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Obviousness-Type Double Patenting" It's Complicated

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In two recent decisions, the US Court of Appeals for the Federal Circuit found that an asserted patent was not invalid due to obviousness-type double patenting (1) when a patent filed post-Uruguay Round Agreements Act of 1994 (URAA) expires before a patent filed pre-URAA, and (2) when the term of an earlier expiring patent is extended under § 156 so that its term extends past the expiration date of a later filed patent. *Novartis Pharms. Corp. v. Breckenridge Pharm. Inc. et al.*, Case No. 17-2173 (Fed. Cir. Dec. 7, 2018) (Chen, J); *Novartis AG v. Ezra Ventures LLC*, Case No. 17-2284 (Fed. Cir. Dec. 7, 2018) (Chen, J).

Novartis v. Breckenridge

In *Novartis v. Breckenridge*, two related Novartis patents contained the same specification but different filing dates. The earlier patent was filed prior to June 8, 1995, the effective date of the URAA. Novartis's later patent was filed after June 8, 1995. Because the URAA changed the expiration date of a patent from 17 years from the date of issue to 20 years from the effective filing date, Novartis' earlier-filed patent issued sooner but expired later than the later-filed patent.

Novartis sued Breckenridge Pharmaceutical and Par Pharmaceutical for infringement of the earlier-filed patent, which was not yet expired. Both defendants conceded that they infringed the patent, but argued that the patent was invalid as being obvious due to double patenting of the later-filed patent. Novartis agreed that if the later

patent was a proper double patenting reference, then the earlier patent would be invalid. The district court found that the later-filed patent was a proper double patenting reference that invalidated the earlier patent. Novartis appealed.

The Federal Circuit reversed. The Court found that the URAA states that "[t]he term of a patent that . . . results from an application filed before [June 8, 1995] shall be the greater of the 20-year term . . . or 17 years from grant." The Court found that this statement indicates that Congress did not intend for the URAA to truncate the patent terms of pre-URAA patents, but rather intended for these patents to enjoy their full patent term. As a result, the asserted patent was not invalid for obviousness-type double patenting.

Novartis v. Ezra Ventures

Novartis owns US Patent Nos. 5,604,229 and 6,004,565. The '229 patent had an initial expiration date of February 18, 2014, but received a five-year patent term extension under 35 USC § 156. A condition placed on § 156 extensions is that the patent owner can only extend "one patent" out of the multiple related patents it may have.

Novartis sued Ezra Ventures for patent infringement of the '229 patent. In response, Ezra argued that the '229 patent was invalid since its § 156 extension moved its expiration after the expiration date of the related '565 patent. Ezra argued that the '229 patent was invalid for obviousness-type double patenting and extended the life of the related '565 patent in violation of the § 156 requirement that only "one patent" could be extended. The district court rejected Ezra's argument, finding the '229 patent valid, enforceable and infringed. Ezra appealed.

The Federal Circuit affirmed the district court decision. The Court found that § 156 only restricts the "legally conferred" § 156 patent term extension granted by the US Patent and Trademark Office such that it is given to only "one patent." It does not prohibit more than one patent from receiving an "effective" extension under § 156, however, and thus the term of the '565 patent can properly be affected by the extension of the '229 patent term. The Court also found that proper application of § 156 authorizes a patent term to be extended past the expiration date of a related patent, and a § 156 patent term extension is thus not prohibited by obviousness-type double patenting.