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The authors speculate about what the board will do with material information that it's not supposed to have.

What Should the Board Do With the Illicit Information?

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In *So Long 35 U.S.C. § 146—It's Been Good To Know You!*, 90 PTCJ 2845, 8/7/15, dealing with the effects of the holding of *Biogen MA, Inc. v. Japanese Foundation for Cancer Research*, 785 F.3d 648, 114 U.S.P.Q.2d 1669 (Fed. Cir. 2015) (terminating the jurisdiction of the district courts over reviews of decisions of the Patent Trial and Appeal Board in patent interferences declared on or after Sept. 15, 2012), the authors wrote:

> [O]ver the years, the 35 U.S.C. § 146 option has saved many an attorney's bacon. It has been possible for losing counsel (or successor counsel representing the losing party) to take the board's opinion as a guide to what was done wrong and what should have been done. Sometimes (not always, but sometimes) it has been possible to correct the errors of the past by the submission of new evidence during a 35 U.S.C. § 146 proceeding. That possibility is now gone forever unless *Biogen* is reversed. [90 PTCJ at 2847.]

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The views expressed herein are those of the authors and are not necessarily shared by their employer or its clients.

Well, *Biogen* wasn't reversed, and it has been followed in two opinions by the U.S. Court of Appeals for the Federal Circuit, including the one under consideration here: *Bd. of Trs. of Leland Stanford Junior Univ. v. Chinese Univ. of Hong Kong*, No. 2015-2011, 2017 BL 220606 (Fed. Cir. June 27, 2017) (opinion by Judge Kathleen M. O'Malley for a panel that also consisted of Judges Jimmie V. Reyna and Raymond T. Chen). However, the facts (1) that the 35 U.S.C. § 146 proceeding was ongoing when *Biogen* came down, (2) that discovery had already been taken in that proceeding when *Biogen* came down, and (3) that the panel of the Federal Circuit that decided *Stanford v. CUHK* not only reversed the panel of the board (consisting of Administrative Patent Judges Deborah Katz, Fred E. McKelvey, and Richard E. Schafer, opinion by APJ Katz), but remanded the case to the board to try again presents the board with a fascinating quandary, described below.

What the Federal Circuit Said and Did in *Stanford v. CUHK*

The Federal Circuit decided four questions on appeal: (1) whether it should reconsider *Biogen*, (2) whether it should take into consideration the record developed in the 35 U.S.C. § 146 proceeding before the case was transferred to the Federal Circuit, (3) whether it should vacate the board's orders and instruct the board to take that record into consideration on remand, and (4) whether it should reverse the board on the merits even without consideration of the additional evidence developed before the case was transferred to the Federal Circuit.

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On the first question, the panel briefly held that ''we decline to accept Stanford's invitation to criticize . . . [*Biogen*]. *Biogen* is the law in this circuit and we, as a panel, will not revisit it.'' 2017 BL 220606, at *6.

On the fourth question, the panel reversed the board on the merits. In doing so, the panel stated:

> On this issue, the Board had to determine what the '018 specification's [i.e., CUHK's specification] reference to Illumina products means *at the time of the invention*, and whether such a reference encompassed random and/or targeted sequencing. ''Written description is a question of fact, judged from the perspective of one of ordinary skill in that art *as of the relevant filing date*.'' *Falko-Gunter*, 448 F.3d at 1363 (citing *VAS-Cath*, 935 F.2d at 1563-64). [2017 BL 220606, at *8; first emphasis by the court; second emphasis supplied.]

That curious internal inconsistency (not to mention the fact that the first statement is contrary to decades of precedent) elicited an outcry from the remaining members of the interference bar. However, since it does not related to the subject of this article, it will not be discussed here.

On the second and third questions (which are the ones that concern us here), Judge O'Malley wrote as follows:

> While the parties spend a great deal of their briefing on the meaning and impact of . . . [the discovery taken by Stanford during the pendency of the 35 U.S.C. § 146 proceeding], we agree with CUHK's threshold position that we may not consider it and may not remand this matter to direct the Board to do so. Given that the district court did not have subject matter jurisdiction to review the Board's interference decisions, Stanford's attempt to include evidence elicited during proceedings there is inappropriate – the activities in the district court are a nullity when the district court lacks subject matter jurisdiction to consider a matter. *See Ruhrgas AAG v. Marathon Oil Co.*, 526 U.S. 574, 577 (1999) (''The requirement that jurisdiction be established as a threshold matter . . . is inflexible and without exception; for jurisdiction is power to declare the law, and without jurisdiction the court cannot proceed at all in any cause.'' (quoting *Steel Co. v. Citizens for a Better Env't*, 523 U.S. 83, 94-95 (1998) (brackets, citations, and internal quotation marks omitted [by the Federal Circuit])). CUHK cannot waive the district court's lack of jurisdiction through its consent to litigate pre-*Biogen*. *See Ins. Corp. of Ir., Ltd. v. Compagnie des Bauxites de Guinee*, 456 U.S. 694, 702 (1982) (''[N]o action of the parties can confer subject-matter jurisdiction upon a federal court [sic; upon an Article III federal court]. Thus, the consent of the parties is irrelevant . . . and a party does not waive the requirement by failing to challenge jurisdiction early in the proceedings.'') (citations omitted).
>
> Our precedent makes clear that our review of a Board interference decision must be confined to the ''four corners'' of the record before the Board. *In re Gartside*, 203 F.3d 1305, 1314, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000); 35 U.S.C. § 144 (2012). CUKH correctly asks that we treat the district court proceedings as if they never occurred. *While we ultimately vacate the Board's decision for other reasons, moreover, we do not do so because new evidence may have been developed [sic; was developed] in the district court proceedings. It will be up to the Board to decide whether it wishes to reopen the record for that reason, or any other; we express no opinion on whether it should do so.* [2017 BL 220606, at *6; emphasis supplied.]

So, What Should the APJs Do on Remand?

Initially, the authors wish to make it clear that we have no stake in this interference and that we have not reviewed (and are expressing no opinion concerning) the additional evidence that Stanford developed during the aborted 35 U.S.C. § 146 proceeding. Additionally, we are expressing no opinion here concerning whether *Biogen* was decided correctly—although we *will* reiterate our previously expressed opinion that *Biogen* reached a socially undesirable result. However, we acknowledge that sometimes precedent compels an honest judge to reach a socially undesirable result.

For present purposes, what we are assuming is that the discovery that Stanford obtained during the aborted 35 U.S.C. § 146 proceeding was not only material, but potentially outcome-determinative. It is on that basis that this remand becomes fascinating.

We share the view of many (probably most) in the interference bar that the limited scope of the discovery available during the administrative phase of interferences sometimes (we believe often) leads to ''incorrect'' results—by which we mean results other than the results that would be obtained if discovery before the board were more sweeping, more like the discovery that is available in federal district court proceedings. What has made that situation tolerable (if not desirable) is the discovery that has been available in follow-on 35 U.S.C. § 146 proceedings.

In this case, such discovery was obtained, and the question is whether, on remand, the panel of federal Article I judges should ignore it, permit it to be taken again pursuant to a 37 C.F.R. § 41.150(c)(1) motion, or simply deem it to be part of the record on remand.

We urge the panel (or the singleton APJ, presumably Judge Katz) to authorize the filing of a carefully crafted 37 C.F.R. § 41.150(c)(1) motion for ''Additional discovery.'' While it might be tempting to simply sweep the discovery that has already been obtained during the 35 U.S.C. § 146 proceeding into the record on remand, we suggest that the likelihood that the evidence obtained during the district court proceedings exceeds the evidence normally obtained by motion in the board's administrative proceedings would invite unproductive controversy in the likely subsequent appeal to the Federal Circuit. Surely, since he now knows what's there, counsel for Stanford can get what he needs without asking for the kind of discovery that was available in 35 U.S.C. § 146 proceedings! Moreover, none of the limitations on federal Article III judges discussed in the above lengthy quotations from Judge O'Malley's opinion applies to federal Article I judges.

At the other extreme, if the panel (or the singleton APJ) were to ignore the evidence that has already been adduced and that is well known to counsel for both sides, the board would simply look stupid, eliciting the

kind of derogatory comments that do the board's reputation no good.