

2014 FICPI ABC MEETING

Day 2

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Topic 4:

Double Patenting-The Silent Killer...

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Double-Patenting in Canada

2014 FICPI ABC Meeting

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INTELLECTUAL PROPERTY LAW

The Statutory Basis

- Section 36(1) of the *Patent Act* provides that a “patent shall be granted for one invention only...”
- Section 36(1) has been interpreted to mean that the “inventor is only entitled to ‘a’ patent for each invention”. *Whirlpool v. Camco*, p. 1104, [2000] 2 S.C.R 1067 (SCC).
- Section 36 of the *Patent Rules* provides that “an application does not claim more than one invention if the subject-matters defined by the claims are so linked as to form a single general inventive concept” (emphasis added)

What is Double-Patenting?

- There are two types of double-patenting:
 1. Conterminous claims
 - “A subsequent claim cannot be invalidated on the ground of prior claiming unless the two claims are precisely conterminous.” *Whirlpool v. Camco*, p. 1105, [2000] 2 S.C.R 1067 (SCC).
 2. Obviousness-type double patenting
 - Prevents issuance of a second patent with claims that are not “patentably distinct” from the claims of an issued earlier patent. *Whirlpool v. Camco*, p. 1105, [2000] 2 S.C.R 1067 (SCC).
 - Claims in divisional must be patentability distinct from parent!

What is Double-Patenting?

- The general inventive concept is assessed based on the elements in the claim and not the preamble.
 - Independent claims that define the solution to a problem (or how it is to be put into operation or manufactured, as the case may be) may all relate to a single inventive concept.
 - Independent claims share a general inventive concept if they each contain a set of new and unobvious elements that are those required for the proper operation of the invention in its broadest aspects.
- Acceptable types of claims in one application:
 - a product and a process for making that product;
 - a product and a use (or method of using) that product;
 - a product, a process for making that product, and a use of that product;
 - an apparatus and a process carried out on that apparatus.

The Harm of Double-Patenting?

- Evergreening (*Whirlpool v. Camco*, p. 1104, [2000] 2 S.C.R 1067 (SCC)).
 - But the standard term of a patent is 20 years from the filing date.
 - No patent term adjustment in Canada
- Gut reaction – it's wrong
 - “..regardless of whether ‘the sin of double patenting’ [i.e., evergreening] still exists, a patent holder should not be able to receive additional patents for the same invention” (see *GlaxoSmithKline Inc. v Apotex Inc.*, (2003), 27 CPR (4th) 114 at para. 89)

When Does Double Patenting Arise?

- Applies to any two applications or patents that are owned by the same company.
 - Applies to applications that have the same filing/priority date.
- Can arise:
 - during prosecution by an Examiner (double patenting rejection); or
 - during enforcement of a patent.

Divisional Applications

- Divisional applications are permissible in Canada
 - Voluntary divisional applications
 - 36(2) Where an application ...describes more than one invention, the applicant may limit the claims to one invention only, and any other invention disclosed may be made the subject of a divisional application....
 - Directed divisional applications
 - 36(2.1) Where an application ... describes and claims more than one invention, the applicant shall, on the direction of the Commissioner, limit the claims to one invention only, and any other invention disclosed may be made the subject of a divisional application....
- There are no continuation or CIP applications in Canada
- There are no Terminal Disclaimers in Canada

Divisional Applications

- If an application contains more than one invention, the Examiner will issue a unity of invention rejection.
- Directed divisional applications
 - ...if the filing of a divisional application was “directed by the Patent Office”, the doctrine of double-patenting does not apply between the divisional and any of its parent or sibling applications. (Manual of Patent Office Practice (“MPOP”), page 14-26); *Consolboard Inc. v. Macmillan Bloedel (Saskatchewan) Ltd.* (1981), 56 C.P.R. (2nd), 145 (S.C.C.) at page 169
 - Section 36(1) of the *Patent Act* provides that “...in an action or other proceeding a patent shall not be deemed to be invalid by reason only that it has been granted for more than one invention”.
- Therefore do not file a voluntary divisional application except in a clear case
 - Force a unity of invention rejection

Case 1: Applicant Wants additional Protection

- Only one Canadian application is pending and a U.S. continuation application has been filed with additional claims or the applicant would like to target claims at a new infringing product.
- Place all desired claims for a given description into the Canadian application
 - No limit on the number of claims
 - No excess claim fees or extra fees for multiply dependent claims

Case 1: Applicant Wants additional Protection

- Can add claims to a Canadian application any time up until the payment of the final fee.
 - Pre allowance – file a voluntary amendment
 - Part allowance:
 - Consider an Amendment after Final
 - Abandon and reinstate
- If the Examiner issues a unity of invention rejection, file a divisional application.

Case 1: Applicant Wants additional Protection

- Can I have my cake and eat it to? No.
- The Canadian application is allowed and the client would like to file a divisional application in case additional claims are needed when a competitive product is introduced.
 - The scope of the possible additional claims is unknown.
 - Do not let the Canadian application issue since there may be a double patenting rejection.
- Chose immediate protection and risk double patenting or delay issuance.

Case 2: Multiple Pending Applications

- Two co-pending Canadian applications which have the same description.
 - E.g., multiple applications filed in Europe with different sets of claims but the same description to avoid excess claim fees.
- If a double patenting rejection is raised, consider placing all of the claims in one of the pending Canadian applications.

Case 3: Multiple Pending Applications

- Two co-pending Canadian applications which have the different descriptions.
 - Can the claims from one application be inserted in the other?
 - If no, can you (do you want to) argue that the claims are patentably distinct?
 - If no, can you amend the claims to be patentably distinct?
 - If no, select claims to abandon.

Case 4: A Patent has Issued

- Two possible scenarios:
 1. A double patenting rejection is issued during prosecution of a pending application citing an issued patent.
 2. Two patents issued and an infringer alleges one patent is invalid for double patenting.
- Solution – change the claims of the issued patent
 - Re-issue (s. 47 of the *Patent Act*)
 - Disclaimer (s. 48 of the *Patent Act*)
 - Re-examination (ss. 48.1 – 48.5 of the *Patent Act*)
 - Dedication to the public

Re-issue

- A patent may be reissued if it claims more or less than the patentee has a right to claim.
 - Can be used to add narrower claims to avoid double-patenting
 - Can be used to expand claims to cover those in a pending divisional application
- The reissued claims are treated as if they were the claims initially granted. In any action commenced after the reissue. The reissue does not affect pending actions.
 - Must act before an invalidity action commenced.
- Problems
 - Must apply within 4 years of the grant of the patent
 - If the claims that are sought are broader than the claims in the original patent, the new claims must be directed to what the patentee was attempting to protect in the original patent (MPOP, page 23-6)
 - The new claims must be directed to the same invention that the patentee attempted to protect in the original patent (MPOP, page 23-8)
 - The error must be the result of “inadvertence, accident or mistake”.

Re-issue

- What is “inadvertence, accident or mistake”.
 - the patent agent failed to comprehend and claim the invention properly
 - The fact that the original patent disclosed but did not claim the matter covered in the reissue may be a ground to reissue if it can be shown that there was intent to claim the subject matter.
- The onus is on the patentee to demonstrate his or her intent to protect the new claims
 - The evidence of the inventors at the filing of the reissue petition cannot be used to establish intent
- Reissue is not to be used to
 - reassert claims that were deliberately cancelled during the prosecution of the original patent
 - change the claims because the patent is being circumvented by others

Disclaimer

- A patentee may file a disclaimer to amend a patent to claim less than which was claimed in original patent
- Cannot use disclaimer to correct double-patenting issues for a pending action (48(4) of *Patent Act*)
- A disclaimer may only be filed if the problem arose due to mistake, accident or inadvertence

Re-Examination

- A patent may be re-examined at the instance of any person if a substantial new question of patentability affecting any claim is raised by any patent, published application, or printed publication.
- Problems
 - Need new prior art
 - The patent may be cancelled or the claims restricted more than desired
- If claims are cancelled, then the patent is deemed to have issued with the corrected claims as of the initial date of grant. (s. 48.4(3) of the *Patent Act*)
 - Can cure double patenting
- If claims are amended, or a new claim inserted, the original claims are considered to exist up until the date of the re-examination decision and the new and amended claims are effective from the date of the certificate of re-examination (s. 48.4(3) of the *Patent Act*)
 - Will not cure double patenting

Dedication to the Public

- Invalidity due to double patenting is not cured by dedication to the public of the portion of the patent term beyond the term of the prior patent (i.e., called a “terminal disclaimer”) – *Bayer v. Canada* (1998), 82 C.P.R. (3d) 359 (F.C.T.D.)
- May be able to disclaim entire claims of a patent to avoid double-patenting
 - “...after claims have been dedicated, the patent is to be construed without reference to the dedicated claims” (*Abbott Laboratories et al. v The Minister of Health and Sandoz Canada Inc.*, 2010 FCA 168)



Thank You

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INTELLECTUAL PROPERTY LAW

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Double Patenting Under U.S. Law

SUTHERLAND

- Two Types of Double Patenting
 - Statutory Double Patenting
 - Non-Statutory Obviousness-Type Double Patenting
- Terminal Disclaimer
- Restriction Practice
- Case Law

Two Types

- **Statutory Double Patenting**
 - 35 USC § 101
 - An applicant (or assignee) is prohibited from obtaining two patents on the same invention.
- **Non-Statutory Obviousness-Type Double Patenting**
 - An applicant (or assignee) is prohibited from obtaining a patent on an obvious variation of an invention for which the applicant (or assignee) already has a patent.

Two Types (continued)

- **Double Patenting May Be Raised:**
 - As a rejection by the examiner during prosecution.
 - As grounds for Post-Grant Review.
 - As grounds for invalidity during litigation.
- **Purpose:**
 - Prevent the unjustified extension of exclusive rights beyond the term of a patent.
 - Public should be free to use the invention and obvious modifications after expiration.

Statutory Double Patenting

- Only concerned with the claims.
- Use of the specification usually not permitted.
- Identical subject matter.
- Is there an embodiment that falls within the scope of one claim but not the other?
- Can one claim be literally infringed without literally infringing the other?
- Response:
 - Amend the claims.
 - Cancel the claims.
 - Terminal Disclaimer is not available.

Non-Statutory Obviousness-Type Double Patenting

- Only concerned with the claims.
- Use of the specification usually not permitted.
- Conflicting claims are not identical.
- But not “patentably distinct” because the latter claim is either anticipated or obvious over the reference claim.
- Response:
 - Amend the claims.
 - Cancel the claims.
 - Argue why patentably distinct.
 - File a terminal disclaimer.

- 35 USC § 253
 - Ensures that the term of a patent granted on the application will not extend past the term of the conflicting patent.
 - Requires common ownership through the term.
 - Prevents the potential for harassment of a potential infringer by multiple patent owners.
 - USPTO allows the patentee to improve upon his original invention.
 - But does not allow the patentee to extend the patent term to prevent others to practice the invention or obvious variations.

- 35 USC § 121

- A patent issuing on an application with respect to which a requirement for restriction has been made;
- Or on an application filed as a result;
- Shall not be used as a reference in the PTO or the courts against a divisional application or against the original application.
- Only applies when a restriction requirement is made.
- Can be lost if claims are not commensurate with the restriction “consonance”.

Duty to Disclose

- Applicants must disclose information within their knowledge as to copending US applications that is “material to patentability”.
- MPEP 2001.06(b).

- *St. Jude Medical, Inc. v. Access Closure, Inc.*
 - St. Jude files for devices and methods for sealing a vascular puncture (Grandparent application).
 - PTO demanded restriction between devices (Group I) and methods (Group II).
 - Also demanded a three way species election (Group IA, IB, IC) and (Group IIA, IIB, IIC).
 - St. Jude elected Group IB – devices with a hollow dilator and guidewire.
 - St. Jude files divisional application (Divisional application).
 - Same restriction and same election.
 - St. Jude files continuation of Grandparent application (Janzen patent).

- Device and method claims but to a different species (Group IC and IIC).
- St. Jude files a further continuation of the Grandparent application (Sibling application).
- Methods only but not species I, II, III.
- St. Jude sues Access Closure on the Janzen patent.
- Access Closure defends on the basis of double patenting.
- St. Jude did not follow the “lines of demarcation” required by the restriction requirements.
- Lost “consonance”.

Two Way or Six Way?

- Majority said consonance followed with the Grandparent, Divisional, and Janzen.
- But not Sibling.
- Sibling not filed “as a result of” the restricted Grandparent application because:
 - Did not claim any of the three species.
 - Had a generic claim that would overlap with the species claims of Janzen.
- **Concurrence said two way**
 - No consonance with Janzen.
 - Because it claims methods and devices.

- *In re Hubbell* (2013): common ownership is not required for obviousness-type double patenting.
- Common inventors was sufficient.
- *Eli Lilly & Co. v. Teva* (2012): The claims of an earlier patent alone should be considered for obviousness-type double patenting, *except*:
 - the disclosure of the earlier patent is necessary to construe the scope of the earlier claims; or
 - the later application claims a use for a composition claimed in the earlier patent wherein the use itself is disclosed but not claimed in the earlier patent.



Double Patenting in the European Patent Office

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2 main types of double patenting problem

Internal priority – i.e. European patent application B claims priority from European patent application A

Conflicting divisional – i.e. European patent application B is a divisional of European patent application A

How would such situations arise?

First Application A filed without priority claim – quick EPO search

Then application B contains further embodiment and claims priority from application A

or

Application B filed as divisional to cover broad invention and application A prosecuted quickly in respect of specific preferred embodiment

Historical development of EPO position on double patenting

T587/98 – 12 May 2000

Divisional having scope encompassing subject matter of parent allowed

Enlarged Board of Appeal decisions G1/05 and G1/06
– 28 June 2007

Obiter dictum

“Prohibition of double patenting based on idea that the applicant has no legitimate interest in proceedings that give rise to the grant of a second patent in respect of the same subject matter for which he already holds a patent.”

T307/03 – 3 July 2007

Relied on Art 60 EPC – “The right to a European patent shall belong to the inventor or his successor in title.”

Interpreted as meaning inventor or successor in title has right to grant of one, and only one, patent for a particular invention

Refused divisional whose claims encompassed subject matter of parent

T877/06 – 2 December 2009

Partial overlap in scopes of protection does not give rise to double patenting prohibition

T1423/07 – 19 April 2010

Related to internal priority – allowed later European application claiming priority from earlier European application having claims of identical scope

Decided A60 EPC not basis for double patenting rejection

Decided applicant had legitimate interest in extra patent term (arising from later filing date)

G2/10 – 30 August 2011

Not abusive, and legitimate, to obtain first quicker protection for preferred embodiment and pursue the general teaching in divisional application

So where are we now?

EPO Guidelines for Examination GIV.5.4

16 September 2013

The EPC does not deal explicitly with the case of co-pending European applications of the same effective date filed by the same applicant. However, it is an accepted principle in most patent systems that two patents cannot be granted to the same applicant for one invention. The Enlarged Board of Appeal has accepted obiter dictum that the principle of the prohibition on double patenting is based on the notion that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent for that subject-matter (see [G 1/05](#), and [G 1/06](#)).

The applicant may, for example, be interested in obtaining a first quicker protection for a preferred embodiment and pursue the general teaching in a divisional application (see [G 2/10](#)).

However, in the rare case in which there are two or more European applications from the same applicant definitively designating the same State or States (by confirming the designation through payment of the relevant designation fee) and the claims of those applications have the same filing or priority date and relate to the same invention, the applicant should be told that he must either amend one or more of the applications in such a manner that the subject-matter of the claims of the applications is not identical, or choose which one of those applications he wishes to proceed to grant.

If he does not do so, once one of the applications is granted, the other(s) will be refused under [Art. 97\(2\)](#) in conjunction with [Art. 125](#). If the claims of those applications are merely partially overlapping, no objection should be raised (see [T 877/06](#)). Should two applications of the same effective date be received from two different applicants, each must be allowed to proceed as though the other did not exist.

EPO Guidelines for Examination CIX1.6 – 16 September 2013

The parent and divisional applications may not claim the same subject-matter (see [G-IV, 5.4](#)). This means not only that they must not contain claims of substantially identical scope, but also that one application must not claim the subject-matter claimed in the other, even in different words. The difference between the claimed subject-matter of the two applications must be clearly distinguishable.

As a general rule, however, one application may claim its own subject-matter in combination with that of the other application. In other words, if the parent and divisional applications claim separate and distinct elements A and B respectively which function in combination, one of the two applications may also include a claim for A plus B.

A125EPC, G1/05 and G1/06 – will object to double patenting where both applications claim the same subject matter

G2/10 – can protect narrow parent and broad divisional

T877/06 – partial overlap of scope permitted

Implication for granted European patents in the UK

UK Patents Act – S.18(5) – UKIPO may refuse an application where there are 2 UK national applications for same invention

UK Patents Act – S73(2) – UKIPO revokes UK patent if UK national patent and European patent (UK) cover same invention

However, there does not appear to be any provision for invalidity or revocation when 2 European patents (UK) cover same invention

Therefore seems little risk of invalidity of UK parts of granted European patents which avoid double patenting prohibition



Thank you

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