

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

Before DEBORAH KATZ, DAVID COTTA, and
RACHEL H. TOWNSEND, *Administrative Patent Judges*.

KATZ, *Administrative Patent Judge*.

ORDER – Procedure on Remand
37 C.F.R. § 41.104(a)

On May 12, 2025, the Federal Circuit rendered an opinion on the Decision on Motions (Paper 877) and Decision on Priority (“Priority Decision”) (Paper 2863) issued by the Board in this interference. *See Regents of the University of California v. Broad Institute, Inc.*, 136 F.4th 1367 (Fed. Cir. 2025). The opinion vacated the Board’s decision to award priority to Senior Party (“Broad”), affirmed the Board’s decision on the accorded benefit of the filing dates of Junior Party’s (“CVC’s”) earlier applications, and remanded the case back to the Board to reconsider the issue of conception. *See id.* at 1385. The court’s mandate was entered on June 18, 2025.

The parties contacted the Board regarding the procedure on remand. (*See Appendix.*) A conference call was held on August 15, 2025. (*See Transcript, Ex. 5357.*) Eldora Ellison, David Holman, Pratibha Khanduri, Li-Hsien Rin-Laures, Sandip Patel, Jeffrey Lamken, and Elizabeth Clarke were present for CVC. Raymond Nimrod and Steven Trybus were present for Broad. Deborah Katz and David Cotta were present for the Board.

Although the parties agree that any additional briefing should be supplemental to the parties’ original briefs and that the evidentiary record should not be reopened, they disagree about the nature of supplemental briefing. (*See id.*)

Briefly, CVC argues that supplemental briefing should provide an opportunity to show that its inventors were the first to conceive of the invention and that they exercised reasonable diligence to reduce it to practice and/or that it had prior conception and there was communication of the conception to Broad. (*See id.*) CVC argues that Broad should not be allowed to reargue its priority case because it was not appealed to the Federal Circuit. (*See id.*) CVC argues that it should be provided an

opportunity to submit an opening supplemental brief of no more than 20 pages, that Broad should be provided with an opportunity to submit a responsive brief of no more than 20 pages, and that CVC should be provided with an opportunity to submit a brief in reply of not more than 10 pages. (*See id.*)

Broad argues that it should be provided an opportunity to argue why it should be awarded priority, as well as why CVC did not have a conception. (*See id.*) Broad argues that the issue of derivation should not be reopened because the Board already rejected CVC's assertions of derivation and because that determination was not appealed to the Federal Circuit and is not within the scope of issues on remand. (*See id.*) Broad argues that CVC should be provided an opportunity to submit an opening supplemental brief on priority of not more than 30 pages, that Broad should be provided an opportunity to submit an opening supplemental brief on priority of not more than 30 pages after CVC's opening brief has been submitted, and that both parties should be provided an opportunity to file briefs in opposition of not more than 30 pages. (*See id.*)

On the conference call, the parties were authorized to each file a paper indicating the dates of conception asserted in their respective priority motions. (*See Papers 2896, 2899.*) CVC asserts that it argued for four alternative dates of conception in its priority motion: March 1, 2012; April 11, 2012; May 28, 2012; and June 28, 2012. (Paper 2896, 1:3–4 (citing CVC Motion 2, Paper 1579, 3:2-7, 4:13–20:23).) Broad asserts that it argued for conception of “an embodiment with the addition of a GAAA covalent linker” on June 26, 2012. (Paper 2896, 1:12–13 (citing Broad Motion 5, Paper 2118, 3:10–4:6; 11:1–12:9; 41:20–44:14).)

The earliest date of conception asserted by Broad in its priority motion (June 26, 2012) is earlier than the last date of conception asserted by CVC in its priority motion (June 28, 2012). “[P]riority of invention goes to the first party to reduce an invention to practice unless the other party can show that it was the first to conceive of the invention and that it exercised reasonable diligence in later reducing that invention to practice.” *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998); see *Regents*, 136 F.4th at 1382. Thus, if, on remand, we are persuaded that the CVC inventors conceived of an embodiment of the count by June 28, 2012, even if not by March 1, 2012, April 11, 2012, or May 28, 2012, we must consider Broad’s arguments that its inventors conceived of an embodiment of the count earlier, by June 26, 2012.

During the conference call, counsel for CVC argued that Broad’s priority motion did not address the basis of the Federal Circuit’s remand, and that, therefore, the parties’ briefing on remand should not address Broad’s conception arguments. (*See* Transcript, Ex. 5357, 20:18–22:13.)

Nevertheless, the Federal Circuit remanded the determination of which party was the first to conceive of the invention, with diligence to later reducing the invention to practice. *See Regents*, 136 F.4th at 1382. Given the parties’ asserted dates of conception, we may have to consider Broad’s priority arguments in light of the standards articulated in the court’s opinion. Accordingly, both parties will be given a chance to submit briefing to supplement their original priority briefs, in light of the court’s opinion.

Broad argues that that CVC should submit its briefing first, followed by Broad, following the “prior and traditional” interference practice. (*See* Transcript, Ex. 5357, 26:17–20.) Because the parties have already submitted their priority briefs, with the facts of each already of record, and the current

briefing is only supplemental, there does not seem to be a reason to stagger the due dates. Accordingly, the parties' supplemental briefs will be due on the same day, followed by oppositions and replies from each party, with both parties' briefs in each round due on the same day.

The parties disagree about whether the court's remand provides for renewed argument about derivation. CVC argues that it should be given an opportunity to argue that the Broad inventors derived the subject matter of the count. (*See Appendix.*) CVC cites the court's statement that "[o]n remand, the later party to reduce to practice will have the opportunity to show, under a conception date established by the correct standard . . . (2) it had 'prior conception of the claimed subject matter and communication of the conception to the adverse claimant.'" (*Regents*, 136 F.4th at 1382 (quoting *Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993) (awarding priority where there was "prior conception of the claimed subject matter and communication of the conception to the adverse claimant."))). CVC argues that this provides an opportunity to reassert derivation. (*See Appendix.*) Broad argues that the question of derivation should not be reopened because the Board's determination that CVC did not prevail on its derivation argument was not appealed and the issue of derivation was not within the scope of the issues on remand. (*See Appendix.*)

We agree with CVC that the Federal Circuit referred to derivation in its explanation of issues on remand. (*See id.*) The parties are free to include arguments in their briefs about whether the issue of derivation is reopened on remand.

In consideration of the foregoing, it is

ORDERED that both CVC and Broad may each file a brief regarding the issues on remand, of not more than 25 pages, by **October 10, 2025**;

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It is further ORDERED that both CVC and Broad may each file a brief in opposition to the other party's brief, of not more than 25 pages, by **November 7, 2025**;

It is further ORDERED that both CVC and Broad may each file a reply brief of not more than 10 pages, by **December 5, 2025**; and

It is further ORDERED that no new evidence shall be filed in the record without authorization.

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Appendix

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Subject: Interference 106,115 (DK)

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Dear PTAB,

The Court of Appeals for the Federal Circuit has issued a decision in the appeal of Interference 106,115, *Regents of the University of California v. Broad Institute Inc.*, 136 F.4th 1367 (Fed. Cir. 2025) (“*CVC II*”) (copy attached for the Board’s convenience). The Court’s mandate, remanding this Interference to the PTAB, issued on June 18, 2025. Pursuant to PTAB Standard Operating Procedure 3, the parties have conferred and jointly submit this request (within 10 business days) for a call with the PTAB to discuss how to proceed on remand.

While the parties have reached agreement on some issues for a proposed procedure on remand, they were unable to reach agreement on others, as set forth below.

Points of Agreement

The parties jointly propose that there be additional briefing on remand to address the impact of the Federal Circuit’s decision in *CVC II* on certain issues. The parties agree that any briefs should be supplements to, not replacements for, the parties’ original priority briefs. The parties agree that the evidentiary record should not be reopened.

CVC’s Proposal

The Federal Circuit stated that, “on remand,” CVC would “have the opportunity to show” that “either (1) it was the first to conceive of the invention and that it exercised reasonable diligence in later reducing that invention to practice, or (2) it had prior conception of the claimed subject matter and communication of the conception to the adverse claimant.” *CVC II*, 136 F.4th at 1382. The Court stated that, in deciding whether conception was complete, the Board must ask “whether a person of ordinary skill in the art could have reduced the invention to practice” with routine skill. *Id.* at 1378-82. The

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Court identified specific categories of evidence the Board's prior decision should have considered in evaluating the completeness of CVC's conception:

"[E]vidence of purported experimental success by others." *CVC II*, 136 F.4th at 1379, 1381.

Whether the CVC inventors "contemplated the use of routine skill or methods at an asserted conception date, or used such routine skill or methods during subsequent, successful experimentation." *CVC II*, 136 F.4th at 1379, 1382.

Whether the CVC inventors "actually and substantively modified the system." *CVC II*, 136 F.4th at 1379.

Consistent with the Federal Circuit's mandate, CVC would be permitted to argue "prior conception of the claimed subject matter and communication of the conception to the adverse claimant," *i.e.*, derivation. *CVC II*, 136 F.4th at 1382 (quoting *Price v. Symsek*, 988 F.2d 1187, 1190 (Fed. Cir. 1993)); *Price*, 988 F.2d at 1190 ("To prove derivation in an interference proceeding, the person attacking the patent must establish prior conception of the claimed subject matter and communication of the conception to the adverse claimant."); *see* CVC Opening Appeal Br. 44-47 (arguing derivation on appeal); Decision on Priority at 71 (rejecting CVC's derivation argument based on holding that CVC did not have "prior conception").

Consistent with SOP 3's provision (at 3) that "[a]dditional briefing . . . will normally be limited to the specific issues raised by the remand," CVC proposes limited remand briefing on CVC's conception, confined to the categories of evidence identified by the Federal Circuit and set forth above. CVC does not believe the scope of remand allows Broad to re-argue its priority case, which was not appealed to the Federal Circuit.

CVC proposes the following briefing schedule and page limits (excluding any Statement of Material Facts):

CVC's Opening Brief (20 pages): 4 weeks after schedule is set;

Broad's Response Brief (20 pages): 4 weeks after CVC's Opening Brief;

CVC's Reply Brief (10 pages): 2 weeks after Broad's Response Brief.

Broad's Proposal

Broad proposes the following procedure on remand:

1. Because the briefs on remand will be supplements to the parties' original priority briefs, Broad proposes that the briefs generally follow the sequence of the original briefs. Specifically, Broad proposes briefs on remand as follows:
 - a. CVC's Opening Brief on its Priority Motion, not to exceed 30 pages, 4 weeks after the schedule is set,

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- b. Broad's Opening Brief on its Priority Motion, not to exceed 30 pages, 4 weeks after CVC's Opening Brief, and
- c. The Parties' Oppositions, each not to exceed 30 pages simultaneously 4 weeks after Broad's Opening Brief.

Broad believes that this is fair and appropriate and allows Broad to focus on both why CVC's Motion for Priority should continue to be denied as well as why Broad should be awarded priority even if the PTAB holds that CVC did have a conception, which it did not.

No matter which briefing schedule is used, Broad proposes:

2. The briefs on remand on CVC's Priority Motion shall address the "key question" of "whether [Regents' scientists] had formed the idea of [the invention's] use for [its intended] purpose in sufficiently final form that only the exercise of *ordinary skill* remained to reduce it to practice' 'without extensive research or experimentation.' *Burroughs*, 40 F.3d at 1228, 1231 (emphasis added [by Federal Circuit])." CVC II, 136 F.4th at 1379.
3. The briefs on remand shall not reopen the question of derivation as suggested by CVC because, as the Federal Circuit noted, the PTAB has already "rejected Regents' assertion that Broad 'derived the system recited in Count 1 entirely from' Regents." CVC II, 136 F.4th at 1377. That determination by the PTAB was not appealed, and the issue of derivation is not within the scope of the issues on remand.

If the PTAB adopts CVC's proposal on briefing, Broad proposes that neither party be allowed a second (reply) brief or that both parties be allowed second (reply and sur-reply) briefs and if the PTAB does allow only CVC to file a second brief that the total pages of briefing be the same for each party, i.e., CVC's Opening – 20 pages, Broad's Opposition – 30 pages, CVC's Reply – 10 pages.

Availability for a Call

With the understanding that SOP 3 (at p. 2) states that "[t]eleconferences with the panel should take place within the first month after the mandate," the parties are available for a call with the Board to discuss remand procedures on Wednesday, July 9 between 12:00pm-2:30 pm and 4:00-5:00 pm ET; Thursday, July 10 between 1:30-3:00pm ET; and Tuesday, July 15 between 2:00 pm-4:00 pm ET.

Respectfully submitted,

Interference 106,115

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