

The Doctrine of Obviousness-Type Double Patenting Maintains Its Vitality

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Abbvie Inc. v. Kennedy Institute of Rheumatology Trust

Addressing whether the doctrine of obviousness-type double patenting is still viable, and, if so, whether it served to invalidate a later-issued and expiring patent, the U.S. Court of Appeals for the Federal Circuit affirmed a lower court's decision of invalidity, finding that the doctrine continues to apply where two patents that claim the same invention have different expiration dates. *Abbvie Inc. v. Kennedy Institute of Rheumatology Trust*, Case No. 13-1545 (Fed Cir., Aug. 21, 2014) (Dyk, J.).

The **Kennedy Institute of Rheumatology owned two patents** directed toward methods of **treating rheumatoid arthritis** by co-administering two drugs. The first patent, which expired in 2012, claimed a method of "coadministering" two drugs to treat arthritis, and the second patent, expiring in 2018, claimed "adjunctively administering" the drugs.

Abbvie is a licensee to the first patent and paid fees to the Kennedy Institute to sell Humira®. When the second patent issued, the Kennedy Institute sought additional licensing fees. Abbvie sued for a declaratory judgment that the second patent was invalid under the doctrine of obviousness-type double patenting (ODP).

The district court, in a bench trial, construed disputed claim term "co-administering" in a way that covered the claimed "adjunctively administering" of the second patent. The district court rejected the Kennedy Institute's construction of "active disease" in the second patent, finding that the second patent was directed to the same arthritis patients as the first. The district court then determined that the second patent was not patentably distinct from the first patent and found the second patent invalid. The Kennedy Institute appealed.

The Kennedy Institute argued that the doctrine of ODP was no longer viable in view of the Uruguay Round Agreement Act's (URAA) 20-year period of patent protection from the earliest claimed priority date. The Federal Circuit rejected that argument, explaining that while the doctrine of ODP is less significant in post-URAA disputes, the doctrine continues to prevent an inventor from securing a second, later-expiring patent for the same invention; a situation prohibited by § 101. The Court explicitly held that the doctrine of ODP continues to apply where two patents that claim the same invention have different expiration dates.

The Federal Circuit also agreed with the district court's ruling of invalidity. Relying on specification of the first patent, the Federal Circuit determined that the lower court's claim construction of "co-administering" was proper and that the term covered three modes of administration, one of which included the mode covered by the second patent. The Federal Circuit rejected the Kennedy Institute's argument that this construction improperly excluded a fourth mode of administration and also rejected its claim differentiation argument.

Regarding the claim term "active disease," the Federal Circuit assumed, without deciding, that the Kennedy Institute's proposed construction was correct and analyzed whether a patent that claims to treat a subset of patients with more severe rheumatoid arthritis (the second patent) is an obvious variant of a patent that claims to treat rheumatoid arthritis patients generally (the first patent). The Court found that the difference did not render the claims of the second patent patentably distinct from the first.

Applying an analysis that is analogous to an obviousness analysis under § 103, the Federal Circuit explained that obviousness is not demonstrated merely by showing that an earlier patent dominates a later expiring patent, noting that a narrow species can be non-obvious despite a patent on its genus. But, as the Court noted, not every species of a patented genus is separately patentable, stating that when a genus is so limited that a person of ordinary skill in the art can at once envisage each member of the limited class, a reference describing the genus anticipates every species within the genus. The Federal Circuit found that, in this case, a reader of the first patent would have easily envisaged a species limited to sicker patients, and therefore the second patent was not patentably distinct from the first.

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