Published on *The National Law Review* https://natlawreview.com

When a Divisional Is Not a Divisional: No Section 121 Safe Harbor for Reissue Patentee Who Retroactively Omitted New Matter

Article By:

Shane G. Smith, Ph.D.

Addressing the "safe harbor" provision under 35 U.S.C. § 121, the U.S. Court of Appeals for the Federal Circuit upheld a district court ruling that a reissue patent was invalid for obviousness-type double patenting. ***G.D. Searle LLC v. Lupin Pharmaceuticals, Inc.***, Case No. 14-1476 (Fed. Cir., June 23, 2015) (Bryson, J.).

Co-plaintiffs G.D. Searle and Pfizer Asia (collectively Pfizer) asserted a reissued U.S. patent (the Pfizer patent) against five generic drug makers. Although the reissue was ostensibly filed to correct certain "technical errors," Pfizer also re-designated the reissue as a divisional (the original application was filed as a continuation-in-part), removing any subject matter not present in the original application. The defendants argued that the Pfizer reissue patent was invalid for obviousness-type double patenting and that Pfizer was not entitled to invoke the safe harbor in § 121, a provision that protects patentees from a double-patenting challenge where the claimed subject matter is presented in a divisional application as a result of a restriction requirement made in a parent application. The district court agreed, concluding that Pfizer's patent was not a proper "divisional" and found the Pfizer reissue patent invalid. Pfizer appealed.

The first issue addressed by the Federal Circuit was whether the "safe harbor" of § 121 applies to the Pfizer reissue patent. The Court found it did not, explaining the Pfizer reissue patent was not a true "divisional" of the parent patent. As the Federal Circuit explained, "[T]he [child] application cannot be a divisional of the [parent] application, despite being designated as such in the reissue patent, because it contains new matter that was not present in the [parent] application." Although Pfizer attempted to delete the new matter during the reissue proceedings, the Federal Circuit found this to be insufficient for purposes of invoking the safe harbor of § 121, stating that "[s]imply deleting that new matter from the reissue patent does not retroactively alter the nature of the [child] application."

The Federal Circuit concluded that § 121 could not save Pfizer's patent for a second reason as well: Pfizer's reissue patent and the reference patent not derive from the same restriction requirement. As the Court explained, to trigger the "safe harbor" under § 121, the restriction requirement must carry forward to the later-filed application. In this case, the U.S. Patent and Trademark Office (USPTO) imposed separate restriction requirements on separate applications so there was no common lineage

and further, there was no evidence that the PTO intended the earlier restriction requirement to carry forward.

National Law Review, Volume V, Number 212