

USPTO Appeals Review Panel Reinstates Double Patenting Rejections, Limits Allergan in Examination

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Executive summary

In *Ex parte Baurin* (Appeal 2024-002920), the US Patent and Trademark Office (USPTO) Appeals Review Panel (ARP) reversed the Patent Trial and Appeal Board (PTAB) and reinstated six obviousness-type double patenting (OTDP) rejections against US Application No. 17/135,529.¹ The decision adopts a narrow reading of *Allergan USA, Inc. v. MSN Laboratories Private Ltd.* and confirms that a later-filed, later-expiring patent can still support an OTDP rejection, even where issuance of the challenged claims would not extend patent exclusivity.²

The decision turns on OTDP's second rationale: preventing harassment through enforcement by separate owners of patentably indistinct patents. Relying on *Fallaux*, *Hubbell* and *Cellect*, the ARP held that this anti-harassment rationale independently supports an OTDP rejection, even when there is no improper extension of patent term.³

Still, the ARP was not entirely comfortable with that outcome. It said that absent binding precedent, it would not treat hypothetical future harassment as a stand-alone basis for rejection, and it sketched a more streamlined, term-focused framework it might adopt in the future. That framework is not the law yet. Until the Federal Circuit says otherwise, examiners will keep applying pre-*Allergan* practice, except in the narrow circumstances where the ARP found *Allergan* applies.

Background

The '529 application is directed to antibody-like binding proteins, was filed December 28, 2020, and has a patent-term filing date of March 28, 2012, giving it an ordinary expiration of March 2032.⁴

The examiner rejected claims 1 – 18 for OTDP over six reference patents/applications, each combined with US 2009/0162359 A1 (the '359 publication). The principal reference, US Patent No. 10,882,922 (the '922 patent), was filed April 13, 2017, issued January 5, 2021, and expires April 13, 2037, after a 70-day patent term adjustment (PTA) award. The '529 application and the '922 patent are commonly owned by Sanofi and share several inventors; it was undisputed that the pending claims would have been obvious over the '922 patent in view of the '359 publication.

The anti-harassment rationale

OTDP rests on two justifications. The first, and historically dominant, one prevents a patentee from obtaining a second, later-expiring patent on a patentably indistinct invention that would unjustifiably extend exclusivity. The second, the anti-harassment rationale, guards against patentably indistinct rights ending up with separate owners, each able to assert the same technology against an infringer or licensee. A licensee that cleared rights under one patent could face a separate claim from another owner of related, indistinct claims. The common-ownership provision required in a terminal disclaimer exists to prevent that outcome, even where the patents' terms are already aligned.

The PTAB reversed the OTDP rejections in November 2024 and denied rehearing in a 2 – 1 decision (with dissent) in December 2025. On March 5, 2026, the director sua sponte convened the ARP, inviting briefing from the applicant and 11 amici on the scope of *Allergan*, projected expiration dates and whether separate ownership risk independently supports an OTDP rejection. On August 6, 2026, the ARP reversed the PTAB and reinstated all six rejections.

The decision

***Allergan* applies only in narrow circumstances**

The ARP rejected the PTAB's broader application of *Allergan*. In *Allergan*, the Federal Circuit held that a first-filed, first-issued, later-expiring claim could not be invalidated for OTDP based on a later-filed, later-issued, earlier-expiring reference claim sharing a common priority date.

On the ARP's reading, *Allergan* applies where the challenged and reference claims are in the same family and share the same patent-term filing date, and the challenged claims are first-filed, first-issued and later-expiring within that family.

The '529 application met none of these: It lacks the first actual filing date in its family, remains pending (so is not first-issued) and does not share a patent-term filing date with the '922 patent, which is from a different family. A pending continuation will rarely qualify as first-issued during ordinary prosecution, so the ARP instructed examiners to continue pre-*Allergan* practice outside this narrow fact pattern.

Anti-harassment can independently support an OTDP rejection

The PTAB treated the absence of a term extension concern as dispositive. The ARP disagreed, concluding that its reading of Federal Circuit precedent recognizes two independent OTDP rationales: preventing unjustified timewise extension and preventing multiple suits by different owners of patentably indistinct rights.

The ARP viewed *Fallaux* and *Hubbell* as controlling because the Federal Circuit affirmed OTDP rejections even where the challenged claims would have expired before the references and relied on *Cellect*'s recognition of divided ownership risk. It rejected the PTAB's view that this reasoning was dicta, since that would leave those affirmances with no articulated basis at all.

The practical result: Claims in a later-filed, later-expiring patent can support an OTDP rejection of earlier-expiring foundational claims even though issuance of the foundational claims would not extend exclusivity, so long as the challenged claims are not patentably distinct from the reference claims.

The ARP questions the rule it applies

Although the ARP reinstated the rejections, it was candid about its discomfort with the rule it applied. Absent controlling precedent, the panel said it would not treat hypothetical future harassment as a stand-alone basis for rejection: Without evidence that an applicant actually split ownership and exposed the public to separate suits, the USPTO is simply speculating. The ARP also credited the amici's concern that a broad anti-harassment rule creates a backward-looking problem, since a later improvement could threaten earlier foundational claims. That concern is particularly acute in collaborative research, licensing-driven portfolios and situations involving inventor mobility. The tension is sharpest because a terminal disclaimer requires continued common ownership: It is easiest to obtain where the harassment risk is most hypothetical, and unavailable precisely where separate ownership already exists.

A proposed new framework, but not yet the law

If the Federal Circuit determines anti-harassment cannot stand alone, the ARP outlined a term-focused alternative. For references outside the application's family, examiners would ask only whether the reference has a later patent-term filing date than the application. If so, the term extension inquiry ends there. If earlier, the examiner would compare the claims for patentable distinctness. Examiners would rely on known facts, such as an existing terminal disclaimer or already awarded PTA, rather than speculate about future events.

Within a single family, the analysis would instead turn on actual filing (and issue) dates: A later-filed application could be rejected over an earlier-filed parent, but not the reverse. This is consistent with *Allergan*'s principle that the first-filed, first-issued patent sets the family's maximum period of exclusivity. The ARP also floated narrowing any surviving anti-harassment rationale by requiring actual evidence of prior ownership-splitting, or a two-way obviousness showing, before it alone could support a rejection. None of this is presently in effect; the ARP expressly conditioned it on further Federal Circuit guidance.

Key takeaways

1. *Allergan* protection remains narrow and family specific.

The *Allergan* exception protects only a first-filed, first-issued, later-expiring claim against a later-filed, later-issued, earlier-expiring reference sharing the same patent-term filing date within the same family. That is not the fact pattern most applicants will see during original prosecution; it is more likely to come up in reexamination, reissue or a later validity dispute.

2. Anti-harassment remains a live, independent ground for rejection.

Applicants should expect examiners to keep making OTDP rejections based on later-filed, later-expiring patents, including cross-family references, wherever the claims are not patentably distinct and a common ownership or inventorship link exists. Under the ARP's current guidance to the USPTO, an earlier expiration date will not by itself defeat that kind of rejection.

3. Terminal disclaimers deserve more strategic attention than they typically get.

A terminal disclaimer is not just a formality. It imposes a common ownership requirement that can affect licensing, assignments, acquisitions and enforcement, and it may cut short a patent term that would otherwise result from PTA. Where common ownership cannot be achieved or maintained, for example in university-industry collaborations, joint development arrangements or after an inventor leaves, a disclaimer will not cure an OTDP rejection. Prosecution strategy, inventorship and ownership provisions need to be coordinated up front in those situations.

Alignment with Federal Circuit precedent

The ARP treated its result as compelled by *Fallaux*, *Hubbell* and *Collect*, while acknowledging the Federal Circuit's more recent focus on patent term in *Gilead*, *Collect* and *Allergan*. *Baurin* is precedential within the USPTO and binds office personnel, but it does not bind the Federal Circuit or district courts. That leaves an open question the ARP expressly asked the Federal Circuit to resolve – whether the anti-harassment rationale is, by itself, still enough to reject an earlier-expiring claim under the current patent-term regime?⁵

Recent developments in this space

That question is now squarely before the Federal Circuit in *In re Ablynx N.V.*, Appeal No. 26-1333, arising from *Ex parte Baumeister*. A decision there could address the continuing force of *Fallaux* and *Hubbell*, the scope of *Allergan* and the ARP's proposed framework. A further appeal from *Baurin* itself could offer a second vehicle for review.⁶

Notes

1. *Ex parte Baurin*, Appeal 2024-002920, Application No. 17/135,529 (USPTO Appeals Review Panel, Aug. 6, 2026) (precedential).
2. *Allergan USA, Inc. v. MSN Laboratories Private Ltd.*, 111 F.4th 1358, 1369-70 (Fed. Cir. 2024).
3. See *In re Fallaux*, 564 F.3d 1313, 1318-19 (Fed. Cir. 2009); *In re Hubbell*, 709 F.3d 1140, 1145-48 (Fed. Cir. 2013); *In re Collect*, LLC, 81 F.4th 1216, 1229-30 (Fed. Cir. 2023).
4. See Cooley, [PTAB Rehearing Limits Double Patenting Rejections of Earlier Patent Applications From Later-Filed Family Members](#), Jan. 26, 2026.
5. See *Gilead Sciences, Inc. v. Natco Pharma Ltd.*, 753 F.3d 1208, 1214-17 (Fed. Cir. 2014); *In re Collect*, LLC, 81 F.4th at 1226-30; *Allergan*, 111 F.4th at 1367-70.
6. *In re Ablynx N.V.*, Appeal No. 26-1333 (Fed. Cir.) (appeal from *Ex parte Baumeister*, Appeal 2026-000193).

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