



THINK FORWARD

Federal Circuit Rules that a Patentee Cannot Seek Safe Harbor Protection by Rewriting History

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The choice of priority claiming designation can enhance or impair the longevity of patent life. Last week, the Federal Circuit invalidated a reissue patent after finding that a patentee's choice of priority claim status left it outside the scope of the safe harbor provision of 35 U.S.C. § 121. See *G.D. Searle LLC v. Lupin Pharms. Inc.*, No. 2014-1476 (Fed. Cir. June 23, 2015). The decision has ended a longstanding patent war relating to the blockbuster prescription pain medication Celebrex®.

G.D. Searle involved a reissue patent with a long and complicated prosecution history. During prosecution of the parent application which disclosed the subject matter of the reissue patent, a three-way restriction requirement was imposed. Instead of filing a divisional application for the un-elected claims, the applicant added some subject matter and filed a series of continuation-in-part applications (CIPs) with claims directed to the originally-unelected subject matter and to the added CIP material.

Seven years prior to the court's ruling last week, the Federal Circuit invalidated the original of the reissue patent for obviousness-type double patenting in view of a patent that was issued as a divisional application from the parent application. See *Pfizer, Inc. v. Teva Pharms. USA, Inc.*, 518 F.3d 1353 (Fed. Cir. 2008). Seeking to remedy the deficiencies of the claims, Pfizer sought reissue of the patent under 35 U.S.C. § 251 on the basis that it had "erred in prosecuting the application leading up to [the patent at issue] as a continuation-in-part, rather than as a divisional application, and that the error had resulted in invalidating the relevant claims." *G.D. Searle*, No. 2014-1476, slip op. at 6. The Patent and Trademark Office (PTO) eventually allowed the claims after Pfizer corrected some technical errors, removed the new matter from the patent, and made changes to the priority so that the patent reissued as a divisional from the parent application instead of as a CIP.

During litigation, defendants argued the reissue patent was invalid for obviousness-type double patenting because the claims were not patentably distinct from claims in a commonly owned earlier patent. Pfizer relied on the safe harbor exception found in 35 U.S.C. § 121, which "in certain circumstances protects a patent that issues on a divisional application from invalidation based on a related patent that issued on an application as to which a restriction requirement was made, or on an application filed as a result of such a requirement." *Id.* at 5. The District of Delaware held the patent invalid for obviousness-type double patenting and the Federal Circuit affirmed.

The Federal Circuit ruled the reissue patent was not entitled to safe harbor protection because it did not issue from the parent application or a divisional of the parent application. "Simply deleting . . . new matter from the reissue patent does not retroactively alter the nature of the . . . application." *Id.* at 9. Citing fairness, the Federal Circuit noted that because "public was not free to practice that new matter (e.g. the now cancelled claims)" of the originally issued patent during the time between original issuance and the reissue, it would be unfair for Pfizer to "now identify [the patent] as a divisional" and

“retroactively relinquish the new matter . . . after having enjoyed years of patent protection for it.” *Id.* The Court also found the safe harbor provision inapplicable to the reissue patent because the reissue patent and the reference patent were not derived from the same restriction requirement. *Id.* at 11. Given the invalidation of the patent based on inapplicability of the safe harbor, the court found it was unnecessary to decide whether the reissue was proper under 35 U.S.C. § 251.

As the patentee learned here, the safe harbor protection may not allow a patentee to cure a priority-claim choice, even if it has been corrected by reissue.

Practitioners are well-advised to confirm priority-claiming strategy when filing continuation, CIP, or divisional applications. In particular, when responding to a restriction requirement, in spite of the additional costs that may be incurred, one may wish to consider filing a divisional application instead of or in addition to a continuation or CIP in order to preserve the safe harbor exception to obviousness-type double patenting.

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