

[BoxInterferences@uspto.gov](mailto:BoxInterferences@uspto.gov)

Filed: January 3, 2017

Tel: 571-272-7822

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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**ORDER – Late Submission of Evidence**  
**37 C.F.R. § 41.104(a)**

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

*Per curiam.*

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1           On 22 December 2016, Senior Party (“UC”) contacted the Board seeking a  
2 conference call to request authorization to file new evidence at this point in the  
3 proceeding, wherein briefing is complete and oral arguments have been heard.  
4 (*See Attachment.*) UC represents that the documents that are the subject of its  
5 request could not have been presented prior to the close of briefing.

6           UC requests that it be authorized to file copies of two Office Actions issued  
7 in two different patent applications, neither of which is involved in this  
8 interference.<sup>1</sup> According to UC, the examiners of those applications addressed  
9 information presented by Junior Party (“Broad”) in the instant interference.  
10 Reportedly, one examiner addressed exhibits filed by Broad in Broad Opposition 4  
11 and the other examiner addressed arguments Broad made in this interference.

12           Broad opposes UC’s request. (*See Attachment.*)

13           UC has not indicated a purpose for adding the Office Actions to the record  
14 of this proceeding. It is not apparent what we would do with the new evidence.  
15 Thus, it is not clear why we should consider authorization for UC to file them. UC  
16 was given a full and fair opportunity to argue and present evidence for the relief it  
17 requests and in opposition to Broad’s motions during the regular schedule of this  
18 interference. UC does not indicate otherwise or indicate that filing these  
19 documents would cure any perceived deficiency.

20           It is Ordered that UC’s request for a conference call seeking to file the  
21 evidence cited is DENIED.

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<sup>1</sup> Both applications have different inventive entities from the applications involved in this interference.

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1 Attachment: E-mail of 22 December 2016

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3 cc (via e-mail):

4 Attorneys for Junior Party Broad Institute:

5

6 Steven R. Trybus

7 Harry J. Roper

8 JENNER & BLOCK LLP

9 [strybus@jenner.com](mailto:strybus@jenner.com)

10 [hroper@jenner.com](mailto:hroper@jenner.com)

11

12

13 Attorneys for Senior Party University of California, et al.:

14

15 Todd R. Walters

16 Erin M. Dunston

17 Travis W. Bliss

18 BUCHANAN, INGERSOLL & ROONEY PC

19 [todd.walters@bipc.com](mailto:todd.walters@bipc.com)

20 [erin.dunston@bipc.com](mailto:erin.dunston@bipc.com)

21 [travis.bliss@bipc.com](mailto:travis.bliss@bipc.com)

22

23 Li-Hsien Rin-Laures

24 Sandip H. Patel

25 Greta Noland

26 MARSHALL GERSTEIN & BORUN LLP

27 [lrinlaures@marshallip.com](mailto:lrinlaures@marshallip.com)

28 [spatel@marshallip.com](mailto:spatel@marshallip.com)

29 [gnoland@marshallip.com](mailto:gnoland@marshallip.com)

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## ATTACHMENT

**From:** North, Christopher [<mailto:christopher.north@bipc.com>]

**Sent:** Wednesday, December 21, 2016 3:54 PM

**To:** BOX INTERFERENCES <[BoxInterferences@USPTO.GOV](mailto:BoxInterferences@USPTO.GOV)>

**Cc:** Margolis, Paul D. <[PMargolis@jenner.com](mailto:PMargolis@jenner.com)>; Walters, Todd <[todd.walters@bipc.com](mailto:todd.walters@bipc.com)>; Bliss, Travis W. <[travis.bliss@bipc.com](mailto:travis.bliss@bipc.com)>; Dunston, Erin M. <[erin.dunston@bipc.com](mailto:erin.dunston@bipc.com)>; [Irinlaures@marshallip.com](mailto:Irinlaures@marshallip.com); [gnoland@marshallip.com](mailto:gnoland@marshallip.com); Sandip H. Patel ([spatel@marshallip.com](mailto:spatel@marshallip.com)) ([spatel@marshallip.com](mailto:spatel@marshallip.com)) <[spatel@marshallip.com](mailto:spatel@marshallip.com)>; Roper, Harry J. ([HRoper@jenner.com](mailto:HRoper@jenner.com)) <[HRoper@jenner.com](mailto:HRoper@jenner.com)>; Trybus, Steven R. ([STrybus@jenner.com](mailto:STrybus@jenner.com)) <[STrybus@jenner.com](mailto:STrybus@jenner.com)>; Raymond N. Nimrod ([raynimrod@quinnemanuel.com](mailto:raynimrod@quinnemanuel.com)) <[raynimrod@quinnemanuel.com](mailto:raynimrod@quinnemanuel.com)>

**Subject:** Interference No. 106,048 (DK)

ATTENTION JUDGES KATZ, SCHAFFER AND LANE

Your Honors:

Senior Party requests a conference call with the Board to request authorization to file evidence that became available after the close of briefing. Specifically, Senior Party will request authorization to file two documents.

The first document is the Office Action issued in U.S. Patent Application No. 14/685,510 on November 17, 2016. In this Office Action, the Examiner addresses a Reply that has been presented in this interference by Junior Party as Ex. 2422, and specifically the declaration of Cullen included therein that has been presented by Junior Party as Ex. 2406 and relied upon in, *e.g.*, in Broad Opposition 4, at page 28, lines 6-9, and slide 47 of Junior Party's demonstratives.

The second document is the Office Action issued in U.S. Patent Application No. 14/324,960 on November 23, 2016. The '960 application was filed as a continuation of Junior Party's involved patents, including the involved '359 Patent. In the Office Action, the Examiner addresses arguments that Junior Party has made in this interference.

Senior Party asserts that these documents could not have been presented prior to the close of briefing.

Junior Party opposes this request; Senior Party's request is untimely and improper. If Senior Party thought that either the '510 (Toolgen) or the '960 (Rockefeller) file histories were relevant, arguments about those should have been made in its preliminary motions or oppositions. If Senior Party believed the November Office Actions were relevant, it should have sought to introduce them when they became available a month ago. Instead, Senior Party argued in its Motion 8 that third-party patent prosecution documents, including Exhibits 2406 and 2422, were irrelevant.

Moreover, Slide 47 was not used or relied on by Junior Party at the oral argument, and in any event, prior to oral argument, Junior Party requested Senior Party's objections to demonstratives so that Junior Party could act to remove any objections. Senior Party did not provide such, stating that Senior Party

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would “raise any objections to demonstratives during the 20 minutes provided to Senior Party for oral argument.” Senior Party did not raise any objection or mention this proposed new counter-evidence to the demonstrative at the hearing. Additionally, Junior Party disputes Senior Party’s contention that these office actions address arguments in the interference.

The Parties are available for a call at any time on Friday morning.

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**Christopher North, PhD, Esq**  
Shareholder

### **Buchanan Ingersoll & Rooney PC**

1737 King Street, Suite 500

Alexandria, VA 22314-2727

703 838 6511 (direct voice)

703 836 6620 (office main)

703 836 2021 (fax)

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KNOW GREATER PARTNERSHIP

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