

USPTO Launches New Round In CRISPR Patent War

By Ryan Davis

Law360 (June 25, 2019, 10:06 PM EDT) -- The dispute between the University of California and the Broad Institute over which was the first to invent the breakthrough gene-editing technology CRISPR entered another phase Monday, as the U.S. Patent and Trademark Office launched a new proceeding aimed at settling the issue.

The office's Patent Trial and Appeal Board issued an order initiating what is known as an interference proceeding, which will analyze patents issued to Broad and applications filed by UC on technology for using CRISPR in plant and animal cells, known as eukaryotes.

The proceeding is designed to determine which party was the first to invent the use of the technology in eukaryotes and should be issued patents for it. This is the second time the board has instituted an interference between the parties related to CRISPR, an acronym for Clustered Regularly Interspaced Short Palindromic Repeats.

The first ended last year when the Federal Circuit affirmed the PTAB's finding that patents issued to Broad on using the technology in plant and animal cells and a patent application filed by UC on using it in any environment were distinct inventions. The board therefore didn't address which party was the first to invent the technology.

The new proceeding was triggered by 10 additional applications filed by UC on using CRISPR in plant and animal cells, which the PTAB will now compare with the same 13 patents and one application filed by Broad that were at issue in the first interference.

"The original proceeding did not answer the question of who was the first to invent. This is the case that will decide that," said Eldora Ellison of Sterne Kessler Goldstein & Fox PLLC, lead patent strategist on CRISPR matters for UC. She said the university is confident that it will be recognized as the first inventor.

Broad said in a statement that "we welcome this action by the PTAB" and "look forward to participating in the interference process."

CRISPR has been called a major breakthrough in gene editing that is much faster, simpler, cheaper and more efficient than previous technologies, and is potentially lucrative for the owner of the key patents on it. The technology was first disclosed by a team that included UC's Jennifer Doudna and Emmanuelle Charpentier of the University of Vienna in May 2012.

Broad, a research institute associated with Harvard and MIT, applied for patents later that year on using CRISPR in eukaryotic cells. The Broad team led by MIT's Feng Zhang was issued patents on the technology first because it sought them on an expedited basis, while UC's remain pending and eventually led the PTAB to declare the new interference.

While in the first interference, the PTAB found that the parties were claiming different inventions, "here, where the parties both are claiming the use of CRISPR in eukaryotes, the patent office has to decide which one of them was the first to invent," Ellison said.

The PTAB identifies one party in an interference as the senior party, whose patent has the earlier filing date, and the other as the junior party, who has the later filing date and bears the burden of proof. In this case, the board designated Broad the senior party and UC as the junior party based on filing dates of their last applications.

Broad said in a statement that the designation "underscores the significance" of its patent claims. But Ellison said that during the interference, UC will argue that it should be deemed the senior party based on earlier applications the university filed on the same subject matter dating back to 2012.

UC has recently been issued several other patents related to CRISPR that are not at issue in the interference because they are generic with respect to the environment in which they are used, Ellison said.

Interference proceedings typically take about two years, and they look at evidence like lab notebooks and emails created during research to determine which party was the first to invent. The PTAB's decision can be appealed to the Federal Circuit.

Since 2013, the USPTO has issued patents to the first inventor to file an application. Because the CRISPR patent applications were filed before that date, they are being analyzed under the previous system, in which the patents are issued to first person to actually invent the technology.

Broad is represented by Jenner & Block LLP.

UC is represented by Sterne Kessler Goldstein & Fox PLLC and RinLaures LLC.

The case is *The Regents of the University of California et al. v. The Broad Institute Inc. et al.*, interference number 106,115, before the Patent Trial and Appeal Board.

--Editing by Haylee Pearl.