Federal Circuit Expands ‘Specification’ Exception for Obviousness-Type Double Patenting Rejections

Yesterday, the Court of Appeals for the Federal Circuit expanded an exception to the general rule that the specification is not used in determining whether a claim is invalid for obviousness-type double patenting. The Federal Circuit expanded the reach of the judicially created doctrine of obviousness-type double patenting in Sun Pharmaceutical v. Eli Lilly (2010-1105, July 28, 2010). The doctrine was expanded when the Federal Circuit held that for an obviousness-type double patenting rejection involving two patent documents claiming a compound and a method of using the claimed compound the analysis requires that the specification of the compound patent be analyzed for any disclosed uses. The Federal Circuit held that a “claim to a method of using a composition is not patentably distinct from an earlier claim to the identical composition in a patent disclosing the identical use,” extends to any and all such uses disclosed in the specification of the earlier patent.” In this case, the earlier-filed patent issued with claims reciting a compound and a method of using the compound to treat a viral infection. The later-issued patent claimed methods of using the same compound to treat cancer. The method of treating cancer was disclosed in the earlier-issued patent but not claimed. Although the Federal Circuit acknowledged the general rule that an earlier patent’s specification is not available to show obviousness-type double patenting,” the Federal Circuit stated that there are “certain instances” in which the “specification of an earlier patent may be used in the obviousness-type double patenting analysis.” One such instance is where an earlier patent claims a compound and the later patent claims a method of its use. To determine the scope of the claimed compound for purposes of obviousness-type double patenting, the specification must be considered. Therefore, a use of a compound that is disclosed in an earlier patent, but is not claimed, is an obvious variant if an applicant later tries to claim the use in a separate application.

The complete decision can be found at: www.cafc.uscourts.gov/images/stories/opinions-orders/10-1105.pdf.

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