

IN RE: JANSSEN BIOTECH, INC., Appeal No. 2017-1257 (Fed. Cir. January 23, 2018).
Before Prost, Reyna, and Wallach. Appealed from PTAB. (Obvious-Type Double Patenting)

Background:

In an *ex parte* reexamination, the claims of a patent owned by Janssen (the '471 patent) were held unpatentable under the doctrine of obviousness-type double patenting over the claims of other patents in the same family. Janssen filed the application that issued as the '471 patent as a CIP application claiming priority to two applications, the '413 application and the '406 application, after receiving a restriction requirement in the '413 application.

During the reexamination, Janssen tried to retroactively convert the '471 patent into a divisional application of the '413 application by canceling subject matter drawn from the '406 application and requesting that the '471 patent be amended to delete the benefit claim to the '406 application. The examiner entered the amendments for the purpose of reexamination but maintained the double patenting rejections on the basis that the safe-harbor provision of 35 U.S.C. §121 did not apply. The Board affirmed the examiner and Janssen appealed.

Issue/Holding:

Did the Board err in affirming the examiner? No, affirmed.

Discussion:

Janssen's principal argument was that obviousness-type double patenting was not applicable because the safe-harbor provision protected the claims of the '471 patent. The safe-harbor provision of §121 provides in relevant part:

...shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

Following its precedent of literal interpretation of the safe-harbor provision in *Searle*, the Federal Circuit found that the safe-harbor provision is strictly limited to a "divisional" application. Although *Searle* dealt with amendments in a reissue application, the Federal Circuit applied the same analysis here in finding that a patent owner cannot retroactively bring its challenged patent within the scope of the safe-harbor provision by amendment in a reexamination. The Federal Circuit further found that the '471 patent did not "issue" on a divisional application or on the original application that was subject to the restriction requirement, *i.e.*, the '413 application, for purposes of §121. According to the Federal Circuit, the '471 patent issued on an application that included new matter, *i.e.*, from the '406 application, not disclosed in the original '413 application, and thus it was properly designated as a CIP.

Janssen attempted to distinguish *Searle* arguing that, unlike the patent in *Searle*, no issued claims in the '471 patent relied on new matter in the filed application and therefore it did not receive any benefit of patent protection from the CIP filing. The Federal Circuit disagreed, noting that Janssen received the benefit of at least thirty-plus patents that had issued to Janssen claiming priority to the '471 patent. The Federal Circuit found that even if it were possible to re-open prosecution of those patents in order to determine whether they claimed any new matter, Janssen never suggested to the PTO during prosecution of the '471 patent that the application was anything other than a CIP.