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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**THE BROAD INSTITUTE, INC., MASSACHUSETTS INSTITUTE OF  
TECHNOLOGY, and PRESIDENT AND FELLOWS OF  
HARVARD COLLEGE,  
Junior Party**

Patents 8,697,359; 8,771,945; 8,795,965; 8,865,406; 8,871,445; 8,889,356;  
8,889,418; 8,895,308; 8,906,616; 8,932,814; 8,945,839; 8,993,233; 8,999,641;  
9,840,713, and Applications 14/704,551 and 15/330,876

v.

**TOOLGEN, INC.  
Senior Party**

Application 14/685,510

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Patent Interference No. 106,126 (DK)

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**TOOLGEN OPPOSITION 2  
(opposing motion to add claims 1, 40, and 41 of 15/160,710 and claims 74, 94, and 95 of  
15/430,260)**

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1 Senior Party ToolGen, Inc. requests that the Board dismiss or deny Broad’s Motion 2  
2 seeking to add to this interference, contingent upon the grant of Broad Motion 1, claims 1, 40, and  
3 41 of Broad application 15/160,710 (“710 Application”) (Ex. 2063) and claims 74, 94, and 95 of  
4 Broad Application 15/430,260 (“260 Application”) (Ex. 2065) and designate those claims as  
5 corresponding to Proposed Count 2. Broad Motion 2 (“Mot.”) at 1.

6 ToolGen has shown elsewhere that Broad’s Motion 1, seeking to substitute Proposed Count  
7 2, should be denied. Such a ruling would also resolve Broad’s Motion 2 by rendering it moot.  
8 Nonetheless, if the Board were to reach contingent Motion 2, it should find that Broad has not  
9 satisfied its burden of showing that the relief it seeks here—to add certain claims to Proposed  
10 Count 2—is justified. 37 C.F.R. § 41.208(b). Broad has neither demonstrated that the claims  
11 should be added, nor that alternative remedies are unavailable. Instead, Broad spends much of  
12 Motion 2 simply—but improperly—re-arguing its Motion 1. Further, Broad offers arguments  
13 inconsistent with the arguments authorized by the Board, and seeks relief outside the scope of what  
14 it requested in its Motions List and what the Board authorized. Accordingly, Broad’s Motion 2  
15 should be dismissed or denied.

16 Appendix 1 is a List of Exhibits Cited. Appendix 2 is the Statement of Material Facts.

17 **I. BROAD HAS NOT MET ITS BURDEN TO SHOW THAT THE RELIEF SOUGHT**  
18 **IS JUSTIFIED**

19 **A. Broad’s Fairness Arguments Are Irrelevant To This Motion**

20 On page 1, line 15 to page 2, line 7, Broad argues that proceeding under Count 1 would be  
21 unfair to Broad. For example, Broad argues that the allowable claims in the 710 and 260  
22 applications “exemplify the problem and unfairness with proceeding with Count 1.” Mot. 1:15–  
23 16. The response is that Broad does not argue reasons why the claims should be added, but rather  
24 argues, as it did in Motion 1, that Count 1 is unfair. Broad’s argument is both misplaced and

1 should be denied as moot, since Motion 2 is contingent upon the Board granting Motion 1 to  
2 replace Count 1 with Proposed Count 2. Were the Board to reach Motion 2, Count 1 would no  
3 longer exist for Broad to complain about.

4 On page 6, line 5 to page 8, line 3, Broad again argues not the merits of Motion 2 as  
5 authorized, but the alleged unfairness of proceeding under Count 1 and the necessity for  
6 substitution of Proposed Count 2. The response is the same—Broad’s arguments that Count 1 is  
7 unfair are duplicative of its Motion 1 arguments, and outside the scope of Broad’s authorization to  
8 file Motion 2. Paper 20, Order – Authorizing Motions and Setting Times, 3:16–4:3; F9, F10.

9 The further response is that Motion 2 does not provide the proofs required under Bd. R.  
10 208(b) and SO ¶ 203.2 to add new claims. Indeed, Broad makes no specific arguments as to why  
11 the new *claims* (as opposed to the new *count*) are required, or why alternatives are not adequate.  
12 Accordingly, the Board should dismiss or deny Motion 2.

13 **B. Broad Has Not Met The Requirements of Bd. R. 208(b) or SO ¶ 203.2 To Show**  
14 **Why It Should Be Entitled To Add Claims To The Interference**

15 As its Motion acknowledges at page 1, lines 2–3 and page 2, lines 12–24, Broad bears the  
16 burden of making a showing under 37 C.F.R. § 41.208(b) and SO ¶ 203.2, that the requested claims  
17 should be added. Bd. R. 208(b) requires that Broad make its showing with supporting evidence,  
18 but Broad has neither made such a showing, nor proffered supporting evidence. SO ¶ 203.2 also  
19 requires that Broad explain why alternative remedies are not adequate, but Broad has not done  
20 that, either. SO ¶ 203.2 requires that Broad explain what attempts, if any, have been made to have  
21 the examiner recommend declaration of another interference involving the application sought to  
22 be added; again, Broad has not done so. Motion 2 should be dismissed or denied for each of these  
23 independent reasons.

1                   **1.       Broad Does Not Show, With Supporting Evidence, That It Is Entitled**  
2                   **To Add the Requested Claims**

3                   Broad bears the burden of showing, with supporting evidence, that it is entitled to the relief  
4 it seeks. *See* 37 C.F.R. § 41.208(b). On page 3, line 16 to page 6, line 3, Broad argues that the  
5 requested claims should be added. The response is that Broad purports to show only that the claims  
6 correspond with the Broad half of Proposed Count 2 (an independent requirement of SO ¶ 203.2),  
7 but does not argue anywhere *why* the claims should be added. *See* Mot. 3–6. Nor does Broad  
8 offer any evidence, in the form of expert testimony or otherwise, to support the necessity of the  
9 claims being added to this interference.

10                  One cannot broaden the scope of a count just for the sake of doing so. Likewise, one cannot  
11 simply add claims for the sake of designating more claims without offering a compelling reason.  
12 *See* 37 C.F.R. § 41.208(b); *see generally* *Louis v. Okada*, 59 U.S.P.Q.2d 1073, 2001 WL 775529  
13 at \*4 (B.P.A.I. 2001) (precedential) (holding that the scope of a count should not be changed unless  
14 there is a “compelling reason” to do so). Broad offers no reason, let alone a compelling one  
15 supported by evidence.<sup>1</sup>

16                  Nor are the proposed additional claims necessary. If Broad were to prevail under Proposed  
17 Count 2, the claims it seeks to add would issue in its allowed applications. F5, F6. If Broad loses,  
18 it would be estopped from prosecuting those claims. In either event, the new claims would have  
19 no effect on the adjudication of priority to the invention of Proposed Count 2. *Matsushima v. H.A.*,

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<sup>1</sup> As discussed in Section I.A. *supra*, arguments that Count 1 is unfair or improper are irrelevant to Motion 2, which is contingent upon the grant of Motion 1 to substitute Proposed Count 2.

1 Int. 104,354, Paper 45 (B.P.A.I. May 2, 2000) (precedential) (*citing* 35 U.S.C. § 135(a)) (“The  
2 primary purpose of an interference is the resolution of questions of priority....”).

3 **2. Broad Does Not Explain Why Alternative Remedies Are Not Adequate**

4 On page 6, line 5 to page 8, line 21, Broad asserts that the alternative remedies are  
5 inadequate, but it only argues the unfairness of maintaining Count 1. *First*, such argument is  
6 improperly duplicative of Motion 1 and would be mooted by the grant of that Motion, for the  
7 reasons discussed above. *Second*, nowhere in Motion 2 does Broad consider any alternatives to  
8 adding the requested claims, or whether such alternatives are inadequate. *Id.* And alternatives  
9 exist, even though Broad does not address them. For example, Broad could have requested  
10 authorization to add the identical claims to one of its involved pending applications and designate  
11 them as corresponding to Count 2. *See* SO ¶ 208.5.1. Broad does not show why this, or any other  
12 alternative, is inadequate, which is required under SO ¶ 203.2 to meet its burden. And Broad may  
13 not meet its burden by raising such proofs for the first time in its Reply. *Nau v. Ohuchida*, Int. No.  
14 104,258, Paper 57 (B.P.A.I. 1999) (precedential) (“The Trial Section does not deem it fair to an  
15 opponent when a party ‘gets its licks in’ for the first time at the reply stage after the opponent can  
16 no longer submit evidence and/or argument.”).

17 **3. Broad Does Not Explain Any Attempts To Request Declaration Of**  
18 **Another Interference**

19 On page 2, lines 12–24, Broad identifies the SO ¶ 203.2 requirements to add a claim. “The  
20 motion must,” among other things:

- 21 (4) Explain . . . what attempts, if any, have been made to  
22 have the examiner recommend declaration of another interference  
23 involving the application or patent to be added to the interference.

1 Mot. 2: 12–24; SO ¶ 203.2. The response is that Motion 2 is devoid of any such explanation. To  
2 the extent such course of action was a potential alternative remedy, Broad does not argue its  
3 insufficiency. And even if there had been no such attempt, Broad does not so inform the Board.  
4 Motion 2 does not satisfy the requirement that “[t]he motion must . . . explain . . . what attempts,  
5 if any, have been made . . . .” Accordingly, the Board should deny Motion 2.

6 **II. THE BOARD DID NOT AUTHORIZE THE ADDITION OF THE REQUESTED**  
7 **COUNTS TO PROPOSED COUNT 1**

8 On page 1, lines 12–15, Broad notes that in the event that the Board denies Broad Motion  
9 1 and proceeds with Count 1, claim 41 of the 710 Application and claim 95 of the 260 Application  
10 are both limited to single-molecule RNA (“sgRNA”) configurations, and thus also correspond to  
11 Count 1. The response is that, as discussed above, if the Board reaches Motion 2, it has granted  
12 Motion 1, so Broad’s request would be unnecessary in that event. The further response is that, to  
13 the extent this observation were to be construed as a motion for relief, Broad did not request such  
14 relief in its Motions List, and the Board did not authorize a motion to add claims to Count 1. *See*  
15 Paper 17, Broad Motions List; Paper 20, Order – Authorizing Motions and Setting Times; F9, F10.  
16 The Board should reject Broad’s unauthorized and improper request.

17 **III. THE BOARD SHOULD NOT ADD CLAIMS 40 AND 41 OF THE 710**  
18 **APPLICATION, OR 94 AND 95 OF THE 260 APPLICATION, BECAUSE BROAD**  
19 **CHARACTERIZED THESE CLAIMS AS ENCOMPASSING BOTH SINGLE-**  
20 **AND DUAL-MOLECULE RNA**

21 On page 3, line 23 to page 4, line 5, Broad argues that “the species claims [40 and 41 of  
22 the 710 Application and 94 and 95 of the 260 Application] also correspond to Proposed Count 2,  
23 which is generic as to the RNA configuration.” Mot. 3:23–4:5. The response is that Broad’s  
24 characterization of these claims in Motion 2 is inconsistent with its characterizations in its Motions  
25 List and, therefore, its argument exceeds the scope of the Board’s authorization for Motion 2.



1           In its Motions List, Broad characterized all six claims of the two applications as “generic”  
2 claims: “Broad understands that claims that are generic to encompass both dual RNA and chimeric  
3 RNA embodiments . . . are considered ready for allowance . . . . These allowable claims therefore  
4 are appropriate for addition to this interference . . . .” Paper 17, Broad Motions List, 5:21–5:26;  
5 F11. In the Order authorizing the motions, the Board accepted and relied on this Broad  
6 representation: “Broad asserts that these claims [i.e., all six claims] encompass both dual and  
7 single RNA embodiments . . . .” Paper 20, Order – Authorizing Motions and Setting Times, 3:16–  
8 22; F12.

9           In its Motion, however, Broad has reversed course, now characterizing claim 1 of the 710  
10 Application and claim 74 of the 260 Application as “parallel independent claims” and claims 40  
11 and 41 of the 710 Application and claims 94 and 95 of the 260 Application as “dependent claims,”  
12 and for the first time characterizing claims 41 and 95 as limited to single-molecule RNA, and  
13 claims 40 and 94 as limited to dual-molecule RNA. Mot. 3:18–4:4; F13. Broad’s statements in  
14 contingent Motion 2 are plainly inconsistent with its prior representations, in its Motions List,  
15 where Broad characterized all six claims as “generic.” F11.

16           Because the Board relied on Broad’s prior characterization (F12), the Board’s authorization  
17 is also limited to the Broad’s initial characterization of the claims as generic. Broad may not now  
18 expand its arguments to urge that claims 40, 41, 94 and 95 are limited to single- or dual-molecule  
19 RNA. In doing so, Broad exceeds the scope of its authorization for Motion 2. Accordingly, for  
20 this additional reason, the Board should dismiss or deny Broad’s request to add claims 40, 41, 94  
21 and 95.

22 **IV. CONCLUSION**

23           For the foregoing reasons, and those set forth in ToolGen’s opposition to Broad’s Motion  
24 1, the Board should dismiss or deny Broad’s request to add claims 1, 40, and 41 of the 710

1 Application and claims 74, 94, and 95 of the 260 Application to the interference and to designate  
2 them as corresponding to Proposed Count 2.

3 Respectfully submitted,

4 Dated: August 6, 2021

/Timothy J. Heverin/

5 Timothy J. Heverin  
6 Reg. No. 77,386  
7 JONES DAY  
8 Counsel for Senior Party ToolGen, Inc.

**APPENDIX 1: LIST OF EXHIBITS CITED**

<b>Ex. No.</b>	<b>Description</b>
2063	U.S. Patent Application 15/160,710, Zhang, May 20, 2016 (the 710 Application).
2065	U.S. Patent Application 15/430,260, Zhang, February 10, 2017 (the 260 Application).

**APPENDIX 2: STATEMENT OF MATERIAL FACTS**

**Junior Party's Alleged Facts 1-8 and Senior Party's Answers**

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3 1. Proposed Count 2 reads as follow:

4 **Proposed Count 2**

5 Broad application 15/160,710, claim 1

6 or

7 ToolGen Application 14/685,510, claim 85

8 Broad Motion 1 at 4.

9 **Response: Admitted.**

10 2. The applications sought to be added are Broad applications 15/160,710 (allowable claims  
11 1, 40, and 41) and 15/430,260 (allowable claims 74, 94, and 95). Exs. 2063 and 2065.

12 **Response: Admitted.**

13 3. The 710 Application has been posted by the Office electronically and is available on  
14 Public PAIR. *See* Ex. 2063.

15 **Response: Admitted.**

16 4. The 260 Application have been posted by the Office electronically and is available on  
17 Public PAIR. *See* Ex. 2065.

18 **Response: Admitted.**

19 5. Claims 1, 40, and 41 of the 710 Application are in allowable condition as acknowledged  
20 in an Office communication dated April 5, 2021. Ex. 2063 at April 5, 2021 Office  
21 Communication, page 2. (Part 4 at PDF pp. 230, 253).

22 **Response: Admitted that the Examiner has found the claims to be in allowable**  
23 **condition.**

1 6. Claims 74, 94, and 95 of the 260 Application are in allowable condition as acknowledged  
2 in an Office communication dated April 5, 2021. Ex. 2065 at April 5, 2021 Office  
3 Communication, page 2. (Part 36 at PDF p. 248).

4 **Response: Admitted that the Examiner has found the claims to be in allowable**  
5 **condition.**

6 7. Claims 1, 40, and 41 of the 710 Application correspond to Proposed Count 2. Ex. 2454,  
7 Seeger Decl. ¶¶ 203-06.

8 **Response: Denied.**

9 8. Claims 74, 94, and 95 of the 260 Application correspond to Proposed Count 2. Ex. 2454,  
10 Seeger Decl. ¶¶ 203-06.

11 **Response: Denied.**

**ToolGen’s Additional Material Facts 9-13**

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9. The Board authorized Broad to file a motion, contingent on the grant of Broad proposed motion to substitute the count, to add claims of Broad applications corresponding to the substituted count—Proposed Count 2. Paper 20, Order – Authorizing Motions and Setting Times, 3:16–4:3

10. Broad did not request and the Board did not authorize Broad to file a motion to add claims of Broad applications corresponding to Count 1. *See generally* Paper 20, Order – Authorizing Motions and Setting Times, 2:17–6:13.

11. In its Motions List, Broad characterized all six claims—Claims 1, 40, and 41 of the 710 Application and Claims 74, 94, and 95 of the 260 Application—as generic, stating: “Broad understands that claims that are generic to encompass both dual RNA and chimeric RNA embodiments . . . are considered ready for allowance . . . . These allowable claims therefore are appropriate for addition to this interference . . . .” Paper 17, Broad Motions List, 5:21–5:26.

12. In the Order authorizing the motions, the Board accepted and relied on Broad’s representation that all six claims are generic: “Broad asserts that these claims [i.e., all six claims] encompass both dual and single RNA embodiments . . . .” Paper 20, Order – Authorizing Motions and Setting Times, 3:16–22.

13. In Motion 2, Broad characterizes claim 1 of the 710 Application and claim 74 of the 260 Application as “parallel independent claims” and claims 40 and 41 of the 710 Application and claims 94 and 95 of the 260 Application as “dependent claims,” and for the first time characterizes claims 41 and 95 as limited to single-molecule RNA, and claims 40 and 94 as limited to dual-molecule RNA. Mot. 3:18–4:4.

## CERTIFICATE OF SERVICE

I hereby certify that the foregoing **TOOLGEN OPPOSITION 2** was filed via the Interference Web Portal on August 6, 2021 by 8:00 PM EDT, and thereby served on the attorneys of record for the Junior Party pursuant to ¶ 105.3 of the Standing Order. Pursuant to agreement of the parties, service copies are being sent by email by counsel for Junior Party as follows:

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