwaite, 379 F.2d 594, 601 (C.C.P.A. 1967).

43. *In re* Robeson, 331 F.2d 610, 614 (C.C.P.A. 1964).

44. *In re* Longi, 759 F.2d 887, 892–93 (Fed. Cir. 1985) (quoting *In re* Zickendraht, 319 F.2d 225, 232 (C.C.P.A. 1963) (Rich, J., concurring) (emphasis added).

45. *In re* Braat, 937 F.2d 589, 592 (Fed. Cir. 1991) (second emphasis added).

B. The Patent Act Assumes a Patentee-Based Justification

In 1952, Congress enacted § 121 of the Patent Act. This was Congress's first clear recognition of and acquiescence to double patenting,[46] and § 121 views ODP as a patentee-based problem. Until 1952, even when an examiner insisted that claims be divided, the claims of the divisional application could still be rejected for ODP over the first application and vice-versa.[47] This was unfair to the patentee—so much so that the C.C.P.A. had a rule that "every reasonable doubt appertaining to the [double patenting] issue should be resolved in [the patentee's] favor" if the patentee divided her claims in response to a restriction requirement.[48] In 1952, Congress did away with the problem, adding § 121, which provides that, when an inventor files a divisional application in response to a restriction requirement, one restricted application "shall not be used as a reference" against the other.[49] This exception to ODP addresses only a patentee-based problem: since the inventor is playing by the rules (dividing applications when told to do so), it would be unfair to the patentee if she had to face a double patenting rejection. Section 121 does nothing to address the public's rights. A member of the public will still be prohibited from using an invention (or its obvious variant) claimed in an expired patent.

C. Regulatory Provisions Reflect a Public-Rights Justification

The Patent Office's regulations, meanwhile, evince a concern for the public's rights. As described above, an inventor can traverse an ODP rejection by filing a terminal disclaimer. The 1952 Patent Act provides that an inventor can "disclaim or dedicate to the public . . . any terminal part of the term . . . of the patent granted or to be granted."[50] The two primary drafters of the Act, Pasquale J. Federico and Giles S. Rich, both

46. William T. Bullinger is thus mistaken in asserting that the 1952 Act "eliminate[d] the law of double patenting." William T. Bullinger, *"Double Patenting" and the 1952 Patent Act*, 10 PAT., TRADEMARK & COPYRIGHT J. RES. & EDUC. 389, 399 (1966).

47. Studiengesellschaft Kohle mbH v. N. Petrochemical Co., 784 F.2d 351, 358 (Fed. Cir. 1986) (Newman, J., concurring) (citing pre-1952 cases), *cited with approval in* Boehringer Ingelheim Int'l GmbH v. Barr Labs., Inc., 592 F.3d 1340, 1350 (Fed. Cir. 2010); *see also* STRINGHAM, *supra* note 39, § 2851A, 357 (citing cases).

48. *In re* Cady, 77 F.2d 106, 108 (C.C.P.A. 1935).

49. *See* 35 U.S.C. § 121 (2012).

50. *Id.* § 253.

explained that terminal disclaimers were created specifically to allow inventors to get around ODP rejections.[51]

The statute's disclaimer provision talks about disclaiming terms, but it says nothing about common ownership of the two patents. And early terminal disclaimers addressed only the patent's *term*.[52] Extending term is both a patentee-based problem and violates the public's rights. And the C.C.P.A. focused on the patentee-based problem: holding that that terminal disclaimers would not work in "a situation where any abuse of the terminal disclaimer is suggested."[53]

However, the Patent Office ultimately shifted the doctrine to require public-rights-specific provisions. In 1971, the Patent Office issued a regulation that a terminal disclaimer would overcome a double-patenting rejection only if the disclaimer included a provision that the patent would be enforceable when the disclaimed patent was "commonly owned with the application or patent which formed the basis for the rejection."[54] The C.C.P.A. later upheld the regulation, and the common-ownership provision is now a standard part of terminal disclaimers.[55] The need for common ownership makes sense in the public-rights justification. Because of collateral estoppel, if the patents are commonly owned, a member of the public cannot be sued by the same patent owner for infringing the same invention—even if claimed in different patents. Common ownership does nothing to address a misbehaving patentee.

III. THE PATENTEE-BASED AND PUBLIC-RIGHTS JUSTIFICATIONS DIVERGE FOR EARLIER-FILED/ISSUED BUT LATER-EXPIRING PATENTS

In addition to the question of divisional applications and terminal disclaimers, which are addressed by statute and regulation, respectively, the justification for ODP matters in cases where the reference patent is

51. *See* Pasquale J. Federico, *Commentary on the New Patent Act*, 75 J. PAT. & TRADEMARK OFF. SOC'Y 161, 210 (1993) (reprinting his comments from the 1954 edition of Title 35 of the United States Code Annotated) (explaining that § 253 was "contemplated" as a means of "combatting a defense of double patenting."); *see also Selected Speeches of Giles S. Rich*, 3 J. FED. CIR. HIST. SOC'Y 103, 112 (2009) (reprinting his speech to the New York Patent Law Association held on November 6, 1952) (explaining that one might file a terminal disclaimer "if you are in a double-patenting situation.").

52. *See In re* Gibbs, 437 F.2d 486, 487 n.2 (1971).

53. *In re* Robeson, 331 F.2d 610, 615 (C.C.P.A. 1964).

54. 36 Fed. Reg. 7312 (Apr. 17, 1971); 37 C.F.R. § 1.321(b) (1972). Before the 1971 promulgation, the Patent Office had an internal rule that a terminal disclaimer had to provide that the patent would "expire immediately" if it stopped being "commonly owned." *In re* Van Ornum, 686 F.2d 937, 948 (C.C.P.A. 1982) (quoting 834 Off. Gaz. Pat. Office 1615 (Jan. 31, 1967)).

55. *Van Ornum*, 686 F.2d at 944–48; MPEP § 1490 (9th ed. Rev. 08.2017, Jan. 2018).

later-filed (pre-URAA) or later-issued (post-URAA) than the challenged patent.

A. Earlier-Filed but Later-Expiring Patents Before the URAA

As explained above, before the URAA, a patent's expiration date depended on the date of *issue*, and, usually, an earlier-issued patent was filed earlier too. So double patenting would normally be a problem for only the *later-filed and later-issued* patent. But not always. Sometimes, the earlier-filed patent would get held up during prosecution, and a later-filed patent would issue first. What then? The patentee would argue that she should not lose protection just because the Patent Office delayed issuing the patent, so the earlier-filed patent should not be subject to an ODP challenge from the later-filed patent. On the other hand, the public would argue that it should still be free to use the inventions and obvious variations of claims in expired patents; the inventor's tortuous path to getting her patent is not the public's problem. Courts were divided on this question of earlier-filed but later-issued patents.

Suffolk Co. v. Hayden[56]

Hayden filed for a patent in 1854, but, "[f]or some cause," the application just lingered in the Patent Office.[57] So Hayden filed another patent application for the "same improvements" in 1857, which the Patent Office issued that same year.[58] The earlier-filed 1854 application, meanwhile, did not issue until 1860.[59]

56. Suffolk Co. v. Hayden, 70 U.S. (3 Wall.) 315 (1865).
57. *Id.* at 316.
58. *Id.*
59. *Id.*

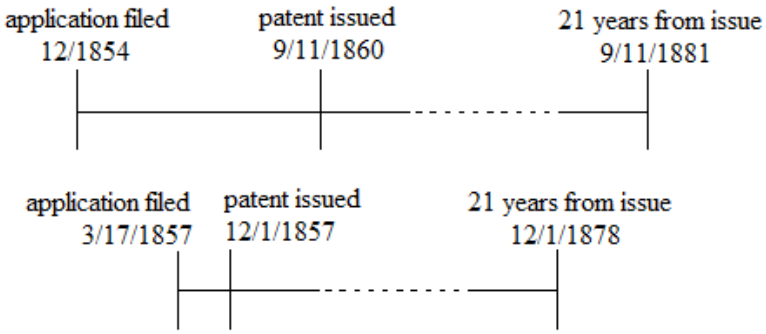

Figure 1: Timeline of Hayden's patent prosecution

When Hayden sued for infringement of the 1857 patent, the defendant argued that the 1857 patent should be invalid for double patenting over the earlier-filed but later-issued 1860 patent.[60] The Supreme Court held that was exactly backwards: "The last [issued], not the first, is void."[61] The Supreme Court later summarized *Suffolk* as "deciding that it is the issue date, and not the filing date, which determines priority to patents issued to the same inventor on the same machine."[62]

Suffolk, itself, can be reconciled with both patentee and public-rights justifications for prohibiting double patenting. The patentee is still getting one full term of protection, and the public is still permitted to use the invention as soon as one patent expires. However, courts diverged on how to apply *Suffolk*.

The *Thomson-Houston Electric Co*. Cases[63]

The Second Circuit added nuance to *Suffolk*'s rule in a series of cases relating to Thomson-Houston's patents. Relying on a patentee-based justification for double patenting, the Second Circuit held that, sometimes, the earlier-filed but later-issued patent could also be immune to an ODP challenge.

60. *Id.* at 319.
61. *Id.*
62. Miller v. Eagle Mfg. Co., 151 U.S. 186, 197 (1894).
63. Thomson-Houston Elec. Co. v. Winchester Ave. Ry. Co., 71 F. 192 (C.C.D. Conn. 1895); Thomson-Houston Elec. Co. v. Elmira & H. Ry. Co., 71 F. 396 (2d Cir. 1896); Thomson-Houston Elec. Co. v. Hoosick Ry. Co., 82 F. 461 (2d Cir. 1897).

Thomson-Houston applied for a patent in 1887, but that patent got tied up in an interference proceeding and only issued in 1893.[64] In 1888, while that application was pending, Thomson-Houston filed another patent that issued in 1890.[65] As in *Suffolk*, this led to a later-filed but earlier-issued patent. *Suffolk* had already held that the patent that issued in 1890 was valid, but the question was whether the one that issued in 1893 might also be valid. The circuit court for the district of Connecticut held that the 1893 patent claimed a genus while the later-filed but earlier-issued 1890 patent claimed a species, and, in such cases, the patentee should not "be deprived of his broad patent where the application for such patent was made first, and was delayed in the patent office through no fault of the inventor. Such a ruling would be a reproach to the law."[66] The same patent came up again a few years later (with a different defendant) in the Second Circuit. The Second Circuit declared that it "should concur" with the Connecticut court if the patents really could be divided into a genus versus a species patent, but, in its view, the two patents were to the "same invention," and it invalidated the 1893 patent.[67] Other 19th century cases are to the same effect.[68] This focus on justice to the patentee is, naturally, consistent with a patentee-based rationale for ODP. The concern that the public will not be permitted to use an invention claimed in an expired patent applies independently of whether or how the issuance of the first-filed patent got tied up.

In 1897, the same Thomson-Houston patents were challenged in the Sixth Circuit.[69] Then-Judge Taft, writing for the circuit, came to the same conclusion. He declared that he would not invalidate an earlier-filed patent based on the happenstance that the Patent Office delayed issuing the patent—through no fault of the patentee—"unless it is required by the express words of the statute, or by the express holding of the Supreme Court."[70] This, again, is a patentee-based justification. But Judge Taft went on. He emphasized that, in the later-filed but earlier-issued 1890 patent, the inventor "expressly states that he has an application pending for the main invention . . . and thus shows beyond peradventure that he has no intention of abandoning or dedicating to the public his main

64. *See Winchester*, 71 F. at 203.

65. *See id.*

66. *See id.* at 204.

67. *Hoosick*, 82 F. at 466–68.

68. *See, e.g.*, Eagle Mfg. Co. v. Bradley, 35 F. 295, 298 (C.C.S.D. Iowa 1888) (ruling that there cannot be double patenting where "the issuance of two patents was not for the purpose of extending the life of the monopoly, but was caused by the action of the patent-office.").

69. Thomson-Houston Elec. Co. v. Ohio Brass Co., 80 F. 712 (6th Cir. 1897).

70. *Id.* at 724.

invention."[71] Thus, the 1890 patent, on its face, informs the public that there may be other relevant patent protection.

Birmingham Cement Mfg. Co. v. Gates Iron Works[72]

Other courts of that era disagreed. In 1896, the Fifth Circuit declared in dicta that it was "untenable" to treat an earlier-filed but later-issued patent any differently than a later-filed and later-issued patent.[73] Emerson Stringham, in his 1933 treatise DOUBLE PATENTING, agrees.[74] Presumably, they understand the prohibition on double patenting as ensuring that the public gets to use inventions (and their obvious variants) claimed in expired patents, and they do not accept Judge Taft's suggestion that double patenting should depend on what is disclosed in the specification of the challenged patent.

The C.C.P.A. and Federal Circuit's Approach

The C.C.P.A. took a particularly harsh approach to earlier-filed but later-issued patents. In *In re Griswold*, the C.C.P.A. allowed a form of patent patricide. Griswold filed a patent application, and while it was pending, he filed a continuation-in-part application. The continuation-in-part application issued first. The examiner rejected the earlier-filed parent application for double patenting based on its own child, and the Federal Circuit affirmed.[75] The child killed the parent.

That said, in cases where the later-filed application issues first, the Federal Circuit applies a modified version of ODP. Normally, the question for ODP is only whether the claims in the later-issued patent would have been obvious over the claims of the earlier-issued patent (a "one-way" test).[76] Where the later-filed application issues first, however, an ODP rejection is proper only if each set of claims would have been obvious over the other (the "two-way" test).[77] The Federal Circuit has emphasized,

71. *Id.* at 726.

72. Birmingham Cement Mfg. Co. v. Gates Iron Works, 78 F. 350 (5th Cir. 1896).

73. *Id.* at 360.

74. STRINGHAM, *supra* note 41, § 2854, 368–72. Stringham is the preeminent scholar on double patenting. *See In re* Sarett, 327 F.2d 1005, 1015 (C.C.P.A. 1964).

75. *In re* Griswold, 365 F.2d 834, 840 (C.C.P.A. 1966).

76. *In re* Berg, 140 F.3d 1428, 1432 (Fed. Cir. 1998).

77. *In re* Braat, 937 F.2d 589, 593–94 (Fed. Cir. 1991) (citing earlier cases). Robert Armitage argues that *Braat* "perverts" the earlier caselaw by allowing the earlier-filed application to ever be invalidated. *Everything You Ever Wanted to Know About Double Patenting. . . But Never Realized That You Needed to Ask (From the Makers of Prozac), The "Innovation Act"*: Appendix to Hearing Before the H. Comm. on the Judiciary, 113th Cong. 170, 189 (Oct. 29, 2013).

though, that the two-way test is a "narrow exception" limited to the "unusual circumstance" where the delay of the earlier-filed application was "through no fault of the applicants."[78] The court's allowance for the possibility of patent patricide suggests a public-rights justification for ODP, but the mitigating two-way test exists to prevent injustice to the patentee.

B. Earlier-Issued but Later-Expiring Patents After the URAA

1. District Court and Patent-Office Decisions on Earlier-Issued but Later-Expiring Patents

The URAA created a new ODP question: can an earlier-issued patent be invalidated for ODP over a later-issued (and perhaps even later-filed) patent? This question is both troubling and common for continuation patents where the parent patent has PTA. If the justification for ODP is that the public should be free to use any invention (and obvious variations) claimed in an expired patent, then ODP should apply to an earlier-issued patent as much as to a later-issued one. After all, the public is equally harmed. On the other hand, a patentee who files a later-issuing but earlier-expiring patent has done nothing wrong.

The first cases to address the effects of the URAA dealt with situations where one application was filed before the URAA and the other application was filed after. Because pre-URAA patents expire 17 years from *issuance*, while post-URAA patents expire 20 years from the effective *filing date*, the earlier-issued patent often expired later. Until the Federal Circuit's 2014 opinion in *Gilead*,[79] the Patent Office assumed that the later-issued patent could serve as an ODP reference, while district courts assumed it could not.

The Patent Office's Decision in *Ex parte Pfizer, Inc*.[80]

In 1994 (i.e., before the URAA),[81] Pfizer filed for a patent on its blockbuster drug Viagra, and it received its '012 patent in 2002. Several drug companies asked the Patent Office to reexamine the patent. On

78. *Berg*, 140 F.3d at 1432; *accord* Eli Lilly & Co. v. Barr Labs., Inc., 251 F.3d 955, 969 n.7 (Fed. Cir. 2001). Judge Newman believes that the "no fault" rule is too strict. *Lilly*, 251 F.3d at 973 (Newman, J., dissenting).

79. Gilead Scis., Inc. v. Natco Pharma Ltd., 753 F.3d 1208 (Fed. Cir. 2014).

80. *Ex parte* Pfizer, No. 2009-4106, 2010 WL 532133, at *1 (B.P.A.I. Feb. 12, 2010).

81. To be precise, the Patent Cooperation Treaty (PCT) application was filed in 1994 and the national entry was in 1996. That suffices for receiving a term of 17 years from issuance. *See* MPEP § 2701 (9th ed. Rev. 08.2017, Jan. 2018).

reexamination, the Examiner rejected one of the claims for ODP over three patents by one Campbell—all owned by Pfizer but unrelated to the '012 patent. The first, Campbell 270, was filed after the '012's priority date, but it issued before the '012 patent. The other two, Campbell 511 and Campbell 945, were filed and issued after the '012 patent. Because of the URAA, though, all three Campbell patents were set to expire before the '012 patent.

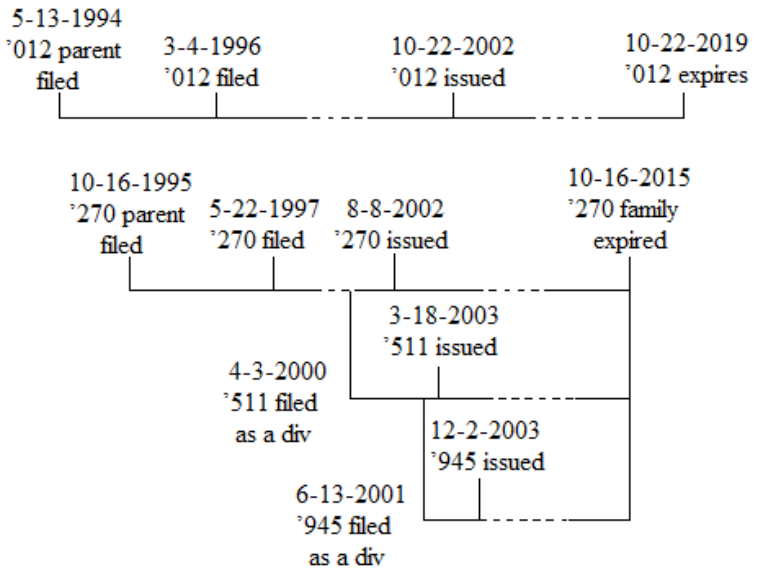

Figure 2: Timeline of Pfizer's patent prosecution

This fact scenario presents two interesting ODP questions. *First*, can Campbell 270, which was filed after the '012 patent's parent but issued before the '012 patent, serve as an ODP reference? The parties assumed it could—and, at least before the URAA, this was the case.[82] *Second*, can Campbell 511 and Campbell 945 serve as ODP references to the '012 patent, which was both filed and issued earlier than those two references? Before the URAA, an earlier-issued patent would always expire earlier, so this was a non-issue. The Patent Office's Board of Patent Appeals and Interferences held that the URAA changed how ODP works: the '012 patent would "exclude the public from practicing" the earlier-expiring patents, which "is precisely what obviousness-type double patenting was

82. *See, e.g.*, *Lilly*, 251 F.3d at 962, 968–72.

intended to prevent."[83] The Board therefore affirmed the ODP rejection based on a later-filed and later-issued patent.

The next year, however, two Delaware district courts came to the opposite conclusion—focusing on the fact that the patentee did nothing wrong in obtaining the later-issued patent.

The Delaware District Court Decisions in Brigham *and* Abbott

In *Brigham & Women's Hospital Inc. v. Teva Pharmaceuticals USA, Inc.*, two pre-URAA patents, the '068 and '003 patents (which happened to have their own unrelated terminal disclaimers), were challenged for ODP over a later-filed, later-issued, unrelated, post-URAA patent that expired earlier, the '244 patent.[84]

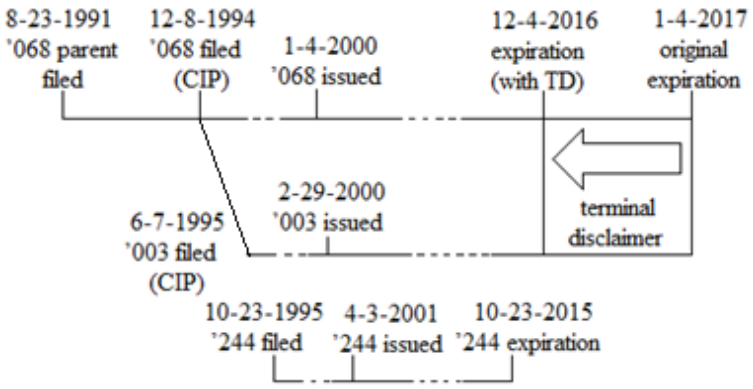

Figure 3: Timeline of Brigham's patent prosecution

The district court believed there was no reason for the patentee to lose patent term based on a "later-filed, later-issued" patent, and it was "not persuaded by the Board's reasoning" in *Pfizer*.[85] There was no reason to punish a patentee who obtained "a valid, earlier-granted patent with a longer term" or to shorten the "patent protection to which plaintiffs were already entitled."[86]

Later that year, in *Abbott Laboratories v. Lupin Ltd.*, another Delaware court was faced with a similar situation but with a patent-

83. *Ex parte* Pfizer, 2010 WL 532133, at *21 (emphasis added).

84. Brigham & Women's Hosp. Inc. v. Teva Pharm. USA, Inc.,761 F. Supp. 2d 210, 214 (D. Del. 2011).

85. *Id.* at 225.

86. *Id.*

patricide twist: the ODP reference, the '930 patent, was a continuation-in-part of the earlier-filed but later-expiring '428 patent.[87]

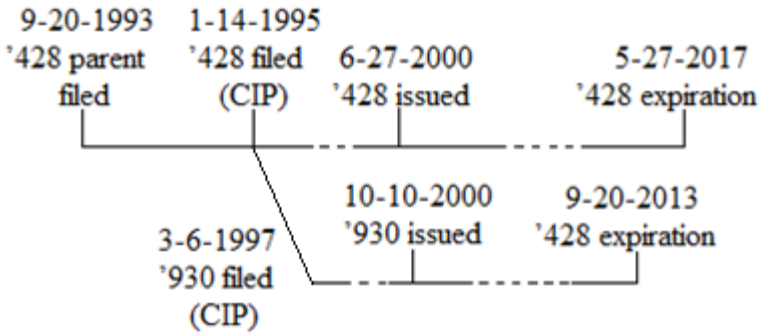

Figure 4: Timeline of Abbott's patent prosecution

The *Abbott* court agreed with *Brigham* and concluded that the '428 patent was immune to an ODP challenge from the later-issued patent because there was no "improper gamesmanship by the patentee."[88]

The Patent Office's decision in *Ex Parte Martek Biosciences Corp.*[89]

In 2013, the Patent Office Patent Trial and Appeal Board (the successor to the Board of Patent Appeals and Interferences) had the issue come up again. In *Martek*, an examiner rejected the earlier-filed, earlier-issued, pre-URAA '244 patent (not the *Merck* 244 patent discussed above) for ODP over a later-filed, later-issued, post-URAA '225 patent. Both patents were continuations-in-part of a common application filed in 1992.

87. Abbott Labs. v. Lupin Ltd., No. 09-cv-152, 2011 WL 1897322, at *1 (D. Del. May 19, 2011).

88. *Id.* at *9–10 (emphasis added).

89. *Ex parte* Martek Biosciences Corp., No. 2012-10020, 2013 WL 3326850 (P.T.A.B. May 21, 2013).

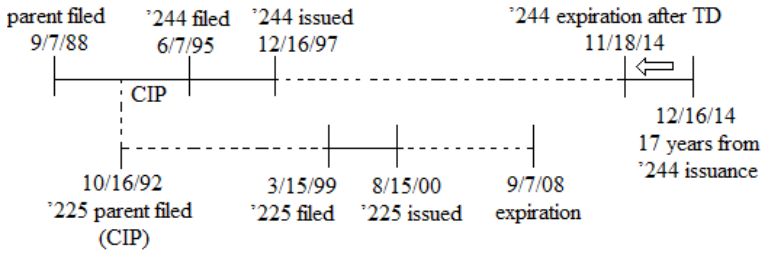

Figure 5: Timeline of Martek's patent prosecution

The Board believed the relationship between the patents was a critical distinction from *Pfizer* and the two Delaware decisions.[90] According to the Board, Martek should have filed all the claims of the later patents in the parent 1992 application, and it was Martek's fault for deciding "to wait to file."[91] It therefore invalidated the claims of the '244 patent. Thus, *Martek* seems to meld a public rights and patentee-based justification: since the patentee could have avoided the situation, the public's right prevails.

2. The Federal Circuit's broad application of ODP in its 2014 *Gilead* and *AbbVie* decisions

In 2014, the Federal Circuit issued two decisions, both of which suggested that a later-issued patent could serve as an ODP reference against an earlier-issued one based on a public-rights rationale.

Gilead Sciences, Inc. v. Natco Pharma Ltd.[92]

After the URAA, Gilead filed two unrelated patent applications for its Oseltamivir product. The first was filed on February 26, 1996 and issued as the '375 patent on September 14, 1999. The second was filed on December 27, 1996 and issued as the '483 patent on June 9, 1998—that is, the second patent was a later-filed but earlier-issued patent.

90. *Id.* at *10–11.
91. *Id.* at *12.
92. Gilead Scis., Inc. v. Natco Pharma Ltd., 753 F.3d 1208 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1530 (2015).

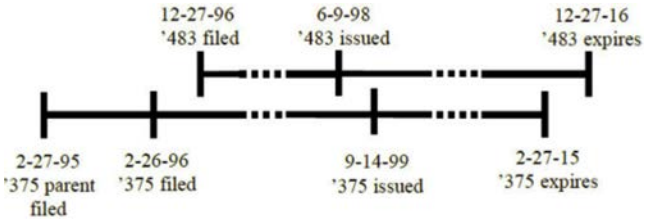

Figure 6: Timeline of Gilead's patent prosecution

When Gilead sued Natco for infringing the later-expiring '483 patent, Natco responded that the '483 patent was invalid for ODP over the '375 patent.[93] Relying on *Brigham* and *Abbott*, a New Jersey court concluded that Gilead's later-issued patent could not serve as an ODP reference against the earlier-issued one.[94]

Natco appealed, and the Federal Circuit reversed.[95] Judge Chen wrote the majority opinion, which was joined by Judge Prost, over a dissent by Chief Judge Rader. The dispute centered on the justification for ODP. Quoting Justice Story's second justification for prohibiting double patenting, the majority ruled that ODP was "primarily designed" to ensure that the "public . . . [has] the right to use the invention at the expiration of the term"—and this was the doctrine's "core principle."[96] Accordingly, the majority ruled that, come the expiration of the '375 patent, "the public should have the right to use the invention claimed in the patent and all obvious variants of that invention."[97]

The majority recognized that the Supreme Court had previously held that an earlier-issued patent could not be challenged based on a later-issuing patent.[98] However, it concluded that this was no longer true. Before the URAA, the issue date and expiration date were "inextricably intertwined," and the cases discussing "issue dates" were really using the issue date as a "reliable stand-in for the date that really mattered—patent expiration."[99] Now, however, only the expiration date mattered.[100]

93. Gilead Scis., Inc. v. Natco Pharma Ltd., No. 11-CV-1455 SDW-MCA, 2012 WL 6697411, at *2 (D.N.J. Dec. 21, 2012), *vacated and remanded*, 753 F.3d 1208 (Fed. Cir. 2014).

94. *Id.* at *4.

95. *Gilead*, 753 F.3d at 1208.

96. *Id.* at 1212 (quoting Odiorne v. Amesbury Nail Factory, 18 F. Cas. 578, 579 (C.C.D. Mass. 1819) (No. 10,430)) (some citations omitted) (emphasis added).

97. *Id.* at 1214 (emphasis added).

98. *Id.* at 1215 (citing Miller v. Eagle Mfg. Co., 151 U.S. 186, 197 (1894); Suffolk Co. v. Hayden, 70 U.S. (3 Wall.) 315, 319 (1865)).

99. *Id.* at 1214–15.

100. *Id.* at 1215.

The majority made only two allusions to patentee misconduct. The first was a remark in the statement of the facts that Gilead had "crafted" two separate chains of applications.[101] The second was the majority's second rationale for moving away from focusing on issue dates. The majority worried that patentees could play games by filing multiple applications with different filing dates and by then allowing the latest-filed one to issue first.[102]

Judge Rader, meanwhile, did not accept the public-rights justification. He criticized what he perceived as the majority's "flawed assumption that upon the expiration of a patent, the public obtains an absolute right to use the previously-claimed subject matter."[103] Rather, according to Judge Rader, the problem with ODP was that a "patentee could file successive continuations and obtain additional patent term for obvious modifications of its earlier claim."[104]

AbbVie Inc. v. Kennedy Institute[105]

Gilead was soon followed by another Federal Circuit case with a similar result. The Kennedy Institute owned two related post-URAA patents on methods of treating rheumatoid arthritis using a combination of two products. The first patent was the '766 patent, which issued in 2001. Filed on August 1, 1996, it claimed priority to a 1992 application through a continuation-in-part. Thus, the patent was set to expire twenty years from 1992, i.e., in 2012. In 2005, the Institute filed a continuation of a continuation of this application, which issued as the '442 patent. This time, though, the Institute claimed priority only to the August 1, 1996 date, so this patent would have been set to expire in 2016.[106] Additionally, the '442 patent had 750 days of PTA, and it was therefore set to expire on August 21, 2018.

101. *Id.* at 1210.
102. *Id.* at 1214–15.
103. *Id.* at 1219 (Rader, C.J., dissenting) (emphases added).
104. *Id.* at 1217 (emphasis added).
105. AbbVie Inc., v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust, 764 F.3d 1366 (Fed. Cir. 2014).
106. *Id.* at 1373 n.2.

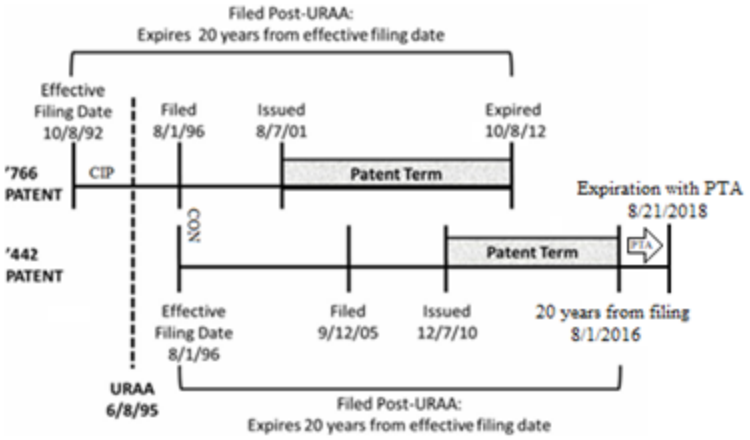

Figure 7: Timeline of the Kennedy Institute's patent prosecution

AbbVie had a license on the earlier '766 patent. When the '442 patent issued in 2010, the Kennedy Institute demanded that AbbVie take a license on that patent as well. AbbVie refused and sought a declaratory judgment that the '442 patent was invalid for ODP over the '766 patent. The district court granted the motion,[107] and the Federal Circuit affirmed. The unanimous opinion, authored by Judge Dyk and joined by Judges Wallach and Chen, again emphasized the public's right: "The ban on double patenting ensures that the public gets the benefit of the invention after the original period of monopoly expires"—and does not exist just to curb potential patentee "abuse[]" based on sequential filings.[108] In dicta, *Abbvie* declared that ODP could apply even where one patent expires later through no fault of the patentee but rather based on the Patent Office's "examination delays" that lead to "patent term adjustments."[109]

Abbvie did recognize that the patentee might have abused the system. It was troubled by the possibility that a patentee, like the Institute, might "choose[] to file separate applications for overlapping subject matter and to claim different priority dates for the applications."[110] However, *Abbvie*'s holding was not premised on that possibility.

107. AbbVie Inc., v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust, 956 F. Supp. 2d 429, 493 (S.D.N.Y. 2013), *aff'd*, 764 F.3d 1366 (Fed. Cir. 2014).
108. *AbbVie*, 764 F.3d at 1373 (emphasis added).
109. *Id.*
110. *Id.*

Gilead/AbbVie's Children

Gilead and *AbbVie* made an immediate splash. Practitioners had assumed that an earlier-issued patent could not lose term based on a later-issued one[111] (the Patent Office decisions in *Pfizer* and *Martek* notwithstanding). That was certainly no longer true. The scope of *Gilead*, however, remained unclear. Most significantly, the two patents in *Gilead* were unrelated, and the two patents in *AbbVie*, although related, claimed different effective filing dates. The more common scenario is overlapping claims among related patents that have the same effective filing date. This will typically happen where the Patent Office takes more time to issue the first application in a family, leading to the first patent receiving significant PTA. Later continuation patents, meanwhile, are often quickly allowed, and they will have little to no PTA.[112] In such cases, can the continuation commit patent patricide?[113]

It did not take long for this issue to come up in district courts, and most ruled that the child could kill its parent. These courts all quoted *Gilead*'s language that the primary justification for ODP was to protect the right of the public to use inventions claimed in expired patents.[114] Largely, these cases involved a later-expiring pre-URAA patent and an earlier-expiring post-URAA patent,[115] but one involved only post-URAA patents—where the difference in expiration date came from PTA.[116]

Judge Robinson's 2016 decision in *Merck Sharpe & Dohme Corp. v. Teva Pharmaceuticals USA, Inc.*, refusing to allow patent patricide, is the one exception.[117] Merck's pre-URAA '353 patent was challenged for

111. *See, e.g.*, Laurence H. Posorske & Christopher J. Nichols, *Will Novartis and Gilead Eviscerate Patent Term Adjustments?*, 28(2) INTELL. PROP. & TECH. L.J. 11, 13 (2016); N. Scott Pierce, *Inventorship, Double Patenting, and the America Invents Act*, 30 BERKELEY TECH. L.J. 1613, 1674–83 (2015); Emily A. Evans & Jill A. Jacobson, *Double Patenting Recapitulated*, 87 J. PAT. & TRADEMARK OFF. SOC'Y 625, 630 (2005).

112. Posorke & Nichols, *supra* note 111, at 13.

113. *See* Amelia F. Baur & Elizabeth A. Doherty, *Navigating Through the Obviousness-Type Double Patenting Minefield*, 10(3) LANDSLIDE 48, 51 (2018).

114. Novartis Pharms. Corp. v. Breckenridge Pharm., Inc., 248 F. Supp. 3d 578, 586 (D. Del. 2017), *rev'd* 909 F.3d 1355 (Fed. Cir. 2018); MLC Intellectual Prop., LLC v. Micron Tech., Inc., No. 14-cv-3657, 2017 WL 1493025, at *6 (N.D. Cal. Apr. 26, 2017); Janssen Biotech, Inc. v. Celltrion Healthcare Co., 210 F. Supp. 3d 278, 280 (D. Mass 2016); Magna Elecs., Inc. v. TRW Auto. Holdings Corp., No. 1:12-cv-654, 2015 WL 11430786, at *4 (W.D. Mich. Dec. 10, 2015); DDB Techs., L.L.C. v. Fox Sports Interactive Media, LLC, No. A-11-cv-929, 2014 WL 12167628, at *3 (W.D. Tex. May 15, 2014).

115. *Novartis*, 248 F. Supp. 3d at 578; *MLC*, 2017 WL 1493025, at *7; *Janssen*, 210 F. Supp. 3d at 278; *DDB*, 2014 WL 12167628, *4.

116. *Magna*, 2015 WL 11430786, at *3.

117. Merck Sharpe & Dohme Corp. v. Teva Pharm. USA, Inc., 217 F. Supp. 3d 782, 787–88 (D. Del. Nov. 14, 2016), *appeal dismissed*, No. 17-1366 (Fed. Cir. Apr. 6, 2017).

ODP over its direct continuation—the ’781 patent, which was also a pre-URAA patent.

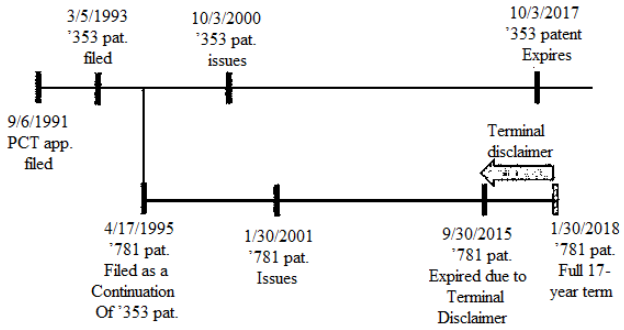

Figure 8: Timeline of Merck’s patent prosecution[118]

Because both patents were subject to the pre-URAA rules, the later-issued ’781 patent would normally expire later. But there was a hitch. During prosecution of the ’781 patent, Merck’s application went abandoned, and to revive it, Merck had to disclaim the time during which the application was abandoned.[119] As a result, Merck’s ’781 patent was going to expire before the ’353 patent (this is the unicorn of situations for pre-URAA patents, where the later-issued patent expires earlier).

Although both patents were pre-URAA patents, Judge Robinson did not find this significant. Instead, she assumed *Gilead* was applicable but distinguished it because of the “particular circumstances” of patent patricide: it would not be fair to the patentee for the child patent to be an ODP reference against “the first issued parent patent.”[120]

3. The Federal Circuit’s Narrow Application of ODP in Its 2018 Novartis Decisions

Last year, the Federal Circuit issued two decisions, coincidentally both involving Novartis, that appear to pull back from the *Gilead*/*AbbVie* framework. The first was *Novartis Pharmaceuticals Corp. v. Breckenridge Pharmaceutical Inc.*,[121] and the second was *Novartis AG v. Ezra Ventures LLC*.[122]

118. *Id.* at 787.
119. *See* 37 C.F.R. § 1.137 (2018).
120. *Merck*, 217 F. Supp. 3d at 787–88.
121. Novartis Pharms. Corp. v. Breckenridge Pharm. Inc., 909 F.3d 1355 (Fed. Cir. 2018).
122. Novartis AG v. Ezra Ventures LLC, 909 F.3d 1367 (Fed. Cir. 2018).

In *Breckenridge*, Novartis Pharmaceuticals owned two patents covering the drug Zortress: the earlier-filed, earlier-issued, *pre*-URAA '772 patent and the later-filed, later-issued, *post*-URAA '990 patent—a (non-safe-harbored) divisional of the '772 patent. Because of the URAA, the '772 patent was set to expire later.

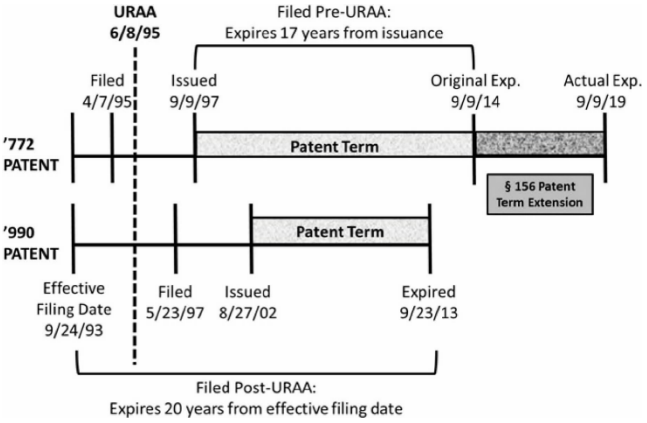

Figure 9: Timeline of Novartis's Zortress patent prosecution

The parties agreed that if the '990 patent was a proper ODP reference, then it invalidated the '772 patent. District Judge Andrews believed that *Gilead* was applicable, and he ruled that there was an ODP problem.[123]

The Federal Circuit reversed.[124] The appeal happened to go to a panel that included Judge Chen, who authored the majority opinion in *Gilead*, and (now Chief) Judge Prost, who joined in *Gilead*. The third judge in *Breckenridge* was Judge Wallach, instead of *Gilead*'s Judge Rader—who had since resigned from the Federal Circuit.

In a unanimous opinion authored by Judge Chen, the Federal Circuit ruled that *Gilead* was inapplicable for several reasons. The first was that *Gilead* involved two "*post*-URAA" patents, whereas Novartis had one pre- and one post-URAA patent.[125] Although this is a distinction, the *Breckenridge* court does little to explain why this this should make a difference.

123. Novartis Pharms. Corp. v. Breckenridge Pharm., Inc., 248 F. Supp. 3d 578, 600 (D. Del. 2017).

124. *Novartis*, 909 F.3d at 1355.

125. *Id.* at 1358.

Breckenridge's other reason is more persuasive: it argues that there was no evidence that the patentee, Novartis, did anything to game the system—unlike the patentees in *Gilead*/*AbbVie*. Gilead "'crafted a separate "chain" of application,'" which suggests there may have been "gamesmanship" on Gilead's part.[126] *AbbVie* involved "an inventor[] seeking to prolong his exclusivity" by filing two patents with "different" priority dates.[127] In its conclusion, *Breckenridge* reiterated that ODP exists to "prevent a patent owner from extending the exclusivity rights over his invention beyond a full patent term. We saw this impermissible practice in *Gilead* and in *AbbVie*, where the patent owners claimed different effective filing dates for different patents (involving related inventions) to extend the life of patent exclusivity."[128] Thus, the Federal Circuit in *Breckenridge* was framing *Gilead* and *AbbVie* as cases where patentees gamed the system by playing with filing dates. Novartis, meanwhile, was just filing normal continuation applications that happened to expire earlier than their parents, so a later-issued continuation patent should not be able to commit patent patricide. Thus, *Breckenridge* does not put much stock in the public-rights justification for ODP.

The same day that the Judge Chen issued his *Breckenridge* opinion, he also issued another ODP decision in *Ezra*.[129] Novartis held two patents covering its drug Gilenya, but the two patents were unrelated to one another. One was its pre-URAA '229 patent, which was filed in 1993 and issued in 1997, and the other was its post-URAA '565 patent, which was filed in 1997 and issued in 1999. The '229 patent was set to expire in 2014, and the '565 patent was set to expire in 2017. Novartis then received PTE on its '229 patent, extending the term until 2019.

126. *Id.* at 1364 (quoting Gilead Scis., Inc. v. Natco Pharma Ltd., 753 F.3d 1208, 1210 (Fed. Cir. 2014)).

127. *Id.* at 1364–65 (analyzing AbbVie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust, 764 F.3d 1366, 1373–74 (Fed. Cir. 2014)).

128. *Id.* at 1367.

129. *Id.*

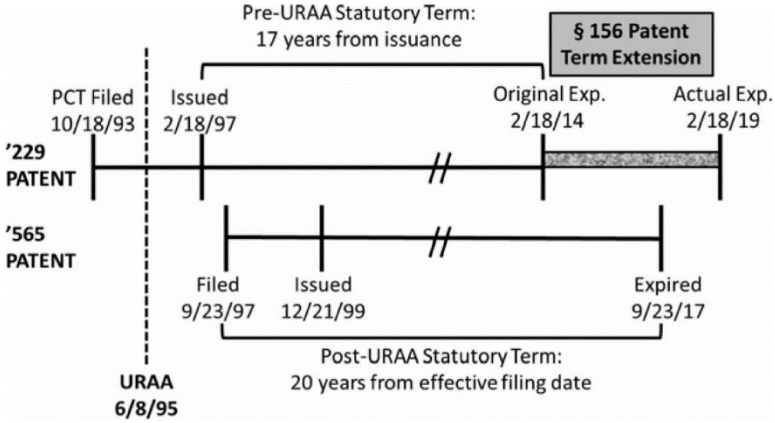

Figure 10: Timeline of Novartis's Gilenya patent prosecution[130]

When Novartis sued Ezra for infringing the '229 patent, Ezra argued that the '229 patent was invalid for ODP. Delaware's Judge Stark rejected Ezra's argument, ruling that ODP cannot cut PTE short.[131] The Federal Circuit affirmed. After finding that the statute and its own prior case law mandated this result, the Federal Circuit turned to "Ezra's Policy Concerns."[132] It explained that the case "does not present the concerns that drove [the] recent decisions" in *Gilead* and *AbbVie*.[133] *Gilead*, it explained, sought to avoid situations where patentees "orchestrate" longer exclusivities, but "Ezra does not identify any similar tactics on the part of Novartis."[134] Again, Judge Chen relied on patentee-based justifications for ODP and did not put much weight in the public-rights justifications.

IV. PATENT PATRICIDE IS BAD POLICY BUT NOT UNPRECEDENTED

Patent patricide is sometimes a billion-dollar question. Patents on pharmaceutical drugs can be worth billions of dollars a year,[135] and these

130. Novartis AG v. Ezra Ventures, LLC, 909 F.3d 1367, 1370 (Fed. Cir. 2018).

131. Novartis AG v. Ezra Ventures, LLC, No. 15-150, 2016 WL 5334464, at *3 (D. Del. Sept. 22, 2016).

132. *Ezra*, 909 F.3d at 1374 (Fed. Cir. 2018).

133. *Id.*

134. *Id.* at 1375 (quoting Gilead Scis. Inc. v. Natco Pharma Ltd., 753 F.3d 1208, 1215 (Fed. Cir. 2014)).

135. Jamie F. Cárdenas-Navia, *Thirty Years of Flawed Incentives: An Empirical and Economic Analysis of Hatch-Waxman Patent-Term Restoration*, 29 BERKELEY TECH. L.J. 1301, 1347 (2014); Verne A. Luckow & Steven C. Balsarotti, *Statistical Analysis of Federal District Court Cases Seeking Longer Patent Term Adjustments in the Wake of* Wyeth v. Kappos, 10 J. MARSHALL REV. INTELL. PROP. L. 1, 21, 44 (2010).

patents often have *years* of PTA.[136] So the PTA is worth billions of dollars. It is common practice for inventors to file continuation applications,[137] but if continuation applications can commit patent patricide, those continuation applications may not be worth it.

A. The Federal Circuit's Inconsistent Signals about Patent Patricide

Pre-URAA patents are obsolescent. Such patents had to be filed on June 7, 1995 and had to issue less than 17 years ago. The billion-dollar question is how ODP applies to post-URAA patents that are related. Unfortunately, the Federal Circuit's statements provide inconsistent guidance.

Gilead/AbbVie's Broad Statements

Although *Gilead* and *AbbVie* involved the more troubling situation of a patentee filing multiple patents with *different* priority dates, they both rely on the public's right to use expired patents. The public-rights rationale applies just as much to patents having the same filing date as to patents that have different filing dates. Moreover, *AbbVie* (in a parenthetical) even discusses the situation of related patents having different expiration dates due to PTA.[138] Thus, *Gilead*/*AbbVie* would seem to allow patent patricide even for a standard continuation application.

Breckenridge's Descriptions of Its Own Scope

Breckenridge describes its own facts as "present[ing] a narrow legal question: can a post-URAA patent that issues after and expires before a pre-URAA patent qualify as a double patenting reference against the pre-URAA patent?"[139] The court "conclude[s] under the circumstances of this case that it cannot."[140] All these caveats suggest that the Federal Circuit does not want to make waves with this opinion. And these are not just

136. Luckow & Balsarotti, *supra* note 135, at 8.

137. *See* Christopher A. Cotropia & Cecil D. Quillen, Jr., *Continuing Patent Applications and Performance of the U.S. Patent and Trademark Office as of Fiscal Year 2017* (Mar. 19, 2018) at 5, INTELLECTUAL PROPERTY INSTITUTE, Research Paper No. 2018-01, https://ssrn.com/abstract=3147056 [https://perma.cc/KXJ5-6KBN].

138. AbbVie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust, 764 F.3d 1366, 1373 (Fed. Cir. 2014).

139. Novartis Pharms. Corp. v. Breckenridge Pharm. Inc., 909 F.3d 1355, 1361 (Fed. Cir. 2018).

140. *Id.* at 1361–62.

one-off remarks. *Breckenridge* repeatedly emphasizes that it would be unfair for a patentee to lose term based on the URAA's "intervening change in law," and it emphasizes Congress's concern with giving pre-URAA patents their "maximum possible term."[141] None of those reasons apply to ODP for two post-URAA patents.

How the *Novartis* Decisions Distinguish *Gilead* and *AbbVie*

Breckenridge distinguishes *Gilead* and *AbbVie* for two reasons: *first*, those cases involved two post-URAA patents, and *second*, in those cases the patentee played games with the claimed priority dates.[142] But what if only one of the rationales is present—like a case involving two post-URAA patents with no gaming of priority dates. Can the child commit patent patricide?

Ezra is similarly ambiguous. The court ruled that there were statutory reasons that ODP should not cut PTE short. But it also noted that Novartis had not used improper "tactics" to extend its monopoly. Are improper "tactics" a requirement for an ODP rejection?

The Differing Justifications for ODP

As this article has detailed, there have always been multiple justifications for prohibiting ODP: (1) the public has a "right to use the invention at the expiration of the term," and (2) the patentee should not be permitted to "perpetuate his exclusive right during a century" where the Patent Act limits patent term.[143]

This dichotomy is, possibly, the distinction between *Gilead*/*AbbVie*, on the one hand, and the *Novartis* decisions on the other. According to *Gilead* and *AbbVie*, "the bar against double patenting was created to preserve that bargained-for right held by the public."[144] By contrast, *Breckenridge* describes the "key purpose" of the ODP doctrine as "prevent[ing] a patent owner from extending the exclusivity rights over his invention beyond a full patent term," and both *Novartis* decisions are troubled by the "gamesmanship" in *Gilead* and *AbbVie*.[145]

141. *Id.* at 1357–59, 1364, 1366–67.

142. *Id.* at 1365–67.

143. Odiorne v. Amesbury Nail Factory, 18 F. Cas. 578, 579 (C.C.D. Mass. 1819) (No. 10,430) (emphasis added).

144. AbbVie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust, 764 F.3d 1366, 1372 (Fed. Cir. 2014) (quoting Gilead Scis. Inc. v. Natco Pharma Ltd., 753 F.3d 1208, 1212 (Fed. Cir. 2014)) (citations omitted; emphasis added).

145. *Breckenridge*, 909 F.3d at 1362, 1367 (emphasis added); Novartis AG v. Ezra Ventures, LLC, 909 F.3d 1367, 1374 (Fed. Cir. 2018).

The justification is critical for how to apply ODP to continuation applications. If the reason for ODP is that the public should always be free to use an expired patent, then it should not matter whether the expired patent is a parent or a continuation. Nor should any of the other factors be relevant either: it should not matter whether the expired patent is (1) a pre- or post-URAA patent; (2) the earlier-filed or later-filed patent; (3) the earlier- or later-issued patent; or (4) related to the challenged patent. Once a patent expires, the public is free to use the patented invention and its obvious variations. *Gilead* and *AbbVie*, which focus on the free-to-use-upon-expiration rationale, thus suggest a very broad application of ODP. By contrast, if the concern underlying ODP is an unfair extension of the patentee's rights, an earlier-filed, earlier-issued patent (at the very least) should keep one full patent term independent of whether a later application is filed.

B. The Federal Circuit Should Not Allow Patent Patricide

At some point, the Federal Circuit will have to decide whether a standard continuation application that issues after its parent can serve as an ODP reference against its earlier-issued parent. The court should conclude that it cannot. *First*, "the traditional obviousness-type double patenting practices extant in the pre-URAA era" was to look at the patent's "issuance date."[146] History thus favors letting an earlier-issued patent keep its full term.

Second, as explained above, §121 of the Patent Act shows that a patentee who has done nothing wrong should not be forced to give up term for ODP. Allowing patent patricide would do just that.

Third, in most cases, the later-issuing patent will be the continuation patent—a fact that will be evident on the face of the patent.[147] A member of the public reading the continuation patent will therefore recognize that the rights conferred by the patent are subject to the pre-existing rights from the parent patent. Therefore, as Judge Taft explained, the public is on notice that there may be other relevant patents.[148]

Fourth, normally, "the duration of the term of the United States patent is fixed when the patent issues."[149] Unless a patentee does something that deserves punishment—like the gamesmanship of *Gilead*

146. *Breckenridge*, 909 F.3d at 1358.

147. *See* 37 C.F.R. § 1.78(d) (2018).

148. *See* SHAFFER, *supra* note 41 (discussing Thomson-Houston Elec. Co. v. Ohio Brass Co., 80 F. 712, 728 (6th Cir. 1897)); *accord* WILES, *supra* note 39, at 505 (explaining that double patenting should not apply where the reference patent gives "due notice" that it is a follow-on patent).

149. Paillard v. Bruno, 29 F. 864, 865 (C.C.S.D.N.Y. 1886).

and *AbbVie*—there is no reason that obtaining a later-issued patent should affect the term of an earlier-issued one. Looking to the issue date solves this problem: the first-issued patent gets its full term, and the inventor's decision to continue prosecuting applications will not cut that term short. On the other hand, ODP still prevents an inventor who already has an issued patent from extending her monopoly by receiving PTA on a later-issued continuation.

Fifth, a close statutory analogue to ODP shows that patent terms should not change after the patent has been issued. In 1839, Congress passed a statute that provided that if an inventor received a foreign patent six months before filing a U.S. "application," then the term of the U.S. patent would be fourteen years (the statutory patent term at the time) "from the date or publication of such foreign letters patent."[150] In *Bate Refrigerating Co. v. Sulzberger*, the Supreme Court explained that the 1839 Act meant what it said about the U.S. "application" date: so long as the U.S. application was filed before the grant of the foreign patent, it did not matter when the U.S. patent itself issued.[151] The focus on the application date seems to reflect a patentee-based concern that the inventor should file in the U.S. first. Assuming the inventor does, she will get her full patent term independent of which country happens to issue her patent first.

However, in 1870 Congress changed the language to focus on the "grant" date instead of the "application" date. Thus, the 1870 Act provided that "every patent *granted* for an invention which has been previously *patented* in a foreign country shall be so limited as to expire at the same time with the foreign patent."[152] Under the 1870 statute, the Supreme Court explained, it did not matter where the inventor *filed* first. What mattered was where the patent *issued* first.[153] As *Bate* explained, this was a public-rights justification: "the American public became entitled to use the invention from the time the foreign public were permitted to use it."[154] Notably, even in this public-rights scheme, the Supreme Court still accepted that a patent's term is fixed at the time of issuance. A patentee would not lose term if the inventor failed to pay foreign maintenance fees after the U.S. patent issued—even though this would mean the foreign patent expired before the U.S. one.[155] By analogy

150. 5 Stat. 354, c. 88, § 6 (1839).
151. Bate Refrigerating Co. v. Sulzberger, 157 U.S. 1, 43 (1895).
152. Patent Act of 1890, Ch. 230, 16 Stat. 198–217 (July 8, 1870) (emphasis added).
153. *See Bate*, 157 U.S. at 35–36.
154. *Id.* at 36.
155. *See* Pohl v. Anchor Brewing Co., 134 U.S. 381, 385 (1890).

to ODP (an analogy that the Supreme Court made),[156] once a domestic patent issues, its term should be set for ODP purposes independent of what happens after.

Sixth, even if *Gilead* is right to move away from the issue date, it is not clear why the court moved to the expiration date. If, as *Gilead* claims, pre-URAA issue dates were a "stand-in" for expiration dates,[157] then, logically, courts should now look to the new "stand-in": the effective filing dates. Focusing on the effective filing date is particularly appealing given that even before the URAA a minority of courts believed that a later-*filed* patent could not serve as an ODP reference against an earlier-filed one.[158] It bears noting that *Gilead*'s choice of the expiration date instead of the effective filing date was unnecessary to *Gilead*'s holding. In *Gilead*, the earlier-filed patent was the earlier-expiring one. The choice of the expiration-date was dicta.

Focusing on the priority date instead of the expiration date will often be quite important. In cases where two patents have different effective filing dates, the approach described above would mean that the one with the earlier filing date could not be invalidated for ODP over the one with the later date—even if the earlier-filed one was set to expire later because of PTA.

More significantly, in cases where two patents share the same effective filing date—as will happen in essentially *every* continuation application—looking to the filing date creates a tie. Before the URAA, the rule was that when you had a tie, i.e., when two pre-URAA patents issued on the same day, at the very least, the earlier-numbered patent was unchallengeable in view of the later-numbered patent, and the majority view was that neither patent could be challenged over the other.[159] As applied to patents with the same effective filing dates, this would mean that the earlier-issued patent could not be challenged over the later-issued one, and, perhaps, both would be unchallengeable over the other.

156. *See* Fireball Gas Tank & Illuminating Co. v. Commercial Acetylene Co., 239 U.S. 156, 160–66 (1915).

157. Gilead Scis., Inc. v. Natco Pharma Ltd., 753 F.3d 1208, 1215 (Fed. Cir. 2014).

158. *See* STRINGHAM, *supra* note 39, §§ 2804(A), 2804(B), 50–58 (recognizing but criticizing this view). For example, the Supreme Court in The Barbed Wire Patent, 143 U.S. 275, 281 (1892), writes that "the date of the application and not the date of the patent controls." In Nat'l Elec. Ticket Register v. Automatic Ticket Register Corp., 15 F.2d 257, 257–58 (2d. Cir. 1926), the court invalidated one of Sullivan's patents over his own earlier-filed but later-issued patent.

159. *See* 3A CHISUM ON PATENTS § 9.03(2)(d) (2018); STRINGHAM, *supra* note 39, §§ 2856, 2856(A), 379–83.

C. Sometimes a Patentee's Rights Change After Her Patent Issues

Despite the desire for having a patentee's rights vest at the time a patent issues, the Patent Act does, in at least one circumstance, allow for post-issuance events to affect a patentee's rights. If one patentee receives a patent to an invention but a second inventor later decides to file claims (from an earlier-filed application) to the same invention, the second inventor's post-issuance decision to amend her claims can, retroactively, invalidate the first patent.[160] Nevertheless, one troubling law[161] does not justify another.

CONCLUSION

For a doctrine that has existed for two centuries, ODP is a surprisingly unsettled area of law. As shown above, much of the confusion stems from the differing justifications for ODP. Is the problem that a patentee should not be able to unduly extend his or her patent term or is it that the public should be entitled to assume that inventions claimed in an expired patent are free to the public?

The implications are immense if an inventor is considering filing a continuation application on a patent that has received significant PTA. For now, applicants should consider (1) filing many claims in their original applications to force restriction requirements, which provide a statutory safe harbor from double patenting rejections[162]; (2) not allowing a continuation application to issue; and/or (3) keeping a live continuation application to see how the law settles.

160. *See* Dynamic Drinkware, LLC v. Nat'l Graphics, Inc., 800 F.3d 1375, 1381–82 (Fed. Cir. 2015); *id.* at 1381 n.2. Even without *Dynamic Drinkware*, this can happen where an applicant allows an earlier-filed application to publish.

161. *See In re* Wertheim, 646 F.2d 527, 537 (C.C.P.A. 1981) ("[W]e will extend the 'secret prior art' doctrine . . . only as far as we are required to do so.").

162. *See* 35 U.S.C. § 121 (2012).