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Double Patenting

In re Basell Poliolefine (Fed. Cir. 2008)

Richard P. Beem
Chicago USA
www.BeemLaw.com

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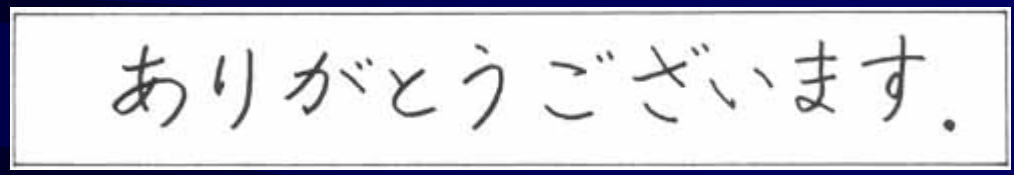
Double Patenting

***In re Basell Poliolefine* (Fed. Cir. 2008)**

By Richard Beem



Arigatou gozaimasu.

Thank you very much.

Special thanks to Whitney Wilson (member of AIPLA Japan Committee), who prosecuted the ‘687 patent in suit, for his helpful insights

Disclosure of Interest

- The presenter (Richard Beem) was one of the attorneys for Phillips Petroleum in *United States Steel Corp. v. Phillips Petroleum Co.*, 865 F.2d 1247 (Fed. Cir. 1989).
- The latter appeal was the culmination of about 35 years of prosecution, interferences and litigations involving multiple claims to the invention of crystalline polypropylene
- Natta's applications were involved
- Phillips' U.S. Patent 4,376,851 to Hogan and Banks ultimately was held valid and infringed by the industry
- Related cases, including Natta's, are still being decided more than 50 years after the inventions were made

Natta: Won the 1963 Nobel prize but not the broadest patents

- Natta (Italian) and Ziegler (German) shared the 1963 Nobel prize in chemistry "for their discoveries in the field of the chemistry and technology of high polymers," i.e., Ziegler-Natta catalysts and processes for making polymers
- The application that led to Natta's '687 patent was involved in three interferences. *See* Judge Newman's dissenting opinion in *In re Basell.*
- *See Standard Oil (Indiana) v. Montedison*, 664 F.2d 356 (3d Cir. 1981) (awarding priority to Phillips).

The Natta ‘687 patent and *In re Basell* are small parts of a big story

- Prosecution, interferences and litigations involving Natta led to changes in U.S. patent law and practice, including:
  - Interference practice
  - Patent term (20 years from filing instead of 17 years from issue)

Statutory or "same invention" double patenting

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain **a [one and only one]** patent therefor, subject to the conditions and requirements of this title.

Obviousness

35 USC § 103

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 [novelty] of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole **would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. § 103(a) (1952).

Obviousness-type double patenting

- Judicially created doctrine
- Prevents extension of a patent for “obvious modification” of that patent
- Prohibits extension through claims in later patent “not patentably distinct” from claims in commonly owned earlier patent

In re Basell Poliolefine (Fed. Cir. 2008)

- Reexam of Natta's U.S. Patent 6,365,687 ('687 patent)
- "Process for the Polymerization…"
- Claims polymerizing any alpha-olefin C[4] or higher with any olefin (some claims, specifically ethylene) using a titanium halide aluminum alkyl catalyst

***In re Basell Poliolefine Italia S.P.A.*, 547 F.3d 1371 (Fed. Cir. 2008)**

In re Basell Poliolefine (Fed. Cir. 2008)

- ’687 patent from July 1954 Italian app.
- Issued April 2002
- Reexamination ordered June 2002
- FOIA request showed that a major oil company prompted the reexam

Bases for Reexam

- Reexam originally declared based on two expired Natta patents
- During reexam, the examiner added two additional Natta patents, including U.S. 3,582,987 (the ‘987 patent), ultimately the basis for Fed. Cir. affirmance

One way test—harder on applicant—is "normally applied"

- One way test: Whether claims of later application "are" obvious over claims of earlier patent
- Two way test: Also ask whether earlier patent claims are obvious over later application claims
- Two way test only applies "in the unusual circumstance that the PTO is solely responsible for the delay in causing [a] second-filed application to issue prior to [a] first." *In re Basell*.

Federal Circuit's reasons for holding Natta to the "one way" test that is harder on the applicant

- Natta presented the broad claims several years after filing original application
- He urged interferences for "unrelated inventions"
- He filed several continuing applications without appeal

One way test is “normally applied”

- If you accept a patent with narrow claims
- You may not be able to obtain another patent with broader claims
- Unless you file a terminal disclaimer
- Would not have helped Natta because so many years had elapsed

PTO may reject claims without full Graham analysis

- Board failed to set forth Graham analysis of obviousness
- But the Federal Circuit nevertheless affirmed the determination of obviousness

Judge Newman's Dissent

- PTO did not follow the reexamination statute then in effect
- Natta's right to priority already had been decided in his favor
- Most of the delay was not Natta's fault
- Delay is not a basis for double patenting
- PTO ignored expert testimony and its own findings

Conclusions

- Patents require both scientific achievement and skillful advocacy
- Be zealous in prosecuting applications and appeals, especially if you want broad claims

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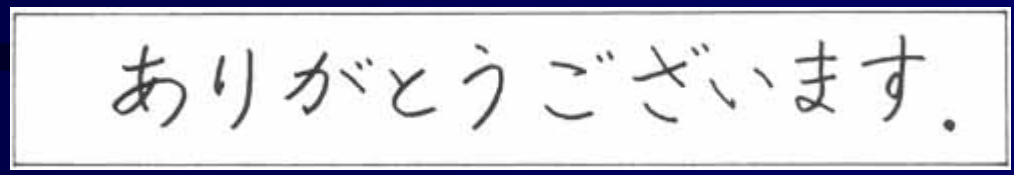

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