

## **In Re Hubbell Puts Inventors At A Disadvantage**

Law360, New York (March 21, 2013, 1:42 PM ET) -- Obviousness-type double patenting usually arises between commonly owned patents or patent applications. While the U.S. Patent and Trademark Office has interpreted the judicially created doctrine as pertaining when there is common or overlapping inventorship, without regard to common ownership, the Federal Circuit had not upheld that interpretation of the doctrine until recently in *In re Hubbell*.

### **The Patent and Application at Issue**

The obviousness-type double patenting rejection at issue was raised in U.S. Patent Application No. 10/650,509, which names Jeffrey Hubbell, Jason Schense, Andreas Zisch and Heike Hall as inventors and was assigned to California Institute of Technology.

The '509 application was filed on Aug. 27, 2003, as a continuation of U.S. Patent Application No. 10/024,918, filed on Dec. 18, 2001, which was a continuation-in-part of U.S. Patent Application No. 09/057,052, filed on April 8, 1998, also a continuation of PCT Application PCT/US98/06617, filed on April 2, 1998, which claimed priority to U.S. Provisional Application No. 60/042,143, filed on April 3, 1997.

The '509 application is directed to "enzyme-mediated modification of fibrin for tissue engineering." Representative claim 18 recites: "A bidomain protein or peptide comprising a transglutaminase substrate domain and a polypeptide growth factor."

In 1998, Hubbell left Cal Tech and went to work at Eidgenossische Technische Hochschule Zurich (ETHZ). The cited patent, U.S. Patent [7,601,685](#), is related to work done by Hubbell and Schense at the ETHZ.

The '685 patent names Jeffrey Hubbell, Jason Schense and Shelly Sakiyama-Elbert as inventors and was assigned to the ETHZ and Universitat Zurich.

The '685 patent is based on an application that was filed Dec. 17, 2002, and was granted on Oct. 13, 2009. The patent is directed to "growth factor modified protein matrices for tissue engineering."

Representative claim 1 recites:

A fusion protein, comprising:

- (i) a first protein domain;
  - (ii) a second protein domain; and
  - (iii) an enzymatic or hydrolytic cleavage site between the first and second domains;
- wherein the first domain is a growth factor selected from the group consisting of the platelet derived growth factor superfamily and the transforming growth factor beta (TGF $\beta$ ) superfamily;
- wherein the second domain is a crosslinking Factor XIIIa substrate domain;
- wherein the enzymatic cleavage site is selected from the group consisting of proteolytic substrates and polysaccharide substrates, and
- wherein the hydrolytic cleavage site comprises a substrate with a linkage which undergoes hydrolysis by an acid or a base catalyzed reaction.

### **The Obviousness-Type Double Patenting Rejection**

As summarized by the Federal Circuit, the obviousness-type double patenting rejection was based on the USPTO Examiner's finding that certain claims in the '685 patent "are a species of the instantly claimed invention [of the '590 application] and as such are encompassed by the claimed invention and thus anticipate the claimed invention."

The USPTO Board of Patent Appeals and Interferences affirmed the rejection, finding that "claim 1 of the '685 patent recites a protein that contains both of the features required in rejected claim 18:

- “a transglutaminase substrate domain” was met by the “crosslinking Factor XIIIa substrate Domain” and
- “a polypeptide growth factor” was met by the “first protein domain,” which is defined in the claim as “a growth factor selected from the group consisting of the platelet derived growth factor superfamily and the transforming growth factor beta (TGFβ) superfamily.”

Further, because claim 18 used the open transitional phrase “comprising,” it encompassed constructs with other elements, such as those recited in claim 1 of the ‘685 patent.

Because a genus claim is anticipated by a species claim, the board agreed that the claims of the ‘509 application were properly rejected over the claims of the ‘685 patent.

Hubbell argued that the obviousness-type double patenting rejection was not proper because the ‘685 patent and the ‘509 application were not commonly owned. The board rejected that argument, citing the USPTO’s Manual of Patent Examining Procedure (MPEP) which states in MPEP § 804(I)(A): “Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by a different inventive entity having a common inventor, and/or by a common assignee/owner.”

The board also cited Federal Circuit precedent for the proposition that the doctrine of obviousness-type double patenting stems from a “concern over potential harassment of an infringer by multiple assignees asserting essentially the same patented invention,” even where there was no common ownership.

### **The Doctrine of Obviousness-Type Double Patenting**

The Federal Circuit provided this summary of the doctrine of obviousness-type double patenting: Obviousness-type double patenting is a judicially created doctrine designed to “prevent claims in separate applications or patents that do not recite the ‘same’ invention, but nonetheless claim inventions so alike that granting both exclusive rights would effectively extend the life of patent protection.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1373 (Fed. Cir. 2005). It prohibits the issuance of claims in a second patent that are “not patentably distinct from the claims of the first patent.” *In re Longi*, 759 F.2d 887, 892 (Fed. Cir. 1985) (citations omitted). A later patent claim “is not patentably distinct from an earlier claim if the later claim is obvious over, or anticipated by, the earlier claim.” *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 968 (Fed. Cir. 2001) (citations omitted).

The court explained that “[t]here are two justifications for obviousness-type double patenting.”

- The first is “to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about.”
- The second rationale is to prevent multiple infringement suits by different assignees asserting essentially the same patented invention.

### **No Requirement for Common Ownership**

As summarized by the Federal Circuit, Hubbell’s argument on appeal was: Obviousness-type double patenting should not apply where ... an application and a conflicting patent share common inventors but do not have identical inventive entities, were never commonly owned, and are not subject to a joint research agreement.

The court disagreed.

The Federal Circuit determined that it could “take judicial notice” of MPEP § 804(I)(A) because it is consistent with the rationale that the court has applied in the obviousness-type double patenting context, e.g., “the importance of preventing harassment of an alleged infringer by multiple assignees asserting essentially the same patented invention.”

The court noted that that very concern would arise here if the '509 application were granted:

[I]f Hubbell's rejected application claims were to issue, the potential for harassment by multiple assignees would exist because an infringer of claim 1 of the '685 patent would also infringe at least rejected claim 18. As such, there is a risk that a potential infringer could be subject to suit from both Cal Tech and ETHZ and Universitat Zurich under their respective patents.

The court reasoned that because of this concern, it does not matter that the patent and application never were commonly owned.

The court also rejected Hubbell's argument that he should be permitted to file a terminal disclaimer to overcome the rejection, citing the USPTO's rule (37 CFR § 1.321(c)(3)) providing that a terminal disclaimer requires common ownership.

Thus, the court affirmed the obviousness-type double patenting rejection.

### **Judge Newman's Dissent**

Newman dissented, explaining her view that:

Obviousness-type double patenting does not apply when the application and patent are of separate ownership and have separate inventive entities. In such situation the appropriate examination path is on the merits of the invention, or through the interference or derivation procedures, or other standard protocol as may apply in the particular situation.

Alternatively, Newman asserted that if obviousness-type double patenting could be found without common ownership, it should be possible to file a terminal disclaimer without common ownership.

### **Is "Harassment" by Different Owners Really a Problem?**

The court's emphasis on avoiding the "problem" of being subject to harassment by different patent owners is particularly interesting in the genus and species context. There are numerous species patents that are dominated by a genus patent with a different owner. Indeed, the whole patent paradigm is based on the principle that once an inventor discloses his invention to the public in his patent application, others will build on that work and develop improvement inventions.

The court's decision here seems to put prolific inventors at a disadvantage by keying obviousness-type double patenting to overlapping inventorship rather than common ownership. If the '685 patent had been invented by a completely different inventive entity, both patents would have been granted, notwithstanding the fact that someone practicing the subject matter of the '685 patent also would have infringed the '590 claims and would have been subject to suit by both owners.

Further, if the claims had been prosecuted in a different order, such that the '509 application claims were granted before the '685 patent, both patents might have been granted, notwithstanding their overlapping subject matter.

For example, even if an obviousness-type double-patenting rejection had been raised in the '685 patent, such a rejection can be overcome on the merits by establishing that the claimed species is patentably distinct from the earlier granted genus claims. In such circumstances, there would be two separate patents with different owners that both would be infringed by practicing the '685 patent.

Perhaps the lesson here is to prosecute genus claims first, but applicants often focus their efforts on obtaining species claims directed to commercial products or products in development, with the understanding that genus claims can be pursued in a continuation application. This is particularly the case if the USPTO Examiner agrees that species claims are allowable but has rejected genus claims.

Instead of delaying the grant of all claims through continued prosecution or appeal, many applicants decide to obtain prompt grant of allowable claims and pursue broader claims in a continuation application. While applicants usually understand that a terminal disclaimer over the granted patent may be required in the continuation application, this decision raises the risk that the genus claims may never be granted.

--By Courtenay Brinckerhoff, [Foley & Lardner LLP](#)

[Courtenay Brinckerhoff](#) is a partner at [Foley & Lardner's Washington, D.C., office](#).

*The opinions expressed are those of the author and do not necessarily reflect the views of the firm, its clients, or Portfolio Media Inc., or any of its or their respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.*

Reprinted with permission from [Portfolio Media, Inc.](#)