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Federal Circuit Patent Bulletin: *Biogen MA, Inc. v. Japanese Found. for Cancer Research*

May 8, 2015

"[W]e have jurisdiction under § 141 as a result of the transfer if § 146 review was unavailable, but we lack jurisdiction if this case was properly brought to the district court under § 146."

On May 7, 2015, in *Biogen MA, Inc. v. Japanese Found. for Cancer Research*, the U.S. Court of Appeals for the Federal Circuit (Dyk,* Schall, Chen) affirmed the U.S. Patent & Trademark Office Patent Trial & Appeal Board decision estopping Walter Fiers from establishing priority in Interference No. 105,939 involving U.S. patent applications Serial No. 08/253,843 (Fiers) No. 08/463,757 (Sugano), which related to DNA sequences that encode the precursor and/or mature forms of human fibroblast interferon proteins that promote viral resistance in human tissue, as well as the district court's 28 U.S.C. § 1631 transfer of the case to the Federal Circuit. The Federal Circuit stated:

Congress has provided two mutually exclusive avenues of review under § 146 and § 141, so the question of our jurisdiction and the district court's jurisdiction are different sides of the same coin. If the district court lacked jurisdiction under § 146, we have jurisdiction under § 141 (as a result of the transfer), and if the district court had jurisdiction under § 146, we lack jurisdiction under § 141. [W]e have jurisdiction under § 141 as a result of the transfer if § 146 review was unavailable, but we lack jurisdiction if this case was properly brought to the district court under § 146. We thus must determine if the district court indeed lacked jurisdiction under § 146 in order to determine whether we lack jurisdiction and should retransfer the case. [B]ecause the AIA and its technical corrections provided that only pre-AIA § 141 review in this court would be available for interferences declared after September 15, 2012, and the '939 interference here was declared July 16, 2013, the district court properly found that it lacked subject matter jurisdiction. It follows that we have jurisdiction to hear Biogen's appeal pursuant to § 141.

Interference estoppel "by judgment" applies where "a losing party in a previous interference between the same parties" tries to patent a claim "not patentably distinct from the counts in issue in that [prior] interference." The parties do not dispute that estoppel by judgment, if applicable, is itself sufficient to estop

Fiers from continuing the interference even if Fiers' motion to add protein counts to the earlier interferences failed. Estoppel by judgment rests on the principle that a "judgment in an action precludes relitigation of claims or issues that were. . . raised in [the earlier] proceeding." This is "an application of settled principles of res judicata," under which "a final judgment on the merits of an action precludes . . . relitigating issues." Claims that are not patentably distinct from lost counts were already adjudicated in the prior interference and are thus conclusive. Even if Fiers' filing of the motion to add the protein count would suffice to avoid other forms of estoppel, it is irrelevant to estoppel by judgment.

We agree with the Board that Fiers failed to meet his burden to show patentable distinctness to avoid interference estoppel by judgment. This issue of patentable distinctness arose in the most recent interference proceeding when the Board issued as how cause order requiring Fiers to "show why it will be able to prove an earlier date of conception in the current interference when it could not do so in the prior interference [the '096 interference]." Noting that a losing party to an interference is barred from obtaining a patent on claims that are patentably indistinguishable from the subject matter of the earlier count, the Board stated that "[i]n light of [the fact] that DNA and the known genetic code indicating which DNA sequences encode each amino acid, those of skill in the art would have considered the polypeptide Fiers now claims to have been obvious."