**UNITED STATES PATENT AND TRADEMARK OFFICE**

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BEFORE THE APPEALS REVIEW PANEL OF THE
PATENT TRIAL AND APPEAL BOARD

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*Ex parte* NICOLAS BAURIN, CHRISTIAN BEIL, CARSTEN CORVEY, CHRISTIAN LANGE, DANXI LI, VINCENT MIKOL, ANKE STEINMETZ, and ERCOLE RAO

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Appeal 2024-002920
Application 17/135,529
Technology Center 1600

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# BRIEF OF PROFESSORS MARK A. LEMLEY AND LISA LARRIMORE OUELLETTE AS AMICI CURIAE IN SUPPORT OF AFFIRMING THE EXAMINER'S REJECTIONS

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## INTEREST OF *AMICI CURIAE*

We are scholars and experts in intellectual property who have written about the proper approach to double patenting at the USPTO. *See* Mark A. Lemley & Lisa Larrimore Ouellette, *Fixing Double Patenting*, 74 Am. U. L. Rev. 1013 (2025). We direct our response primarily to question one articulated by the Director: the applicability of *Allergan* to these facts.[1]

## ARGUMENT

### I. Federal Circuit precedent supports the examiner's rejections, and *Allergan* does not apply to the facts of this appeal.

#### A. Obviousness-type double patenting applies to patentably indistinct patents related by common inventorship or ownership, even when the reference patent has a later priority or patent-term filing date.

Obviousness-type double patenting (ODP) is not limited to patent applications filed later than the reference patent. The Federal Circuit has repeatedly sustained ODP rejections where the reference patent has a later priority and patent-term filing date than the application under examination. The cases look not to the relative filing dates of the patents, but to whether the claims are patentably indistinct and whether the relationship between the patents creates the risks ODP exists to prevent.

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[1] We do not represent any party and have no personal or financial interest in the outcome of this case. No one other than the undersigned has drafted or paid for any part of this brief. The Director has issued blanket approval for the filing of amicus briefs in this case.

*In re Fallaux*, 564 F.3d 1313 (Fed. Cir. 2009), is directly on point. The application on appeal was a continuation filed in 2003, with a priority and patent-term filing date of 1997. *Id.* at 1315. The ODP reference patents had later priority and patent-term filing dates (1998 and 1999) and issued in 2002, before the continuation was filed. *Id.* The Federal Circuit affirmed the Board's ODP rejection based on these later-priority reference patents. *Id.* at 1319. The court acknowledged that "the unjustified patent term extension justification for obviousness-type double patenting has limited force in this case," but it identified a "second justification for obviousness-type double patenting—harassment by multiple assignees." *Id.* at 1318–19 (citing *In re Van Ornum*, 686 F.2d 937, 944–48 (C.C.P.A. 1982)). This problem could not be cured by a terminal disclaimer because the patents were not commonly owned. *Id.* at 1319.

The Federal Circuit affirmed a similar ODP rejection in *In re Hubbell*, 709 F.3d 1140 (Fed. Cir. 2013). There, the reference patent also had a later priority and patent-term filing date than the application under examination. *See id.* at 1142 (citing U.S. Patent No. 7,601,685 (reference patent, with priority and effective patent-term filing date of Aug. 27, 1998); U.S. Patent Application No. 10/650,509 (application at issue, claiming priority to 1997, with patent-term filing date of Apr. 2, 1998)). The Federal Circuit again affirmed the ODP rejection, stating that "the multiple assignee harassment justification adopted in *Van Ornum* and reaffirmed in *Fallaux*

applies here." *Id.* at 1148.

The issue in this appeal falls squarely within the holdings of *Fallaux* and *Hubbell*, which refute any categorical rule that later-priority patents are ineligible ODP references. As in those cases, the reference patents here have later priority dates and later expiration dates than the application under examination. As in those cases, the application and reference patents share common inventors. And as in those cases, the applicant could have sought the claims at issue earlier but chose not to do so, filing the instant application more than nine years after the priority application. Under *Fallaux* and *Hubbell*, the examiner's rejections were proper.

**B. *Allergan* created a narrow exception for a first-filed, first-issued patent sharing a common priority date that is inapplicable here.**

The Federal Circuit's 2024 decision in *Allergan USA, Inc. v. MSN Laboratories Private Ltd.*, 111 F.4th 1358 (Fed. Cir. 2024), addressed a materially different question than the one presented in this appeal. It held that "a first-filed, first-issued, later-expiring claim cannot be invalidated by a later-filed, later-issued, earlier-expiring reference claim having a common priority date." *Id.* at 1369.

The facts of *Allergan* bear little resemblance to this appeal. In *Allergan*, the challenged patent was the first-filed application in a priority chain, so that the later-filed continuations were derivative of the very patent they were being used to attack. 111 F.4th at 1369. Here, the reference patents arise from separate application

families and do not share a common priority date with the application on appeal. In *Allergan*, the challenged patent was the first to issue. *Id.* Here, the reference patents issued before the application on appeal has even resulted in a patent.

*Allergan*'s reasoning reinforces this narrow scope. The Federal Circuit emphasized that "[t]o hold otherwise—that a first-filed, first-issued parent patent having duly received PTA can be invalidated by a later-filed, later-issued child patent with less, if any, PTA—would . . . effectively abrogate the benefit Congress intended to bestow on patentees when codifying PTA." *Id.* at 1371. That concern arises only when the challenged patent is the first to establish exclusivity over the claimed subject matter and the only difference in expiration dates results from PTA. Where, as here, the reference patents have entirely independent filing dates and claim entirely different priority chains, invalidating the earlier-filed application does not "abrogate" any PTA benefit—it addresses the classic double patenting concern of preventing proliferation of patentably indistinct claims across independent patent families.

### C. The *Baurin* panel's broader reading of *Allergan* is irreconcilable with *Fallaux* and *Hubbell*.

The *Baurin* panel reversed the examiner's ODP rejections on the ground that the reference patents had later filing dates and later expiration dates than the application on appeal, without citation to *Fallaux* or *Hubbell*. *Ex parte Baurin*, No.

2024-002920 (P.T.A.B. Nov. 6, 2024). In denying rehearing, the panel reaffirmed this holding and attempted to distinguish *Fallaux* and *Hubbell* on the ground that the applicants in those cases did not specifically challenge whether the reference patents were proper ODP references. *Ex parte Baurin*, No. 2024-002920, at 17–21 (P.T.A.B. Dec. 17, 2025). The panel also referred to the Federal Circuit's anti-harassment justification for ODP as "dicta at best." *Id.* at 22. But as explained above, in both precedents, the Federal Circuit recognized that the ODP rejections based on a later-filed, later-expiring patent were proper, and it explicitly grounded these decisions in an anti-harassment rationale. Treating this rationale as dicta would require concluding that the Federal Circuit affirmed these ODP rejections on no ground at all.

The *Baumeister* panel, confronting materially identical facts, reached the opposite conclusion and correctly recognized that "*Fallaux* remains good law" and that "the Federal Circuit cited *Fallaux* as recent[ly] as in *Allergan*." *Ex parte Baumeister*, No. 2026-000193, at 8 (P.T.A.B. Nov. 20, 2025). Applying *Fallaux*, *Hubbell*, and *Cellect*, the *Baumeister* panel recognized that the anti-harassment rationale independently supports ODP rejections where reference patents have later filing dates and later expiration dates, because the risk of divided ownership persists. As the Federal Circuit recognized in *Cellect*, even a patent owner's promise not to divide ownership does not "suffice[] to abrogate the potential future risk of multiple

owners." *In re Cellect*, LLC, 81 F.4th 1216, 1230 (Fed. Cir. 2023).

Indeed, the anti-harassment rationale applies with particular force when, as here, patentably indistinct patents arise from separate application families with different priority dates. There is less inherent structural reason for such patents to remain commonly owned, increasing the risk that the patents end up in different hands. Adopting the *Baurin* panel's reading would immunize earlier-filed applications from ODP based on later-filed reference patents regardless of whether the patents share a common priority chain, increasing the risk of the harassment that ODP is designed to prevent.

## II. The growing prevalence of double patenting heightens the concerns underlying both justifications the Federal Circuit has recognized for ODP.

### A. Double patenting is a large and growing practice, particularly for pharmaceutical and litigated patents, increasing the stakes of the scope of the *Allergan* exception.

The Federal Circuit has identified two independent justifications for ODP rejections: preventing unjustified extensions of exclusivity and preventing harassment by multiple assignees of patentably indistinct patents. *See, e.g.*, *In re Fallaux*, 564 F.3d at 1318–19; *In re Hubbell*, 709 F.3d at 1145. Both purposes would be undermined by the *Baurin* panel rule, as the scale of modern double patenting practice makes clear.

As we have demonstrated in recent empirical work, double patenting is a large and growing phenomenon. Terminal disclaimers are now filed for over 15% of all

patents, over 50% of litigated patents, and over 60% of patents covering FDA-approved drugs, with each of these figures rising steadily over time. *See* Mark A. Lemley & Lisa Larrimore Ouellette, *Fixing Double Patenting*, 74 Am. U. L. Rev. 1013 (2025).

A rule immunizing earlier-filed applications from ODP, as the *Baurin* panel adopted, would remove a significant check on the growth of patentably indistinct patents across independent application families for some of the patents with the highest stakes. The consequences of unchecked proliferation are substantial. As we have explained, "the proliferation of multiple patents on obvious variants of the same invention contributes to the problem of patent thickets, significantly increasing the transaction costs of searching, licensing, or litigating patents." *Id.* at 1015. In the pharmaceutical context, the costs are especially acute: the Hatch-Waxman Act means that "pharmaceutical companies can often profit from listing multiple patents even if those patents are invalid, because they will delay generic entry until every last patent has been invalidated." *Id.* at 1031. And "[i]t is more expensive to challenge ten patents than to challenge one, even with the same number of total claims," whether in litigation or in PTAB proceedings. *Id.* at 1030. A rule that removes ODP as a constraint on the accumulation of patentably indistinct patents across independent filing chains—each with its own twenty-year term—would exacerbate these costs for the patents that matter most.

**B. There is no evidence that ODP's limits on extensions of exclusivity for patentably indistinct inventions harm innovation.**

Opponents of ODP's constraints have argued that limiting double patenting will harm innovation by reducing incentives to patent follow-on inventions. But this argument lacks empirical support. As we have explained, "the costs of challenging invalid patents are a presumptive harm, and the opponents of [more stringent restrictions on double patenting] have made no showing that the current rule is benefitting the American economy compared with a more restrictive practice." Lemley & Ouellette, *supra*, at 1047. To the contrary, "[w]e currently lack sufficient empirical evidence on whether strengthening patent rights even increases overall research investments, much less whether this benefit is large enough to outweigh patents' costs." *Id.* There is even less reason to think that innovators need the ability to accumulate portfolios of patentably indistinct patents—which, by definition, do not represent a meaningful advance over what has already been claimed.

What the evidence does show is that double patenting imposes real costs. The growing volume of patents on trivial variants of the same invention "is placing an increasing burden on the USPTO." *Id.* at 1030. When examiners inevitably make mistakes in granting patents, the resulting patent portfolios increase costs for market participants, subsequent innovators, and the public. Unless and until evidence of the innovation benefits of unrestricted double patenting is developed, there is thus a

strong policy argument in favor of "reforms that reduce the substantial administrative and transaction costs of the patent system" by curbing this growing practice. *Id.* at 1056. At the very least, maintaining ODP's existing limits on patentably indistinct patents—including its application to later-filed reference patents from independent families—serves the patent system's core function of "allow[ing] inventors and the USPTO to focus on what should be important—inventing and patenting new inventions rather than multiplying patents on trivial variants of old inventions." *Id.*

## CONCLUSION

For the reasons set forth above, the Appeals Review Panel should affirm the examiner's rejections for obviousness-type double patenting.

March 18, 2026

Respectfully submitted,

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