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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**THE BROAD INSTITUTE, INC.**, MASSACHUSETTS INSTITUTE  
OF TECHNOLOGY, and PRESIDENT AND FELLOWS  
OF HARVARD COLLEGE,  
(Patents 8,697,359; 8,771,945; 8,795,965; 8,865,406; 8,871,445; 8,889,356;  
8,895,308; 8,906,616; 8,932,814; 8,945,839; 8,993,233; 8,999,641  
and Application 14/704,551),

**Junior Party,**

v.

**THE REGENTS OF THE UNIVERSITY OF CALIFORNIA**, UNIVERSITY  
OF VIENNA, AND EMMANUELLE CHARPENTIER  
(Application 13/842,859),

**Senior Party.**

Patent Interference No. 106,048 (DK)

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Decision on Request for Rehearing of Order Authorizing Motions

37C.F.R. § 41.125(c)

Before RICHARD E. SCHAFER, SALLY GARDNER LANE, and DEBORAH  
KATZ, *Administrative Patent Judges*.

*Per curiam.*

Senior Party, The Regents of the University of California, University of Vienna, and Emmanuelle Charpentier (“UC”), filed Miscellaneous Motion 2 to request reconsideration of the Order Authorizing Motions (“Order,” Paper 33). (“Request,” Paper 39.) Specifically, UC requests that we authorize it to file its Proposed Motion 1 and Proposed Motion 5, as listed in Senior Party List of Proposed Motions (Paper 27).

*Proposed Motion 1*

UC’s Proposed Motion 1 would argue for judgment that all of Broad’s involved patents are unpatentable over UC’s involved ‘859 application/‘797 publication. (Paper 27, at 1-6.) According to UC, all of Broad’s patents are subject to the provisions of the America Invents Act and therefore Broad cannot antedate the filing date of UC’s involved application and publication with testimony. UC argues that this is a “threshold motion,” which must be considered in the preliminary motions phase of the interference.

UC has not persuaded us that we overlooked or misapprehended anything in deferring consideration of whether to authorize its Proposed Motion 1. We are still not persuaded that UC Proposed Motion 1 presents a “threshold issue.” As we indicated in our Order:

Whether Broad’s claims are unpatentable over prior art is not dispositive of issues of priority. The interference may proceed to determine if UC was not the first to invent the common subject matter under 35 U.S.C. § 102(g) even if Broad’s claims were held not to be patentable. Because UC suggested the interference it chose to challenge Broad’s claims in a priority contest instead of through another procedure. UC has not provided a sufficient reason why its

prior art challenge to Broad's claims should preempt the priority contest.

(Order, Paper 33, at 10.) Though UC argues in its Request that Broad would lack standing if UC's proposed motions were granted, UC still fails to persuade us that it can avoid a priority determination under 35 U.S.C. § 102(g), even if Broad's claims are found to be unpatentable.

According to UC, its proposed motion addresses a standing issue because Broad allegedly chose to present claims that lack written description in a pre-AIA application. UC argues that because the consequences of this choice are the same as for an involved application lacking written description support under 35 U.S.C. § 112, a threshold issue identified in 37 C.F.R. § 41.201, Broad lacks standing. (Request, Paper 39, at 3:8-14.)

This argument is not persuasive. The interference rules provide examples of "threshold" issues, which, if proven, show that a party lacks standing. The exemplary issues include whether an interference even exists (no interference-in-fact), whether a party presented interfering claims too late after notice of the other party's claims (35 U.S.C. § 135(b)), or whether an applicant presented interfering claims to subject matter it did not possess at filing (35 U.S.C. § 112, first paragraph). *See* 37 C.F.R. § 41.201. We are not persuaded that UC's attack on Broad's claims is analogous to these threshold issues. UC does not show that this is a situation where an applicant "suggested or could have suggested" an interference and then presented interfering claims after notice of UC's claims. As noted previously, even if Broad's claims were held to be unpatentable over the prior art, it would not necessarily deprive Broad of standing to establish that UC was not the first inventor of the subject matter of the count. 35 U.S.C. § 102(g)(1).

UC argues that “Broad pursued, and obtained issuance of, claims to which it is not entitled, thereby inducing this interference.” (Request, Paper 39, at 5:1-4.) UC also argues that “this interference [was] forced upon [UC] by Broad” (*id.*, at 10:7-9). We are not persuaded that by pursuing and obtaining issued claims, Broad necessarily “suggested or could have suggested” an interference. Instead, UC suggested the interference and Broad requested, and received, authorization to argue that there is no interference-in-fact between the parties’ claims. (Order, Paper 33, at 4-5.) In other words, it appears that Broad believes its claims and UC’s claims are not in conflict.

UC cites to several non-precedential interference decisions to argue that authorizing Proposed Motion 1 would be consistent with long-standing Board practice. (Request, Paper 39, at 11:12-12:8; *see also id.* at 8:21-9:12.) We are not persuaded that non-precedential opinions from different proceedings, presented under different circumstances and with different facts, necessarily shed light on the current interference. Instead, an opinion from our reviewing court, cited by UC, demonstrates that the Board may use its discretion to decide whether to determine the patentability of a party’s claims. *See McMullin v. Carroll*, 153 F. App’x 738, 746 (Fed. Cir. 2005) (unpublished) (“the Board’s decision to terminate the interference without reaching the issue of the patentability of [junior party’s] patents was based on the Board’s determination, consistent with its regulations, that the dispositive issue was a threshold issue going to whether the interference was properly declared.”). As further explained in that opinion,

The Patent and Trademark Office has included written description as a threshold issue because of the “perception that some applicants would copy a claim simply to provoke interferences ... regardless of whether [they] had actually invented the same subject matter as the [opposing]

patentee had claimed.” 69 Fed.Reg. 49960, 49991 (Aug. 12, 2004). Because the Board determined that McMullin's application lacked sufficient written description to support the claims on which the interference was based, the Board ruled that McMullin lacked standing and therefore dissolved the interference.

*Id.* at 745 (Fed. Cir. 2005).

In the absence of a reason why the interference should not have been declared, at this time we are not persuaded that a determination of priority should not be made, even if Broad's claims are determined to be unpatentable on the basis of prior art. Accordingly, we are not persuaded that we misapprehended or overlooked anything in regard to UC's assertion that its Proposed Motion 1 would resolve a threshold issue of Broad's standing. We note, in addition, that we did not deny authorization for UC's Proposed Motion 1, but deferred consideration of whether it is authorized. Therefore, if appropriate, UC may request authorization again before the priority phase of the interference, if such a phase is necessary.

UC argues further that we overlooked “the fact that a ruling on Senior Party's Proposed Motion 1 is essential in determining a Count that is directed to subject matter that is patentable to each party.” (Request, Paper 39, at 6:25-7:7.) A count “means the Board's description of the interfering subject matter that sets the scope of admissible proofs on priority.” 37 C.F.R. § 41.201. While the parties' claims inform the determination of the subject matter of the count, and may at times be identical to the count, a count is not a claim. A count must describe subject matter patentable over the prior art, but it does not have to be “patentable” in the sense of being supported by either party's specification. Neither party has a claim that is identical to the count. The determination of the patentability of Broad's claims based upon prior art would not require the count to be changed.

Accordingly, we are not persuaded that the patentability of Broad's claims must be determined in order to address the central issue of this proceeding—priority.

UC also argues that we overlooked that authorizing its Proposed Motion 1 at this stage of the proceeding would further the Board's mandate to secure 'the just, speedy, and inexpensive resolution of every proceeding before the Board.'"

(Request, Paper 39, at 9:18-11:11.) According to UC, petitioning or requesting other procedures would be "an enormous waste of resources of both parties and the Board, given that the Board could, and should, effectively and efficiently address [the issues of Proposed Motion 1] in the current proceeding." (*Id.*, at 10:9-12.)

Our mandate is for a just, speedy, and inexpensive resolution of priority issues. *See* 35 U.S.C. § 135(a) ("The Patent Trial and Appeal Board *shall* determine questions of priority of inventions and may determine questions of patentability." (emphasis added)). The motions that we authorized impact the determination of priority. There may also be issues addressed in these motions that shed light on whether Broad's patent and application claims are unpatentable over the prior art and would aid the Board in any later consideration of these prior art patentability issues. Accordingly, we are not persuaded that the most just, speedy, and inexpensive resolution of this proceeding requires authorization of UC Proposed Motion 1 at this time.

#### *Proposed Motion 5*

UC argues that we failed to address its Proposed Motion 5, which would argue that each of UC's involved claims should be designated as not corresponding to Count 1 and that a new claim, which does correspond to Count 1, should be added. (Request, Paper 39, at 13:1-14:7.) According to UC, this motion should be authorized because Count 1 encompasses two separate patentable inventions: "a

single-molecule DNA-targeting RNA” and “a double-molecule format.”<sup>1</sup> (*Id.*, at 13:12-17.)

We agree with UC’s characterization of this motion as a means of arguing that the current count is improper. To allow UC to address its concern, we authorized it to argue the merits of what it proposes as the proper count between the parties’ current claims in a single motion. UC suggested an interference between its currently pending claims and Broad’s claims. Thus, it is not clear why UC would need to cancel its claims and add a new claim.

### *Conclusion*

After consideration of UC’s arguments, the request for rehearing and reconsideration of the Order is *denied*.

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<sup>1</sup> UC argues in its Request and in its list of proposed motions that the separate patentability was recognized by the Office in a restriction requirement issued by the examiner. (Request, Paper 39, at 13:17-19.) We do not consider an examiner’s restriction requirement to be evidence that inventions are separately patentable or that subject matter cannot be included in one count. *See Applied Materials, Inc. v. Advanced Semiconductor Materials America, Inc.*, 98 F.3d 1563 (Fed. Cir. 1996) (explaining that restriction requirements are made for the purpose of “examination convenience,” not as a final determination on the subject matter claimed).

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