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Paper 79  
5 June 2009

UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,613

AMGEN, INC.  
(09/895,943),  
Junior party,

v.

HUMAN GENOME SCIENCES, INC.  
and Schering Corp.  
(6,844,170),  
Senior party.

Before: RICHARD TORCZON, SALLY G. LANE, and MICHAEL P.  
TIERNEY, *Administrative Patent Judges.*

TORCZON, *Administrative Patent Judge.*

DECISION

Bd.R. 127  
on rehearing

The senior party (HGS) seeks rehearing of the decision to enter judgment.<sup>1</sup> The junior party (Amgen) opposes.<sup>2</sup> The decision underlying the judgment granted an Amgen motion to hold all involved HGS claims unpatentable for a lack of utility and dismissed other motions.<sup>3</sup> HGS does not seek rehearing of the decision holding its claims unpatentable, but seeks a decision on two HGS motions not treated in the earlier decision.<sup>4</sup>

The decision to enter judgment has been reconsidered, but the requested relief is DENIED.

### MEMORANDUM OPINION

An interference is a tool to determine priority for competing claims to the same invention.<sup>5</sup> The Board has discretion to reach other issues as well.<sup>6</sup> A decision that one party lacks utility may render the need for a priority decision moot.<sup>7</sup> The Board may, nevertheless, exercise its discretion to reach a patentability issue even after the priority contest has been resolved.<sup>8</sup>

The decision to exercise discretion is necessarily case-specific and depends on a variety of considerations such as the issues raised and the

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<sup>1</sup> Paper 76 seeking rehearing of Paper 75.

<sup>2</sup> Paper 78.

<sup>3</sup> Paper 74.

<sup>4</sup> Paper 76.

<sup>5</sup> 35 U.S.C. 135(a) (directing the Board to determine priority).

<sup>6</sup> *Id.* (permitting the Board to determine patentability). Although 35 U.S.C. 6(b) says the Board shall decide patentability, it does so in the context of allocating responsibilities between the Board and the Director of the United States Patent and Trademark Office. *See Berman v. Housey*, 291 F.3d 1345, 1354 (Fed. Cir. 2002) ("Section 6 is an enabling provision.").

<sup>7</sup> *Brenner v. Manson*, 383 U.S. 519, 528 n.12 (1966) (explaining decision to reject claim for lack of utility rather than declare interference).

status of the case, the parties, and the tribunal. A pertinent consideration in this case is whether the two motions in question (HGS motions 2 and 4) have been fairly raised and fully developed.

#### A. HGS Motion 2

HGS motion 2 is not, in fact, a motion at all. HGS requested "authorization to file a motion for judgment on priority based on Amgen's lack of a *prima facie* showing of priority in requesting this interference."<sup>9</sup> The order setting times for the initial round of motions construed proposed HGS motion 2 as essentially a request to place Amgen under an order to show cause why judgment should not be entered against it. The request was deferred since "[t]he decision on Amgen motion 1 will clarify the appropriateness of such an order." Since Amgen's motion 1 was granted, and its grant is not contested in this request for reconsideration, the question of the appropriateness of an order to show cause against Amgen has been resolved. 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.

#### B. HGS Motion 4

HGS motion 4 seeks to have all of Amgen's involved claims held unpatentable under 35 U.S.C. 102(e) or 103 in view of the involved HGS patent.<sup>10</sup> Although HGS did not provide a utility for the contested invention, lack of utility is not necessarily fatal to an anticipation of a compound or

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<sup>8</sup> *Berman*, 291 F.3d at 1352 (explaining that the Board may, but need not, decide issues that have been fairly raised and fully developed).

<sup>9</sup> Paper 23 (HGS list of motions) at 1:8-11.

<sup>10</sup> Paper 32 at 2:2-5.

composition.<sup>11</sup> An apparent anticipation under § 102(e) may, however, be overcome by evidence of invention before the critical date for the anticipating patent.<sup>12</sup> Board practice permits an opponent to request deferral of an antedating effort until the priority phase of an interference since there tends to be a high degree of overlap between antedating and priority proofs.<sup>13</sup>

In the present case, Amgen sought deferral of HGS motion 4 until the priority phase of the interference. The Board granted the request and deferred all further action on the motion except objections and supplementations for evidence served with the motion.<sup>14</sup> In particular, Amgen did not file an opposition with antedating evidence. 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.

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.<sup>15</sup> It is worth noting at this point that HGS did not file its own motion for judgment against Amgen for lack of utility,<sup>16</sup>

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<sup>11</sup> *In re Gleave*, 560 F.3d 1331, 1335 (Fed. Cir. 2009). Lack of utility might, however, affect the obviousness analysis. *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 417-21 (2007).

<sup>12</sup> *In re Costello*, 717 F.2d 1346, 1348-49 (Fed. Cir. 1983) (listing several ways to antedate a reference).

<sup>13</sup> *LeVeen v. Edwards*, 57 USPQ2d 1416, 1419-20 (BPAI 2000).

<sup>14</sup> Paper 35 (Order) at 2.

<sup>15</sup> *Id.*; *cf. In re Ziegler*, 992 F.2d 1197, 1200 (Fed. Cir. 1993) (antedating failed because foreign priority application lacked utility).

<sup>16</sup> *See* Paper 25 at 2 (authorizing HGS motion 3 for judgment on written description and enablement to make and use).

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."<sup>17</sup> The request for rehearing is an appropriate vehicle to raise the concern again, but the request must stand or fall on its own merits.

HGS urges that the evidence that Amgen has submitted thus far, principally its suggestion for interference and its priority statement, do not measure up to the utility standards that Amgen urged in its motion. The suggestion, however, was filed before Amgen filed its motion, which might have forced it to modify its position. The priority statement was filed at the same time as the motion, but for a different purpose. Indeed, a priority statement is not evidence<sup>18</sup> and at best preserves the option of antedating a reference under § 102(e).<sup>19</sup> In sum, Amgen has not filed its antedating case and is not barred from adding additional evidence that would address what HGS has identified as problems in its other filings.

The issue of anticipation and obviousness in view of the HGS involved patent has not been fully developed. The question remaining is whether the Board is the proper forum to continue the development of a patentability issue in a pending application. While Board members are "persons of competent legal knowledge and scientific ability",<sup>20</sup> patent

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<sup>17</sup> Paper 35 at 2.

<sup>18</sup> Bd.R. 120(b) (notice of basis for relief is not evidence except as a party admission); *see also* Bd.R. 204(a) (identifying priority statements as a species of such notices).

<sup>19</sup> *LeVeen*, 57 USPQ2d at 1419-20.

<sup>20</sup> 35 U.S.C. 6(a).

examiners are practical experts in the examination of their respective technologies. Determination of patentability under §§ 102(e) and 103 are core competencies for patent examiners. Institutionally, a patent examiner is best suited to address this issue in the first instance.

HGS may be disappointed<sup>21</sup> that it cannot participate in the further examination of Amgen's claims. This disappointment does not amount to prejudice, however. There is no private right of opposition to an opponent's application.<sup>22</sup>

### C. Conclusion

HGS has not demonstrated that the Board improperly overlooked or misapprehended any issue in failing to reach HGS motions 2 and 4. Neither motion was fully developed. Since the Board may exercise its discretion not to reach even a fully developed issue, it cannot have overlooked or misapprehended its obligations in deciding not to reach issues not fully developed.

cc:

Anthony M. Zupcic and Robert H. Fischer, FITZPATRICK, CELLA, HARPER & SCINTO, of New York City, New York, for Amgen, Inc.

Richard L. DeLucia and John Kenny, KENYON & KENYON LLP, New York City, New York, for Human Genome Sciences, Inc. and Schering Corp.

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<sup>21</sup> Understandably in view of its "sweat equity" in its motion as developed thus far.

<sup>22</sup> *Ewing v. Fowler Car Co.*, 244 U.S. 1, 10-11 (1917) (declining to compel an interference where the Office changed its mind and decided to continue the examination instead).