UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR

University of Western Australia Junior Party (U.S. Patent No. 8,486,907) v. **Academisch Ziekenhuis Leiden** Senior Party (Application No. 14/198,992)	)	Interference No. 106,013 (RES) Decision on Request under 37 C.F.R. § 1.304(a)(3)(i)

MEMORANDUM AND ORDER

On February 12, 2016, Junior Party University of Western Australia ("UWA") filed a "Request For Extension Of Time Pursuant To 37 CFR 1.304(a)(3)(i) And/Or 90.3(c)(1)(i)" ("Request"), seeking a one-month extension of time "for filing an appeal of the Decision and Judgment" of the Patent Trial and Appeal Board (Board) decision in Interference No. 106,013. Req. at 1. The Board issued its Rehearing Decision in the underlying interference on December 29, 2015. Per § 1.304(a)(1), any Notice of Appeal to the Federal Circuit is due on or before February 29, 2016 (*i.e.*, two months from the "date of the decision" being appealed).[1] Because this Request was filed

[1] On September 16, 2012, the existing USPTO regulations went into effect; the current regulations at 37 C.F.R. §§ 90.1-90.3 replaced those at 37 C.F.R. §§ 1.301-304. Per 37 C.F.R. § 90.1, however, "where available, judicial review of decisions arising out of interferences declared pursuant to 35 U.S.C. 135 continue to be governed by the pertinent regulations in effect on July 1, 2012." Thus, the previous regulations at § 1.304 apply here, including those for time computation (Rule 304(a)(1)) and time extensions (Rule 304(a)(3)). Note that the standards governing additional time are the same in either set of regulations.

before the expiration of the period for seeking judicial review, this Request falls under the "good cause" standard of 37 C.F.R. § 1.304(a)(3)(i). If the request is granted, the new filing deadline would be March 29, 2016.

UWA explains that the additional month is necessary to "complete review of the record, including the reasoning in the decision for refusing to continue the interference to allow the filing of motions addressing threshold issues." Req. at 1. UWA explains that it "has been diligently conducting this review, but has yet to complete it." *Id.* Additionally, UWA proffers that its decision whether to appeal to the Federal Circuit "will also be influenced" by whether the Supreme Court grants the currently-pending writ of *certiorari* in *Biogen MA, Inc. v. Japanese Foundation for Cancer Research, et al.* (No. 15-607) to address the availability of actions under pre-AIA 35 U.S.C. § 146 in interferences instituted after September 16, 2012. Req. at 2. Thus, argues UWA, the requested additional time "will likely provide UWA with additional information to allow an informed decision to be made" regarding whether to pursue direct appeal to the Federal Circuit under § 141. *Id.* UWA additionally states that "a further extension" may be necessary if the Court has not acted on the *certiorari* petition by Mid-March. *Id.*

Senior Party Academisch Ziekenhuis Leiden ("AZL") subsequently filed a "request" to file an opposition to UWA's request for additional time on its appeal deadline. In that request, AZL outlines the considerations it would elaborate on in any

formally-filed opposition, including that AZL would be prejudiced by the additional time, which would delay the issuance of its patent that is already subject to terminal disclaimers; that UWA should not need more time given the relative simplicity of the existing record; and that any additional time to wait on whether the Court agrees to hear the *Biogen* appeal would not impart any clarity to UWA because only disposition on the merits will resolve the availability of § 146 actions and that will not occur for many more months. *See* Ltr. from Timothy M. Murphy to Thomas W. Krause (Feb. 15, 2016) ("Opp."). UWA then filed a letter requesting that AZL's letter "not be considered and be stricken from the record," citing a decision from the Director in a time extension request from *Ho v. Furcht* that UWA maintains "essentially den[ied] a similar request" in that interference. *See* Ltr. from R. Danny Huntington to Thomas W. Krause (Feb. 16, 2016). AZL then responded to the characterization of the *Ho* decision in UWA's letter. *See* Ltr. from Timothy M. Murphy to Thomas W. Krause (Feb. 16, 2016).

Before turning to the merits of UWA's Request, the parties' jockeying about whether AZL may oppose needs to be addressed. UWA is incorrect that the Director's Order in *Ho v. Furcht* "essentially den[ied]" a request to oppose a time extension request. *Ho* states that while neither the previous nor existing regulations contemplated the filing of an "opposition" or subsequent "reply" thereto, the Director has the discretion to consider them, and did so in that particular matter. *See*

Decision on Request under 37 C.F.R. § 1.304(a)(3)(i), at 2 n.2, *Ho v. Furcht*, Int. No. 105,953 (Dec. 12, 2014)). But *Ho* makes clear that "such filings should be avoided in the future," and that private parties should not expect the ability to file them. *Id.* That remains true. The papers filed by the parties here are motions practice. But "requests" for time extensions are not filed under the motions regulations. So parties should not expect the opportunity to file responsive papers, or that they will be considered if submitted. Here, the parties filed their subsequent correspondence before the Director issued a decision on the Request. Thus, consistent with *Ho*, the Director has considered the parties' papers in considering UWA's Request.[2]

The Director may extend the time for filing an appeal notice "[f]or good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action." 37 C.F.R. § 1.304(a)(3)(i).[3] Like the extension request in *Ho*, UWA's Request breaks down along two lines. UWA first maintains that it needs the additional time to complete review of the decision and record to determine whether to appeal to the Federal Circuit. The second basis asks for the additional time to see how the *certiorari* petition in *Biogen* plays out, with the hopes that the Court will

[2] It is not necessary that AZL file a formal opposition, per its "request" to do so. The information provided by AZL's letter is adequate to consider AZL's position on the matter.

[3] Decisions on requests for additional time to seek judicial review of Board decisions are delegated to the Solicitor. MPEP § 1002.02(k)(3).

act on the petition during the extension. Absent such action, UWA suggests it will need more time.

As in *Ho*, the latter basis does not constitute good cause for the requested extension. While the "good cause" standard is lenient, it must still have limits. The Court may not decide the *Biogen* petition in the requested month, which would require additional extensions. Req. at 2. And even if the Court agrees to hear the *Biogen* appeal during March, UWA will not have any further guidance on whether it should pursue judicial review of this Board decision, or even whether it could pursue such review in district court. Clarity as to whether a § 146 action is available to UWA will come only if/when the Court decides the merits of the *Biogen* case, which could be up to one year or more from the current appeal deadline. Taking UWA's argument to its logical conclusion, then, if the Court grants *certiorari* in *Biogen*, UWA would require additional time extensions until the Court issues its decision. The time extension provisions do not contemplate what would effectively be a stay of an appeal before it is even filed, particularly where the reason for such a prolonged extension does not speak to the merits of the subject Board decision. The USPTO has issued final agency action in this interference; the administrative proceedings have concluded and there is nothing to "stay." And it should be the reviewing court who decides whether to stay judicial review pending *Biogen*, if for no other reason than such a determination contemplates the kind of briefing that the time-extension regulations do not provide for, as already

discussed. Ultimately, nothing in the status quo seemingly prohibits UWA from filing a § 146 action in an attempt to preserve the option should future events alter that status quo, as other parties have done. *See* Brief for the United States at 7-9, *Storer v. Clark*, Appeal No. 2015-1802 (Feb. 19, 2016).

Nonetheless, UWA has shown "good cause" exists to grant additional time in which to seek judicial review of the Board decision based upon its representation that such time is needed to assess the merits of the issues reached in the Board decision. This request is again like *Ho* in this respect. While additional information as to why the two months already provided to determine whether to appeal was insufficient for that purpose would have strengthened UWA's request (*see* Opp. at 1), the Director accepts UWA's statement that is has been "diligently conducting" its review of the record, but still requires additional time to complete it. Req. at 1. And the requested one month is proportional to the particular circumstances alleged by UWA as giving rise to the need for the additional time.

ORDER

Upon consideration of the Request for an extension of time under 37 C.F.R. § 1.304(a)(3)(i), it is ORDERED that the Request is granted.

UWA's time for seeking judicial review of the Board decision in the underlying interference here under 37 C.F.R. § 1.304(a)(1) is extended for one (1) month from February 29, 2016, until March 29, 2016.

MICHELLE K. LEE
UNDERSECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES
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DATE: February 26, 2016

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