

# JONES DAY

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July 27, 2011

## VIA HAND DELIVERY

Mr. Jan Horbaly  
Clerk  
United States Court of Appeals for the Federal Circuit  
717 Madison Place, N.W.  
Washington, D.C. 20439

Re: AMP v. PTO, 2010-1406 (argued April 4, 2011)

Dear Mr. Horbaly:

On behalf of Defendants-Appellants, we write because we are obligated to bring to the Court's attention events occurring since the April 4 oral argument that could have a bearing on the threshold jurisdictional issue presented in this case.

During oral argument, the panel asked several questions concerning whether Dr. Harry Ostrer had standing to seek declaratory-judgment relief based on statements in his declaration. (Oral Arg. Tr. at 9:45, 27:30; 1:03:00; *see* A2932-96 (averring (in ¶ 4) that Dr. Ostrer has the "capability and desire" to sequence genes at his Genetics Laboratory at the NYU Langone Medical Center ("NYU Langone") and averring (in ¶ 9) that NYU Langone "has all of the personnel, expertise, and facilities necessary to do various types of sequencing."))

Defendants-Appellants have learned that Dr. Ostrer is leaving NYU Langone, effective August 2011 if not sooner. Dr. Ostrer is now identified as an employee in the Department of Genetics at Albert Einstein College of Medicine, Bronx, New York ("Einstein Genetics"). ([http://www.einstein.yu.edu/home/faculty/profile.asp?id=12751&k=.](http://www.einstein.yu.edu/home/faculty/profile.asp?id=12751&k=)) (last visited July 27, 2011) (copy enclosed). Defendants-Appellants are further informed that Einstein Genetics, unlike NYU Langone, does not offer, and is not qualified to offer, clinical genetic testing.

"The burden is on the party claiming declaratory judgment jurisdiction to establish that such jurisdiction existed at the time the claim for declaratory relief was filed and that it has continued since." *Benitec Australia Ltd. v. Nucleonics, Inc.*, 495 F.3d 1340, 1344 (Fed. Cir. 2007) (citing authorities). This requirement continues throughout the appellate process: "This case-or-controversy requirement subsists through all stages of federal judicial proceedings, trial and appellate. To sustain our jurisdiction ... it is not enough that a dispute was very much alive when suit was filed, or when review was obtained in the Court of Appeals. The parties must

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continue to have a 'personal stake in the outcome' of the lawsuit." *Lewis v. Continental Bank Corp.*, 494 U.S. 472, 477-78 (1990).

Although Defendants-Appellants maintain that plaintiffs never had declaratory-judgment standing in the first place, to the extent that jurisdiction could possibly have been predicated on Dr. Ostrer's declaration, any such jurisdiction would terminate because Dr. Ostrer will no longer be employed at NYU Langone, or able to conduct tests there.

Please distribute this letter to the members of the panel assigned to this appeal (Judges Lourie, Bryson, and Moore).

Respectfully submitted,

  
Gregory A. Castanias  
*Attorney for Defendants-Appellants*

Enclosure

cc: Christopher A. Hansen, Esq. (via e-mail and UPS)  
All other counsel of record (via e-mail and U.S. Mail)