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Filed: 14 September 2016

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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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**ORDER – Additional Discovery and New Evidence in Reply  
37 C.F.R. § 41.150(c) and Standing Order ¶ 122.6**

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

*Per curiam.*

1 Senior Party (“UC”) was authorized to file a notice under 37 C.F.R.  
2 § 41.120(a) stating the basis on which it would request subpoena of Shuailiang Lin  
3 and George Church if authorized to file a motion. (*See* Paper 792.) UC was also  
4 authorized, in the same notice, to state the basis on which it would request  
5 authorization to submit new evidence and testimony in response to Junior Party  
6 (“Broad”) Oppositions 3 and 4. (*See* Paper 794.) UC timely filed a notice. (*See*  
7 Paper 795 (“Notice”). Broad was not authorized to file any papers regarding these  
8 issues.

9 *Additional Discovery*

10 “The standard for granting requests [for additional discovery] is high and  
11 requires specific bases for expecting that the discovery will be productive. Bd.R.  
12 150(a) & (c)(1).” Standing Order (“SO”) ¶ 150.2.

13 UC asserts that it requires testimony from Dr. Lin to address Broad’s  
14 allegations in Broad Opposition 4 that the Jinek 2012 publication “triggered and  
15 guided the work” of the Broad scientists and that the Broad scientists had  
16 commenced their work in 2011. (Notice, Paper 795, at 1:6-23, citing Broad Opp.  
17 4, Paper 56, at 3:17-21.) Similarly, UC argues that it requires testimony from Dr.  
18 Church to address the challenge in Broad Opposition 4 on the issue of whether  
19 research groups, particularly Dr. Church’s group, “moved the Type-II CRISPR-  
20 Cas system into eukaryotic cells before December 12, 2012.” (Notice, Paper 795,  
21 at 1:24-2:18.)

22 UC Motion 4 (Paper 57) seeks to be accorded the benefit of priority of  
23 earlier applications as constructive reductions to practice of the count. UC fails to  
24 explain why testimony from either Dr. Lin or Dr. Church regarding the timing of  
25 actual work done by Broad scientists would be productive in regard to its

1 arguments regarding the disclosure of UC's earlier applications. Thus, whether or  
2 not the requested discovery would address Broad's specific arguments, UC has  
3 failed to show that it would present a basis for discovery that would be productive  
4 to the issues of its Motion 4.

5 In addition, UC does not direct us to any portion of Broad's oppositions  
6 where testimony from fact witnesses is used to oppose UC's arguments. Thus, it is  
7 not clear why UC requires testimony from fact witness in reply.

8 UC also argues that if authorized to file a motion, it would show compelled  
9 testimony is necessary to address Broad's objections to UC's evidence. (Notice,  
10 Paper 795, at 2:19-3:3.) UC asserts that Broad has objected to certain exhibits  
11 (Exhs. 1475, 1548, 1550-53, and 1559-60) as being impermissible hearsay, but UC  
12 does not explain where these exhibits were relied upon or what arguments they  
13 were used to support. Without more explanation, we are not persuaded that  
14 testimonial evidence would be productive in addressing objections to this evidence.  
15 UC asserts that this evidence is "highly relevant evidence to determine whether  
16 Broad's assertions are true." (Notice, Paper 795, at 3:8-10.) Without any  
17 explanation of how or where this evidence was used, UC has failed to show why at  
18 this stage of the interference when priority is not yet at issue and given the motions  
19 before us regarding benefit, substitution of the count, and interference-in-fact, such  
20 testimony would be productive.

21 UC has not explained why there would be a sufficient basis for a motion for  
22 additional testimony or for subpoena. Accordingly, UC's request for such a  
23 motion is DENIED.

1 *New Evidence and Testimony in Reply Briefs*

2 Under the Standing Order “declaration evidence shall not be submitted with  
3 a reply” without authorization. SO ¶ 122.6. UC requests authorization to present  
4 new declaration evidence with its replies regarding six issues. (Notice, Paper 795,  
5 at 3:22-5:23.)

6 For each issue UC states that it disputes an allegation presented by Broad,  
7 but fails to explain why a new declaration is necessary to address it. For example,  
8 in regard to the second through sixth issues, UC argues that it disputes Broad’s  
9 assertions of how those of skill in the art would have understood certain facts or  
10 would have interpreted certain publications as explained by Broad’s witnesses.  
11 UC does not explain why it cannot challenge Broad about these facts or  
12 publications with cross-examination of Broad’s witnesses or by referring to  
13 contradictory portions of the cited documents.

14 UC has the burden of presenting a *prima facie* case for the relief it seeks in  
15 its motions. 37 C.F.R. § 41.121(b) (“The party filing the motion has the burden of  
16 proof to establish that it is entitled to the requested relief.”) “To be sufficient, a  
17 motion must provide a showing, supported with appropriate evidence, such that, if  
18 un rebutted, it would justify the relief sought.” 37 C.F.R. § 41.208(b). UC does not  
19 explain why relying on declaration evidence in its replies will show that it has met  
20 its burden in Motions 3 and 4. Though UC argues that Broad presents new  
21 arguments and evidence in its oppositions, UC does not show that Broad presented  
22 these arguments and evidence for any other reason than to challenge the *prima*  
23 *facie* case in each of UC’s motions. If UC disputes these arguments and evidence,  
24 it is not clear why UC cannot address them with specific questioning of Broad’s

1 witnesses to show the deficiencies or by showing that Broad's arguments lack  
2 support or relevance.

3 In regard to the first issue, UC requests authorization to submit expert  
4 testimony demonstrating that none of Broad's asserted best proofs meets the  
5 requirement of either Count 1 or proposed Count 2. (Notice, Paper 795, at 4:7-15.)  
6 Again, UC merely states that it disputes Broad's allegations, but does not provide  
7 any explanation why new declaration testimony is needed in UC's reply. We note  
8 further that UC states that the requested testimony would "demonstrate[e] that  
9 none of Broad's alleged best proofs meet the requirements of either existing Count  
10 1 or proposed Count 2." (Notice, Paper 795, at 4:13-15.) Whether or not Broad's  
11 proofs are within the scope of Count 1 is an issue for priority, which is premature  
12 at this point in the proceeding. UC has failed to explain why it needs additional  
13 testimony to make its arguments about Broad's best proofs.

14 Accordingly, it is ORDERED that Broad is NOT AUTHORIZED to file a  
15 motion regarding the submission of new declaration testimony with its reply briefs.

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**ERRATA**

- 1 On 18 September 2016, the parties contacted the Board to request
- 2 confirmation that the Order entered 14 September 2016 (Paper 801) contained
- 3 certain errors.

4 It is ORDERED that the Order (Paper 801) is corrected to read at page 2,  
5 lines 13-16: “UC asserts that it requires testimony from Dr. Lin to address Broad’s  
6 allegations in Broad Opposition 4 in opposition to UC’s argument that the Jinek  
7 2012 publication “triggered and guided the work” of the Broad scientists and that  
8 the Broad scientists had commenced their work in 2011.”

9 It is further ORDERED that the Order (Paper 801) is corrected to read at  
10 page 5, lines 14-15: “Accordingly, it is ORDERED that ~~Broad~~ UC is NOT  
11 AUTHORIZED to file a motion regarding the submission of new declaration  
12 testimony with its reply briefs.”

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