

How Close is Too Close in Patent Law?

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Most are aware that you can't obtain a patent for an invention that already exists. However, this issue becomes more complicated when inventions are nearly duplicative but not identical and they are both yours and presented in perhaps related, but separate, patent applications. In such cases, patentees can find their patents challenged on the basis of "obviousness-type double patenting" or "inherent anticipation." The Federal Circuit recently expounded on both of these concepts in *Perricone v. Medicis Pharm. Corp.*, a case involving sunburn and skin treatments.

Perricone held patents both on methods of treating and preventing sunburns (the '693 patent) and methods of treating skin damage and disorders (the '063 patent). Both patents disclosed the same subject matter—the treatment or prevention of various forms of skin damage through the topical application of Vitamin C in a fat-soluble form.

Perricone sued Medicis, alleging the company infringed both patents with its line of prescription skin products. Medicis defended itself on the ground that the patents' claims were invalid on the basis of double patenting or anticipation. The district court found in favor of Medicis and Perricone appealed.

Obviousness-Type Double Patenting

The double patenting doctrine prevents a patentee from receiving two patents for the same invention. This legal doctrine takes two forms: Statutory (or same invention) double patenting and non-statutory (or obviousness-type). The latter was at issue in Perricone.



Non-statutory double patenting was created by the courts to prevent claims to separate applications or patents that don't recite the same invention, but that claim inventions so alike that granting exclusive rights to both patents would effectively extend patent protection for the first invention. In this instance, the district court found a claim in the '063 patent invalid because of obviousness-type double patenting over a claim in the '693 patent.

The Federal Circuit agreed, holding that sunburn is a species of skin damage. It noted, however, that a non-statutory double patenting rejection can be overcome by the filing of a terminal disclaimer, which would make the second patent expire at the same time as the first. A terminal disclaimer can be filed even after the second patent is issued. The court found no evidence of a disclaimer here but stated that Perricone could still file one. It didn't determine the retrospective effect of a terminal disclaimer in this case.

Anticipation: A Natural Result (Or Not)

As the court observed, prior art (any relevant documents and patents that predate the in-

vention) can still inherently anticipate an invention. Part or all of an invention may be inherent in the prior art if it's the natural result flowing from the prior art's disclosure.

The district court ruled that an earlier patent—referred to by the inventor's name "Pereira"—anticipated claims of Perricone's '063 and '693 patents. Pereira disclosed a cosmetic composition for topical application to hair or skin including various ingredients, including eight compositions that comprised all the various ingredients claimed by Perricone in Perricone's concentrations. The district court concluded that the topical application of Pereira's compositions would necessarily yield the skin benefits of Perricone's claimed invention.

The Court of Appeals for the Federal Circuit disagreed. In its view, the issue wasn't whether Pereira's lotion if applied to sun-

burn would inherently treat that damage, but whether Pereira discloses the application of its composition to sunburn. The court found that Pereira discloses only "topical application," not application to sunburned skin. Pereira made no reference to sunburn prevention or treatment benefits, and new uses of existing products or processes can be patentable. However, when the inherent property corresponds to a claimed new benefit of an invention found in prior art, the new realization alone doesn't render the earlier invention patentable.

The Federal Circuit threw Perricone a potential life preserver on the double patenting issue and reversed the district court on its flawed anticipation analysis. It sent the case back to the district court for further proceedings, so Perricone may end up on the sunny side of the street.

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