Filed on behalf of Junior Party Paper No. ___

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA,
UNIVERSITY OF VIENNA, AND EMMANUELLE CHARPENTIER

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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)

CVC OPPOSITION TO CONTINGENT RESPONSIVE MOTION 6

(for correction of inventorship)

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As authorized by Paper No. 2458, CVC submits this opposition to Broad's Contingent Responsive Motion 6 to correct inventorship of its involved patents and patent application.

I. PRECISE RELIEF REQUESTED

Broad's motion should be denied because Broad has not met its burden of establishing that anyone should be added as inventors of Broad's involved patents and application. Broad's motion also should be denied because Shauiliang Lin never consented to be added as an inventor, as required by 35 U.S.C. § 256. In addition, Broad's request is equitably barred due to laches and because it is made in bad faith. Broad's motion is further defective because only the Director may issue a certificate of correction naming the actual inventors, and Broad has made no showing that the Director delegated this authority to the PTAB. *See* 35 U.S.C. § 256; 37 C.F.R. § 1.324; MPEP § 1412.04.

II. DESCRIPTION OF APPENDIX

Appendix 1 is a list of cited Exhibits. Appendix 2 is a Statement of Material Facts.

III. ARGUMENT

Broad has failed to establish—as it must under 37 C.F.R. § 41.121(b)—that it is entitled to its requested relief of correcting inventorship under 35 U.S.C. §§ 116 and 256. In its motion, Broad ignores the clear language of 35 U.S.C. § 256, which requires that Broad provide "proof of facts" and an "application of all the parties" to correct inventorship. But Broad's motion does not even state who it believes should be listed as inventors—much less provide the facts demonstrating that such unnamed persons meet the requirements of inventorship.

In any event, even if Broad met its burden of demonstrating who were the proper inventors of its patents and application—which it did not—its request fails for multiple other reasons. Broad has not provided the consent of Shauiliang Lin to be added as an inventor to the

involved patents, as it must under the statute. MF 48. Moreover, Broad's motion to correct is barred by laches and because it is made in bad faith. Finally, Broad's motion fails because it has not shown that the PTAB—as opposed to the Director—has the authority to issue a certificate of correction naming the actual inventors and thus formally changing inventorship.

A. Broad's Motion Should Be Denied Because Broad Has Not Met Its Burden to Correct Inventorship

On page 3, lines 17-20 of Broad's motion, Broad argues that it satisfies the requirements for correction of inventorship simply by paying applicable fees and setting forth consent statements by the named and unnamed potential inventors[1] and assignees. CVC's response is that Broad is wrong. To correct the inventorship of its patents, 35 U.S.C. § 256 requires Broad to provide "*proof of the facts* and such other requirements as may be imposed." *See also Loken-Flack, LLC v. Novozymes Bioag, A/S*, No. 105,996, 2015 BL 165619, *2-3 (P.T.A.B. May 27, 2015) (denying motion for judgment that Loken was a joint inventor because the moving party had failed to meet its burden of proof by a preponderance of the evidence); Paper 2117, Appx. C-2. But Broad has not set forth *any* evidence in its motion that any unnamed inventors contributed to the conception of the claimed invention. MF 49. Indeed, Broad does not even identify the people who it believes should be added as inventors to each of its patents and patent application. MF 50.

As the movant, Broad bears the burden of establishing why it is entitled to its requested relief. 37 C.F.R. §41.121(b) ("The party filing the motion has the burden of proof to establish that it is entitled to the requested relief."). Specifically, Broad would need to explain how each (currently unidentified) person contributed to the conception of at least one claim of each of

[1] Except for unnamed potential inventor Shauiliang Lin. *See infra* Section III.B.

Broad's involved patents and application. And it would need to provide evidence to support those assertions. *See Henkel Corp. v. Proctor & Gamble Co.*, No. 105,174, 2008 WL 5783337, at *20-25 (B.P.A.I. Mar. 28, 2008) (granting P&G's motion to correct inventorship in view of P&G's "clear and sufficient evidence that McGregor collaborated with at least one named inventor[,] contributed in a not insignificant manner to the conception of at least one claim of the '564 patent[,] [and] that his contribution is corroborated by the evidence of record").

On page 5, lines 20-23 of Broad's motion, Broad blankly asserts that it is not required to concede that there are unnamed inventors to avail itself of the savings provisions of §§ 116 and 256. Broad is wrong. Section 256 just gives the Director *authority* to correct inventorship, but does not *require* him to do so. *See* 35 U.S.C. § 256 ("[T]he Director *may*, on application of all the parties and assignees…issue a certificate correcting such error"). Moreover, before doing so, 35 U.S.C. § 256 explicitly requires Broad to provide "proof of the facts and such other requirements as may be imposed." Broad cannot avoid the burden of proof that the statute and the regulations impose, § 41.121(b), and that the PTAB Order emphasized. *See* Order – Opposition and Reply to Contingent Motion (Paper No. 2458, dated December 29, 2020) (stating that Broad "will bear the burden of complying with the requirements of 37 C.F.R. § 1.324" in its motion, which in turn requires compliance with § 41.121).

Broad finds itself in the untenable position of, on the one hand, arguing that inventorship is correct and, on the other, having to affirmatively set forth why inventorship should be corrected. But this is a predicament of Broad's own making. Broad cannot dodge the consequences of its own litigation strategy that seeks to at once defend and correct inventorship.

To support its position that it need not concede incorrect inventorship, Broad points to *Pannu v. Iolab Corp.*, where the patent owner relied on 35 U.S.C. § 256 to save the patent at

issue from invalidity after a determination that the inventorship was in error. 155 F.3d 1344, 1350 (Fed. Cir. 1998). But in *Pannu*, the court found that "there exists sufficient evidence for a reasonable jury to find that Link was an actual inventor" including "based on Pannu's unrebutted testimony." *Id.,* 1351. In contrast, Broad has submitted no evidence from which the PTAB could find inventorship; indeed, as noted above, Broad has not even identified who ought to be listed as an inventor. MF 49-50.

At pages 2, 4, 5, and 6 of Broad's motion, Broad cites *Pannu* and other court decisions where a court ordered the Director to correct inventorship. But those decisions are not relevant here for an additional reason. In the context of an improper inventorship assertion in federal court proceedings, the statute offers a remedy to save a patent from a court judgment of invalidity, *see* Section 256 (stating that the "court before which [inventorship] is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly"), but the statute does not offer the patent owner the same remedy for *inter partes* proceedings before the PTAB. Instead, the patent owner must move the PTAB to cede its jurisdiction so the patent owner may request and convince the Director to issue it a certificate correcting inventorship—a motion Broad did not file. *See*, *infra*, Section III.D.

At bottom, Broad appears to believe that if CVC wins its motion on incorrect inventorship, then Broad automatically meets its burden to correct inventorship. But the situations are not symmetric. As CVC demonstrated, Broad made binding concessions that the inventorship of its PCT applications were wrong. Ex. 4295, ¶¶ 1-11, 15-17. MF 51-64. CVC's motion simply asserts that, as a matter of logic, those binding admissions must also apply to Broad's involved patents and application. Paper 1558, 9-13. CVC made a showing based on the

Kowalski Declaration and the PTAB should hold Broad to its own damning, litigation-driven admissions. In its contingent responsive motion, Broad could have, but elected not to, set forth all facts and evidence in line with Mr. Kowalski's analysis or more selectively sought corrections based on the evidence and involved claims. Broad did neither and its position that it can automatically correct invenotrship if CVC wins its motion is quite different than Broad meeting its burden of providing factual proof as to which persons should rightfully be named as inventors on its patents and application. Because Broad has failed to do so, its motion must be denied.

B. Even Under Broad's View of the Law, Broad Cannot Correct Inventorship of the Involved Patents as to Lin

On page 6, line 13 through page 7, line 6 of Broad's motion, Broad also argues that it may correct inventorship even though Lin has not agreed to be named as inventor. MF 48. CVC's response is this argument is foreclosed by the plain text of the statute. Specifically, 35 U.S.C. § 256(b) states that the "error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section." Subsection 256(a), in turn, requires that the Director may correct an error in inventorship only "on application of *all* parties…with proof of the facts and such other requirements as may be imposed" (emphasis added). In other words, the Office may impose additional requirements to correct inventorship—and it has via 37 C.F.R. § 1.324, which includes a requirement to pay fees, among other things—but the application must be made by all parties. *See also Iowa State Univ. Research Found., Inc. v. Sperry Rand Corp.*, 444 F.2d 406, 410 (4th Cir. 1971) ("when the Commissioner is asked to correct innocent errors of misjoinder or nonjoinder, all parties must apply for relief to comply with the requirements of the first and second paragraphs of § 256"). The PTAB cannot waive this statutory requirement. *See Chien Ming Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 1460 (Fed. Cir. 1988) (Office may not

waive "statutory requirement[s]" in issuing corrections); *Kimberly-Clark Corp. v. Proctor & Gamble Distributing Co.*, 973 F.2d 911, 917 (Fed. Cir. 1992) (the "Patent and Trademark Office cannot waive statutory requirements" of 35 U.S.C. § 116).

Finally, even if the PTAB could waive a statutory requirement—which it cannot—37 C.F.R. § 1.182 would not be the mechanism to do so. Section 1.182 applies only in "situations not specifically provided for in the regulations of this part." But the regulations already specifically provide for the situation where correction of inventorship is sought: compliance with 37 C.F.R. § 1.324. Thus, 37 C.F.R. § 1.182 cannot be called upon to avoid the specific statutory and regulatory requirements. Therefore, all of Broad's involved patents are invalid because Lin is an unnamed inventor on all of Broad's involved patents and application who does not agree to be added as inventor. MF 48.

C. Broad's Request is Blocked By Laches and the PTAB Should Address Allegations that Broad's Inventorship Determination Was Made in Bad Faith

Broad's request is not only too little; it is also too late. Because it comes long after Broad knew the correct inventorship of its patents and because it prejudices CVC, it is barred by laches.

Laches is an equitable defense that may bar an inventorship claim. *See Serdarevic v. Advanced Med. Optics, Inc.*, 532 F.3d 1352, 1360 (Fed. Cir. 2008). A rebuttable presumption of laches attaches if more than six years passes from the time "a purportedly omitted inventor knew or should have known of the issuance of the relevant patent." *Lismont v. Alexander Binzel Corp.*, 813 F.3d 998, 1002 (Fed. Cir. 2016). The Federal Circuit will also consider that the "reasonableness of the behavior of the person against whom laches is asserted depends on the facts of the particular case." *Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.*, 988 F.2d 1157, 1162 (Fed. Cir. 1993) (measuring the unnamed inventor's delay from the date he had information sufficient to place upon him a duty of inquiry because he was not involved in any

further work after the catheter's development and did not know a patent had been obtained). A rebuttal presumption of laches should apply here because Broad conducted inventorship studies in 2013 and therefore affirmatively investigated and knew the identities of the correct inventors eight years ago. Paper 1558, 17; MF 52, 63, 64. Yet, immediately after the inventorship studies, Broad intentionally and in bad faith failed to name certain inventors for each involved Broad patent and application. Paper 1558, 15-18.

In view of Broad's unreasonable behavior, the PTAB should find that a presumption of laches attaches. Indeed, the same patent attorneys responsible for prosecuting Broad's CRISPR patent portfolio swore under oath as to the inventorship per U.S. law of certain "inventive" contributions related to the use of CRISPR-Cas9 and were involved in the exclusion of those individuals from Broad's CRISPR patent filings in the United States involving the same contributions. *Id. See also* MF 51-64. Put simply, Broad's attorney, Mr. Kowalski, learned of the correct inventors to Broad's patents and communicated that knowledge to in-house counsel, Ms. Law, as early as 2013. Paper 1558, 17; MF 52, 63, 64. Yet, to achieve a strategic advantage—and without any excuse—Broad ignored this knowledge. Broad makes no attempt in its motion to explain why it is only seeking to correct inventorship now.

The Federal Circuit has affirmed the authority of the Board to invoke equitable laches as a ground to forfeit an applicant's rights. *In re Stephen B. Bogese II*, 303 F. 3d 1362 (Fed. Cir. 2002) (affirming Board's holding of prosecution history laches). Here, the Board should find that Broad has forfeited its rights and is barred by laches from correcting inventorship.

On page 5, lines 12-17 of Broad's motion, Broad asserts that correction of inventorship does not depend on its intent. Again, Broad is wrong. The intent of an interference party seeking a change of inventorship in the middle of the priority phase after submitting its priorty brief is

highly relevant. Given the consequences such a change may have, the candor with which that change is solicited is paramount. Deceptive intent and inequitable conduct would render a patent unenforceable, so the PTAB should address this issue and not permit correction of inventorship at this late stage due to laches and lack of good faith. Specifically, applicants have a duty to exercise candor and good faith in all dealings with the USPTO per 37 C.F.R. § 1.56, and the PTAB may not ignore evidence of deceptive intent. The Federal Circuit in *Stark v. Advanced Magnetics, Inc.* stated that the hypothetical situation involving an avowedly deceptive inventive entity "would call on the Commissioner or a court to determine whether the listed inventive entity committed inequitable conduct in filing a false oath." 119 F.3d 1551, 1555 (Fed. Cir. 1997). In the face of evidence that Broad intentionally misidentified the inventors of its involved patents and applications, as demonstrated by its own attorney's sworn declaration, and pursuant to the Federal Circuit's suggestion in *Stark*, the PTAB should address whether there was bad faith in the original inventorship determination and deny Broad's motion.

D. Broad's Motion is Defective Because it Failed to Show that the PTAB Has the Authority to Grant the Requested Relief

With respect to Broad's thirteen involved patents, Broad has not demonstrated that the PTAB, rather than the Director, has authority to grant Broad its requested relief. The statute provides that patent owner may request *the Director* to issue a certificate correcting an error in failing to name an inventor in an issued patent: "Whenever … through error an inventor is not named in an issued patent, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error." 35 U.S.C. § 256(a). This same statutory section continues that the "error of omitting inventors … shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section." *Id*. at § 256(b). Whether the error can be corrected, however, is the

Director's determination. Had Congress intended to grant that authority to the PTAB, it would have have said so.

The Federal Circuit recently addressed *how* a patent owner can seek to correct a patent involved in a proceeding before the PTAB. *Honeywell Int'l Inc. v. Arkema Inc.*, 939 F.3d 1345, 1349 (Fed. Cir. 2019) (addressing corrections under 35 U.S.C. § 255 and 37 C.F.R. § 1.323). The court's *Honeywell* decision recognizes and explains the process by which a patent owner may seek a certificate during a post grant review proceeding, but because the relevant language in the statute and rule the court addressed in that case is the same as in the statute and rule involved in this interference, *Honeywell* is instructive, if not controlling. To be sure, the Federal Circuit recently reiterated the well-known maxim that "when one statute 'tracks the wording of' another, there is a 'strong indication that the two statutes should be interpretated pari passu,' particularly if the provisions share a common purpose." *Uniloc 2017 L.L.C. v. Facebook Inc.*, Appeals 2019-1688, -1689, Slip Op. at 13 (Fed. Cir. Mar. 9, 2021) (quoting *Northcross v. Board of Ed. Of Memphis City Schools*, 412 U.S. 427, 428 (1973) (per curiam). Both statutory provisions—sections 255 and 256—share the common purpose of explaining how a patent owner may obtain correction of errors in a patent.

In *Honeywell*, the Federal Circuit explained that, to obtain a correction certificate, the patent owner had to sequentially: (1) seek the Board's authorization to file a motion; (2) file the authorized motion, asking the Board to cede its exclusive jurisdiction to permit the Director's consideration of a certificate; and, (3) if the motion is granted, ask the Director to issue a certificate. *Honeywell*, 939 F.3d at 1349. The court said that the Director—not the PTAB—decides whether to grant the certificate. The PTAB's role, said the court, is "to 'determine

whether there is sufficient basis supporting Patent Owner's position that the mistake may be correctable.'" *Id*.

Rather than following the clear path offered by the statute, rule, and Federal Circuit, Broad instead seeks to have the PTAB somehow issue it a certificate correcting inventorship of its thirteen involved patents. It is Broad's burden, as movant, to request the proper relief and support its motion with evidence and explanations. Broad's motion is therefore fatally defective because it has not sought grantable relief, much less a suitable request to the Director demonstrating its entitlement to correct its patents.

VII. CONCLUSION

For the foregoing reasons, Broad's Contingent Responsive Motion 6 should be denied in whole.

Respectfully submitted,

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APPENDIX 1 – LIST OF EXHIBITS

Exhibit No.	Description
Exhibit 3011	U.S. Patent No. 8,697,359, issued on April 15, 2014, to Feng Zhang ("the 359 Patent").
Exhibit 3013	U.S. Patent No. 8,895,308, issued on November 25, 2014, to Feng Zhang and Fei Ran ("the 308 Patent")
Exhibit 3014	U.S. Patent No. 8,906,616, issued on December 9, 2014, to Feng Zhang et al. ("the 616 Patent")
Exhibit 3015	U.S. Patent No. 8,771,945, issued on July 8, 2014, to Feng Zhang ("the 945 Patent")
Exhibit 3016	U.S. Patent No. 8,889,356, issued on November 18, 2014, to Feng Zhang ("the 356 Patent")
Exhibit 3017	U.S. Patent No. 8,865,406, issued on October 21, 2014, to Feng Zhang and Fei Ran ("the 406 Patent")
Exhibit 3022	U.S. Patent No. 8,945,839, issued on February 3, 2015, to Feng Zhang ("the 839 Patent")
Exhibit 3024	U.S. Patent No. 8,993,233, issued on March 31, 2015 to Feng Zhang et al. ("the 233 Patent")
Exhibit 3027	U.S. Patent No. 8,795,965, issued on August 5, 2014, to Feng Zhang ("the 965 Patent")
Exhibit 3029	U.S. Patent No. 8,871,445, issued on October 28, 2014, to Le Cong and Feng Zhang ("the 445 Patent")
Exhibit 3037	U.S. Patent No. 8,932,814, issued on January 13, 2015, to Le Cong and Feng Zhang ("the 814 Patent")
Exhibit 3043	U.S. Patent 9,840,713, issued on December 12, 2017 to Feng Zhang ("the 713 Patent")
Exhibit 3047	U.S. Patent No. 8,999,641, issued on April 7, 2015 to Feng Zhang et al. ("the '641 Patent")
Exhibit 3050	U.S. Patent Application No. 14/704,551, filed on May 5, 2015 to Feng Zhang et al. ("the '551 Application")
Exhibit 4295	Thomas Kowalski Declaration filed in Opposition of European Patent No. EP 2771468, executed on June 15, 2016, 16 pages
Exhibit 4313	The Broad Institute, Inc.; Massachesetts Institute of Technology; President and Fellow of Harvard College, Submission in opposition proceedings, Opposition of European Patent No. EP 2771468, filed June 30, 2016, 3 pages
Exhibit 4323	File History for U.S. Pat. Appl. No. 14/324,960
Exhibit 5260	Deposition transcript of Le Cong, with errata, Patent Interference No. 106,115 (February 1, 2021)
Exhibit 5262	Deposition transcript of Feng Zhang, Ph.D., with errata, Patent Interference No. 106,115 (February 9, 2021)
Exhibit 6059	Emails from December 14, 2012 through December 16, 2020 from Steven Trybus to Shuailiang Lin, 4 pages

APPENDIX 2 – STATEMENT OF MATERIAL FACTS

Broad's Alleged Facts 1-47

1. If the PTAB grants CVC Substantive Motion 3 in whole or in part as to the involved patents, there has been a determination that there has been error in not naming an inventor on an issued patent.

RESPONSE: Admitted that there is an error but denied that the error is correctable.

2. If the PTAB grants CVC Substantive Motion 3 in whole or in part as to the involved application 14/704,551, there has been a determination that there has been error in not naming an inventor on the application.

RESPONSE: Admitted that there is an error but denied that the error is correctable.

Patents

3. U.S. Patent No. 8,697,359 was filed on October 15, 2013, issued on April 15, 2014, and names Feng Zhang as an inventor. Ex. 3011, face page.

RESPONSE: Admitted.

4. CVC alleges that Le Cong, Patrick Hsu, Shuailiang Lin, Randall Platt, and Fei Ran should be added as inventors of U.S. Patent No. 8,697,359. Paper 1558, 7.

RESPONSE: Admitted.

5. The necessary consents of the current inventor, the assignees, and the alleged unnamed inventors to add one or more of Le Cong, Patrick Hsu, Randall Platt, and Fei Ran, as inventors to U.S. Patent No. 8,697,359 are submitted herewith. Paper 2117, Appx. C.

RESPONSE: Denied.

6. U.S. Patent No. 8,771,945 was filed on February 18, 2014, issued on July 8, 2014, and names Feng Zhang as an inventor. Ex. 3015, face page.

RESPONSE: Admitted.

7. CVC alleges that Le Cong, Patrick Hsu, Shuailiang Lin, Randall Platt, and Fei Ran should be added as inventors of U.S. Patent No. 8,771,945. Paper 1558, 7.

RESPONSE: Admitted.

8. The necessary consents of the current inventor, the assignees, and the alleged unnamed inventors to add one or more of Le Cong, Patrick Hsu, Randall Platt, and Fei Ran as inventors to U.S. Patent No. 8,771,945 are submitted herewith. Paper 2117, Appx. D.

RESPONSE: Denied.

9. U.S. Patent No. 8,795,965 was filed on February 18, 2014, issued on August 5, 2014, and names Feng Zhang as an inventor. Ex. 3027, face page.

RESPONSE: Admitted.

10. CVC alleges that Randall Platt, Le Cong, Fei Ran, Patrick Hsu, and Shuailiang Lin should be added as inventors of U.S. Patent No. 8,795,965. Paper 1558, 7.

RESPONSE: Admitted.

11. The necessary consents of the current inventor, the assignees, and the alleged unnamed inventors to add one or more of Randall Platt, Le Cong, Fei Ran, and Patrick Hsu as inventors to U.S. Patent No. 8,795,965 are submitted herewith. Paper 2117, Appx. E.

RESPONSE: Denied.

12. U.S. Patent No. 8,865,406 was filed on March 24, 2014, issued on October 21, 2014, and names Feng Zhang and Fei Ran as inventors. Ex. 3017, face page.

RESPONSE: Admitted.

13. CVC alleges that Le Cong, Patrick Hsu, Shuailiang Lin, and Randall Platt should be added as inventors of U.S. Patent No. 8,865,406. Paper 1558, 7.

RESPONSE: Admitted.

14. The necessary consents of the current inventors, the assignees, and the alleged unnamed inventors to add one or more of Le Cong, Patrick Hsu, and Randall Platt as inventors to U.S. Patent No. 8,865,406 are submitted herewith. Paper 2117, Appx. F.

RESPONSE: Denied.

15. U.S. Patent No. 8,871,445 was filed on April 23, 2014, issued on October 28, 2014, and names Feng Zhang and Le Cong as inventors. Ex. 3029, face page.

RESPONSE: Admitted.

16. CVC alleges that Patrick Hsu, Shuailiang Lin, Randall Platt, and Fei Ran should be added as inventors of U.S. Patent No. 8,871,445. Paper 1558, 8.

RESPONSE: Admitted.

17. The necessary consents of the current inventors, the assignees, and the alleged unnamed inventors to add one or more of Patrick Hsu, Randall Platt, and Fei Ran as inventors to U.S. Patent No. 8,871,445 are submitted herewith. Paper 2117, Appx. G.

RESPONSE: Denied.

18. U.S. Patent No. 8,889,356 was filed on February 18, 2014, issued on November 18, 2014, and names Feng Zhang as an inventor. Ex. 3016, face page.

RESPONSE: Admitted.

19. CVC alleges that Le Cong, Patrick Hsu, Shuailiang Lin, Randall Platt, and Fei Ran should be added as inventors of U.S. Patent No. 8,889,356. Paper 1558, 9.

RESPONSE: Admitted.

20. The necessary consents of the current inventor, the assignees, and the alleged unnamed inventors to add one or more of Le Cong, Patrick Hsu, Randall Platt, and Fei Ran as inventors to U.S. Patent No. 8,889,356 are submitted herewith. Paper 2117, Appx. H.

RESPONSE: Denied.

21. U.S. Patent No. 8,895,308 was filed on June 2, 2014, issued on November 25, 2014, and names Feng Zhang and Fei Ran as inventors. Ex. 3013, face page.

RESPONSE: Admitted.

22. CVC alleges that Le Cong, Patrick Hsu, Shuailiang Lin, and Randall Platt should be added as inventors of U.S. Patent No. 8,895,308. Paper 1558, 7.

RESPONSE: Admitted.

23. The necessary consents of the current inventors, the assignees, and the alleged unnamed inventors to add one or more of Le Cong, Patrick Hsu, and Randall Platt as inventors to U.S. Patent No. 8,895,308 are submitted herewith. Paper 2117, Appx. I.

RESPONSE: Denied.

24. U.S. Patent No. 8,906,616 was filed on May 29, 2014, issued on December 9, 2014, and names Feng Zhang, Le Cong, Patrick Hsu, and Fei Ran as inventors. Ex. 3014, face page.

RESPONSE: Admitted.

25. CVC alleges that Shuailiang Lin and Randall Platt should be added as inventors of U.S. Patent No. 8,906,616. Paper 1558, 8.

RESPONSE: Admitted.

26. The necessary consents of the current inventors, the assignees, and the alleged unnamed inventors to add Randall Platt as inventor to U.S. Patent No. 8,906,616 are submitted herewith. Paper 2117, Appx. J.

RESPONSE: Denied.

27. U.S. Patent No. 8,932,814 was filed on April 22, 2014, issued on January 13, 2015, and names Feng Zhang and Le Cong as inventors. Ex. 3037, face page.

RESPONSE: Admitted.

28. CVC alleges that Patrick Hsu, Shuailiang Lin, Randall Platt, and Fei Ran should be added as inventors of U.S. Patent No. 8,932,814. Paper 1558, 9.

RESPONSE: Admitted.

29. The necessary consents of the current inventors, the assignees, and the alleged unnamed inventors to add one or more of Patrick Hsu, Randall Platt, and Fei Ran as inventors to U.S. Patent No. 8,932,814 are submitted herewith. Paper 2117, Appx. K.

RESPONSE: Denied.

30. U.S. Patent No. 8,945,839 was filed on April 18, 2014, issued on February 3, 2015, and names Feng Zhang as an inventor. Ex. 3022, face page.

RESPONSE: Admitted.

31. CVC alleges that Le Cong, Patrick Hsu, Shuailiang Lin, Randall Platt, and Fei Ran should be added as inventors of U.S. Patent No. 8,945,839. Paper 1558, 7.

RESPONSE: Admitted.

32. The necessary consents of the current inventor, the assignees, and the alleged unnamed inventors to add one or more of Le Cong, Patrick Hsu, Randall Platt, and Fei Ran as inventors to U.S. Patent No. 8,945,839 are submitted herewith. Paper 2117, Appx. L.

RESPONSE: Denied.

33. U.S. Patent No. 8,993,233 was filed on December 12, 2013, issued on March 31, 2015, and names Feng Zhang, Le Cong, Randall Platt, Neville Espi Sanjana, and Fei Ran as inventors. Ex. 3024, face page.

RESPONSE: Admitted.

34. CVC alleges that Patrick Hsu, Shuailiang Lin, and Ophir Shalem should be added as inventors of U.S. Patent No. 8,993,233. Paper 1558, 8.

RESPONSE: Admitted.

35. The necessary consents of the current inventors, the assignees, and the alleged unnamed inventors to add one or more of Patrick Hsu, and Ophir Shalem as inventors to U.S. Patent No. 8,993,233 are submitted herewith. Paper 2117, Appx. M.

RESPONSE: Denied.

36. U.S. Patent No. 8,999,641 was filed on March 26, 2014, issued on April 7, 2015, and names Feng Zhang, Le Cong, Randall Platt, and Neville Espi Sanjana as inventors. Ex. 3047, face page.

RESPONSE: Admitted.

37. CVC alleges that Patrick Hsu, Shuailiang Lin, and Fei Ran should be added as inventors of U.S. Patent No. 8,999,641. Paper 1558, 8

RESPONSE: Admitted.

38. The necessary consents of the current inventors, the assignees, and the alleged unnamed inventors to add one or more of Patrick Hsu, and Fei Ran as inventors to U.S. Patent No. 8,999,641 are submitted herewith. Paper 2117, Appx. N.

RESPONSE: Denied.

39. U.S. Patent No. 9,840,713 was filed on October 24, 2014, issued on December 12, 2017, and names Feng Zhang as an inventor. Ex. 3043, face page.

RESPONSE: Admitted.

40. CVC alleges that Le Cong, Matthias Heidenreich, Patrick Hsu, Shuailiang Lin, Randall Platt, Fei Ran, and Lukasz Swiech should be added as inventors of U.S. Patent No. 9,840,713. Paper 1558, 8.

RESPONSE: Admitted.

41. The necessary consents of the current inventor, the assignees, and the alleged unnamed inventors to add one or more of Le Cong, Matthias Heidenreich, Patrick Hsu, Randall Platt, Fei Ran, and Lukasz Swiech as inventors to U.S. Patent No. 9,840,713 are submitted herewith. Paper 2117, Appx. O.

RESPONSE: Denied.

42. Broad attempted in good faith to obtain the consent of alleged unnamed inventor Shuailiang Lin. Ex. 6059

RESPONSE: Denied.

Application

43. U.S. Patent Application No. 14/704,551 was filed on May 5, 2015 and names Feng Zhang, Le Cong, Patrick Hsu, and Fei Ran as inventors. Ex. 3050, 156-159.

RESPONSE: Admitted.

44. CVC alleges that Randall Platt and Shuailiang Lin should be added as inventors of U.S. Patent Application No. 14/704,551. Paper 1558, 8.

RESPONSE: Admitted.

45. The corrected ADSs to add Randall Platt, to add Shuailiang Lin, or to add both Randall Platt and Shuailiang Lin as inventors to U.S. Patent Application No. 14/704,551 are submitted herewith. Paper 2117, Appx. P.

RESPONSE: Admitted that Broad submitted with its motion ADSs to add Randall Platt, to add Shuailiang Lin, or to add both Randall Platt and Shuailiang Lin as inventors to U.S. Patent Application No. 14/704,551, but denied that these are "corrected ADSs" because they are improper.

Fees

46. Broad authorizes any fees required by 37 C.F.R. § 1.20(b) be charged to Deposit Account No. 121781.

RESPONSE: Admitted.

47. Broad authorizes any fees required by 37 C.F.R. §§ 1.17(d) and 1.17(i) be charged to Deposit Account No. 121781.

RESPONSE: Admitted.

Junior Party Facts in Support of Opposition

48. Shuailiang Lin has not consented to be named as inventor to the involved patents. Paper 2117, 6-7.

49. In its Contingent Responsive Motion 6, Broad has not set forth any evidence that any unnamed inventors contributed to the conception of the claimed invention.

50. In its Contingent Responsive Motion 6, Broad does not identify the names of the individuals it believes should be added as inventors to each of its patents and patent application, other than to say that any individuals the PTAB determines to be an unnamed inventor should be added as an inventor.

51. On June 30, 2016, Broad submitted a sworn declaration by its attorney, Thomas J. Kowalski, in opposition proceedings involving its European Patent No. EP 2771468 (PCT/US2013/074819). Ex. 4295, ¶¶ 1, 19; Ex. 4313, 2.

52. Mr. Kowalski states in his declaration that he was retained by Broad Institute of MIT and Harvard in 2012 and was asked by Ellen Law, Broad's in-house counsel, in mid-January 2013 to "take over representation of certain CRISPR matters originating from Dr. Feng Zhang's laboratory." *Id*., ¶ 11.

53. In his declaration, Mr. Kowalski identifies his duty of candor and good faith under 37 C.F.R. § 1.56 in making the statements contained in his declaration. *Id.,* ¶ 4.

54. Mr. Kowalski explains in his declaration that his assessment of inventorship of Broad's PCT applications reflects the inventorship standards under U.S. law. *Id.,* ¶¶ 5-10, 15.

55. Mr. Kowalski explains in his declaration that his inventorship study included interviewing the relevant individuals to determine his or her contributions to any subject matter or claim features. *Id.,* ¶ 9.

56. Mr. Kowalski states in his declaration that, based on his inventorship study, he concluded that Dr. Le Cong "contributed in a not insubstantial manner to the following inventions" of "co-delivery to the nucleus…and the CRISPR-Cas9 system adapted in for uses in eukaryotic cells [and] Dr. Cong was therefore named as an inventor and applicant on PCT/US2013/074790…and PCT/US2013/074611, respectively." Ex. 4295, ¶ 16.

57. Mr. Kowalski states in his declaration that, based on his inventorship study, he concluded that Dr. Patrick Hsu "contributed in a not insubstantial manner to the following inventions" of "the CRISPR-Cas9 system for certain uses in eukaryotic cells [and] Dr. Hsu was therefore named as an inventor and applicant on…PCT/US2013/074611." *Id.,* ¶ 16.

58. Mr. Kowalski states in his declaration that, based on his inventorship study, he concluded that Dr. Fei Ran "contributed in a not insubstantial manner to the following inventions" of "co-delivery to the nucleus, *in vivo* applications,…ortholog design, and the CRISPR-Cas9 system for certain uses in eukaryotic cells [and] Dr. Ran was therefore named as an inventor and applicant on…PCT/US2013/074790, PCT/US2013/074667,… PCT/US2013/074691 and PCT/US2013/074611 respectively." *Id.,* ¶ 16.

59. Mr. Kowalski states in his declaration that, based on his inventorship study, he concluded that Mr. Shuailiang Lin "contributed in a not insubstantial manner to the following inventions" of "certain methods of using CRISPR-Cas9 systems in eukaryotic cells and was therefore named as an inventor and applicant on PCT/US2013/074611." *Id.,* ¶ 16.

60. Mr. Kowalski states in his declaration that, based on his inventorship study, he concluded that Dr. Randall Platt "contributed in a not insubstantial manner to the following inventions" of "methods of using CRISPR-Cas9 systems in eukaryotic cells [and] was therefore named as an inventor and applicant on PCT/US2013/074611..." *Id.,* ¶ 16.

61. Mr. Kowalski states in his declaration that, based on his inventorship study, he concluded that Dr. Ophir Shalem "contributed in a not insubstantial manner to the following inventions" of "ortholog design [and] was therefore named as an inventor and applicant on PCT/US2013/074691..." Ex. 4295 at ¶ 16.

62. Mr. Kowalski states in his declaration that, based on his inventorship study, he concluded that Dr. Matthias Heidenreich and Dr. Lukasz Swiech "contributed in a not insubstantial manner to the following inventions" of "*in vivo* applications and were therefore both named as inventors and applicants on PCT/US2013/074667." *Id.,* ¶ 16.

63. Ellen Law, in-house counsel for Broad, submitted a sworn declaration dated August 4, 2014 in the file of U.S. Application No. 14/324,960 which states that "Broad TWICE conducted an inventorship study" in 2013 regarding the claims of the CRISPR portfolio, including those that claim a lineage back to U.S. provisional application 61/736,527. Ex. 4323 at 335-36.

64. Ms. Law, in her August 4, 2014 declaration, further explains: "[a]fter the filing of US Provisional applications 61/736,527 and 61/788,427 [sic, 61/748,427], I had Mr. Kowalski investigate inventorship of the claims of the CRISPR portfolio. I understand that the inventorship investigation included reviewing all documents provided by all individuals involved in any aspect of the CRISPR portfolio, and also Mr. Kowalski interviewing each of these individuals." *Id.,* 335-36.

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **CVC OPPOSITION TO CONTIGENT RESPONSIVE MOTION 6 (for correction of inventorship)** was filed via the Interference Web Portal by 8:00 PM Eastern Time on March 26, 2021, pursuant to an agreement between the parties, and thereby served on the attorney of record for the Senior Party pursuant to ¶ 105.3 of the Standing Order. Pursuant to the agreement between the parties, the foregoing were also served via email by 11:00 pm ET on counsel for the Senior Party at:

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