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EXAMINER	
DUNSTON, JENNIFER ANN	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
PATENT TRIAL AND APPEAL BOARD

Ex parte FUQIANG CHEN and
GREGORY D. DAVIS

Application 15/188,911
Technology Center 1600

DECISION ON PETITION

This is a decision dismissing Applicants' "URGENT PETITION TO THE DIRECTOR UNDER 37 C.F.R. §§ 1.181-1.183 AND TO THE CHIEF ADMINISTRATIVE PATENT JUDGE UNDER 37 C.F.R. §§ 41.3 & 41.103 . . ." filed July 19, 2019 ("petition"). In the petition, Applicants request that the Chief Administrative Patent Judge declare an interference between The Regents of the University of California et al. v. Sigma-Aldrich, in parallel with recently declared interference no. 106,115 between numerous applications of The Regents of the University of California et al. and numerous patents and one application of The Broad Institute Inc. et al. Petition 1. The petition fee of $400.00 pursuant to 37 C.F.R. § 41.20(a) was charged to Applicants' deposit account on July 22, 2019.

PROCEDURAL HISTORY

1. On June 21, 2016, application no. 15/188,911 ("the '911 application") was filed.
2. On August 12, 2016, a non-final Office action was mailed.
3. Prosecution was conducted and on December 30, 2016, a final Office action was mailed.
4. On April 17, 2017, prosecution was re-opened and a second non-final Office action was mailed.
5. Prosecution continued and on February 8, 2018, a second final Office action was mailed.
6. A Notice of Appeal was filed on August 7, 2018.
7. Prosecution continued and on December 14, 2018, a third final Office action was mailed.
8. A Request for Continued Examination (RCE) was filed, accompanied by an amendment and a petition to make the application special, on April 29, 2019.
9. On May 2, 2019, the decision granting the petition to make special was mailed.
10. On July 18, 2019 a non-final Office action was mailed.
11. Applicants filed the instant petition on July 19, 2019.

RELEVANT AUTHORITY

37 C.F.R. § 41.3(a) and (b) provide:

> (a) *Deciding official.* Petitions must be addressed to the Chief Administrative Patent Judge. A panel or an administrative patent judge may certify a question of policy to the Chief Administrative

Patent Judge for decision. The Chief Administrative Patent Judge may delegate authority to decide petitions.

(b) *Scope*. This section covers petitions on matters pending before the Board (§§ 41.35, 41.64, 41.103, and 41.205); otherwise, see §§ 1.181 to 1.183 of this title. The following matters are not subject to petition:

(1) Issues committed by statute to a panel, and

(2) In pending contested cases, procedural issues. See § 41.121(a)(3) and § 41.125(c).

37 C.F.R. § 41.100 provides in pertinent part:

In addition to the definitions in § 41.2, the following definitions apply to proceedings under this subpart:

. . .

Involved means the Board has declared the patent application, patent, or claim so described to be a subject of the contested case.

37 C.F.R. § 41.102 provides:

Before a contested case is initiated, except as the Board may otherwise authorize, for each involved application and patent:

(a) Examination or reexamination must be completed, and

(b) There must be at least one claim that:

(1) Is patentable but for a judgment in the contested case, and

(2) Would be involved in the contested case.

37 C.F.R. § 41.103 provides:

The Board acquires jurisdiction over any involved file when the Board initiates a contested case. Other proceedings for the involved file within the Office are suspended except as the Board may order.

DISCUSSION

In a single petition, Applicants have included multiple petitions filed under different regulations. Specifically, Applicants (1) PETITION TO THE DIRECTOR UNDER 37 C.F.R. §§ 1.181-1.183; and (2) PETITION

TO THE CHIEF ADMINISTRATIVE PATENT JUDGE UNDER 37 C.F.R. §§ 41.3 & 41.103.

In accordance with 37 C.F.R. § 1.4(c):

> [E]ach distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Patent Owner's petition is not in compliance with 37 C.F.R. § 1.4(c), because it appears to be directed to different matters, which are considered by different branches or sections of the Office. For example, Applicants appear to have filed a petition under 37 C.F.R. § 41.3, to request that the Patent Trial and Appeal Board (Board) declare an interference pursuant to 37 C.F.R. § 41.103. Petition 1. Applicants also appear to be requesting supervisory review of the Examiner's non-final Office action in the petition under 37 C.F.R. § 1.181, which is delegated to the Technology Center 1600 for a decision. *Id.* at 4–6. Applicants further appear to be requesting that the Director of the USPTO suspend or waive its regulations under 37 C.F.R. § 1.183 and permit Applicants to forego the completion of the examination of their applications, and go straight to the declaration of an interference prior to a determination by the Patent Examining Corps that at least one of the Applicants' claims are patentable. *Id.* at 6–11. Therefore, the petition is **improper** pursuant to 37 C.F.R. § 1.4(c). Nevertheless, we address Applicants' request below.

In the petition, Applicants request that the Chief Administrative Patent Judge declare an interference between The Regents of the University of California et al. v. Sigma-Aldrich in parallel with recently declared interference no. 106,115 between numerous applications of The Regents of

the University of California et al. and numerous patents of The Broad Institute Inc. et al. Petition 1. Applicants state that:

> On Monday, June 24, 2019, the PTAB declared a patent interference directed to CRISPR-Cas9-based methods and compositions of matter in eukaryotic cells (e.g., human and animal cells). Int. No. 106,115 (The Regents of The University of California et al. v. The Broad Institute Inc. et al.) (individually, "UC" and "Broad Inst."; together, "UC v. Broad Inst."). Sigma-Aldrich's pending patent applications (e.g., Serial Nos. 15/188,911, 15/456,204, and 15/188,924) are also directed to CRISPR-Cas9-based methods in eukaryotic cells. Of critical importance here, Sigma-Aldrich's benefit applications **pre-date** the earliest possible benefit applications involved in the UC v. Broad Inst. interference with respect to their respective disclosures of CRISPR-Cas9 in eukaryotic cells. *See infra* Fig. 1. For the effective administration of justice, efficiencies of the USPTO and the parties, conservation of considerable valuable resources, and the public interest, Sigma-Aldrich respectfully requests that the PTAB declare a parallel interference between Sigma-Aldrich and UC.
>
> Sigma-Aldrich recognizes, of course, that its pending applications' claims have not yet been allowed, and thus declaring a patent interference now would - in ordinary circumstances - be premature. However, the facts here are truly ***extra***ordinary, and Sigma-Aldrich feels compelled to apprise the Director and the CAPJ of the current situation and to briefly explain why the PTAB's declaration of a parallel interference in this instance would be in the long-term best interests of everyone, including the USPTO, the parties, and the public. Indeed, the sole issue raised by this Petition has already been effectively decided by both the PTAB and the Federal Circuit, and those decisions completely support Sigma-Aldrich's request here; namely, does UC's disclosure of CRISPR-Cas9 in *in vitro* cell-free and nucleus-free test tube environments (hereinafter, "prokaryotic environment") render obvious claims directed to CRISPR-Cas9 in eukaryotic cells? The controlling

> answer to this question is decidedly "no." Sigma-Aldrich respectfully submits that the PTAB's and the Federal Circuit's "no" answer compels the grant of this Petition.

Id. at 1–2.

In the '911 application, the Examiner entered a non-final Office action on July 18, 2019, in which claims 1, 6–11, and 13–27 are rejected. To the extent Applicants believe that the Examiner erred in that Office action, Applicants may appeal that decision to the Board under 37 C.F.R. § 41.21. Because at least one of Applicants' claims has not been found patentable, and examination of the application has not been completed in accordance with 37 C.F.R. § 41.102, Applicants' request to declare an interference is premature.

Additionally, even if we exercised our discretion and reviewed Sigma-Aldrich's and UC's claims for purposes of declaring an interference, Applicants have failed to demonstrate that an interference is warranted. Specifically, Applicants' petition does not comply with the requirements of 37 C.F.R. §§ 41.202(a) and 41.203(d) for suggestions regarding an interference or the addition of an application to an interference. In suggesting an interference, among other things, an applicant "must" identify all claims that the applicant believes interfere, as well as propose one or more counts, and how the claims correspond to the proposed count(s). 37 C.F.R. § 41.202(a). Further, the applicant "must" explain why the applicant will prevail on priority for the proposed counts. *Id.* Absent such information, the Board lacks a sufficient basis to entertain the suggestion of an interference. Accordingly, based on the premature nature of Applicant's

request, and the lack of sufficient information to suggest an interference, Applicants' petition is dismissed without prejudice.

DECISION

In view of the forgoing, the petition is DISMISSED.

The '911 application is before the Patent Examining Corps to await receipt of a response to the outstanding non-final Office action.

Scott C. Weidenfeller
Vice Chief Administrative Patent Judge

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