

Ex Parte Moncla helps, but does not Resolve, Uncertainty in Appeal of Applications Including Provisional Double Patenting Rejections

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I. INTRODUCTION

United States patent applicants are frequently faced with statutory rejections coupled with a non statutory or statutory Provisional Double Patenting Rejections (PDPRs). The PDPR is provisional because the claims in other application have not, and may never, issue. PDPRs have been problematic because they introduce uncertainty in the effect of an appeal to the Board of Patent Appeals and Interferences (BPAI). The BPAI has now addressed this issue in Ex parte Moncla, Appeal 2009-006448, (BPAI 6/22/2010) (precedential, expanded panel). In Moncla, the BPAI determined that, at least in certain circumstances, PDPRs do not count.

II. THE FACTS AND HOLDING IN MONCLA

Specifically, in Moncla, the BPAI reversed the examiner without reaching the PDPRs. The facts and holding are as follows:

In an Office Action mailed Nov. 21, 2006, the Examiner finally rejected all pending claims as follows: claims 9, 10, 12, 32, 35, 57-62 and 64-72 under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103(a), and claims 9, 10, 12, 32, 33, 35, 57-62 and 64-72 (provisionally) on the ground of nonstatutory obviousness-type double-patenting over claims 1-42 of later-filed, co-pending Application Serial No. 11/068,573. Appellants appealed to the Board pursuant to 37 C.F.R. § 41.31(a), requesting review of all three grounds of rejection. (Appeal Brief, filed Apr. 20, 2007, 14.) ***

The prior Decision by the Board reversed the Examiner's rejections under 35 U.S.C. § 102 and § 103. The only remaining rejection is a provisional non-statutory double patenting rejection. We conclude that in this circumstance it was premature for the original Board panel to address the Examiner's provisional rejection of the claims.

Therefore, it is ORDERED:

1. The decision of the original Board panel affirming the provisional rejection of claims 9, 10, 12, 32, 33, 35, 57-62 and 64-72 on the ground of non-statutory obviousness-type double-patenting over claims 1-42 of later filed, co-pending Application Serial No. 11/068,573 is vacated.

2. The overall decision of the original Board panel affirming the Examiner's decision to reject all of the pending claims is vacated.

3. We enter a new Decision in which:

a. The decision of the original Board panel reversing the rejections under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103(a) remains unchanged; and

b. We do not reach the Examiner's provisional rejection of claims 9, 10, 12, 32, 33, 35, 57-62 and

double-patenting.

REVERSED [Ex parte Moncla, Appeal 2009-006448, (BPAI 6/22/2010)
(precedential, expanded panel).]

III. ANALYSIS

Reversal has legal significance, in addition to law of the case, for patent term adjustment.² Accordingly, the BPAI decision to "not reach" the PDPR and "reverse" is legally significant because it substantially impacts patent term.

Since the BPAI did not adjudicate the PDPRs, the examiner is not estopped from, subsequent to the appeal, considering their impact on allowability of the appealed application.

Unfortunately, there is no reasoning contained in this decision *explaining why* the expanded panel decided to "*not reach*" the PDPRs issue in this case, and why the panel *reversed*. Accordingly, one should hesitate in relying upon this holding in situations where the specific facts differ. One such fact was that the PDPRs were over claims "of [a] later-filed, co-pending Application." The fact that the appeal application was filed before the application over which the PDPR was imposed may be relevant because of Patent and Trademark Office (PTO) policy embodied in MPEP 804, subsection B.1. MPEP 804 subsection B.1 states in relevant part that:

If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue.

Thus, PTO policy is to allow the earlier of the two applications containing the PDPRs to issue. In Moncla, the application appealed was the earlier of the two applications, and accordingly PTO policy indicates that it should issue that earlier application, notwithstanding the provisional rejection, since all other rejections were reversed. Accordingly, because of PTO policy, the reversal of all the non PDPR rejections should have resulted in allowance and issue, which could only occur if the BPAI decision was deemed a reversal.

Closely analogous situations exist, such as when the rejections are provisional, but statutory, in which case MPEP 804 subsection B.2 explains PTO policy. In this fact pattern, the PTO policy is also to issue the earlier of the applications having the statutory PDPRs and convert the statutory rejections in the other case to non provisional status. It would seem that the assumed rationale for the decision in Moncla would apply in the B.2. situation.

What about when the appealed application is the later filed application? There is no PTO policy to issue such application subject only to PDPRs. Instead, the PTO policy is issue the other application and to require a terminal disclaimer in the later filed application, before dropping the PDPRs therein. Hence, it is less likely that Moncla would extend to this type of situation.

Moreover, the policy embodied in MPEP 804 subsection B does not sense in all

situations. Presumably, that policy originated prior to the 1999 law change in patent term adjustment.³ That law change resulted in patent term adjustment depending upon the facts of each application. Accordingly, under current law, an earlier filed application may in fact have a patent term extending further into the future, due to vagaries of patent term adjustment facts, than a later filed continuation of that earlier filed application. In this situation, the PTO policy arguably should be to issue the application having the patent term ending on the earlier date, and make the PDPR in the other application non provisional, thereby requiring a terminal disclaimer in the other application, whichever it may be.⁴ That is, the PTO policy should be to truncate patent term, which was the original policy upon which the PTO obtained judicial approval for requiring terminal disclaimers. See In re Van Ornum, 686 F.2d 937, 948, 214 USPQ 761, 770 (CCPA 1982). Thus, even if the facts of a case are identical to those contained in Moncla, additional facts, such as the relative terms of the appealed application and the other application may be relevant to how the BPAI treats an appealed PDPR.

IV. CONCLUSION

Moncla provides some clues how the BPAI will treat appealed PDPRs, but only under limited facts and circumstances. It would have been helpful if the BPAI had deigned to include a discussion of why they acted as they did in this case, as guidance to applicants.

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2.See 37 CFR 1.703(b)(4). A successful appeal results in patent term adjustment equal to "The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences."

3.The 1999 law change is discussed in "Summary and Analysis of the New Patent Laws Enacted November 29, 1999" Rick Neifeld, first published at: JPTOS, 82 (March 2000), p. 181.

4.The patent term adjustment to which an application is entitled is uncertain until the application issues. Accrued patent term adjustment can be determined at any time during pendency. The accrued patent term adjustment may be lost due to subsequent applicant delay or increased to further PTO delay. Accordingly, this may be a difficult factor for the BPAI to include in its decisional process, and it is not a factor typically of record in an appeal. Nevertheless, situations where there are gross differences in accrued patent term adjustments at any point in time between copending parent and child applications are not uncommon and could be a factor for

BPAI consideration whether to render a decision on a PDPR. In particular, the existence of a successful appeal creates a large patent term adjustment, so that in most parent child application situations where one of the applications has been successfully appealed, a gross difference in accrued patent term adjustment is likely, in favor of the successfully appealed application.

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