

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, UNIVERSITY
OF VIENNA, AND EMMANUELLE CHARPENTIER**
Junior Party

(Applications 15/947,680; 15/947,700; 15/947,718; 15/981,807;
15/981,808; 15/981,809; 16/136,159; 16/136,165; 16/136,168; 16/136,175;
16/276,361; 16/276,365; 16/276,368; and 16/276,374),

v.

**THE BROAD INSTITUTE, INC., MASSACHUSETTS INSTITUTE OF
TECHNOLOGY, and PRESIDENT AND FELLOWS OF HARVARD
COLLEGE,**
Senior Party

(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,
9,840,713, and Application 14/704,551).

Patent Interference No. 106,115 (DK)
(Technology Center 1600)

**Decision on CVC Miscellaneous Motion 1
(to seal priority statement)
37 C.F.R. § 41.125(b)**

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1 Before: SALLY GARDNER LANE, JAMES T. MOORE, and DEBORAH KATZ,
2 *Administrative Patent Judges.*

3
4 KATZ, *Administrative Patent Judge.*

5
6 Junior Party the Regents of the University of California, University of
7 Vienna, and Emmanuelle Charpentier (“CVC”) filed Miscellaneous Motion 1
8 requesting that its priority statement be filed under seal. (*See* Paper 53.)
9 Specifically, CVC requests that its priority statement remain confidential until
10 45 days after a final judgment is issued or indefinitely and also that it be provided
11 with a 45 day window after final judgment to file a motion to expunge. (*See* CVC
12 Misc. Motion 1, Paper 53, 1:12–18.) In the alternative, CVC requests that its
13 priority statement be filed under seal until after the Board issues a scheduling order
14 for the priority phase and that CVC be allowed to file a renewed motion to
15 expunge, for example if the count has changed. (*See* CVC Misc. Motion 1, Paper
16 53, 1:19–2:2.) Senior Party Broad Institute, Inc., Massachusetts Institute of
17 Technology, and President and Fellows of Harvard (“Broad”) filed an opposition.
18 (*See* Paper 73.)

19 CVC argues that there is good cause to maintain its priority statement as
20 confidential because the statement will contain sensitive research and development
21 information that would be otherwise kept confidential. (*See* CVC Misc. Motion 1,
22 Paper 53, 2:4–8.) CVC asserts that there are several third-party competitors in the
23 field of CRISR-Cas9 gene editing technology and that it will be prejudiced in any
24 potential interference with these parties if its confidential research and

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1 development information were to be made public. (*See* CVC Misc. Motion 1,
2 Paper 53, 2:8–18.)

3 CVC argues that the purpose of maintaining priority statements as
4 confidential is to ensure that the parties’ statements are not tainted by hindsight in
5 having had advance notice of the other’s asserted dates and evidence. (CVC Misc.
6 Motion 1, Paper 53, 2:19–3:12, citing *Goutzoulis v. Athale*, 15 USPQ2d 1461
7 (Comm’r Patents March 30, 1990) and REVISE & CAESAR, INTERFERENCE
8 PRACTICE AND LAW § 86 (“The purpose of requiring preliminary statements
9 from the parties to an interference is to obtain from them an honest statement of the
10 essential facts and dates upon which they may have to rely to prove priority of
11 invention.”).)

12 CVC’s concerns are that three entities (Sigma-Aldrich, ToolGen, and
13 Vilnius University), which are not involved in this interference, would have an
14 unfair advantage if CVC’s priority statements were publicly available. (*See* CVC
15 Misc. Motion 1, Paper 53, 6:12–9:2.) CVC argues that these third parties have
16 pending patent applications with filing dates within about ten months of the filing
17 date of the CVC applications’ earliest provisional application and that the
18 applications have claims CVC characterizes as being “allegedly directed to similar
19 subject matter as the CRISPR-Cas9 invention at issue here.” (CVC Misc. Motion
20 1, Paper 53, 7:9–14, citing U.S. Appl. No. 14/685,568.) CVC asserts that at least
21 some of these parties have argued that their claims interfere with CVC’s currently
22 involved claims or with Broad’s currently involved claims. (*See* CVC Misc.
23 Motion 1, Paper 53, 7:14–23, citing Petition in Applications 15/188,911,
24 15/188,924, and 15/456,204, Ex. 4001.) CVC asserts further that Broad announced

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1 a partnership with at least one of these parties to offer licenses to their respective
2 intellectual property. (*See* CVC Misc. Motion 1, Paper 53, 8:1–3, citing Ex. 4004.)

3 CVC argues:

4 It would be prejudicial to CVC for its priority statement to be available to
5 non-interference parties, including Sigma-Aldrich, ToolGen, and other
6 competitors, who may attempt to use the sensitive research and development
7 information in that statement against CVC in future interferences, in
8 prosecution before the Patent Office, or as unfair leverage in public
9 announcements or licensing negotiations.

10
11 (CVC Misc. Motion 1, Paper 53, 8:5–9.) According to CVC, “[e]ven if the Board
12 enters judgment against Broad in this Interference, CVC may nonetheless be drawn
13 into an interference with any one or more of these parties who filed applications
14 before Broad.” (CVC Misc. Motion 1, Paper 53, 8:19–21.)

15 We agree with Broad that CVC’s argument is based on speculation. (*See*
16 Broad Opp. 1, Paper 73, 5:5–11.) No interference has been declared between CVC
17 and any applications or patents other than those named in this interference. Thus,
18 no count has been used to describe interfering subject matter between any of
19 CVC’s applications or patents and any other applications or patents. CVC presents
20 no evidence that any of the claims it asserts might interfere with CVC’s own
21 claims have been determined to be allowable. Thus, even if, as CVC argues, there
22 might be “future interferences,” it is unknown what the counts would be in such
23 interferences and therefore, what showing would be needed to prevail on priority.

24 Given that our rules require “[t]he record of a Board proceeding [be]
25 available to the public unless a patent application not otherwise available to the
26 public is involved” 37 C.F.R. § 41.6(b)(1) and CVC’s involved applications are

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1 otherwise public, we are not persuaded that CVC’s priority statements should be
2 maintained in confidence indefinitely. (*See* CVC Misc. Motion 1, Paper 53, 1:15–
3 17.)

4 Furthermore, “the board has a well-established and firm policy of having its
5 judgments subject to public scrutiny when one or more of the involved files
6 becomes public.” *Fletcher v. Leib*, 72 U.S.P.Q.2d 1701, 1703 (BPAI 2004). (*See*
7 Broad Opp. 1, Paper 73, 2:19–3:18.) This policy is the basis for 37 C.F.R.
8 § 1.11(e), wherein “the file of any interference or trial before the Patent Trial and
9 Appeal Board is open to public inspection” Thus, we strive towards making
10 all filings in an interference public at least by the time we issue a final judgment.
11 CVC requests that we order its priority statement to be held under seal until 45
12 days after we issue a final judgment. (*See* CVC Misc. Motion 1, Paper 53, 1:15–
13 17.) At this time, we are not persuaded that there is a good reason to maintain
14 CVC’s priority statement under seal even after a judgment has been issued. CVC
15 may request authorization to file a renewed request for seal when a final judgment
16 is entered, if specific circumstances warrant it.

17 CVC’s alternative request is that we order seal of CVC’s priority statement
18 until after the Board issues a scheduling order for the priority phase. (*See* CVC
19 Misc. Motion 1, Paper 53, 1:19–21.) CVC argues that there is no public interest or
20 private interest between the parties in having access to priority statements if the
21 interference is not decided on the basis of priority. (*See* CVC Misc. Motion 1,
22 Paper 53, 9:15–17.) CVC also argues that the Board’s rules allow for priority
23 statements to remain in confidence, citing 37 C.F. R. § 41.120(a) (“The Board may
24 require a party to provide a notice stating the relief it requests and the basis for its

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1 entitlement to relief. The Board may provide for the notice to be maintained in
2 confidence for a limited time.”). CVC cites to the uncertain status of the current
3 count, in light of Broad’s anticipated motion to change it and the possibility of
4 settlement, as reasons that diminish the public interest in CVC’s priority statement.
5 (See CVC Misc. Motion 1, Paper 53, 9:20–10:2.)

6 In light of our rule allowing priority statements to be maintained in
7 confidence for a limited time, CVC’s arguments to seal its priority statement until
8 a priority phase has been scheduled has merit. In opposition, Broad argues that it
9 would be prejudiced by such an order because “Broad’s potential licensees,
10 commercial partners, and the public will not be able to evaluate for themselves
11 CVC’s claims to priority, and Broad’s patents will continue to be subject to the
12 uncertainty CVC has sought to create around them since suggesting the 048
13 Interference four years ago.” (Broad Opp. 1, Paper 73, 6:4–7.) Broad argues that

14 [i]f [it] cannot inform the public of the basis for its defenses due to a
15 Protective Order on facts that have not been treated as confidential, then
16 Broad is prejudiced. A Protective Order would act to tie Broad’s hands in
17 explaining the defense of its eukaryotic CRISPR claims to the public, while
18 CVC apparently intends to continue to attack Broad’s patents in the public
19 forum.

20
21 (Broad Opp. 1, Paper 73, 6:16–20.)

22 We are not persuaded by Broad’s arguments that CVC’s priority statements
23 must be made publicly available at this time. Broad refers to CVC’s basis for
24 priority, but such evidence will not be made in full until the filing of a priority
25 motion and then only if the interference continues to a priority phase. At this time,
26 Broad cites only to CVC’s statements that the current interference “jeopardizes

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1 essentially all of the Broads' CRISPR patents involving eukaryotic cells." (*See*
2 Broad Opp. 1, Paper 73, 6:9–11; *see also id.* at 2:7–13.) The statement that Broad
3 highlights does not refer to anything about either party's priority dates or
4 arguments. Thus, it is not clear why Broad would not be able to defend the priority
5 of its claims if CVC's priority statement is kept under seal before a priority phase.

6 CVC has persuaded us there is sufficient reason to delay public access to its
7 priority statement until the count has been finally determined and a priority phase
8 scheduled. Broad has not provided sufficiently persuasive arguments why it will
9 be prejudiced by an order to keep CVC's priority statement under seal until such
10 time. Accordingly, we grant CVC's miscellaneous motion to the extent the CVC's
11 protective order is kept under seal until a priority phase of this interference is
12 scheduled.

13 It is ORDERED that CVC submit a revised proposed protective order to
14 keep CVC's priority statement under seal until a priority phase of this interference
15 is scheduled by **7 November 2019**.

16
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cc (via e-mail):

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