

No. 18-692

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IN THE  
**Supreme Court of the United States**

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MYLAN PHARMACEUTICALS INC., et al.,  
*Petitioners,*

v.

UCB, INC., et al.,  
*Respondents.*

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ON PETITION FOR WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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**BRIEF OF THE R STREET INSTITUTE AND  
PUBLIC KNOWLEDGE AS *AMICI CURIAE* IN  
SUPPORT OF THE PETITION**

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## TABLE OF CONTENTS

TABLE OF AUTHORITIES . . . . .	ii
INTEREST OF <i>AMICI CURIAE</i> . . . . .	1
SUMMARY OF ARGUMENT . . . . .	2
ARGUMENT . . . . .	4
I. Certiorari Should Be Granted on the Double Patenting Question . . . . .	4
A. The Federal Circuit Is Hopelessly Divided on the Doctrine of Double Patenting . . . . .	5
B. Patent Thickets, a Result of Uncertainty About Double Patenting, Plague Competition and Innovation in the Computer Industry . . . . .	8
II. Certiorari Should Be Granted on the Obviousness Question . . . . .	13
A. There Is Widespread Agreement that the Federal Circuit Has Disregarded this Court’s Precedents on Obviousness . . . . .	13
B. Correction of the Atextual Lead-Compound Rule Will Help to Alleviate Erroneous Obviousness Rules in Multiple Contexts . . . . .	16
CONCLUSION . . . . .	18

## TABLE OF AUTHORITIES

### CASES

<i>AbbVie Inc. v. Mathilda &amp; Terrance Kennedy Institute of Rheumatology Trust</i> , 764 F.3d 1366 (Fed. Cir. 2014) . . . . .	7–8
<i>Amgen Inc. v. F. Hoffmann-La Roche Ltd.</i> , 580 F.3d 1340 (Fed. Cir. 2009) . . . . .	5
<i>Apotex, Inc. v. Sanofi-Synthelabo</i> , 558 U.S. 990 (2009) (tbl.) . . . . .	15
<i>Automotive Body Parts Ass’n v. Ford Global Technologies, LLC</i> , 293 F. Supp. 3d 690 (E.D. Mich. 2018) . . . . .	16
<i>Berg, In re</i> , 140 F.3d 1428 (Fed. Cir. 1998) . . . . .	6
<i>Boylan, In re</i> , 392 F.2d 1017 (C.C.P.A. 1968) . . . . .	5
<i>Braat, In re</i> , 937 F.2d 589 (Fed. Cir. 1991) . . . . .	6
<i>Commil USA, LLC v. Cisco Systems, Inc.</i> , 135 S. Ct. 1920 (2015) . . . . .	11
<i>Durling v. Spectrum Furniture Co.</i> , 101 F.3d 100 (Fed. Cir. 1996) . . . . .	16
<i>Eli Lilly &amp; Co. v. Barr Laboratories, Inc.</i> , 251 F.3d 955 (Fed. Cir. 2001) . . . . .	5–6, 8
<i>Eli Lilly &amp; Co. v. Teva Parenteral Medicines, Inc.</i> , 689 F.3d 1368 (Fed. Cir. 2012) . . . . .	7
<i>Eli Lilly &amp; Co. v. Teva Pharmaceuticals USA, Inc.</i> , 619 F.3d 1329 (Fed. Cir. 2010) . . . . .	8

(iii)

<i>General Foods Corp. v. Studiengesellschaft Kohle mbH</i> , 972 F.2d 1272 (Fed. Cir. 1992) . . . . .	7
<i>Geneva Pharmaceuticals, Inc. v. GlaxoSmithKline plc</i> , 349 F.3d 1373 (Fed. Cir. 2003) . . . . .	6–7
<i>Google, Inc. v. Arendi SARL</i> , No. 16-626, 2017 WL 1040877 (U.S. Mar. 20, 2017) (mem.) . . . . .	15
<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966) . . . . .	5
<i>KSR International Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007) . . . . .	3, 13–15, 17
<i>Longi, In re</i> , 759 F.2d 887 (Fed. Cir. 1985) . . . . .	8
<i>Markman v. Westview Instruments, Inc.</i> , 517 U.S. 370 (1996) . . . . .	5
<i>Millennium Pharmaceuticals, Inc. v. Sandoz, Inc.</i> , 862 F.3d 1356 (Fed. Cir. 2017) . . . . .	17
<i>Motion Picture Patents Co.</i> <i>v. Universal Film Manufacturing Co.</i> , 243 U.S. 502 (1917) . . . . .	12
<i>MRC Innovations, Inc. v. Hunter Manufacturing, LLP</i> , 747 F.3d 1326 (Fed. Cir. 2014) . . . . .	16
<i>Oetiker, In re</i> , 977 F.2d 1443 (Fed. Cir. 1992) . . . . .	9
<i>Otsuka Pharmaceutical Co. v. Sandoz, Inc.</i> , 678 F.3d 1280 (Fed. Cir. 2012) . . . . .	5–6
<i>Perricone v. Medicis Pharmaceutical Corp.</i> , 432 F.3d 1368 (Fed. Cir. 2005) . . . . .	8

(iv)

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566 F.3d 989 (Fed. Cir. 2009) . . . . . 6

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137 S. Ct. 429 (2016) . . . . . 16

*Samsung Electronics Co. v. Apple Inc.*,  
No. 16-1102 (U.S. filed Feb. 17, 2017) . . . . . 14

*Van Ornum, In re*,  
686 F.2d 937 (C.C.P.A. 1982) . . . . . 12

*Vogel, In re*,  
422 F.2d 438 (C.C.P.A. 1970) . . . . . 5

**STATUTES**

35 U.S.C. § 101 . . . . . 8

—— § 103 . . . . . 3, 5–6, 13–14, 16

—— § 112(b) . . . . . 5

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## INTEREST OF *AMICI CURIAE*

*Amici curiae*<sup>1</sup> are nonprofit organizations that seek to advance balanced intellectual property law.

The R Street Institute is a nonprofit, nonpartisan public-policy research organization. R Street's mission is to engage in policy research and educational outreach that promotes free markets as well as limited yet effective government, including properly calibrated legal and regulatory frameworks that support economic growth and individual liberty.

Public Knowledge is a nonprofit organization that is dedicated to preserving the openness of the Internet and the public's access to knowledge, promoting creativity through balanced intellectual property rights, and upholding and protecting the rights of consumers to use innovative technology lawfully. Public Knowledge advocates on behalf of the public interest for a balanced patent system, particularly with respect to new and emerging technologies.

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<sup>1</sup>Pursuant to Supreme Court Rule 37.2(a), all parties received timely notice of intent to file this brief. Petitioners have given blanket consent for the filing of this brief, those respondents who were appellees below have consented, and the remaining respondents have indicated that they will not object. Pursuant to Rule 37.6, no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of the brief. No person or entity, other than *amici*, their members, or their counsel, made a monetary contribution to the preparation or submission of this brief.

## SUMMARY OF ARGUMENT

Although the patents at issue relate to chemical compounds, the questions presented are far broader and touch on important issues of widespread concern for federal patent law. Certiorari should be granted to correct significant errors of patent law that currently harm the software, communications, and other important innovative industries across the board.

1. Certiorari should be granted on the first question relating to obviousness-type double patenting, the doctrine that prohibits the issuance of two patents directed to subject matter sufficiently similar to be not patentably distinct, for two reasons.

First, the obviousness-type double patenting doctrine is extraordinarily uncertain. This is not due to the newness of the doctrine or a lack of percolation through the appellate courts; indeed the Federal Circuit has addressed the doctrine in numerous cases across its three decades of existence. But over those three decades, no consistent rule has emerged, and the appellate court has shown itself to be repeatedly divided on even the most basic questions about the doctrine. The court has failed to agree on the test for obviousness-type double patenting, the relevance of the patent specification in assessing the doctrine, and even the legal basis for the doctrine itself. Clarity will only be achieved through this Court's review.

Second, the lack of clarity about obviousness-type double patenting has led to abuses of the patent system across multiple industries, especially the software and technology industries. When multiple patents can issue on essentially the same invention, inventors can build up "patent thickets" dozens or hundreds of patents deep, even on just one inventive concept. Patent thickets can

effectively extend the duration of the patent term and can also pose a practical barrier to the assessment of patent validity. As a result, they have been the basis of a wide variety of anticompetitive and unproductive conduct in the technology industry. Clarification of the doctrine will thus greatly alleviate many of the ongoing abuses of patent law that take place today.

2. Certiorari should also be granted on the second question, which challenges the correctness of the Federal Circuit's rule that a showing of obviousness under 35 U.S.C. § 103 for a chemical compound patent requires identification of a "lead compound" predating the patent. Reversal is exceptionally important for the following reasons.

Commentators and stakeholders have now repeatedly recognized that the Federal Circuit has failed to adhere to this Court's precedent in *KSR International Co. v. Teleflex Inc.*, which held § 103 is necessarily a flexible standard not amenable to rigid rules. Most notably, the Solicitor General specifically observed in a brief before this Court that the Federal Circuit's decisions are in error and that "this Court's review may ultimately be warranted." Additionally, technologists, policy advocates, and even noted patent lawyers have remarked that the Federal Circuit has ignored this Court's precedents, some going so far to say that the appellate court has "overruled" its superior tribunal. There is thus widespread agreement that the Federal Circuit's § 103 doctrine has gone astray, toward the sorts of rigid rules that this Court disapproved.

Insofar as the lead-compound rule is one such rigid rule inconsistent with *KSR*, this Court's review and correction of that rule would improve the state of the obvi-

ousness doctrine overall. Rules very similar to the lead-compound rule affect multiple industries—even the software industry—and a course correction on one particular erroneous rigid rule of obviousness would likely prompt a reconsideration of others. Accordingly, even though the lead-compound rule facially only affects the chemical arts, this Court’s decision would likely have a broader beneficial impact on patent law.

For at least the foregoing reasons, certiorari should be granted on both questions presented.

## **ARGUMENT**

### **I. CERTIORARI SHOULD BE GRANTED ON THE DOUBLE PATENTING QUESTION**

The petition first seeks clarification of the doctrine of obviousness-type double patenting, under which an inventor may not obtain two patents directed to patentably indistinct subject matter. Certiorari should be granted on the double patenting<sup>2</sup> question for two reasons. First, the Federal Circuit has failed to reach a consistent test for double patenting despite trying for three decades to do so. Second, double patenting has widespread industry impact, especially on the communications and technology industry, because ambiguity in the legal standard for double patenting enables the growth of problematic patent thickets.

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<sup>2</sup>Throughout this brief, “double patenting” will refer solely to obviousness-type double patenting, as distinguished from the related but distinct doctrine of statutory double patenting.

## A. THE FEDERAL CIRCUIT IS HOPELESSLY DIVIDED ON THE DOCTRINE OF DOUBLE PATENTING

Certiorari should be granted to clarify the doctrine of double patenting because the Federal Circuit has failed to articulate a single, consistent standard for that doctrine and is internally divided in multiple respects.

The doctrine of obviousness-type double patenting prohibits the issuance of a second patent containing claims that are “merely an obvious variation” of the claims of a first. *In re Vogel*, 422 F.2d 438, 442 (C.C.P.A. 1970); accord *In re Boylan*, 392 F.2d 1017, 1018 n.1 (C.C.P.A. 1968). This Court has delimited the standard for obvious variations of physical devices and processes. See *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966). But delimiting obviousness of variations of *claims* is a different question entirely, because a claim is not a physical thing but rather a formal definition of a patent’s legal boundaries, akin to a statute or contract. 35 U.S.C. § 112(b); see *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373–74 (1996). As one court put it, “How can it be obvious or not obvious to modify a legal boundary?” *Vogel*, 422 F.2d at 442.

Despite having had thirty-six years to answer that question, the Federal Circuit has yet to settle on even the basic standard for double patenting. In some cases, the court has explained that “the obviousness-type double patenting analysis is analogous to an obviousness analysis under 35 U.S.C. § 103.” *Amgen Inc. v. F. Hoffmann-La Roche Ltd.*, 580 F.3d 1340, 1361 (Fed. Cir. 2009); see *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 968 (Fed. Cir. 2001) (double patenting occurs when “the later claim is obvious over . . . the earlier claim”); *Otsuka Pharm. Co. v.*

*Sandoz, Inc.*, 678 F.3d 1280, 1397 (Fed. Cir. 2012) (double patenting “implicates the question of obviousness under § 103”). Yet that court has also held that double patenting does not follow the standard of § 103, at least because “[o]bviousness requires inquiry into a motivation to modify the prior art; nonstatutory double patenting does not.” *Geneva Pharm., Inc. v. GlaxoSmithKline plc*, 349 F.3d 1373, 1387 n.1 (Fed. Cir. 2003); *Procter & Gamble Co. v. Teva Pharm. USA*, 566 F.3d 989, 999 (Fed. Cir. 2009); see also *In re Braat*, 937 F.2d 589, 592–93 (Fed. Cir. 1991) (double patenting analysis is “similar to, but not necessarily the same as, that undertaken under 35 USC § 103”).

Subsequently, the Federal Circuit rejected its own holding, stating that double patenting as applied to two chemical compound patents “requires identifying some reason . . . to modify the earlier compound.” *Otsuka*, 678 F.3d at 1297. The court attempted to distinguish *Geneva* and *Procter & Gamble* on the grounds that those cases “involved nonstatutory double patenting based on anticipation, not obviousness.” *Otsuka*, 678 F.3d at 1297. But there is no such thing as “nonstatutory double patenting based on anticipation.” Both of the supposedly distinguished cases unambiguously referred to obviousness-type double patenting by name. See *Geneva*, 349 F.3d at 1377; *Procter & Gamble*, 566 F.3d at 999. And no Federal Circuit opinion other than *Otsuka* embraces a doctrine of “anticipation-type nonstatutory double patenting.” Cf. *Barr Labs.*, 251 F.3d at 968 (discussing “obviousness-type double patenting where a patent application claim . . . is anticipated by a patent claim”) (citing *In re Berg*, 140 F.3d 1428, 1437 (Fed. Cir. 1998)). The Federal Circuit’s attempt to dismantle its own precedents has thus created confusion and uncertainty in the law.

Practical application of the double patenting doctrine is equally uncertain under Federal Circuit precedent. For example, of relevance to the present case, there is the question of whether the disclosure text of a patent is relevant to double patenting. On the one hand, the court has repeatedly stated in no uncertain terms that “the *disclosure* of a patent cited in support of a double patenting rejection cannot be used as though it were prior art.” *Gen. Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1281 (Fed. Cir. 1992); *see also Eli Lilly & Co. v. Teva Parenteral Meds., Inc.*, 689 F.3d 1368, 1378–79 (Fed. Cir. 2012) (patent disclosure is relevant “only to the extent necessary to construe its claims”).

Despite these holdings, the Federal Circuit has repeatedly relied on patent disclosures to support double patenting rejections. *See, e.g., AbbVie Inc. v. Mathilda & Terrance Kennedy Inst. of Rheumatology Trust*, 764 F.3d 1366, 1380–81 (Fed. Cir. 2014) (challenging the *General Foods* doctrine); *Geneva*, 349 F.3d at 1386 (invalidating for double patenting a patent based on what a prior patent’s “written description discloses”). The appeals court once attempted to resolve this discrepancy by limiting reliance on the disclosure to situations where the prior patent claimed a compound and the later patent covered a use of that compound. *See Teva Parenteral*, 689 F.3d at 1380. But no principled reason for that limitation was given, and the Federal Circuit has since disregarded it. *See AbbVie*, 764 F.3d at 1381.

The Federal Circuit has not even been able to articulate a unified position on the origin of the double patenting doctrine. Generally the court deems it to be a “judicially created doctrine grounded in public policy rather than based purely on the precise terms of the

statute.” *In re Longi*, 759 F.2d 887, 892 (Fed. Cir. 1985); accord *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1373 (Fed. Cir. 2005). Yet the court has also said that “obviousness-type double patenting is grounded in the text of the Patent Act,” *AbbVie*, 764 F.3d at 1372, and in particular that “[n]onstatutory double patenting was borne out of 35 U.S.C. § 101.” *Eli Lilly & Co. v. Teva Pharm. USA, Inc.*, 619 F.3d 1329, 1341 (Fed. Cir. 2010). Other cases have attempted to bridge the gap, stating that “[t]he judicially-created doctrine of obviousness-type double patenting cements that legislative limitation” of 35 U.S.C. § 101. *Barr Labs.*, 251 F.3d at 967.

Thus, double patenting may be a policy-grounded judicial doctrine devoid of statutory basis, or it may be a statutory interpretation of § 101, or it may “cement” the statute. The legal basis of double patenting could potentially affect further interpretation of that doctrine, so this uncertainty over the legal basis compounds the ongoing uncertainty over double patenting.

None of this is to say that double patenting is inherently difficult; it is just as amenable to clear standards as other patent doctrines that this Court has helpfully addressed. Nor is there need for further percolation of the issues in the Federal Circuit; thirty-six years would seem enough. This Court should grant review to clarify application of the double patenting doctrine.

## **B. PATENT THICKETS, A RESULT OF UNCERTAINTY ABOUT DOUBLE PATENTING, PLAGUE COMPETITION AND INNOVATION IN THE COMPUTER INDUSTRY**

Clarification of the law of double patenting is of critical importance to many industries, especially the com-

puter and information technology industries. Uncertainty about double patenting has contributed to the rise of “patent thickets”—large portfolios of patents directed to individual technologies. Patent thickets historically have been the basis for problematic and even anticompetitive behavior, and continue to be problematic especially in the high tech industry.

Insofar as the double patenting doctrine guards against the issuance of multiple patents on the same invention, uncertainty about that doctrine leads to the issuance of multiple patents on one invention.<sup>3</sup> Patent-holding firms exploit this phenomenon to build up thickets of patents around individual inventions.

Although patent thickets are especially common in the drug industry, they are also prevalent across the technology industry. The term “patent thicket” itself was first popularly used in a paper reviewing semiconductor and software industry practices. *See* Carl Shapiro, *Navigating the Patent Thicket: Cross Licenses, Patent Pools, and Standard Setting*, 1 *Innovation Pol’y & Econ.* 119, 121–22 (2001). Individual technologies exhibit patent thickets: Smartphones are reportedly covered by an estimated 314,490 patents, for example.<sup>4</sup> Numerous federal

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<sup>3</sup>The Patent and Trademark Office has been treated as obliged to issue patents unless it can make a prima facie case of a defect in a patent application. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). So where the law is uncertain, the Office is likely to err on the side of issuance.

<sup>4</sup>*See* Joel Reidenberg et al., *Patents and Small Participants in the Smartphone Industry*, 18 *Stan. Tech. L. Rev.* 375, 382 tbl.2 (2015) (reporting number of “entities”; the authors appear to have meant number of patents); *see also* RPX Corp., Registration Statement (Form S-1), at 59 (Sept. 2, 2011), *available online* (reporting “250,000 active patents relevant to today’s smartphones”). To be sure, smartphones contain distinct components amenable to separate patents,

officials, intergovernmental organizations, and other commentators have observed the rise of patent thickets, especially in the information and communications sectors.<sup>5</sup>

In the technology industry as well as for pharmaceuticals, patent thickets are problematic for multiple reasons. They can effectively extend the term of a patent and complicate licensing and avoidance of infringement, as Petitioner notes (e.g., at 23–26). And patent thickets cause additional problems of particular concern for the technology industry.

First, patent thickets serve as a practical barrier to the invalidation of erroneously granted patents. Invalidation of a patent is a costly process, requiring searches of the prior art and pages of legal argumentation; even in the heavily streamlined post-grant proceedings conducted by the Patent and Trademark Office, legal fees can add up to \$350,000.<sup>6</sup> Multiplying the patents on a single

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but it is difficult to believe that there are a quarter million components. Locations of authorities available online are shown in the Table of Authorities.

<sup>5</sup>See, e.g., *Scoping Note on Competition and Intellectual Property Rights as a Long-Term Theme for 2019–2020*, OECD Competition Committee, 129th mtg., Agenda Item 13, at 6, OECD Doc. DAF/COMP/WD(2018)4; url (“Patent thickets or pools are common today in industries such as semiconductors, computing and telecommunications . . .”); Fed. Trade Comm’n, *To Promote Innovation* ch. 3, at 52 (2003), available online (“A number of panelists confirmed the existence of a patent thicket in the software industry . . .”); Iain M. Cockburn & Megan J. MacGarvie, *Patents, Thickets and the Financing of Early-Stage Firms: Evidence from the Software Industry*, 18 J. Econ. & Mgmt. Strategy 729, 768 (2009) (“In aggregate, start-up software companies operating in markets characterized by larger patent thickets see their initial round of VC or corporate funding delayed relative to firms in markets less affected by patents.”).

<sup>6</sup>See Saurabh Vishnubhakat et al., *Strategic Decision Making In Dual PTAB And District Court Proceedings*, 31 Berkeley Tech. L.J.

technology multiplies too the costs of proving invalidity, so a large enough patent thicket can effectively prevent challenges. Given that the correctness of issued software patents is notoriously doubtful, the insulation of possibly invalid patents through thicket strategy should be especially worrying.

Second, patent thickets enable a variety of anticompetitive and otherwise problematic behavior. Practices of evergreening and product-hopping are a consequence in the pharmaceutical industry. In the technology space, patent thickets enable manipulation of the standard-setting processes that support modern technologies. See Olga Gurgula, *Strategic Accumulation of Patents in the Pharmaceutical Industry and Patent Thickets in Complex Technologies—Two Different Concepts Sharing Similar Features*, 48 Int'l Rev. Intell. Prop. & Competition L. 385, 398–99 (2017). And they enable the abusive assertion of patents against small businesses, a practice that has earned the derisive name “patent trolling.” See *Commil USA, LLC v. Cisco Sys., Inc.*, 135 S. Ct. 1920, 1390 (2015); *id.* at 1932 (Scalia, J., dissenting) (discussing “the *in terrorem* power of patent trolls”). Patent owners have delegated their patent thickets to subsidiaries or privateer firms, thereby enabling harassment of those small businesses on an extraordinary scale. See, e.g., Tom Ewing, *Indirect Exploitation of Intellectual Property Rights By Corporations and Investors: IP Privateering and Modern Letters of Marque and Reprisal*, 4 Hastings Sci. & Tech. L.J. 1 (2012), available online.

Indeed, if history is a guide, patent thickets can enable truly monopolistic behavior. A patent thicket on mo-

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45, 60 (2016) (citing Am. Intellectual Prop. Law Ass'n, *Report of the Economic Survey* 38 (2015)).

tion picture technologies in the early 1900s was the basis for a small cartel's near-total control over that market for over a decade.<sup>7</sup> Notably, the cartel's control over the industry was largely premised on a legal theory of patent-based control that should not have been possible in view of the doctrine of patent exhaustion. The strategy was successful only due to uncertainty over the extent of the exhaustion doctrine, and this Court's clarification of that doctrine led to the demise of the cartel. *See Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502 (1917).

Clarification of the double patenting doctrine would similarly prevent many of the problems laid out above, by preventing the issuance of multiple nearly-identical patents on a single technology. To be sure, not all such problems arising from patent thickets would be prevented.<sup>8</sup> But in view of the increasing prevalence of patent thickets, all steps to prevent their unjustified growth and harms should be taken, and clarifying the double patenting doctrine is one correct and important step in that regard.

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<sup>7</sup>See generally Ralph Cassady, Jr., *Monopoly in Motion Picture Production and Distribution: 1908–1915*, 32 S. Cal. L. Rev. 325 (1959); Charles Duan, *Tech Companies Are Using Patent Strategies the Supreme Court Shot Down 100 Years Ago*, Slate: Future Tense (Apr. 4, 2017), *available online*.

<sup>8</sup>This is because, among other things, a patent applicant may overcome an obviousness-type double patenting problem by filing a terminal disclaimer tying the two related patents together. This terminal disclaimer practice, approved by the Federal Circuit and its predecessor but never by this Court, solves the problems of effective extension of patent terms and of harassment by multiple assignees, but it does not address the problem of insulation of erroneously granted patents from validity challenges. *See In re Van Ornum*, 686 F.2d 937, 948 (C.C.P.A. 1982).

## II. CERTIORARI SHOULD BE GRANTED ON THE OBVIOUSNESS QUESTION

The petition also challenges the Federal Circuit’s lead-compound rule, under which a showing of obviousness under 35 U.S.C. § 103 requires identifying a lead compound and then assessing the differences between the patented invention and the lead compound. Certiorari should be granted for two reasons. First, numerous commentators and relevant parties have found that the Federal Circuit’s holdings on obviousness are inconsistent with this Court’s precedents. Second, a reversal of the lead-compound rule would have wider impact beyond just the chemical industry, because such a reversal would signal a need to reconsider the many other rigid rules of obviousness that the Federal Circuit has erroneously devised.

### A. THERE IS WIDESPREAD AGREEMENT THAT THE FEDERAL CIRCUIT HAS DISREGARDED THIS COURT’S PRECEDENTS ON OBVIOUSNESS

In *KSR International Co. v. Teleflex Inc.*, this Court adopted “an expansive and flexible approach” to obviousness under § 103, and rejected the “rigid and mandatory formulas” that the Federal Circuit had layered upon that flexible statute. 550 U.S. 398, 415, 419 (2007). Yet in the decade since that decision, the Federal Circuit has reverted from this Court’s clear pronouncement in *KSR*, instead fashioning numerous rigid rules under § 103.

A broad group of commentators and stakeholders have recognized the ongoing disregard of this Court’s precedents on the obviousness doctrine.

**THE FEDERAL GOVERNMENT.** In a brief filed with this Court, the Solicitor General expressed “concern that the Federal Circuit may be drifting back toward ‘rigid

and mandatory formulas’ of the type this Court rejected in *KSR*.” Brief for the United States as Amicus Curiae at 16, *Samsung Elecs. Co. v. Apple Inc.*, No. 16-1102 (U.S. Oct. 4, 2017), *available online*. After review of several Federal Circuit decisions, the Solicitor General concluded that “this Court’s review may ultimately be warranted,” should an appropriate vehicle arise. *Id.* at 17.<sup>9</sup>

**EMERGING TECHNOLOGY ENTREPRENEURS.** In 2015, a materials engineer published an article that listed a wide variety of combinations of materials to be used in the emerging field of 3-D printing technology in order to ensure that those combinations were obvious under § 103. Joshua M. Pearce, *A Novel Approach to Obviousness: An Algorithm for Identifying Prior Art Concerning 3-D Printing Materials*, 42 *World Pat. Info.* 13 (2015). The article is a disappointing reflection of the state of patent law for two reasons. First, the article’s author observes that the “acceleration of aggressive patenting in the 3-D printing space is already causing concern for some of the 3-D printing industry members and to the wider technology community,” and notes that several issued patents appear to be directed to combinations of materials that are obvious to himself and other materials engineers. *Id.* at 16. Second, the article itself—a list of combinations that the author believes to be obvious to try—demonstrates how far the Federal Circuit has deviated from *KSR*, which specifically held that an obvious-to-try idea would likely be unpatentable under § 103. 550 U.S. at 421. If the Federal Circuit had been adhering to this

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<sup>9</sup>The government recommended against certiorari there only because, in its view, the question presented had not been properly preserved. *Id.* That defect does not appear to be present here.

Court's precedent, then there would be no need for anyone to write an article merely listing obvious ideas.

**HEALTH CARE EXPERTS.** Organizations such as AARP and the Generic Pharmaceutical Association have said that “[a]llowing patents on obvious improvements to existing drugs and medical treatments burdens the public with excessive health care costs.” Motion and Brief of AARP et al. at 1, *Apotex, Inc. v. Sanofi-Synthelabo*, 558 U.S. 990 (Aug. 27, 2009) (No. 09-117) (tbl.); see Brief of the Generic Pharmaceutical Association, *Google, Inc. v. Arendi SARL*, No. 16-626, 2017 WL 1040877 (U.S. Dec. 9, 2016) (mem.). Similarly, the Initiative for Medicines, Access & Knowledge leads its list of patent policy recommendations with “[r]aising the bar for the inventiveness standard.” I-MAK, *Patent Policy Prescriptions 1* (2018), available online.

**THE PATENT BAR.** In 2012, a prominent patent lawyer and blogger acknowledged—indeed, praised—the Federal Circuit for overruling the Supreme Court. Observing that the appeals court was “narrowing the applicability [of *KSR*] in case after case,” the commentator explained that the result of this narrowing would be that “*KSR v. Teleflex* will be overruled.” Gene Quinn, *Killing Industry: The Supreme Court Blows Mayo v. Prometheus*, IPWatchdog (Mar. 20, 2012), available online. To be sure, the commentator applauded the Federal Circuit for its judicial activism, but the celebration of lawyers should be of concern to this Court: Appellate courts cannot overrule their superior tribunals. To allow this result to stand would demean the integrity of this Court and create uncertainty in the law.

This widespread agreement that the Federal Circuit has greatly deviated from this Court's precedents demon-

strates the importance of the obviousness doctrine and the strong need for course correction on that doctrine.

**B. CORRECTION OF THE ATEXTUAL LEAD-COMPOUND RULE WILL HELP TO ALLEVIATE ERRONEOUS OBVIOUSNESS RULES IN MULTIPLE CONTEXTS**

Certainly § 103 at large is not the subject of the present petition; the lead-compound rule that Petitioner seeks to have overturned is generally limited to the chemical arts. But review of this particular rule will be an important course correction for the doctrine of obviousness in general for at least two reasons.

First, rules much like the lead-compound rule are not limited to chemical technologies. Design patents follow a similar rule, in which a court “must identify a single reference, a something in existence, the design characteristics of which are basically the same as the claimed design,” as the first step of determining obviousness. *MRC Innovations, Inc. v. Hunter Mfg., LLP*, 747 F.3d 1326, 1331 (Fed. Cir. 2014) (quoting *Durling v. Spectrum Furniture Co.*, 101 F.3d 100, 103 (Fed. Cir. 1996)) (internal quotations removed). Commentators have characterized primary-reference rule as perhaps “too rigid to survive *KSR*,” noting that while it may be workable for many cases, it should not be the sole and ultimate test of obviousness for design patents. Sarah Burstein, *Visual Invention*, 16 Lewis & Clark L. Rev. 169, 202 (2012). Given that design patents are involved in industries from smartphones to pickup trucks,<sup>10</sup> a decision that identifies error

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<sup>10</sup>See, e.g., *Samsung Elecs. Co. v. Apple Inc.*, 137 S. Ct. 429, 433 (2016); *Auto. Body Parts Ass’n v. Ford Global Techs., LLC*, 293 F. Supp. 3d 690, 694 (E.D. Mich. 2018).

in the primary-reference rules common to chemicals and designs could thus have widespread impact.

Second, a reversal in this case would likely signal to the Federal Circuit that its other rules of obviousness need to be revisited. A declaration that the lead compound rule is inconsistent with *KSR*'s flexible analysis would be sufficient to raise a question as to whether other obviousness rules are also sufficiently flexible. And insofar as Petitioner (at 30–31) specifically sets up the lead-compound rule as inconsistent with *KSR*'s concept of “obvious to try,” this Court’s elucidation on that concept would likely overcome the lines of Federal Circuit cases minimizing the applicability of obviousness to try. *See, e.g., Millennium Pharm., Inc. v. Sandoz, Inc.*, 862 F.3d 1356, 1365–66 (Fed. Cir. 2017) (finding combination of a drug and a particular bulking agent nonobvious despite prior art teaching recommending combination of the drug with a bulking agent, and despite the particular bulking agent being “one of a relatively small number of bulking agents,” because “neither the requisite motivation nor expectation of success is found in the prior art”).

Accordingly, correction of the seemingly narrow lead-compound rule would potentially correct the course of obviousness law much more generally, to the benefit of a wide variety of technological arts and industries. Certiorari should be granted.

## CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted on both questions presented.

Respectfully submitted,

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