PORZIO
BROMBERG&NEWMAN P.C.

DC CLIENT ALERT

April 21, 2016

CRISPR Interference at the USPTO

By W. John McKeague, Ph.D.

The CRISPR (Clustered Regularly Interspaced Short Palindromic Repeats) Technology was first identified in bacteria and is an RNA based system to help protect bacteria against viral infections. It has broad applications and is poised to be a valuable tool in genome engineering.

Earlier this year, the United States Patent and Trademark Office (USPTO) declared an interference between a patent application owned by University of California Berkeley, University of Vienna and Emmanuelle Charpentier (collectively, University of California), and five patents owned by Massachusetts Institute of Technology and The Broad Institute, Inc. along with seven patents owned by Massachusetts Institute of Technology, The Broad Institute, Inc. and the President and Fellows of Harvard College (collectively, Broad Institute). In doing so, the USPTO declared that the University of California is the Senior Party and the Broad Institute is the Junior Party, and proposed one count in the interference. The interference is in the motions phase, and each party has already requested permission to file various motions. The USPTO has authorized some motions and deferred authorization on others.

On March 3, 2016, the Broad Institute asked the USPTO permission to file the following motions:	**On March 17, 2016, the USPTO authorized Broad Institute to file the following motions:**
No interference-in-fact.	No interference-in-fact.

EDITORIAL TEAM

Principals

Kevin M. Bell
202.517.6325
kmbell@pbnlaw.com

Scott A.M. Chambers, Ph.D.
202.517.6324
sachambers@pbnlaw.com

Richard J. Oparil
202.517.6323
rjoparil@pbnlaw.com

Counsel

Matthew J. Laskoski
202.517.1919
mjlaskoski@pbnlaw.com

W. John McKeague, Ph.D.
202.517.6320
wjmckeague@pbnlaw.com

Associates

B. Dell Chism
202.517.6314
bdchism@pbnlaw.com

Caroline C. Maxwell
202.517.1988

The Broad Institute is entitled to the priority benefit of **at least one** of the provisional applications with respect to the subject matter of the count.	The Broad Institute is entitled to the priority benefit of **at most four** of the provisional applications with respect to the subject matter of the count.
The University of California claims are unpatentable for lack of written description, **lack of enablement, and anticipation and/or obviousness in view of prior art.**	The University of California claims are unpatentable for lack of written description. The University of California claims are unpatentable for lack of enablement, and anticipation and/or obviousness over the prior art, **was deferred.**
Certain claims of the Broad Institute patents do not correspond to the count.	Certain claims of the Broad Institute patents do not correspond to the count.

On March 3, 2016 the University of California asked the USPTO permission to file the following motions:	**On March 17, 2016, the USPTO authorized the University of California to file the following motions:**
All the Broad Institute claims are unpatentable because they are subject to America Invents Act (AIA) prior art provisions.	All the Broad Institute claims are unpatentable because they are subject to America Invents Act (AIA) prior art provisions, **was deferred**.
Substitute the count and add further counts.	Substitute the count **for one other count, alternatively propose two counts to describe two separately patentable inventions**.
De-designate claims corresponding to the current count and add claims designated to the current count.	**The USPTO did not issue an order on this motion**.

ccmaxwell@pbnlaw.com

Matthew D. Zapadka
202.517.6313
mdzapadka@pbnlaw.com

The University of California is awarded priority of invention.	**The USPTO did not issue an order on this motion**.
The University of California is entitled to the priority benefit of **each of its four** provisional applications with respect to the subject matter of the count.	The University of California is entitled to **the priority benefit of the provisional applications with respect to the subject matter of the count.**
The Broad Institute claims are unpatentable as anticipated or obvious over the prior art.	The Broad Institute claims are unpatentable as anticipated or obvious over the prior art, **was deferred**.
The Broad Institute claims are unpatentable under obviousness-type double patenting over non-commonly-owned involved patents.	The Broad Institute claims are unpatentable under obviousness-type double patenting over non-commonly-owned involved patents, **was deferred**.
The Broad Institute claims are unpatentable for lacking proper inventorship.	The Broad Institute claims are unpatentable for lacking proper inventorship, **was deferred**.
The Broad Institute claims were obtained through inequitable conduct.	The University of California's request to file a motion that the Broad Institute claims were obtained through inequitable conduct, **was denied.** **The University of California may request authorization to file this motion after the conclusion of the priority phase**.

On March 31, 2016, the University of California filed a request for reconsideration of the USPTO's decision on the authorization of motions. Specifically, the University of California sought reconsideration of the motions that the Broad Institute claims are subject to AIA prior art provisions, and the proposed motion to de-designate certain of the University of California claims as corresponding to the count. On April 15, the USPTO denied the request for rehearing.

It appears from the list of motions that the University of California requested permission to file that there may be numerous attacks on the validity of the claims in the Broad Institute patents. While the USPTO has not permitted the University of California to file these motions at this time, it remains to be seen if this will cause a problem for the Broad Institute patents. The USPTO may authorize the University of California motions at a later time during the course of the interference. Also, there is the possibility that a third party, or parties, may challenge the validity of the Broad Institute patents in another forum or proceeding.