Developments up to second-filed application relevant to show no double patenting

The **Federal Circuit** has clarified the relevant timeframe for purposes of determining whether two claimed inventions are patentably distinct or would result in impermissible double patenting. The court held "the relevant time frame for determining whether a product and process are 'patentably distinct' should be at the filing date of the secondary application."

Here, the product application was filed over a decade before the process application. The district court originally granted summary judgment of no double patenting based on evidence of developments that came after both applications were filed. It was unclear whether any of the alternative methods were available before the second application was filed, so the court remanded the case for resolution of that issue.

Takeda Pharmaceutical Company developed novel **cephem** compounds though a new **acylation** process, introducing a new **acyl group** to an **amino group**. Takeda applied for a patent on the compounds in the United States in 1975, claiming priority to a 1974 Japanese application. Takeda also filed a divisional application in 1979. Eventually **two** U.S. **patents** related to the compounds issued from these applications. In 1990, Takeda filed another continuation application claiming priority to the original application directed to the only method of producing the compounds disclosed in the priority application. This eventually matured into a **patent** as well.
In 1998, the **USPTO** received (and granted) two requests for reexamination of the method patent based on obviousness-type double patenting over the previously-issued patents. Takeda contended the method claims were patentably distinct because the products could be made from a materially different process, and submitted a declaration to this effect. The examiner was unpersuaded and held the claims invalid for double patenting. The **BPAI** affirmed.

Takeda sought review in the **District Court for the District of Columbia** under **§ 145**. At the district court, Takeda presented an additional declaration describing that two later **issued patents** provided alternative processes for producing the cephem compounds at issue. For purposes of summary judgment, the parties agreed this was the case, and presented the issue of whether the later-developed process could be used to defeat the double patenting rejection. The district court sided with Takeda, holding the later process could be considered in the double patenting analysis. The USPTO appealed.
The Federal Circuit vacated and remanded. On appeal, Takeda contended all evidence, regardless of date, should be considered when determining whether a different process could produce a previously-claimed product. The USPTO asserted the relevant date should be the date of the first-filed application.

The court agreed with neither party. Instead, the court held neither of these approaches serves the policy underlying the double patenting doctrine, namely avoiding an unjustified extension of patent term. The Federal Circuit held the relevant time is the

filing date of the secondary application, as that is the date when the "unjustified" extension would be implicated.

Applying this rule, the critical date for double patenting purposes is January 8, 1990. the two patents referred to in the declaration first published more than a decade later, and therefore the patents could not be used to defeat the double patenting rejection. However, there was a question as to the actual date of disclosure of the alternative methods. As a result, the court remanded the case to the district court to determine whether the alternative methods were, in fact, available as of the newly-defined cutoff date.
Judge Schall dissented in part. In his opinion, the cutoff date for double patenting purposes should be the invention date (in this case assumed to be the priority date of the original application) rather than the filing date of the secondary application. His logic is that double patenting is another patentability doctrine, and all other patentability doctrines are considered as of the invention date (with the exception of the statutory bars of **§ 102(b) and (d)**).