

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

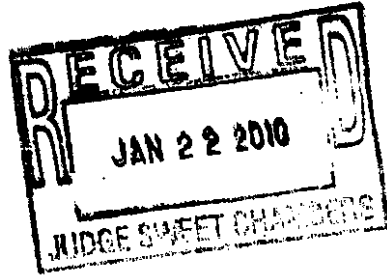
ASSOCIATION FOR MOLECULAR
PATHOLOGY, et al.,

Plaintiffs,

v.

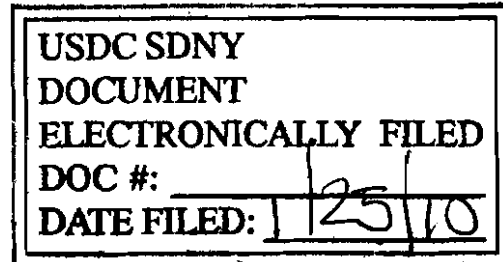
UNITED STATES PATENT AND
TRADEMARK OFFICE, et al.,

Defendants



09 Civ. 4515 (RWS)

**MOTION FOR LEAVE TO FILE
BRIEF *AMICUS CURIAE***



Proposed *Amicus Curiae*, Professor Kenneth Chahine, submits this memorandum
of law in support of his motion for leave to file a brief *amicus curiae*.

*So ordered
Sweet
USDC
1-25-10*

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I. CONFLICT OF INTEREST

While I reside in Utah and am a professor of law at the University of Utah, I do not have a conflict of interest. Moreover, none of the University of Utah-affiliated Defendants, the University of Utah General Counsel, or any of the other Defendants were consulted or allowed to review the contents of this brief.

I have no financial interest in Myriad Genetics.

I consult with biotechnology companies and currently advise one genetic diagnostic start-up company.

II. INTRODUCTION AND INTERESTS OF PROPOSED AMICUS CURIAE

I am a patent attorney admitted to practice in the State of Utah and in the U.S. Patent and Trademark Office. I also have a Ph.D. in biological chemistry from the University of Michigan. I have taught Intellectual Property and Transactional Law at the University of Utah College of Law.

I have had an interest in gene and protein patents for over a decade. I have numerous publications in the area of gene patents, including Chahine, K.G., *Defining the Proper Scope of Gene and Diagnostic Patents: Going Beyond the Laws and Product of Nature to Determine Patent Eligibility*, (submitted for publication); Chahine, K.G., "Building the proper foundation for genomic based patents," *Nature Biotechnology*, 16: 683-684 (1998); Chahine, K.G., "Enabling DNA and Protein Claims: Why Claiming Biological Equivalents Encourages Innovation," *American Intellectual Property Law*

Association Quarterly Journal, 25(3): 333(1997); Chahine, K.G., "Patenting Genes: Just when you thought it was safe," *Nature Biotechnology*, 15: 586-587 (1997); and Chahine, K.G., "Going beyond the native: Protecting DNA and protein patents," *Nature Biotechnology*, 15: 183-185 (1997). I have also given numerous presentations on the subject dating back to 1998.

In addition to my experience as a patent attorney and professor of law, I have been involved in raising capital for numerous start-ups. I have, therefore, first-hand experience in the incentives that drive biotechnology investment by angel investors, venture capitalists, and fund managers.

I seek leave to file the proposed *amicus curiae* brief, submitted herewith, in order to assist the Court with the complex issues raised by this case. My experience across multiple disciplines put me in a unique position to comment on the scientific merits, the legal precedence, and the economic incentives that will be impacted by the court's decision. My brief clarifies the scientific facts critical to the court's decision, the legal precedence with respect to laws and products of nature, and the economic incentives of patents to the biotechnology industry. In short, while strong aversions to patents in new technological areas is nothing new, what sets the current dispute apart is its far-reaching implications and the potential damage an ill-informed decision would have on the future of medicine and healthcare reform.

I have contacted counsel for the parties in this case and have their consent to file an *amicus curiae* brief in this matter.

III. ARGUMENT

Permitting the filing of amicus curiae briefs falls within the broad discretion given U.S. Federal District Courts. *Esther Sadowsky Testamentary Trust v. Syron*, 2009 U.S. Dist. LEXIS 43977, *8 (S.D.N.Y. May 6, 2009) (“A district court has broad discretion to grant or deny an appearance as amicus curiae in a given case,” citing *United States v. Ahmed*, 788 F.Supp. 196, 198 n.1 (S.D.N.Y.1992)). When considering whether to accept an amicus curiae brief, district courts in the Southern District of New York have looked to factors including (1) whether the amicus will be of assistance to the Court, (2) whether a party will be prejudiced by the amicus, (3) whether a party's interest are not adequately represented by counsel, and (4) whether the amicus is timely. *See, e.g., Esther Sadowsky*, 2009 U.S. Dist. LEXIS 43977, *8 (denying motion to appear as *amicus curiae*); *Strougo ex rel. Brazil Fund v. Scudder, Stevens, & Clark, Inc.*, 1997 U.S. Dist. LEXIS 12243, *7-8 (S.D.N.Y. 1997)(granting motion to participate as amicus curiae); *Long Island Soundkeeper Fund v. New York Athletic Club*, 1995 U.S. Dist. LEXIS 8176, *1-4 (S.D.N.Y. June 12, 1995) (denying motion for leave to file an amicus brief). Amicus participation has been recognized by this Court as useful in situations where “participation will not prejudice any party and may be of assistance to the court.” *Strougo*, 1997 WL 473566, at *3 (S.D.N.Y. 1997). In particular, this Court has recognized the importance of granting leave for participation by *amicus curiae* when such participation may result in the advancement of policy arguments capable of illuminating the legal issues in dispute. *Id.* (granting leave for amicus curiae to participate when “the policy arguments advanced by the [amicus curiae] may illuminate the legal issues presented by this motion”).

IV. CONCLUSION

In view of the foregoing, I respectfully request that this Court grant my Motion for Leave to File the proposed *amicus curiae* brief submitted herewith.

Dated: January 19, 2010

Respectfully Submitted,

/s/ Kenneth G. Chahine, Ph.D., J.D.

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