

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIOGEN MA INC.
Junior Party
Patent 8,399,514 B2,

v.

FORWARD PHARMA A/S
Senior Party
Application 11/576,871.

Patent Interference No. 106,023 (McK)
Technology Center 1600

Before FRED E. McKELVEY, SALLY GARDNER LANE, and
DEBORAH KATZ, *Administrative Patent Judges*.

McKELVEY, *Administrative Patent Judge*.

DECISION ON BIOGEN MOTION 6

Revival of Application 12/526,296

37 C.F.R. § 41.125(a)

- 1 I. Biogen Motion 6
- 2 Biogen Motion 6 (Paper 221) seeks entry of an order reviving abandoned
- 3 patent application 12/526,296 (“the ’296 application”) *inter alia* for the purpose of

1 entry of an amendment (**Ex 2009**) to claim in the '296 application benefit of the
2 filing date of U.S. Provisional Application 60/888,921 (**Ex 2006A**) (“the '921
3 provisional application”). Paper 221, page 1:8–12. Upon entry of the amendment,
4 the '296 application again would become abandoned.

5 According to Biogen, the '296 application became unintentionally
6 abandoned without containing a specific reference to the '921 provisional
7 application.

8 Forward Pharma timely opposed. Paper 542.

9 Biogen timely replied. Paper 561.

10 II. Witnesses

11 Biogen sought, and obtained from the Board, authorization to file Biogen
12 Motion 6. Paper 196, pages 9–13.

13 In addition to documentary evidence, Biogen submitted direct declaration
14 testimony of attorneys:

15 (1) Thomas L. Irving,

16 (2) John M. Covert,

17 (3) Adriane M. Antler, and

18 (4) Theresa Devlin.

19 Cross-examination of attorneys Irving, Covert, and Antler took place live
20 before one member of the panel. Cross-examination of attorney Devlin took place
21 in Cambridge, Massachusetts with two judges of the panel participating via
22 telephone.

23 The exhibits for direct declaration testimony and cross are as follows:

Table 1—Witnesses		
Witness	Direct Testimony	Cross-examination
Thomas L. Irving	2051	2074
John M. Covert	2052	2073
Adriane M. Antler	2053	2072
Theresa Devlin	2054	2075

1 III. Facts

2 Biogen is involved in the interference by virtue of U.S. Patent 8,399,514 B2
3 (“the ’514 patent”) (**Ex 2001A**). Application 13/372,426 (“the ’426 Application”)
4 (**Specification: Ex 2007A**) matured into the ’514 patent.

5 The ’514 Patent claims priority of:

- 6 (1) the ’296 application (**Specification: Ex 2004A**);
- 7 (2) PCT/US2008/001602 (**Ex. 2005A**); and
- 8 (3) the ’921 Provisional Application (**Ex 2006A**).

9 **Ex. 2001A**, page 1 (60) and (63).

10 Two other applications are relevant to issues raised in Biogen Motion 6:

- 11 (4) application 13/767,014 (“the ’014 application”) filed as a
- 12 continuation of the ’426 application, and
- 13 (5) application 14/718,962 (“the ’962 application”).

1 In table form, the applications in filing date order are:

Table 2—Relevant Applications	
Application	Filing Date
Provisional Application 60/888,921	8 February 2007
PCT/US2008/001602	8 February 2008
Application 12/526,296	13 January 2011
Application 13/372,426 issued as U.S. Patent 8,399,514 B2 and involved in the interference	13 February 2002
Application 14/767,014	14 February 2013
Application 14/718,962	21 May 2015

2 A “specific reference” to the ’921 provisional application does not appear in
3 the ’296 application. Accordingly, under 35 U.S.C. § 119(e), Biogen is not entitled
4 to benefit of the ’921 Provisional Application.

5 To overcome the lack of a “specific reference,” Biogen has filed a motion to
6 (1) revive the ’296 application based on unintentional delay and (2) amend the
7 ’296 application to make a “specific reference” to the ’921 provisional application.
8 Paper 221.

9 The Director is authorized by Congress to establish procedures to revive an
10 unintentionally abandoned application for patent upon petition by the applicant for
11 patent. 35 U.S.C. § 27.

12 Among other requirements, any petition must contain a statement that the
13 entire delay in filing a reply from the due date of the reply until the filing of a
14 grantable petition was unintentional. 37 C.F.R. § 1.137(b)(4). In addition to the
15 statement, the Director may require additional information. *Id.*

1 Because the revival issue arose in this interference, any petition to revive is
2 decided by the Board. 37 C.F.R. § 41.121(c)(2).

3 Rather than reply to an Office Action, Biogen abandoned the '296
4 application in favor of the '426 application. Paper 221, page 9:19–20.

5 We understand that attorneys for Biogen contend that Biogen would not
6 have abandoned the '296 application had the relevant attorneys been aware that the
7 '296 application did not contain a “specific reference” to the '921 provisional
8 application.

9 We further understand that attorneys for Biogen believed that they had
10 claimed benefit, the belief said to have been based in part on documents issued by
11 the USPTO and set out below in date order, including:

Table 3—USPTO Issued Documents			
Exhibit	Application	Document	Date
2055	'296	Confirmation No. 5197 371 Formalities Letter	2010/09/13
2056	'296	Electronic Acknowledgement Receipt	2011/01/13
2015	'296	Filing Receipt	2011/02/01
2021	'296	Confirmation No. 5197 371 Acceptance Letter	2011/02/01
2022	'296	Published Application	2011/05/12
2016	'426	Filing Receipt	2012/03/29
2026	'426	Updated Filing Receipt	2012/04/24

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