

**Keywords: Patentable Subject Matter; Safe Harbor Provision; Divisional Filing Date; Double Patenting Rejection**

**General:** Safe harbor provision does not shield a divisional application from the double patenting effect of a patent that issued before the divisional application was filed.

*Ex parte Sauerberg*

Appeal No. 2015-007064 (P.T.A.B. December 1, 2017)

**I. Facts**

An appeal was brought before the Patent Trial and Appeal Board (“the Board” herein after), because of an Examiner’s obviousness-type double patenting rejection of a divisional application.

In 2008 Sauerberg et al. filed a patent application (“the Original Application”), which received restriction requirements, asking Sauerberg to elect from two groups of compounds (Group I), and methods (Group II) for further prosecution. In response to this restriction, Sauerberg elected Group I, and received a first patent issued with claims directed to Group I, the ‘613 patent (P1), on May 17, 2011. Prior to issuance of P1, Sauerberg filed a first continuation (C1) with claims directed to Group I and prior to the issuance of C1, Sauerberg filed a second continuation (C2) with claims directed to Group I. Subsequently, prior to the issuance of C2 (but after the issuance of P1 and P2), Sauerberg filed a divisional application (D1) directed to the claims of Group II. Fig. 1 illustrates the sequence of filing and issuance dates of the filings.

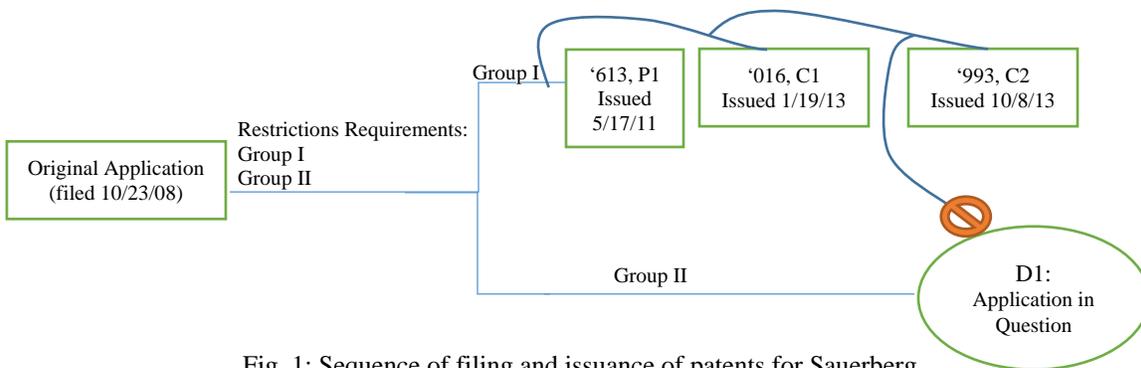


Fig. 1: Sequence of filing and issuance of patents for Sauerberg

The Examiner rejected the claims of D1 application on the grounds of non-statutory double patenting over claims in each of P1, C1, and C2. Sauerberg did not dispute the fact that these claims would have been obvious over the claims of these patents; however, the Appellant argued that safe harbor provision of 35 U.S.C. §121 shields D1 from double patenting.

**II. Issues**

Does the safe harbor provision shield a divisional application from a non-statutory double patenting rejection when the divisional application is filed subsequent to the filing of a continuation without the non-elected subject matter?

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### III. Discussion

No. The Board here affirmed the Examiner's rejections under the doctrine of obviousness-type double patenting over P1, C1, and C2 and asserted that the safe harbor provision does not apply. 35 U.S.C. §121, known as "the safe harbor provision," states:

*[a] patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on **an application filed as a result of** such a requirement, 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.***

The Board held that the safe harbor provision does not shield the present application (D1) from obviousness-type double patenting rejections over P1, C1, and C2 for two reasons:

- 1) The continuation patents (C1 and C2) were not filed "as a result of" a restriction requirement.
- 2) The present application (D1) was not filed "before the issuance of the patent on the other application" (i.e., P1).

With respect to the first reason, the Board explained that the "as a result of" requirement must be satisfied by both the present application (D1), and reference patents (P1, C1, and C2). The board further discussed that since D1 application in this case was not "as a result of" the restriction requirement in the Original Application because the Group I subject matter pursued in the first and second continuations (C1 and C2) was not precluded from being incorporated in the Original Application. Therefore, since C1 and C2 failed to satisfy the "as a result of" requirement of the safe harbor, D1, filed after C1 and C2, could not have been filed "as a result of" the original restriction requirement.

In other words, the Board required the Applicant to show that C1 and C2 were filed as a result of the restriction requirement. The Applicant failed to prove this burden. Thus, the Board held that the Examiner did not err in rejecting D1 under doctrine of obviousness-type double patenting over C1 and C2.

With respect to the Board's second reason for affirming the Examiner's rejections, the Board looked to the portion of the safe harbor provision that states that the provision only applies if the divisional application (i.e., D1) is filed before the issuance of the patent on the other application (i.e., P1). The Appellant here argued that D1 application is entitled the filing date of the Original Application under 35 U.S.C. §120 which reads in part that:

An application for patent for an invention disclosed in the manner provided by section 112(a) (other than the requirement to disclose the best mode) in an application previously filed in the United States, or as provided by section 363 or 385 which names an inventor or joint inventor in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or

is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director.

Appellant argued that D1 is entitled to the filing date of the Original Application (i.e., the effective filing date), and because this effective filing date predates the issue dates of all of P1, C1, and C2, the requirement that D1 should have been filed “before the issuance of the patent on the other application” has been met, and hence they can rely on the safe harbor provision.

The Board rejected the Appellant’s argument and instead interpreted the phrase “the divisional application is filed” to refer to the actual filing date of the divisional application, not the effective filing date, as the Appellant argued. The Board further opined that the Appellant’s interpretation of the “before the issuance ...” would render the provision meaningless and superfluous, and, thus, incorrect.

The Board also determined that “the effective filing date of a patent application is largely irrelevant in the context of a double patenting rejection” because such rejections are based on the substance of the claims of the reference and challenged applications, not the filing dates. Accordingly, because D1 in this case was filed after the issuance of P1, the Board held that the Examiner did not err in asserting P1 as an obviousness-type double patenting reference against D1.

#### **IV. Conclusion**

The Board has ruled that Section 121 does not shield a divisional application from the doctrine of non-statutory double patenting over an original patent or any other continuation that might have been issued thereafter when the divisional application is filed from a continuation. This holding is in contrast to a Fed. Cir. ruling that retains the safe harbor provision in a series of divisional applications directed to different inventive groups identified in an original restriction requirement. *Boehringer Ingelheim Int’l. GmbH v. Barr Labs., Inc.*, 592 F.3d 1340 (Fed. Cir. 2010). The holding is also in contrast to a Fed. Cir. ruling that a continuation filed from a divisional application retains safe harbor protection over an original application in which the restriction requirement was made. *Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569 (Fed. Cir. 1991); *see also Amgen Inc. v. F. Hoffman-La Roche Ltd*, 580 F.3d 1340 (Fed. Cir. 2009).

Thus, the Board has differentiated the applicability Section 121 to a divisional filed from a continuation versus a divisional filed from a previous divisional and a continuation filed from a divisional.