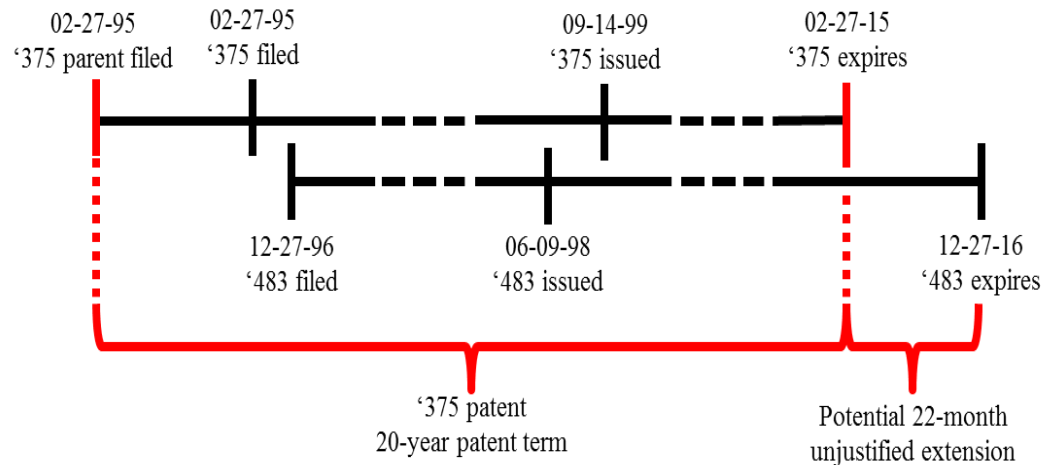


# *Gilead Sciences Inc. v. Natco Pharma Ltd.* 753 F.3d 1208 (Fed. Cir. 2014)



“Under the circumstances of this case,” “a patent that issues after but expires before another patent [can] qualify as a double patenting reference for that other patent.”

# USPTO's Application of the Doctrine – MPEP § 804

<p>Pre-GATT 5th edition, rev. 16 March 1994</p>	<p>Post-GATT 6th edition January 1995</p>	<p>Today 8th edition, rev. 9 August 2012</p>
<p>If the "provisional" double patenting rejections in both application are the only rejections remaining , the examiner should then withdraw that rejection in one of the applications and permit the application to issue as a patent.</p>	<p>If the "provisional" double patenting rejections in both applications are the only rejections remaining , the examiner should then withdraw that rejection in one of the applications (<b>e.g., the application with the earlier filing date</b>) and permit the application to issue as a patent.</p>	<p>If [double-patenting] rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the [] rejection in the <b>earlier filed application</b> thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in <b>the later-filed application</b> before the [] rejection can be withdrawn and the application permitted to issue.</p>

# Unanswered Questions

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- 35 U.S.C. § 154(b) – Patent Term Adjustments
  - Does the double-patenting doctrine truncate the adjustment of a patent term that accommodates for delays caused by the USPTO based on an earlier-expiring, duplicative patent?
- 35 U.S.C. § 156 – Patent Term Extensions
  - Does the double-patenting doctrine similarly shorten the extension of a patent term that accommodates for regulatory delays caused by the FDA based on an earlier-expiring, duplicative patent?