

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)

Order – Additional Briefing
37 C.F.R. § 41.104(a)

Before: DEBORAH KATZ, *Administrative Patent Judge*.

- 1 On 25 June 2021, Junior Party (“CVC”) sent an e-mail to the Board
2 requesting a conference call to discuss authorization for a motion to argue Broad’s

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1 involved claims are unpatentable due to inequitable conduct. CVC had requested a
2 motion on this basis at the beginning of the interference in its list of proposed
3 motions. (*See* Paper 19.) CVC asserts that the issues it would argue overlap with
4 issues raised in the priority phase and that there are new justifications for a
5 requested motion. CVC indicated that Senior Party opposes this request.

6 A conference call is not necessary at this time. As previously explained,
7 consideration of whether to authorize a motion on inequitable conduct is premature
8 until the conclusion of the priority phase, that is, until a decision has been rendered
9 on priority. (*See* Order Authorizing Motions and Setting Times, Paper 22, 10:17–
10 24.) CVC states that issues it would argue overlap with issues it raised in the
11 priority phase. Thus, it is more efficient to consider authorization of a motion for
12 inequitable conduct after a determination has been made on such issues.

13 Authorization of motions in an interference is discretionary. *See* 37 C.F.R.
14 § 41.121 (a)(1) (“Consistent with the notice of requested relief, if any, *and to the*
15 *extent the Board authorizes*, a party may file a motion . . . (iii) For judgment in the
16 contested case.” (emphasis added).) Determination of patentability on grounds
17 other than priority during an interference is also discretionary. *See* 35 U.S.C.
18 § 135(a) (“The Board of Patent Appeals and Interferences shall determine
19 questions of priority of the inventions and *may determine questions of*
20 *patentability.*” (emphasis added)). Both parties have had a full opportunity to brief
21 priority issues. Thus, it is the Board’s discretion whether to take up inequitable
22 conduct issues.

23 It is ORDERED that CVC’s request is DENIED without prejudice. No
24 additional briefing is authorized.

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