The Decision on Rehearing in Amgen, Inc. v. Human Genome Sciences, Inc. (HGS) - Interference 105,613 - Teaching Points on Interference Practice

By Rick Neifeld[1]

A decision on rehearing in this interference dated 6/5/2009 was published 7/1/2009 on the "Informative Opinions" section of the Board of Patent Appeals and Interferences (BPAI) web site. See http://www.uspto.gov/web/offices/dcom/bpai/informative_opinions.html . APJs Torczon, Lane, Tierney participated in the decision. APJ Torczon rendered the decision.

The purpose of the BPAI informative opinions is to provide guidance to the patent bar. This particular opinion provides guidance on factors that enter into a decision for rehearing and the discretion of the BPAI regarding what issues it will decide. However, it also provides another practice tip (or trap for the unwary) in interference practice.

Amgen was in the interference on an application and HGS was in the interference on a patent. Judgement was entered against HGS in response to an Amgen motion alleging all involved HGS claims unpatentable for lack of utility. All other motions were dismissed.

HGS sought rehearing for the purpose of seeking a decision on two of its dismissed motions against Amgen, HGS motions 2 and 4. HGS did not, in its request for rehearing, contest the decision holding its claims lacking in utility. In response to HGS's request for rehearing, the panel reconsidered, but again decided not to decide HGS's motions 2 and 4. As a result, the Amgen application is or will be returned to ex parte prosecution, and HGS will not be able to participate inter partes in examination of the Amgen application.

HGS motion 2 was in fact a motion for an order to show cause why judgement should not be entered against Amgen for failing to prima facie show priority. As to this motion, the decision states that "There is no longer a need to resolve priority so there is no longer a need to issue an order to show cause against Amgen."

HGS motion 4 was a motion for judgement that all of Amgen's involved claims were unpatentable as obvious based upon HGS's involved patent. However, the APJ deferred this motion to the priority phase because it involved antedating over HGSs involved patent, and therefore this motion was not briefed in the preliminary motions phase. As to this motion, the decision states that "Granting HGS motion 4 without permitting an opposition could raise significant due process problems, while proceeding with the briefing and attendant evidentiary processes would delay judgment several months."

Accordingly, because HGS was not entitled to file or brief its motions 2 and 4; they are now a nullity.

There is one more telling point, and practice tip, flowing from this decision. Note that HGS was shut out of inter partes examination of the Amgen application in view of the judgement terminating the interference. That is clearly not what HGS wanted, and it did not have to end that way. Reading between the lines, it appears that the standard for meeting the

utility requirement was an issue for both parties. However, HGS failed to raise that issue via preliminary motions. Instead, it only raised it during a telephone conference call regarding deferral of certain motions. On this point, the decision states that:

> At the telephone hearing for the deferral request, HGS expressed concern that Amgen's antedating effort might be inconsistent with Amgen's motion against HGS on utility. It is worth noting at this point that HGS did not file its own motion for judgment against Amgen for lack of utility, which would not have been subject to an antedating effort. The deferral order permitted HGS, in the event of "judgment on the basis of an adverse decision on utility, [to] raise its concern at that time as a reason not to proceed immediately to judgment." The request for rehearing is an appropriate vehicle to raise the concern again, but the request must stand or fall on its own merits.

What HGS could have done, but apparently did not do, was, upon identifying that "Amgen's antedating effort might be inconsistent with Amgen's motion against HGS on utility," request leave to belatedly file a motion against Amgen on that basis. And if such leave was denied, timely request rehearing. If HGS had timely moved for judgement on the basis of lack of utility of Amgen's application, (for example on the basis that Amgen's pre interference showings were inconsistent with Amgen's motion for lack of utility), that could have tied the antedating issue and the utility issue together, requiring (or at least favoring) their concurrent briefing, either during the preliminary motions phase or priority phase. Instead, HGS apparently agreed to merely be entitled to "raise its concern" about Amgen's utility, in response to adverse judgement against HGS, and clearly that was, in hindsight, insufficient relief.

1. I was the chair of the AIPLA Interference Committee from 2000-2002, and Deputy head of the Interference Section at Oblon Spivak, for several years. I can be reached via telephone at 703-415-0012 or via the firm web site, http://www.Neifeld.com

RAN
Date/time code: July 2, 2009 (11:51am)
Y:\Library\LAW\FirmPublicationsAndPresentationsAndLectureMaterials\RickNeifeld\articles\Amgen_v_HumanGenomeSciences_Interference105613_7-1-2009.wpd