

BIODEN MA, INC. v. JAPANESE FOUNDATION FOR CANCER RESEARCH, Appeal No. 2014-1525 (Fed. Cir. May 7, 2015). Before Dyk, Schall and Chen. Appealed from D. Mass. (Judge Saylor).

Background:

Beginning in 1983, three interferences were declared between the patent applicant (Walter Fiers) and Haruo Sugano, et al. (Sugano) relating to claims to DNA sequences and precursor and mature proteins. In the first and second interferences, the Board of Patent Appeals and Interferences (BPAI) awarded priority to Sugano.

In the present (third) interference, Biogen brought suit pursuant to 35 U.S.C. §146 to challenge the interference decision by the Patent Trial and Appeal Board (PTAB) that Fiers was estopped from establishing priority in the interference because he had lost the two prior interferences covering the same subject matter (interference estoppel by judgment). The district court held that it lacked subject matter jurisdiction because the America Invents Act (AIA) eliminated district court jurisdiction under 35 U.S.C. §146 with respect to interferences commenced after September 15, 2012. Biogen appealed.

Issue/Holding:

Did the district court err in holding that it lacked subject matter jurisdiction? No.
Did the PTAB err in denying the priority claim? No.

Discussion:

The Federal Circuit initially concluded that it had jurisdiction to review the district court holding because the present case was virtually indistinguishable to *In re Teles AG Informationstechnologien*. The Federal Circuit then addressed the issue of whether the district court has subject matter jurisdiction to consider this case under pre-AIA 35 U.S.C. § 146.

In deciding the issue of the district court's subject matter jurisdiction, the Federal Circuit first noted that the district court's jurisdiction under §146 and the Federal Circuit's jurisdiction under §141 are mutually exclusive alternate paths of review for pre-AIA interference decisions by the PTAB. The Federal Circuit held that if a party elects to have the PTAB's decision reviewed by the Federal Circuit under §141, it has irrevocably waived district court review under §146. Likewise, if an election for review under §146 is made, the Federal Circuit would no longer have jurisdiction (this is only the case if §146 review is available).

The Federal Circuit next noted that under the AIA, §146 was amended to authorize review only of derivative proceedings and that under AIA §3(n)(1), the new AIA provisions only apply to applications with an effective filing date on or after March 16, 2013. Biogen argued that this silence "implicitly preserves interference proceedings and judicial review provisions concerning interference proceedings for patent applications filed before March 16, 2013." The Federal Circuit rejected Biogen's argument and instead found support in specific provisions of the AIA (§ 6(f)(3)(C) and § 1(k)(3)) to hold that the AIA eliminated pre-AIA §146 review for interference proceedings declared after September 15, 2012. Accordingly, the Federal Circuit affirmed the district court's lack of subject matter jurisdiction and because pre-AIA §146 review is not available, the Federal Circuit held that it has jurisdiction under §141.

Finally, the Federal Circuit held that Fiers failed to meet his burden to show patentable distinctness of the claims in the present interference from prior interference counts to avoid interference estoppel by judgment.