

ABBVIE INC. v. KENNEDY INST. OF RHEUMATOLOGY, Appeal No. 2013-1545 (Fed. Cir. August 21, 2014). Before Dyk, Wallach and Chen. Appealed from S.D.N.Y. (Judge Crotty).

Background:

Kennedy owned two patents directed to methods of treating rheumatoid arthritis, the second patent set to expire six years later than the first patent. AbbVie held a license under Kennedy's first patent to sell drugs based on the first patent. Once the second patent issued, Kennedy demanded that AbbVie pay for a new license to continue selling the drugs. AbbVie refused and instead filed suit seeking a declaratory judgment that the claims of Kennedy's second patent were invalid over the claims of the first patent for obviousness-type double patenting.

The district court agreed with AbbVie and held the claims of the second patent invalid. Kennedy appealed.

Issue/Holding:

Did the district court err in holding the claims of the second patent invalid for obviousness-type double patenting? No, affirmed.

Discussion:

Both patents owned by Kennedy contain identical disclosures of a treatment for rheumatoid arthritis including administration of a disease-modifying anti-rheumatic drug and an antibody. The claims of the first patent were directed to the broad "genus" method of "co-administering" the drug and the antibody. The claims of the second patent were directed to the more narrow "species" method of "adjunctively administering" the antibody with the drug in order to reduce the "signs and symptoms" in an individual suffering the "active disease."

Kennedy argued the claims of the second patent were patentably distinct from those of the first patent because certain limitations, such as "adjunctively administering" (i.e., adding a second treatment to one already being administered) and "active disease," are not claimed in the first patent, and the claimed method of the second patent produces the unexpected result of improving the health of "hardest-to-treat patients." The Federal Circuit disagreed with Kennedy.

Under the doctrine of obviousness-type double patenting, it must be determined whether claims of a second patent are obvious in view of claims of a first patent, and thus the specification of the first patent cannot be used as prior art. However, portions of the specification which provide support for the claims of the first patent can be used to determine whether the claims of the second patent are merely obvious variants.

The Federal Circuit held that the second patent's claims merely recite the utility of test results already disclosed in the first patent, and thus there are no new unexpected results resulting from the claimed method of the second patent. Moreover, it was held that the more narrow "species" method claimed in the second patent would have been obvious over the broad "genus" method claimed in the first patent because one of ordinary skill would have easily envisioned the species limited to sicker patients suffering an "active disease."