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A Comment on *In re Cellect*: The Patent Bar Must Push for Eliminating ODP Altogether, Not Interpreting it More Favorably

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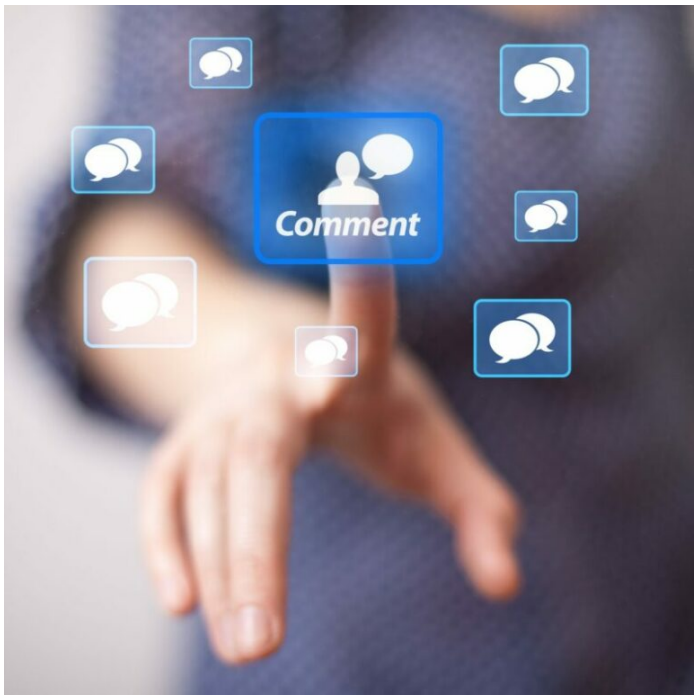
"The longer we as the patent bar accept that obviousness-type double patenting exists without codification and argue at the edges for a kinder application of the doctrine, the faster we sink the ship."

In an IPWatchDog post of September 6, 2022, Anthony Prosser and I traced the history of the doctrine of "Non-Statutory Judicially Created Obviousness-Type Double Patenting" (ODP). We confirmed (as its name indicates) that no Congressional statute has ever codified this doctrine. It is *ultra vires* because Congress has the sole right to create patent law. I refer you to that article for the history.



We also stated that the proper way to apply obviousness against the same assignee under current statutes, read literally and properly, is the following:

1. For claims in applications by the same assignee entitled to the same priority date, there is no prior art effect because §103 refers to prior art, which by definition has to have existed the day before the priority date of the application.
2. For claims in applications by the same assignee with different priority dates, where the first application was not published before the priority date of the second application, there is no prior art effect for obviousness under 35 USC 102(b)(2)(C) as revised by the AIA.
3. For claims in applications by the same assignee with different priority dates, where the first application was published before the priority date of the second application, normal obviousness rules apply.

In the *Cellect decision issued yesterday*, the Federal Circuit stretches the word "disclaimer" in Section 154(b)(2)(B) beyond credibility as justification for the ODP doctrine itself and assumes that is what Congress was talking about without actually saying it (stating with agreement that "The Board also reasoned that terminal disclaimers arise almost exclusively in situations to overcome ODP rejections, and so Congress, by addressing terminal disclaimers in Section 154, effectively addresses ODP"). And of course, Section 154 doesn't use the word "terminal". This reminds me of the famous adage from Justice Scalia that Congress does not hide elephants in mouseholes. The Federal Circuit also admits ODP itself is a court-made policy doctrine. In fact, the truth is that Congress did not create and has never weighed in on ODP.

I am reminded of the alarming statements of Justice Kagan in *Kimble v. Marvel* (576 U.S. 446 (2015) on judicial *stare decisis* that:

> "Respecting *stare decisis* means sticking to some bad decisions. The doctrine rests on the idea, as Justice Brandeis famously wrote, that it is usually more important that the application of the law be settled than it be settled right. *Burnet v. Coronado Oil and Gas Co.* 285 U.S. 393, 406 (1932)….What is more, stare decisis carries enhanced force when a decision, like Brulotte, interprets a statute. Then, unlike in a constitutional case, critics of our ruling can take their objections across the street, and Congress can correct any mistakes it sees….Indeed, we apply statutory *stare decisis* even when a decision has announced a 'judicially created doctrine' designed to implement a statute. All of our interpretive decisions, in whatever way reasoned, effectively become part of the statutory scheme, subject (just like the rest), to congressional change."

The longer we as the patent bar accept that obviousness-type double patenting exists without codification and argue at the edges for a kinder application of the doctrine, the faster we sink the ship. The Supreme Court and the Federal Circuit prove that they will continue to encroach on Congress' sole powers, even where they know they are acting inconsistently, or by creating judicially created doctrines, until we stop it at its core. That said, Congress has so many pressures on drug pricing that it will be hard pressed to clean this up in the short term to demand respect for its own laws as actually codified.

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Paul F. Morgan

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This is ignoring the many judicial decisions over many years under which obviousness type double patenting has been found. Based on 101's statutory requirement of "a" patent per an invention as including obvious claiming variants. And, by far the most effective way to challenge ODP would be with a Sup. Ct. challenge rather than via Congress.

Anon

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