

USPTO Has A Chance To Correct Double-Patenting Doctrine

By Irena Royzman, Clement Roberts and Dana Sublett (March 27, 2026)

Obviousness-type double patenting, or OTDP, is a judicially created rule that prevents patent owners from obtaining a second, later-expiring patent on an invention that is an obvious variant of one already patented.

This doctrine is being wielded by the [U.S. Patent and Trademark Office](#) in a way that ignores the directionality of OTDP and puts earlier-filed, earlier-expiring patents at risk across technologies.

This issue is now front and center in a rare USPTO proceeding called an Appeals Review Panel, where high-stakes questions about the scope of the doctrine and the USPTO's responsibilities for review will be decided.

A Rule Turned on Its Head

OTDP has operated in one predictable direction: a later-filed, later-expiring patent cannot be used to extend the life of an earlier-filed, earlier-expiring one.

But in the case of *Ex parte Baurin*, a USPTO examiner turned the doctrine on its head, using a patent with a later patent term filing date and a later expiration date as a reference to reject an application with an earlier patent term filing date and an earlier expiration date.

The application at issue has a patent term filing date of March 28, 2012, which is over five years before the April 13, 2017, patent term filing date of the purported reference patent. And any patent issuing from the application will expire no later than March 28, 2032, again well before the purported reference patent's June 22, 2037, expiration.

In rejecting the earlier-expiring application for OTDP and in arguments on appeal, the examiner argued that the USPTO is not able to calculate expected expiration dates of patent applications, and thus should not have to consider expiration in the OTDP inquiry, and that the policy concern of harassment by separate patent owners is sufficient ground



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for OTDP.

The [Patent Trial and Appeal Board](#) has already sided with the applicant on this issue twice, first in reversing the examiner's OTDP rejection and again in denying the examiner's request for rehearing, both times on the basis that the later-filed patent, meaning the patent with the later patent term filing date, could not be a proper reference patent for OTDP.

However, a different panel of PTAB judges came to the opposite conclusion on nearly identical facts in *In re: Baumeister* last year. That decision is pending before the Federal Circuit as *In re: [Ablynx NV](#)*.

Perhaps because of the conflicting PTAB decisions and given the importance of the issue, USPTO Director John Squires [convened](#) the ARP this month to examine the PTAB's decision in *Ex parte Baurin*, asking amici to weigh in on the import of [Allergan USA Inc. v. MSN Laboratories Private Ltd.](#), decided by the [U.S. Court of Appeals for the Federal Circuit](#) in 2024; potential for harassment; and whether examiners need to calculate expiration dates.

The Federal Circuit's decision in *Allergan* is central here. In *Allergan*, the court held that a first-filed, first-issued, later-expiring claim cannot be invalidated by a later-filed, later-issued, earlier-expiring reference claim that shares a common priority date.

The court rooted its analysis firmly in the fundamental purpose of the OTDP doctrine: preventing a patentee from obtaining a second patent on a patentably indistinct invention to effectively extend the life of a first patent.

Critically, the Federal Circuit emphasized that this purpose should drive the analysis. The theoretical potential of separate ownership for the first and later patent was of no moment.

The examiner in *Ex parte Baurin* argued that *Allergan* was limited to cases where the patents shared a common priority date. The PTAB disagreed, correctly recognizing that the Federal Circuit's reasoning was grounded in principle, not limited to one factual scenario. It also noted that no decision held that separate ownership was a standalone basis for OTDP.

The PTAB also rejected the argument that examiners do not need to consider expiration dates in analyzing OTDP. Indeed, otherwise, a one-directional doctrine operates in reverse. The validity of earlier claims is put in jeopardy in view of later ones as in *In re: Baumeister*. And determining expiration dates to determine if there is a proper reference for OTDP is the work of patent examiners, same as determining what references are properly prior art to a

patent application.

What's At Stake

The PTAB in *Ex parte Baurin* correctly found that the later-filed, later-expiring patent could not be a proper OTDP reference patent for the earlier-filed, earlier-expiring application. In contrast, the examiner's approach subverts the fundamental purpose of OTDP and would cause serious harm to the innovation economy.

First, the examiner's approach would create massive unpredictability for patent holders. Under the traditional OTDP framework, companies understand their risk at the time of filing.

But under the examiner's approach, a company's foundational, earlier-filed patent could be retroactively put at risk by a later-filed patent — one that did not even exist when the earlier patent was secured. Patent holders would not be able to accurately value their portfolios, and the market for licensing and acquiring patents could be chilled.

Second, the examiner's approach would discourage the collaborative innovation that the patent system exists to promote. As the Federal Circuit recognized in *Allergan*, it is not unusual for a patent applicant to first protect a broader, foundational invention and then file applications to specific improvements that are discovered later.

Under the examiner's approach, that natural progression of innovation could retroactively destabilize earlier patents. Furthermore, companies might even hesitate to collaborate with research partners or universities if the collaborator's later-filed patents, over which the company has no control, could create OTDP problems for previously secured patents.

The OTDP doctrine was built to prevent patentees from gaming the system by extending their exclusivity. Allowing examiners to run the doctrine in reverse — using newer patents to kill older ones — would undermine both the doctrine and the broader patent system it was designed to protect.

On the facts in *Ex parte Baurin*, there is simply no extension of patent exclusivity to prevent. The ARP should affirm and put an end to the USPTO's practice of rejecting earlier-expiring patents for OTDP over later-expiring ones.

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