In re Basell Poliolefine Italia, S.P.A.

No. 07-1450, Fed. Cir. (Newman, Lourie,* Linn)

[A] patent's disclosure may be used to determine whether an application claim is merely an obvious variation of an invention claimed in a patent.

On November 13, 2008, the Federal Circuit affirmed the USPTO Board of Patent Appeals and Interferences decision upholding the examiner's obviousness-type double patenting rejection in a reexamination of the claims of U.S. Patent No. 6,365,687, which related to the copolymerization of certain unsaturated hydrocarbons, in view of U.S. Patent No. 3,582,987. The Federal Circuit stated:

> "The doctrine of double patenting is intended to prevent a patentee from obtaining a time-wise extension of [a] patent for the same invention or an obvious modification thereof." The judicially created doctrine of obviousness-type double patenting "prohibit[s] a party from obtaining an extension of the right to exclude through claims in a later patent that are not patentably distinct from claims in a commonly owned earlier patent." In determining double patenting, a one-way test is normally applied, in which "the examiner asks whether the application claims are obvious over the patent claims." In unusual circumstances, where an applicant has been unable to issue its first-filed application, a two-way test may apply, in which "the examiner also asks whether the patent claims are obvious over the application claims." . . . Those circumstances, however, are not present here.
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> The record shows that the patentees did not present any claim resembling the claims at issue until 1964, nine years after Natta filed the first U.S. application in the chain of priority and well after Natta filed the application that resulted in the '987 patent. Moreover, those claims appear to have been filed for interference purposes only. In addition, the Board found that since 1954, the patentees repeatedly submitted claims directed to claims covering other inventions, urged the examiner to declare interferences for unrelated inventions, and repeatedly filed continuing applications without appeal. During the critical co-pendent period of the applications for the '687 patent and the '987 patent, Natta could have filed the present claims. Natta's actions, or inactions, had a direct effect on the prosecution and thus were responsible for any delay in prosecution. We find no error with regard to the Board's findings and agree with the Board that the two-way test for double patenting does not apply. . . .
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> The critical inquiry before us is whether the claims of the '687 patent define an obvious variation of the claims of the '987 patent. [T]he claims of the '687 patent are not patentably distinct from claim 1 of the '987 patent. [W]ith regard to the alpha olefin of C_4 or higher, claim 1 of the '987 patent provides that one of the monomeric materials may include "unsaturated hydrocarbons of the formula $CH_2{=}CH_R$ in which R is selected from the group consisting of saturated aliphatic radicals containing 1 to 4 carbon atoms." Thus, both claims of the '987 patent and the '687 patent cover alpha olefins of C_4 to C_6. . . . Claim 1 of the '687 patent

is thus not patentably distinct from claim 1 of the ’987 patent. . . . In essence, the claims of the ’987 and ’687 patents consist of various permutations of polymerization of olefins with various numbers of carbon atoms using catalysts of titanium halides and aluminum alkyls. Some expressions are generic to others. While it is true that a generic expression does not render obvious all of the species that it encompasses, these claims are both generic and specific to each other in interchangeable ways, involving the same groups of species.

The ’987 claims are directed to polymerization of C_3 to C_6 olefins with other mixtures of unsaturated hydrocarbons. As homologs are presumptively obvious over known compounds, these claims render obvious the claims of the ’687 patent directed to polymers of the homologous, well-known ethylene and C_4 olefins (claim 1) and the copolymerization of C_4 olefins (claim 9). [T]he specification of the ’987 patent itself refers to ethylene, propylene, butene, and other olefins which indicates that those olefins were intended to fall within the meaning of the claims. Thus, the PTO had good basis for its conclusion that the claims of the ’987 patent rendered obvious the claims of the ’687 patent and that the latter claims are invalid for obviousness-type double patenting. . . .

Basell asserts that the rejection must be reversed because the Board improperly read limitations from the ’987 specification into the claims in concluding that the claims are not patentably distinct. We disagree. While [it] is impermissible to treat a “patent disclosure as though it were prior art” in a double patenting inquiry, . . . certain instances may exist where a patent’s disclosure may be used. Indeed, [a] patent’s disclosure may be used to determine whether an application claim is merely an obvious variation of an invention claimed in a patent. [T]he disclosure may be used to learn the meaning of terms and in “interpreting the coverage of [a] claim.” It may also be used to answer the question whether claims merely define an obvious variation of what is earlier disclosed and claimed. [T]he disclosure “sets forth at least one tangible embodiment within the claim, and it is less difficult and more meaningful to judge whether [something] has been modified in an obvious manner.” “[U]se of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. § 103, since only the disclosure of the invention claimed in the patent may be examined.” As such, we conclude that the Board did not err in referring to the specification of the ’987 patent when it determined whether the claims were patentably distinct from the claims of the ’687 patent.

The previous statements are for information purposes only, and do not constitute legal advice. Questions regarding the matters discussed above, and any requests to be subscribed to the free electronic distribution of this publication, may be directed to Lawrence M. Sung, Ph.D., at +1 202.346.7850 or lsung@dl.com, or to any other Dewey & LeBoeuf LLP attorney with whom you regularly consult.

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