

PatentPC Attorney Bao Tran Outlines Strategies for Handling Double Patenting Rejections at Technology Patent Network

PatentPC Attorney Bao Tran Outlines Strategies for Handling Double Patenting Rejections at Technology Patent Network 2024 in San Francisco

PALO ALTO, CA, UNITED STATES, October 17, 2024 /EINPresswire.com/ -- [Patent](#) attorney Bao [Tran](#) of PatentPC today outlined several key strategies for handling obviousness-type double patenting (ODP) rejections from the U.S. Patent and Trademark Office (USPTO). Drawing on insights from a recent panel discussion featuring experts in the field, Tran provided guidance on navigating the complex landscape of ODP rejections in light of recent court decisions and proposed USPTO rule changes.



Patent Attorney Bao Tran of PowerPatent

"Obviousness-type double patenting continues to be a significant challenge for patent applicants, especially in the biotech and pharmaceutical industries," said Tran. "With recent Federal Circuit decisions like *In re Collect* and *Allergan v. Sandoz*, as well as proposed USPTO rule changes, it's critical that applicants and their counsel understand how to strategically approach ODP issues."

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Key strategies outlined by Tran include: Maximizing Patent Term in First-Filed [Applications](#) One of the most important strategies is to maximize patent term in first-filed applications, as these may set the expiration date for related patents under current case law.

Tran discussed the pros and cons of several approaches:

- 1) File applications using the USPTO's missing parts practice, which allows applicants to delay payment of certain fees and submission of some required documents. This can push out the 14-month deadline for receiving a first Office Action.
- 2) Wait until close to response deadlines before filing responses to Office Actions, even if the response is ready earlier. This accumulates more Patent Term Adjustment (PTA).
- 3) After receiving a Notice of Allowance, wait as long as possible before paying the issue fee to further extend the patent term.
- 4) Keep track of examiner deadlines and proactively request interviews or status updates to keep prosecution moving forward.

"Every day of patent term can be incredibly valuable, especially for pharmaceutical products," Tran noted. "Applicants should take advantage of opportunities to maximize PTA without running afoul of their duty of candor to the USPTO."

Strategic Use of Restriction Requirements and Divisional Applications

Tran emphasized the importance of provoking restriction requirements from the USPTO to create opportunities for filing divisional applications that enjoy "safe harbor" protection from ODP rejections under 35 U.S.C. 121.

"Including a large number of claims, often over 100, in a first-filed application increases the likelihood of receiving a restriction requirement," Tran explained. "This allows applicants to file multiple divisional applications that are shielded from ODP rejections based on the parent application or other divisionals."

He added that maintaining "consonance" with the restriction requirement is crucial when prosecuting divisional applications to preserve safe harbor protection.

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Careful Claim Drafting and Amendment Strategies

To minimize ODP issues, Tran recommends:

Drafting claims with clear distinctions between different applications in a family

Considering deletion of dependent claims that may trigger ODP rejections

Making strategic claim amendments to overcome ODP rejections while preserving claim scope

"It's important to think several steps ahead when drafting and amending claims," said Tran. "Consider how the claims in one application may impact prosecution of related applications down the road."

Leveraging Non-Statutory Double Patenting Arguments

Tran noted that examiners sometimes make improper ODP rejections that can be overcome through well-crafted arguments. He recommends:

Carefully analyzing the claims of the reference patent/application and the rejected claims

Identifying differences in claim scope that are non-obvious

Presenting secondary considerations of non-obviousness where applicable

Arguing that the claims are patentably distinct based on different utility or unexpected results

"Don't assume all ODP rejections are insurmountable," Tran advised. "There are often strong arguments to be made that the claims are patentably distinct, especially for complex biotech inventions."

Strategic Use of Terminal Disclaimers

While filing a terminal disclaimer is often the simplest way to overcome an ODP rejection, Tran cautioned that it should not be done reflexively. He outlined several considerations:

Terminal disclaimers tie the fate of patents together and can limit licensing options

They may unnecessarily give up patent term, especially if there are viable arguments against the ODP rejection

Proposed USPTO rules could make terminal disclaimers even more consequential if



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"Terminal disclaimers should be a last resort, not a default response," said Tran. "Carefully weigh the long-term implications before filing one."

Continuation Practice and Portfolio Management

Tran emphasized the importance of a holistic approach to managing patent portfolios in light of ODP concerns:

File multiple continuation applications to keep prosecution open

Maintain pendency of applications to retain flexibility

Consider effects of patent family structure on ODP vulnerability

Balance desire for broad protection against risk of creating ODP issues

"Having multiple pending applications provides options if ODP issues arise unexpectedly," Tran explained. "But it's also important to avoid creating unnecessary ODP problems through overly aggressive continuation practice."

Leveraging International Filing Strategies

Tran highlighted how international filing strategies can provide advantages in dealing with ODP issues:

File an international PCT application designating a non-U.S. searching authority to potentially get a more comprehensive search report

Consider early national phase entries in jurisdictions like the Netherlands or UK to obtain search reports before U.S. filing

Be aware of how unity of invention practice in the PCT system may impact restriction practice in the U.S.

"Using the international patent system strategically can provide valuable information to guide U.S. prosecution and help avoid ODP pitfalls," said Tran.

Monitoring Developments in Case Law and USPTO Rules

Given the evolving nature of ODP practice, Tran stressed the importance of staying up-to-date on legal developments:

Follow Federal Circuit decisions on ODP issues closely

Monitor proposed USPTO rule changes and provide comments when appropriate

Adjust prosecution strategies as the legal landscape shifts

"The law around ODP continues to evolve, as we've seen with recent cases like *Collect* and *Allergan*," Tran noted. "It's critical to stay informed and be prepared to adapt prosecution strategies accordingly."

Considering Implications for Freedom-to-Operate Analyses

Attorney Tran pointed out that ODP issues can also impact freedom-to-operate (FTO) analyses:

When reviewing potentially problematic patents, check for ODP vulnerabilities

Consider how terminal disclaimers may tie patents together for FTO purposes

Be aware of how recent case law may impact the enforceability of patents in a family

"ODP isn't just a prosecution issue - it can also create opportunities from a defensive perspective," Tran explained. "Understanding how ODP principles apply can help refine risk

assessments in FTO reviews."

Balancing ODP Concerns with Other Strategic Objectives

Finally, Attorney Tran emphasized that ODP considerations must be balanced against other patent strategy goals:

Weigh desire to maximize term against need for prompt patent issuance

Consider how ODP issues may impact licensing and monetization opportunities

Balance granular claim coverage through multiple patents against ODP risks

Align patent strategy with product development and commercial objectives

"There's no one-size-fits-all approach to handling ODP issues," Tran concluded. "The key is to understand the principles at play and develop tailored strategies that align with overall business objectives."

Looking Ahead: Potential Changes on the Horizon

Tran also discussed potential upcoming changes that could significantly impact ODP practice:

Proposed USPTO Rule Changes: The USPTO has proposed rule changes that would make terminal disclaimers even more consequential. Under the proposed rules, invalidation of a single claim in any terminally disclaimed patent would invalidate all claims in all linked patents.

"These proposed rules have been met with significant pushback from the patent community," Tran noted. "If implemented, they would dramatically change how applicants approach ODP issues and terminal disclaimers. We're closely monitoring developments on this front."

Potential Legislative Action: There have been calls for Congress to address ODP through legislation, potentially eliminating or modifying the doctrine.

"Given that ODP is a judicially-created doctrine, there's an argument that legislative action is needed to provide clarity and align U.S. practice with other jurisdictions," Tran explained.

"However, it remains to be seen whether there's appetite in Congress to tackle this issue."

Continued Development of Case Law: Recent Federal Circuit decisions have created some uncertainty around ODP practice, and further refinement through case law is likely.

"We expect to see continued development of ODP jurisprudence through court decisions," said Tran. "This may provide additional clarity on issues like the relationship between ODP and patent term adjustment."

International Harmonization Efforts: There are ongoing efforts to harmonize patent laws globally, which could potentially impact ODP practice in the U.S.

"While ODP is largely a U.S.-specific doctrine, international harmonization efforts could put pressure on the U.S. to reconsider its approach," Tran noted. "This is something to watch in the coming years."

Implications for Different Technology Sectors

Tran highlighted how ODP issues can impact different technology sectors in distinct ways:

Pharmaceuticals and Biotechnology: "ODP is particularly crucial in the pharma and biotech spaces, where patent term is often critical to recouping R&D investments," Tran explained.

"These industries need to be especially strategic in managing patent portfolios to maximize protection while navigating ODP issues."

Medical Devices: "For medical device companies, the calculus around ODP can be different," said

Tran. "While patent term is still important, the rapid pace of innovation often means companies are less concerned about squeezing out every last day of patent protection. However, ODP can still create challenges for building robust patent portfolios."

Software and Electronics: "In fast-moving tech fields, ODP is often less of a concern," Tran noted. "However, it can still create issues for companies looking to build large patent portfolios for defensive or licensing purposes. Strategic use of continuation practice is key in these areas."

Research Tools and Platforms: "Companies developing research tools or platform technologies face unique challenges with ODP," explained Tran. "They need to balance protection for core technologies with the ability to patent subsequent innovations. Careful portfolio management is crucial."

Importance of Tailored Strategies

Tran emphasized that while the strategies outlined provide a general framework, it's crucial for companies and inventors to develop tailored approaches based on their specific situations.

"The optimal strategy for handling ODP issues depends on a variety of factors," he explained.

"These include the nature of the technology, the company's business model, the competitive landscape, and overall IP objectives. It's important to work closely with experienced patent counsel to develop a customized approach."

As the legal landscape around obviousness-type double patenting continues to evolve, patent applicants and their counsel must remain vigilant and adaptable. By employing strategic approaches to application drafting, prosecution, and portfolio management, companies can navigate ODP challenges while building strong, enforceable patent portfolios.

"ODP issues add complexity to the already challenging process of securing patent protection," Tran concluded. "However, with careful planning and execution, these challenges can be overcome. The key is to stay informed, think strategically, and be prepared to adapt as the legal landscape shifts."

About PatentPC:

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