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PTAB Rehearing Limits Double Patenting Rejections of Earlier Patent Applications From Later-Filed Family Members

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Executive summary

In *Ex parte Baurin* (Appeal 2024-002920), the Patent Trial and Appeal Board (PTAB) denied the examiner's request for rehearing and reaffirmed its prior reversal of six nonstatutory obviousness-type double patenting (ODP) rejections applied to US Application No. 17/135,529. The decision emphasizes that ODP is fundamentally a temporal doctrine designed to prevent applicants from obtaining a second, later-expiring patent that would unjustifiably extend exclusivity for the same invention. Thus, references that are later filed and later expiring typically cannot serve as proper ODP references. The PTAB rejected the examiner's arguments that were based on speculative policy concerns (such as potential future separate ownership or withdrawal of terminal disclaimers), holding that such concerns cannot justify an ODP rejection without a proper reference patent.

Background

The PTAB's rehearing decision in *Ex parte Baurin, et al.* concerns six ODP rejections applied to US Application No. 17/135,529,[1] is directed to antibody-like binding proteins. The examiner argued that the PTAB misapplied *Allergan USA, Inc. v. MSN Laboratories Pvt. Ltd.*, 111 F.4th 1358 (Fed. Cir. 2024)[2] failed to follow the US Patent and Trademark Office's (USPTO) Manual of Patent Examining Procedure (MPEP) §§ 804[3] and 804.02,[4] and improperly dismissed concerns about potential separate ownership of related patents.

In November 2024, the PTAB reversed all six ODP rejections. The examiner subsequently filed a request for rehearing under MPEP § 1214.04,[5] arguing that the PTAB misapprehended *Allergan*,[6] misapplied MPEP §§ 804 and 804.02, and improperly dismissed concerns about potential separate ownership of related patents. The examiner asked the PTAB to reinstate all six ODP rejections.

The application at issue was filed and published before the earliest effective filing date of the asserted reference patents. The examiner acknowledged that the later-filed patents were allowed as nonobvious over the earlier application and "could not have been presented in the instant application." Terminal disclaimers filed in the application limit its term to March 28, 2032, preventing any extension of exclusivity.

The decision

The PTAB denied the examiner's request for rehearing, concluding that the examiner failed to identify any point of law or fact that the panel overlooked or misapprehended.

Misapplication of ODP under *Allergan*

The PTAB reaffirmed that *Allergan* requires evaluating both effective filing dates and expiration dates to determine whether a patent is a proper ODP reference. Because the asserted reference patents were later filed and later expiring, they could not serve as ODP references. The PTAB emphasized that ODP exists to prevent a "second, later-expiring patent for the same invention," a scenario that is not present here. The PTAB further explained that MPEP guidance cannot override binding Federal Circuit law, and that determining whether a second patent would create an "unjustified extension" of exclusivity necessarily requires considering expiration dates.

Policy-based arguments were speculative and irrelevant

The examiner's policy-based arguments, including hypothetical withdrawal of terminal disclaimers and potential separate ownership, were speculative and legally irrelevant. The PTAB emphasized that terminal disclaimers may be withdrawn only when the claims become patentably distinct, which would eliminate any ODP issue rather than create one. The PTAB also rejected the examiner's argument that ODP should apply to prevent potential harassment if related patents later become separately owned, explaining that ODP is triggered not by ownership structure but by the presence of an earlier-filed, earlier-expiring patent claiming a patentably indistinct invention. Because the asserted reference patents were later filed and later expiring, the PTAB concluded that no legitimate risk of term extension or public harm existed.

Key takeaways

The temporal relationship between patents is central to ODP

ODP is fundamentally a temporal doctrine. Its purpose is to prevent a patentee from obtaining a second, later-expiring patent that effectively extends exclusivity for the same invention. Under *Allergan*, determining whether a patent is a proper ODP reference requires examining both effective filing dates and expiration dates. In *Baurin*, the asserted reference patents were later filed, had later effective filing dates and would expire later than the application at issue. They also claimed patentably distinct subject matter. Because ODP cannot be used to invalidate or restrict an earlier-filed, earlier-expiring patent based on later-filed, later-expiring patents, none of the cited patents could serve as proper ODP references.

Policy concerns cannot justify ODP without a proper reference patent

The examiner argued that ODP should apply to guard against potential future scenarios, such as patents becoming separately owned or applicants withdrawing terminal disclaimers. The PTAB rejected these arguments as speculative and legally irrelevant. ODP applies only when the USPTO first establishes a proper ODP reference patent – one that is earlier-filed, earlier-expiring and patentably indistinct. The PTAB also noted that terminal disclaimers can be withdrawn only when the claims become patentably distinct, which would eliminate any ODP issue entirely.

Alignment with Federal Circuit precedent

The key takeaways from the *Baurin* rehearing decision align closely with the Federal Circuit's modern ODP framework articulated in *Allergan*, *Cellect*[7] and *Gilead*.[8] Like *Allergan*, the PTAB emphasized that ODP is a temporal doctrine concerned with preventing a patentee from obtaining a second, later-expiring patent on a patentably indistinct invention. The PTAB's conclusion that later-filed, later-expiring, patentably distinct patents cannot serve as ODP references is consistent with *Gilead*, which held that ODP applies only when a later-expiring patent would improperly extend exclusivity beyond the term of an earlier-expiring one. And the PTAB's rejection of speculative policy arguments, such as hypothetical terminal disclaimer withdrawal or future separate ownership, tracks the focus of *Cellect* on actual term extension for indistinct inventions rather than hypothetical scenarios. Together, these cases reinforce that ODP is triggered only when a patent threatens to extend the life of an earlier-expiring patent claiming the same invention – a condition the examiner could not establish in *Baurin*.

Recent developments in this space

Within a week of the *Baurin* rehearing decision, in *Ex parte Mates* (Appeal 2025-001500), the PTAB reversed multiple ODP rejections applied to US Application No. 16/926,552, where the examiner had relied on a co-pending application and several later-filed, later-expiring Mates patents as ODP references. The PTAB held that the rejections were improper because ODP requires a proper earlier-expiring reference, and issuance of the appealed claims could not result in any unjustified timewise extension of patent term, noting that the appealed application would expire before all the asserted references, each of which had a later effective filing date, and thus a longer statutory term. This reasoning aligns directly with *Baurin*, where the PTAB likewise held that ODP is a temporal doctrine, and that later-filed, later-expiring patents cannot support ODP rejections.

In *Ex parte Baumeister* (Appeal 2026-000193), the PTAB declined to follow the *Baurin* PTAB's earlier decision, noting that *Baurin* is nonprecedential and, at the time, remained subject to a pending rehearing request with no final resolution. The *Baumeister* PTAB expressly refused to consider *Baurin* when evaluating whether later-filed, later-expiring patents could serve as ODP references. Instead, the *Baumeister* PTAB applied *In re Fallaux*, 564 F.3d 1313 (Fed. Cir. 2009) and reaffirmed that ODP rejections may rely on commonly owned patents even when those patents have later effective filing dates and later expiration dates. This approach contrasts with the reasoning in *Baurin*, where the PTAB treated *Fallaux* as not controlling and instead, as discussed above, relied on the Federal Circuit's modern ODP framework, concluding that later-filed, later-expiring patents claiming patentably distinct inventions cannot serve as proper ODP references. An appeal to the Federal Circuit was recently filed in *Baumeister*.

Notes

1. The '529 application claims antibody-like binding proteins comprising two polypeptide chains that assemble to form two antigen-binding sites. As described by the PTAB, the constructs include: a first polypeptide chain having the structure VL1–L1–VL2–L2–CL, and a second polypeptide chain having the structure VH2–L3–VH1–L4–CH1, where the arrangement of variable domains (VL1/VL2 and VH1/VH2), linkers (L1–L4), and constant regions (CL and CH1) produces a multispecific binding protein architecture.
2. In *Allergan*, the Federal Circuit held that ODP requires identifying a "second, later-expiring patent for the same invention," reaffirming that both effective filing dates and expiration dates must be considered when determining whether a patent is a proper ODP reference.
3. MPEP § 804 explains that ODP prevents an "unjustified extension of the patent right" by prohibiting issuance of a second patent claiming an obvious variation of an earlier-claimed invention.
4. MPEP § 804.02 describes the use of terminal disclaimers to overcome nonstatutory double patenting rejections and the requirement that commonly owned patents remain commonly owned for the life of the patent.
5. MPEP § 1214.04 describes the standards and permissible grounds for filing a request for rehearing, including the requirement that the request identify points of law or fact that the PTAB misapprehended or overlooked.
6. In *Allergan*, the Federal Circuit held that ODP requires identifying a "second, later-expiring patent for the same invention," reaffirming that both effective filing dates and expiration dates must be considered when determining whether a patent is a proper ODP reference.
7. In *Cellect*, the Federal Circuit held that patentably indistinct claims within a patent family may be invalidated under ODP if a patent's expiration date is extended beyond that of an earlier-expiring family member due to patent term adjustment (PTA).
8. In *Gilead*, the Federal Circuit ruled that a later-issued but earlier-expiring patent can serve as an ODP reference against an earlier-issued but later-expiring patent, because a patentee cannot extend the right to exclude beyond the earliest expiration date of an invention and its obvious variants.

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