

ALERTS | 08.07.2026

USPTO ARP Issues Decision on Obviousness-type Double Patenting

On August 6, 2026, the U.S. Patent and Trademark Office (USPTO) Appeals Review Panel (ARP) issued its decision in *Ex parte Baurin*, holding that under existing Federal Circuit precedent, the USPTO may continue issuing obviousness-type double patenting (OTDP) rejections based on anti-harassment/common-ownership rationale, even where there is no apparent concern regarding an unjustified timewise extension of patent term. The ARP reversed the Patent Trial and Appeal Board (Board) and reinstated the examiner's OTDP rejections for the pending application.

The doctrine of OTDP generally serves to prevent an unjustified timewise extension of patent exclusivity beyond the life of a patent. In other words, the doctrine establishes that a patentee should not be permitted to have more than one patent to the same invention and through that gain additional patent term. During examination, the application in *Baurin* was rejected for OTDP over various issued patents. The applicant appealed to the Board, arguing that none of the cited patents qualify as an OTDP reference because each (1) has a later patent-term filing date than the application in question and (2) expires later than any patent issuing from the application. The Board agreed and reversed all of the rejections. The Board additionally found that the risk of separate ownership of a cited patent and the application at issue is immaterial where the cited patent is not a proper OTDP reference. That is, the Board held that the risk of separate ownership is not an independent basis for an OTDP rejection. In an unusual move, the examiner requested rehearing, arguing that (1) the Board's decision had misapprehended the Federal Circuit's opinion in *Allergan USA, Inc. v. MSN Laboratories Private Ltd.*, 111 F.4th 1358 (Fed. Cir. 2024), (2) the Board's decision was inconsistent with USPTO guidance on the issue, and (3) the Board's conclusion that the risk of separate ownership is immaterial to the OTDP analysis is not supported by case law or USPTO guidance. The Board reconsidered its decision but voted 2-1 to maintain the reversal of each of the OTDP rejections.

On March 5, 2026, the Director of the USPTO *sua sponte* convened an Appeals Review Panel to review the Board's Decision on Appeal and Decision on Request for Rehearing. The ARP invited the applicant and *amici curiae* to address three questions critical to the issues of OTDP implicated by *Baurin*: (1) the applicability, if any, of *Allergan* to the facts of the appeal, and consideration of what constitutes "first-filed" for OTDP purposes under facts different than those presented in *Allergan*; (2) whether examiners should determine projected expiration dates to support OTDP rejections during prosecution; and (3) whether the risk of separate ownership and preventing potential harassment by separate owners of claims to obvious variants of an invention is an independent basis that supports an OTDP rejection during prosecution.

As to the first question, the ARP determined that *Allergan* does not apply to the facts of *Baurin*. As the examiner had urged, the ARP found that the *Allergan* exception from OTDP applies only to a narrow situation: a first-filed, first-issued, later-expiring claim cannot be invalidated by a later-filed, later-issued, earlier-expiring reference with common priority. Thus, according to the ARP, in order to be shielded from OTDP under *Allergan* as being truly "first-filed," the application must have the *earliest* actual filing date in the patent family, not merely an *earlier* filing date than the reference patent. The application also must be *first-issued* to be shielded under *Allergan*, whereas the application in *Baurin* was still pending. Finally, the ARP determined that for *Allergan* to apply, the reference patent must be in the same family as the challenged application, meaning that it has the same "common" priority date. Accordingly, the first application in a patent family will be shielded from continuations and divisionals in the family, but *not* from applications and patents outside the family, even if they have a later filing date. All other applications in the family will continue to be subject to OTDP rejections from later-filed applications both within and without the family.

The ARP additionally relied on older, pre-*Allergan* Federal Circuit precedent, including *Fallaux*, *Hubbell*, and *Cellect*, to hold that the risk of separate ownership and potential harassment by separate owners of claims directed to obvious variants of an invention can independently support an OTDP rejection during prosecution. Despite this, the ARP did note that, were it not bound by what it viewed as controlling precedent, it would “clarify that the risk of separate ownership and hypothetical harassment generally should not form a standalone basis for OTDP rejections during examination.” Nonetheless, the ARP’s ruling provides that applicants can continue to receive OTDP rejections from later-filed applications irrespective of any considerations of actual unjustified timewise extensions of patent term—that is, an earlier-filed claim can be rejected based on disclosure made *after* the claim was filed. Therefore, applicants may in some instances be forced to argue against their own later developments or file a terminal disclaimer in an *earlier*-expiring application, a step that has no impact on the term of earlier case at issue and is taken simply to ensure common ownership with the (later expiring) reference patent. Where common ownership is not present and cannot be achieved, as in certain collaborations, more substantial measures, such as narrowing the claims, may be required.

Finally, the ARP proposed a framework that examiners should not determine projected expiration dates to support OTDP rejections during prosecution. Instead, the ARP proposed using information known during examination, such as patent-term filing dates as a practical surrogate for expiration dates, rather than speculation around uncertain future events.

In view of the *Baurin* decision, the USPTO may compel applicants to file terminal disclaimers in the earlier-expiring application over a later-expiring patent. Notably, however, a terminal disclaimer is only possible when both the OTDP reference and the application at issue are *commonly* owned. Thus, *Baurin*’s rationale of preventing harassment by *different* owners does not exist when the terminal disclaimer is filed; the terminal disclaimer merely prevents the future severing of common ownership. In practice, however, if the claims in the two cases are indeed not patentably distinct, it is likely that any purchase or sale of one case would also include the other in order to preserve freedom to operate for the acquirer. Conversely, where the two cases are not commonly owned, as in the case of a collaboration, there exists the real possibility of harassment by separate owners at the time of the OTDP rejection, and it is not possible to file a terminal disclaimer to obviate the OTDP rejection. Thus, the harm *Baurin* is trying to remedy may not exist as a practical matter when the filing of a terminal disclaimer is possible, but *Baurin*’s narrow reading of *Allergan* may mean there is no practical way to save differently-owned patents from OTDP, where terminal disclaimers are not an option.

Going forward, patent applicants should continue to expect the same level of OTDP scrutiny from the USPTO during prosecution, including in circumstances that would not create any unjustified timewise extension of patent term. Although the ARP signaled discomfort in relying on anti-harassment concerns alone as a basis for OTDP, its decision (which has been designated as precedential) ensures that the USPTO must continue applying pre-*Allergan* practices, unless the Federal Circuit provides guidance to the contrary.

This alert summarizes the USPTO’s decision only in general terms and does not constitute legal advice. Please contact a member of the Choate team if you need advice with respect to any specific matter.

Kristen C. Buteau

Practice Chair, Intellectual Property

Stephanie L. Schonewald, PhD

Partner

Sophie F. Wang

Co-Head of IP Litigation

Daniel A. Klein

Counsel

Natalie A. Phillips

Senior Associate