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Filed: 1 March 2021

Tel: 571-272-9797

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)

Memorandum

Before, DEBORAH KATZ, *Administrative Patent Judge*.

Interference 106,115

1 A conference call was held on 12 February 2021 at approximately 2:00 pm
2 Byron Pickard, Eldora Ellison, Li-Hsien Rin-Laures, and Sandip Patel were present
3 for Junior Party (“CVC”). Steven Trybus and Raymond Nimrod were present for
4 Senior Party (“Broad”). Deborah Katz was present for the Board.

5 CVC requested the conference call seeking an order to “sequester” members
6 of Broad’s legal teams for the upcoming depositions of two of Broad’s witnesses,
7 Drs. Breaker and Ellington, because Dr. Breaker adopted the entirety of
8 Dr. Ellington’s direct testimony as his own testimony in paragraphs 25 and 32 of
9 his declaration (Ex. 3444). (*See Appendix.*) According to CVC, the cross-
10 examinations of Drs. Breaker and Ellington will significantly overlap and without
11 sequester of Broad’s counsel the second witness to be deposed may be prepared
12 knowing what questions will be asked. CVC argues that this would be an unfair
13 advantage to Broad, prejudicing CVC. CVC refers to an agreement between the
14 parties in Interference 106,048, wherein CVC agreed to sequester its counsel. (*See*
15 *id.*)

16 Broad opposes CVC’s request for an order requiring sequestration, arguing
17 that the sequestration agreement in Interference 106,048 was part of a compromise
18 agreement in light of Broad’s reportedly timely objections to CVC’s evidence.
19 (*See Appendix.*) Broad argues that in the current interference, CVC did not object
20 to the reference to another expert’s declaration and agreed to a deposition schedule
21 with no sequestration. (*See id.*)

22 CVC did not cite a basis in the Standing Order or elsewhere for the Board to
23 impose a sequestration of counsel as requested. It is not clear why, in the current
24 situation, deposition of a witness who agrees with another witness and adopts the

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1 other's testimony would be prejudicial to CVC and require ordered sequestration
2 when witnesses who otherwise testify to the same facts would not be. In both
3 cases the witnesses' testimonies will be made under oath and they must testify
4 based on their own knowledge and experience.

5 That the parties reached an agreement on deposition procedures in a
6 different proceeding is not binding on the Board. The parties are free to reach an
7 agreement in this proceeding and to agree to any deposition scheduling that
8 complies with the time constraints of the interference schedule and other rules or
9 orders. Furthermore, CVC will have an opportunity to argue that any witness's
10 testimony should be given no weight, because of contradictory testimony or other
11 evidence, or that it should be excluded. Because CVC has failed to persuasively
12 explain why counsel should be sequestered for the depositions of Drs. Breaker and
13 Ellington, no order is issued.

cc (via e-mail):

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Eric K. Steffe
David H. Holman
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Interference 106,115

Appendix

From: Trybus, Steve <Steven.Trybus@lockelord.com>
Sent: Tuesday, February 9, 2021 10:35 PM
To: Byron Pickard <BPICKARD@sternekessler.com>; Trials <Trials@USPTO.GOV>
Cc: 'raynimrod@quinnemanuel.com' <raynimrod@quinnemanuel.com>;
'matthewrobson@quinnemanuel.com' <matthewrobson@quinnemanuel.com>;
'michaelmitrayon@quinnemanuel.com' <michaelmitrayon@quinnemanuel.com>;
PATENT@LOCKELORD.COM; Eldora L. Ellison <EELLISON@sternekessler.com>; Eric Steffe
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Subject: RE: Interference 106,115 (DK)

Your Honors

This email is in response to CVC's email today requesting a conference call about CVC's last-minute and unusual request that Broad's legal team be split and Broad's counsel be sequestered between the depositions of Broad's two scientific experts.

Broad provides the following background:

- CVC raised this request for the first time yesterday.
- CVC's request was reportedly due to the change in order of the depositions such that Dr. Ellington's deposition was moved last; per CVC, they "plan to cross-examine Breaker on this incorporated testimony" and would allegedly be prejudiced "given that Ellington will testify after Breaker....That is, anyone who is present for Breaker's deposition (or later reads the transcript of that deposition) will effectively have a preview of the questions we are likely to pose to Ellington at his deposition."
- The deposition of Dr. Breaker has now moved to a date after Dr. Ellington's deposition which restores the original order of the witnesses and still allows the depositions to be completed three weeks prior to the deadline for filing Opposition briefs.

As to the agreement from the 048 Interference, the circumstances are completely different here. In the 048 Interference, CVC presented two separate expert witnesses with inexplicably verbatim identical declarations over 200 pages, neither of which referred to the other one and, as it turned out, both were unaware that they gave identical testimony. Broad timely objected and the parties reached a compromise agreement including sequestration as part of the resolution of a number of issues, none of which are present here. Here, Broad's expert Dr. Breaker straightforwardly reviewed Dr. Ellington's testimony and agreed with it. CVC did not object to the reference to another expert's declaration and agreed to a deposition schedule with no sequestration.

Respectfully submitted,
Steven Trybus
Counsel for Senior Party

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From: Byron Pickard <BPICKARD@sternekessler.com>
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Cc: 'raynimrod@quinnemanuel.com' <raynimrod@quinnemanuel.com>; 'matthewrobson@quinnemanuel.com' <matthewrobson@quinnemanuel.com>; 'michaelmitrayon@quinnemanuel.com' <michaelmitrayon@quinnemanuel.com>; Trybus, Steve <Steven.Trybus@lockelord.com>; Patent Docketing <Patent@lockelord.com>; Eldora L. Ellison <EELLISON@sternekessler.com>; Eric Steffe <ESTEFFE@sternekessler.com>; David H. Holman <DHOLMAN@sternekessler.com>; Byron Pickard <BPICKARD@sternekessler.com>; External-Lily <lily@rinlauresip.com>; External-S Patel <spatel@marshallip.com>
Subject: Interference 106,115 (DK)

**** External email ****

Dear PTAB:

Junior Party CVC respectfully requests a conference call concerning the need to sequester Senior Party Broad's legal teams for the upcoming depositions of two Senior-Party expert witnesses, Drs. Breaker and Ellington.

The parties are available for a conference Wednesday February 10, 2020 from 2:30-4:30.

CVC is scheduled to depose two Broad's expert witnesses, Dr. Breaker on Friday February 12 and Dr. Ellington on March 3. Because Dr. Breaker has adopted the entirety of Dr. Ellington's 177-pages of direct testimony as his own (see Ex. 3444, Breaker Decl. at paras. 25 and 32), CVC's cross-examination of the two witnesses will have a significant overlap in the questions that are put to the witnesses. As a result, anyone attending (or reading the transcript) of Dr. Breaker's deposition will have a preview of the very questions that are likely to be put to Dr. Ellington at his deposition next month. In the absence of appropriate remedial steps, the Broad's decision to introduce identical testimony through two expert witness gives it an unfair advantage in preparing the latter-deposed for cross-examination, thereby prejudicing CVC.

Notably, a similar issue of two witnesses presenting similar testimony arose during the '048 Interference between the same parties. There, Broad had asked that CVC follow a sequestration protocol, CVC and Broad resolved that issue without the PTAB's involvement. Specifically, CVC agreed that its counsel and representatives present at (or having read) its first expert witness's cross-examination would not thereafter participate in the preparation of its second expert witness's cross-examination or to be present for the second expert witness's cross-examination. CVC proposed Broad follow the same sequestration protocol here. In response, Broad stated that CVC's proposal was "not necessary or workable here."

Thank you for your attention to this matter.

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Sincerely,

Byron Pickard

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