

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.

TOOLGEN, INC.

Senior Party

Application 14/685,510

Patent Interference No. 106,127 (DK)

**ORDER – Authorizing Motions and Setting Times
37 C.F.R. §§ 104(c) and 121**

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

KATZ, *Administrative Patent Judge*.

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1 motion is GRANTED. The motion shall be entitled “CVC MOTION 1.”

2 CVC also requests authorization for a motion to argue that ToolGen should
3 not have been accorded the benefit of the filing date of its provisional application
4 61/717,324. (*See* CVC List, Paper 22, 3.) Authorization for this motion is
5 GRANTED. The motion shall be entitled “CVC MOTION 2.”

6 CVC requests authorization to file a motion to add the claims of ToolGen
7 patent 10,851,380 because its claims correspond to Count 1. (*See* CVC List,
8 Paper 22, 3.) Authorization for this motion is GRANTED. Although ToolGen
9 argued on the conference call that this motion would not be consistent with
10 Interference 106,126, we see no reason why the separate proceedings at issue must
11 include the same applications and patents. The motion shall be entitled “CVC
12 MOTION 3.”

13 CVC further requests authorization to file two motions to argue that
14 ToolGen claims are unpatentable over the prior art. (*See* CVC List, Paper 22, 3–
15 5.) First, CVC seeks to file a motion to argue that ToolGen’s claim are
16 unpatentable over CVC’s U.S. patent application publication 2014/0068797,
17 which, according to CVC, ToolGen cannot antedate. (*See id.* 3–5.) CVC also
18 seeks to file a motion¹ to argue that ToolGen’s claims are unpatentable over U.S.
19 patent application publication 2016/0298138. (*See id.* 5.) On the call, CVC
20 referred to several other prior art references that were not recited in its proposed

¹ CVC clarified during the conference call that this motion was not intended to be proposed as a “contingent” motion as indicated in the CVC List. (Transcript, Paper 23, 11:4–8.)

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1 motions list.

2 Consideration of whether to authorize these motions is DEFERRED until a
3 priority phase, if one is necessary. The determination of patentability issues that
4 do not impact the determination of priority during an interference is discretionary.
5 *See* 35 U.S.C. § 135(a). We note that patentability over the prior art is not now,
6 and never has been, a “threshold issue” and a holding during the course of
7 interference that a party’s claims are unpatentable over prior art does not
8 necessarily deprive that party of standing on the central issue of an interference—
9 priority. *Cf.* 37C.F.R. § 41.201 (defining “threshold issue”). Furthermore, an
10 interference is not a substitute for other patentability proceedings in the Office or
11 elsewhere.

12 CVC requests authorization to file a motion for judgment based on priority.
13 (*See* CVC List, Paper 22, 5.) Consideration of whether to authorize this motion is
14 DEFERRED until a priority phase, if one is necessary.

15 *ToolGen Proposed Motions*

16 ToolGen requests an expedited miscellaneous motion to argue that this
17 interference should be stayed, pending a final judgment in Interference 106,115,
18 which involves a priority contest on similar subject matter between CVC and The
19 Broad Institute, Inc., Massachusetts Institute of Technology, and President and
20 Fellows of Harvard College. (*See* ToolGen List, Paper 21, 1:6–2:16.) On the
21 conference call, CVC indicated that they did not necessarily agree there is a need
22 to delay this proceeding. (*See* Transcript, Paper 23, 7:25–8:8.) Authorization for
23 this motion is DENIED. The motions authorized in this Order are directed to
24 changing the status quo of the interference as declared in preparation for a priority

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1 phase, if one is necessary. Thus, deciding these issues will prepare the proceeding
2 for judgment on priority. Motions on other issues have been denied or
3 consideration on authorization has been deferred. Thus, even if some motions
4 include issues that overlap those in dispute in Interference 106,115, deciding the
5 issues unique to this proceeding will prepare the proceeding for a priority phase if
6 one is necessary and will further our goal of pendency within two-years. *See* 37
7 C.F.R. § 41.200(c).

8 ToolGen also seeks authorization for a motion to argue that it should be
9 accorded the benefit of the filing date of its provisional application 61/837,481,
10 which was filed 20 June 2013, and of its international application
11 PCT/KR2013/009488, which was filed 2 October 2013. (*See* ToolGen List,
12 Paper 21, 2:18–22.) On the conference call, ToolGen indicated that this motion
13 would be contingent upon the grant of a motion by Broad to attack the benefit of
14 the filing date of ToolGen’s earlier provisional application 61/717,324 accorded to
15 ToolGen upon declaration. (Transcript, Paper 23, 24:11–17.) Authorization for
16 this motion is GRANTED. The motion shall be entitled “TOOLGEN MOTION
17 1.”

18 ToolGen seeks authorization for a motion to argue that CVC should be
19 denied the benefit of the filing date of provisional application 61/757,640. (*See*
20 ToolGen List, Paper 21, 3:1–4.) Authorization for this motion is GRANTED. The
21 motion shall be entitled “TOOLGEN MOTION 2.”

22 ToolGen further requests authorization for a motion to argue that CVC’s
23 claims are unpatentable under 35 U.S.C. § 112, for lack of written description and
24 an enabling disclosure. (*See* ToolGen List, Paper 21, 3:6–12.) ToolGen did not

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1 allege that this motion will present a threshold issue depriving CVC of standing.
2 Specifically, ToolGen did not allege that CVC's application claims were first made
3 after the publication of ToolGen's application. *See* 37 C.F.R. § 41.201
4 (“*Threshold issue* means an issue that, if resolved in favor of the movant, would
5 deprive the opponent of standing in the interference. Threshold issues may include
6 . . . (2) In the case of an involved application claim first made after the publication
7 of the movant's application or issuance of the movant's patent: . . . (ii)
8 Unpatentability for lack of written description under 35 U.S.C. 112 of an involved
9 application claim where the applicant suggested, or could have suggested, an
10 interference under §41.202(a).”). Because the motion will not otherwise further
11 the inquiry into priority of invention of the count, authorization for the motion is
12 DENIED. *See* 35 U.S.C. § 135(a).

13 ToolGen requests authorization for a motion to argue that CVC's claims are
14 unpatentable over the prior art under 35 U.S.C. § 102 and/or § 103 over Cong *et*
15 *al.*, *Science*, 339, 819–23 (2013), and Mali *et al.*, *Science*, 339:823–26 (2013).
16 (*See* ToolGen List, Paper 21, 3:14–21.) Consideration of whether to authorize
17 these motions is DEFERRED until a priority phase, if one is necessary, for the
18 reasons explained above in regard to CVC's proposed prior art motions.

19 ToolGen requests authorization for a miscellaneous motion to argue that
20 there be a protective order to allow ToolGen to file its priority statement under
21 seal. (*See* ToolGen List, Paper 21, 4:4–13.) ToolGen asserts that third-party
22 competitors, specifically Sigma-Aldrich, are pursuing claims with subject matter
23 that may interfere with ToolGen's claims in this interference. (*See id.*) CVC
24 indicated on the conference call that reserved the right to oppose such a motion.

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1 (See Transcript, Paper 23, 25:8–10.) During Interference 106,115, CVC argued to
2 have its priority statement filed under seal because, in part, competitors, including
3 ToolGen and Sigma-Aldrich were pursuing patent applications claiming subject
4 matter that might interfere with CVC’s claims involved in that interference. (See
5 Interference 106,115, CVC Miscellaneous Motion 1 (to seal priority statement),
6 Paper 25, 2:5–7.) Thus, CVC previously argued that similar facts presented good
7 cause for a protective order. Because ToolGen is concerned about potentially
8 interfering subject matter by a competitor and in light of our rule allowing priority
9 statements to be maintained in confidence for a limited time, ToolGen’s arguments
10 to seal its priority statement until a priority phase has been scheduled has merit.
11 See 37 C.F. R. § 41.120(a) (“The Board may require a party to provide a notice
12 stating the relief it requests and the basis for its entitlement to relief. The Board
13 may provide for the notice to be maintained in confidence for a limited time.”).
14 Accordingly, it is ORDERED that ToolGen may submit a proposed protective
15 order to keep ToolGen’s priority statement under seal until a priority phase of this
16 interference. The protective order in Interference 106,115 may be used as a
17 reference. (See Interference 106,115, Paper 452.) ToolGen’s request to file a
18 motion is DISMISSED as moot.

19 ToolGen requests authorization to file a miscellaneous motion for the Board
20 to order that this interference and related Interference 106,126 proceed on the same
21 schedule. (See ToolGen List, Paper 21, 4:15–18.) In order to allow the parties to
22 stipulate to changes in the schedule, as provided below, no other general order
23 regarding the schedule will be issued. Nevertheless, ToolGen is free to agree or

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1 disagree with proposed changes in the schedule and the Board expects all parties to
2 cooperate on scheduling issues. Accordingly, ToolGen’s request is DENIED.

3 ToolGen requests authorization to file a motion for judgment based on
4 priority. (See ToolGen List, Paper 21, 4:20–22.) Consideration of whether to
5 authorize this motion is DEFERRED until a priority phase, if one is necessary.

6 *Other Matters*

7 The requirement for statements of material facts is *not* waived in this
8 interference. See 37 C.F.R. § 41.121(d). Such statements are included in the page
9 limits set for each brief. See, e.g., SO ¶ 121.2. Where required or otherwise helpful
10 to presenting a party’s case, claim charts may be included in the briefs. Claim
11 charts do not count towards the page limits. The parties are encouraged to find
12 ways to consolidate arguments when briefing the authorized motions. Detailed
13 arguments about representative claims, with a note that the argument applies to the
14 other claims, can replace repeated arguments. Such strategies should be fully
15 considered before asking for an extension of the limits on pages in briefs. See SO
16 ¶¶ 121.2, 122.2.

17 It is ORDERED that the requirement for consecutive exhibits numbers in
18 paragraph (Standing Order ¶ 154.2.1) is waived.

19 It is further ORDERED that exhibits may be filed through the interference
20 portal within two business days of the due date of the paper in which they are cited,
21 although it is preferred that exhibits be filed when the paper citing them is filed.

22

23

Schedule

24 The schedule is set by the Board, with the following provisions.

1 A. Time Periods Associated with Motions

2 The TIME PERIODS described below are set out in an Appendix to this
3 ORDER. Action specified for each TIME PERIOD must be completed by the date
4 specified for the TIME PERIOD. The parties are authorized to stipulate different
5 times (earlier or later, but not later than TIME PERIOD 7) for TIME PERIODS 1
6 through 6. A notice of the stipulation must be promptly filed. The notice must be in
7 the form of a copy of the Appendix attached to this ORDER with old dates crossed
8 out and new dates inserted by hand. The parties may not stipulate an extension of
9 TIME PERIOD 7 or the default date for oral argument. In stipulating different
10 times, the parties should consider the effect of the stipulation on times: (1) to
11 object to evidence (5 business days, 37 C.F.R. § 41.155(b)(1)), (2) to supplement
12 evidence (10 business days, 37 C.F.R. § 41.155(b)(2)), (3) to begin cross
13 examination (no earlier than 21 days after service, SO ¶ 157.3.1) and (4) to
14 conclude cross examination (at least 10 days before the opposition or reply is due,
15 SO ¶ 157.3.2).

16 The parties should note that exhibits are no longer filed at the end of the
17 schedule, but should be filed when served on the other party. An exhibit, including
18 an affidavit, cited in connection with a motion, opposition, reply, or affidavit, must
19 be served and filed with the motion, opposition, reply or affidavit in which the
20 exhibit is first mentioned. Exhibits should not be filed more than once. Parties
21 Interference should also note that a single pdf file size greater than 25 MB will
22 need to be divided into smaller pdf files.

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1 Transcripts of cross examinations and depositions taken under 35 U.S.C.
2 § 24 must be served and filed when the other exhibits in connection with a motion,
3 opposition, or reply are filed.

4 TIME PERIOD 1

5 File all authorized motions.

6 If no party files a motion, the SENIOR PARTY must arrange a conference
7 call with the parties and the Board so that appropriate adjustments to the schedule
8 may be made.

9 TIME PERIOD 2

10 File any responsive motions (37 C.F.R. § 41.121(a)(2)) in response to an
11 opponent's motion filed during TIME PERIOD 1.

12 TIME PERIOD 3

13 File oppositions to all motions, including responsive motions.

14 TIME PERIOD 4

15 File replies to all oppositions.

16 TIME PERIOD 5

- 17 a. File any request for oral argument on motions,
18 b. File motions to exclude evidence (37 C.F.R. § 41.155(c); SO ¶ 155.2), and
19 c. File observations on cross examination (SO ¶ 157.7) of reply testimony.

20 TIME PERIOD 6

- 21 a. File oppositions to an opponent's motion to exclude evidence and
22 b. File any response to observations. Interference 106,120

23 TIME PERIOD 7

24 File replies to oppositions to motions to exclude evidence.

1 **B. Priority Statements**

2 1. At TIME PERIOD 1, file but do not serve a priority statement (37 C.F.R.
3 § 41.120; 37 C.F.R. § 41.204(a)).

4 2. When filing the priority statement, the filer may use the “Confidential”
5 setting for the Public Access status.

6 3. A junior party who does not file a priority statement shall not have access
7 to the priority statement of any other party.

8 4. **One (1) business day** after TIME PERIOD 1, serve a copy of the priority
9 statement upon each opponent (except for a junior party barred under B.3 above).

10 **C. Filing Exhibits**

11 A document larger than 25 MB cannot be filed online. If a party needs to file
12 a document larger than 25 MB, unless otherwise instructed by order, please contact
13 the board at the telephone number above to make other arrangements, such as
14 sending a CD-ROM by Express Mail.

15 **D. Default Oral Argument Date**

16 If a request for oral argument (37 C.F.R. § 41.124(a); TIME PERIOD 5) is
17 granted, the default date for such argument is the date provided in the appendix
18 below. No oral argument will occur if either no argument is requested or granted.

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cc (via e-mail):

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APPENDIX--ORDER - RULE 123(a)
(Times for substantive motions; priority deferred)
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TIME PERIOD 1 9 April 2021
File motions
File (but serve one business day later) priority statements

TIME PERIOD 2 14 May 2021
File responsive motions to motions filed in TIME PERIOD 1

TIME PERIOD 3 25 June 2021
File oppositions to all motions

TIME PERIOD 46 August 2021
File all replies

TIME PERIOD 517 September 2021
File request for oral argument
File motions to exclude
File observations

TIME PERIOD 68 October 2021
File oppositions to motions to exclude
File response to observations

TIME PERIOD 715 October 2021
File replies to oppositions to motions to exclude

DEFAULT ORAL ARGUMENT DATE TBD