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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNIPR TECHNOLOGIES LIMITED

(Inventors: Jasper Clube, Morten Sommer, Christian Grøndahl, Eric Van Der Helm, Ruben Vazquez-Uribe)

Junior Party

(Patents 10,463,049; 10,506,812; 10,561,148; 10,524,477; 10,582,712),

v.

THE ROCKEFELLER UNIVERSITY

(Inventors: David Bikard and Luciano Marraffini)

Senior Party

(Patent Application 15/159,929).

Patent Interference No. 106,123 (DK)

Decision on Motions

37 C.F.R. § 125(a)

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

KATZ, *Administrative Patent Judge*.

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1 *I. Introduction*

2 The claims involved in this interference are drawn to methods of killing or
3 modifying specific bacteria within a mixed population of bacteria, for example to
4 treat an infection or contamination within a population of non-offending bacteria.
5 (See Junior Party Clean Copy of Claims, Paper 12; see Rockefeller University
6 Clean Copy of Claims, Paper 7.) The methods rely on reprogramming innate
7 bacterial defense clustered regulatory interspaced short palindromic repeats
8 (“CRISPR”) systems, which naturally protect bacteria against viruses and
9 plasmids, to target specific bacteria, while leaving other bacteria unaltered. (See
10 patent 10,463,049, Ex. 2004, 2:1–12, 4:18–29; see US 2016/0324938
11 (“’938 appl.”); Ex. 2009, ¶ 4, abstract.)

12 The Rockefeller University (“Rockefeller”) is involved based on the claims
13 of its pending patent application. (See *id.*) Upon redeclaration, Rockefeller was
14 accorded benefit of the filing date of its provisional application, filed
15 7 February 2013, as a constructive reduction to practice of Count 1, making it the
16 senior party. (See Redeclaration, Paper 17, 5.)

17 Junior Party SNIPR Technologies Limited (“SNIPR”) is involved in the
18 interference based on the claims of several patents. (See Declaration, Paper 1, 7–
19 8.) Upon declaration, SNIPR was accorded benefit of the filing date of an
20 international application filed 3 May 2016 as a constructive reduction to practice of
21 Count 1. (See Redeclaration, Paper 17, 5.) SNIPR did not file a priority statement,
22 indicating that it does not contest priority against Rockefeller.

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1 Each party has the burden of proof when filing a motion in an interference.
2 *See* 37 C.F.R. § 41.208(b) (“To be sufficient, a motion must provide a showing,
3 supported with appropriate evidence, such that, if unrebutted, it would justify the
4 relief sought. The burden of proof is on the movant.”); *see also* 37 C.F.R.
5 § 41.121(b). We review the parties’ arguments and supporting evidence to
6 determine if the parties have met their burdens.

7 In interferences we take up motions in the order that secures the just, speedy,
8 and inexpensive determination of the proceeding.¹ *See* 37 C.F.R. § 41.125(a). We
9 deny SNIPR Motion 1 (Paper 26), arguing that the interference is contrary to the
10 statute. We also deny SNIPR Motion 5 (Paper 29), arguing that some of its claims
11 were improperly designated as corresponding to the count. Because SNIPR is
12 junior party, but failed to present a priority statement asserting a date of invention
13 before Rockefeller’s earliest accorded benefit date, we enter judgment against
14 SNIPR and dismiss all of the parties’ other motions as being moot.

15 *II. SNIPR Motion 1 – To Terminate as Contrary to the AIA*

16 SNIPR argues that this interference should be terminated because it is
17 contrary to the Leahy-Smith America Invents Act (Pub. L. No. 112-29, 125 Stat.
18 284 (2011)) (“AIA”). According to SNIPR, in the AIA, Congress eliminated
19 interferences for patents that claim inventions with effective filing dates only after
20 the AIA’s effective date and also eliminated the bar to obtaining a patent under

¹ The panel determined that no oral argument was needed and none was ordered. *See* 37 C.F.R. § 41.124 (a).

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1 35 U.S.C. § 102(g) based on priority of invention. (SNIPR Motion 1, Paper 26,
2 1:2–18.) We deny SNIPR Motion 1.

3 SNIPR asserts that the “earliest possible effective filing” dates of its
4 involved patents are after 16 March 2013, the implementation date of the AIA.
5 (See SNIPR Motion 1, Paper 26, 1:20–21.) SNIPR also acknowledges that
6 Rockefeller was accorded benefit as to Count 1 of the filing date of earlier priority
7 applications, with the earliest date being 7 February 2013. (See *id.* at 1:21–23,
8 citing Redeclaration, Paper 17, 5.)

9 As SNIPR argues, the AIA changed United States patent law from a “first to
10 invent” to a “first inventor to file” regime and changed 35 U.S.C. § 135 to address
11 derivation proceedings instead of interferences. See AIA §§ 3(o) and (p). As
12 SNIPR also argues, the AIA eliminated 35 U.S.C. § 102(g), which provides that a
13 person is entitled to a patent unless, during the course of an interference, another
14 inventor establishes that before such person’s invention, the invention was made
15 by another who had not abandoned, suppressed, or concealed it. See AIA § 3(b).

16 Along with these changes, Congress promulgated a portion of the AIA to
17 explain the effective dates of the new laws. Congress provided that “[i]n
18 [g]eneral,” the amendments made by the AIA would take effect 18 months after
19 enactment of the AIA. See AIA § 3(n)(1). But Congress also added a specific
20 timing provision for the changes relating to interfering patents. Specifically,
21 Congress provided:

22 (2) INTERFERING PATENTS.--The provisions of sections
23 102(g), 135, and 291 of title 35, United States Code, as in effect on
24 the day before the effective date set forth in paragraph (1) of this
25 subsection, shall apply to each claim of an application for patent, and

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1 any patent issued thereon, for which the amendments made by this
2 section also apply, if such application or patent contains or contained
3 at any time--

4 (A) a claim to an invention having an effective filing date
5 as defined in section 100(i) of title 35, United States Code, that
6 occurs before the effective date set forth in paragraph (1) of this
7 subsection; or

8 (B) a specific reference under section 120, 121, or 365(c)
9 of title 35, United States Code, to any patent or application that
10 contains or contained at any time such a claim.

11
12 AIA § 3(n)(2). In this provision, Congress expressly provided for the continuation
13 of interferences under certain circumstances.

14 According to SNIPR, “[b]y its plain terms, [the “Interfering Patents”
15 provision of section 3(n)(2)] applies to a narrow subset of applications and
16 patents—those claiming a mix of inventions with different effective filing dates,
17 some before March 16, 2013, and others after (or referencing applications or
18 patents that do so).” (SNIPR Motion 1, Paper 26, 5:19–21.) SNIPR argues that
19 section 3(n)(1) makes it clear that the changes under the AIA apply to all of
20 SNIPR’s patents, including the elimination of 35 U.S.C. §§ 102(g) and 135,
21 because all of the claims of those patents issued from applications having effective
22 filing dates after 16 March 2013. (*See id.* at 7:10–14, 8:6–18.) SNIPR argues that
23 section 3(n) created categories of applications or patents with varying applicability
24 to pre-AIA interference proceedings according to the effective filing date of the
25 claims, but that none of these categories provides for an interference involving
26 “pure-AIA applications or patents” with only post-AIA claims like SNIPR’s
27 claims. (*Id.* at 55:28–6:17, 9:5–21.)

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1 SNIPR argues further that under the AIA the Director lacks authority to
2 declare an interference involving such “pure-AIA applications or patents.” (*See*
3 SNIPR Motion 1, Paper 26, 7:21–23.) SNIPR cites to the section 3(j) of the AIA,
4 which is entitled “Elimination of References to Interferences.” (*See id.* at 7:24–
5 8:5.) SNIPR also cites to section 3(n)(2) of the AIA to argue that if Congress had
6 intended applications and patents filed after implementation of the AIA to be
7 included in interference proceedings, it would have expressly said so. (*See id.* at
8 9:7–14 and 9:19–21.)

9 We are not persuaded that the AIA prevents the Director from declaring an
10 interference with SNIPR’s patent claims despite their later effective filing date.
11 Although section 3(j) of the AIA changes references to the “Board of Patent
12 Appeals and Interferences” to the “Patent Trial and Appeal Board” and changes
13 other references from “interferences” to “derivations,” it does not state that no
14 interferences could be declared after 16 March 2013. Instead, section 3(n)(2)
15 expressly provides for interferences after that date. SNIPR fails to explain how
16 section 3(n)(2) is operable if an interference cannot be conducted, yet the Office
17 must examine claims with an effective filing date before 16 March 2013 under
18 35 U.S.C. § 102(g) and those claims interfere with claims filed after that date.

19 In section 3(n)(2) of the AIA, Congress stated that the provisions of sections
20 35 U.S.C. §§ 102(g) and 135 shall apply to each claim having an effective filing
21 date, or reference to a filing date, before 16 March 2013. (*See* AIA, 125 Stat 284.)
22 Thus, claims with an effective filing date before 16 March 2013, can be allowed
23 only if they comply with 35 U.S.C. § 102(g). If, as here, an applicant’s claims are
24 otherwise allowable, except for the existence of an interference with other claims,

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1 the Director has the authority to conduct an interference proceeding under pre-AIA
2 35 U.S.C. § 135 to determine priority of the claims under examination. SNIPR
3 argues that its claims cannot be subject to an interference under AIA section
4 3(n)(1) regardless of whether this section applies to Rockefeller’s application, but
5 fails to explain how patentability of Rockefeller’s claims can be assessed, given
6 SNIPR’s patent claims, as required under AIA section 3(n)(2). (*See* SNIPR
7 Motion 1, Paper 26, 7:14–15.) SNIPR argues that the response to Rockefeller’s
8 assertion that only one patent be issued for an invention is that “the only issued
9 patents here are SNIPR’s” fails to address the question the Office must answer:
10 whether Rockefeller is entitled to a patent on its involved claims under 35 U.S.C. §
11 102(g). (*See* SNIPR Reply 1, Paper 152, 9:16–18.) Section 3(n) directs us to hold
12 an interference under 35 U.S.C. § 135 to answer that question.

13 Congress could have ended all interferences at the implementation of the
14 AIA, acknowledging that different parties may both be issued claims for the same
15 patentable invention even when one party has an effective filing date before
16 16 March 2013, but Congress decided against this option by enacting
17 section 3(n)(2). Congress did not expressly qualify its choice to continue
18 interferences as being only when both parties’ claims have an effective filing date
19 before 16 March 2013. Because an analysis under 35 U.S.C. § 102(g) must still be
20 done for all pre-AIA claims, we are not persuaded that Congress intended only a
21 subset of interferences arising from such analyses to be completed under 35 U.S.C.
22 § 135(a).

23 SNIPR acknowledges the need for an interference to complete examination
24 of Rockefeller’s claims, but fails to explain how its position would allow the

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1 Office to fulfill its mandate without involvement of SNIPR’s claims. (*See* SNIPR
2 Motion 1, Paper 26, 11:22–12:15.) According to SNIPR, Rockefeller’s application
3 could be subject to interference in a “different proceeding,” but SNIPR fails to
4 explain what this “different proceeding” would be, given that it is Rockefeller’s
5 claims that interfere with SNIPR’s claims. (*Id.* at 12:1–4.) SNIPR does not argue
6 that its claims do not interfere with Rockefeller’s claims. Nor does SNIPR explain
7 how section 3(n)(2) can be applied to Rockefeller’s application claims without a
8 determination of priority between Rockefeller’s and SNIPR’s claims – that is,
9 without an interference between Rockefeller and SNIPR.

10 SNIPR argues that section 3(n) means that both interfering applications, or
11 both interfering application and patent, must be subject to the pre-AIA statutes in
12 order for the Director to have authority to declare an interference. (*See* SNIPR
13 Motion 1, Paper 26, 12:11–13.) SNIPR argues further that “Congress’s express
14 choice to subject a subset of applications and patents to the previous interference
15 provisions reinforces Congress’s intent to exclude applications and patents outside
16 that subset, like SNIPR’s, from interference proceedings.” (SNIPR Reply 1,
17 Paper 152, 3:16–18.) We disagree. Instead, the decision to continue interferences,
18 in section 3(n)(2), indicates that Congress contemplated interferences between pre-
19 AIA and post-AIA applications and patents. SNIPR fails to persuade us that the
20 Director lacked the authority to declare this interference or that it was declared
21 inappropriately.

22 SNIPR argues further that the Board should exercise its discretion and
23 terminate the interference. (*See* SNIPR Motion 1, Paper 26, 13:18–14:5.) Pre-AIA
24 35 U.S.C. § 135(a) states: “The Board of Patent Appeals and Interferences *shall*

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1 determine questions of priority of the inventions and may determine questions of
2 patentability.” (Emphasis added.) Thus, contrary to SNIPR’s argument, once
3 declared, the Board lacks discretion to decline to determine “questions of priority
4 of the inventions.”

5 SNIPR also argues that because 35 U.S.C. §102(g) cannot be used to bar the
6 patentability of SNIPR’s claims, the “Board should clarify that any priority of
7 invention showing by Rockefeller cannot invalidate SNIPR’s claims.” (SNIPR
8 Motion 1, Paper 26, 14:5–8.) We disagree because if, given our obligation under
9 pre-AIA 35 U.S.C. § 135(a) to determine priority, we conclude that SNIPR has not
10 prevailed on priority, the statute provides that

11 [a] final judgment adverse to a patentee from which no appeal or other
12 review has been or can be taken or had shall constitute cancellation of the
13 claims involved in the patent, and notice of such cancellation shall be
14 endorsed on copies of the patent distributed after such cancellation by the
15 Patent and Trademark Office.

16

17 35 U.S.C. § 135(a). Thus, a determination that SNIPR lacks priority must result in
18 judgment against SNIPR and the cancellation of SNIPR’s involved patent claims.

19 Accordingly, we DENY SNIPR Motion 1.

20

21 *II. SNIPR Motion 4 – To Deny Rockefeller Benefit of Its Provisional*
22 *Application*

23 SNIPR argues that Rockefeller should not have been accorded benefit of the
24 filing date, 7 February 2013, of its provisional application 61/761,971 as to
25 Count 1 upon redeclaration of the Interference because it does not include a

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1 constructive reduction to practice of Count 1. (*See* SNIPR Motion 4, Paper 28,
2 1:2–4.) SNIPR asserts, further, that

3 [i]f this motion is granted, Rockefeller’s priority benefit would be limited to
4 February 14, 2014, the filing date of PCT/US2014/015252. Because this date
5 and SNIPR’s effective filing date are both after the effective date of the
6 America Invents Act (Pub. L. No. 112-29, 125 Stat. 284 (2011)), granting
7 this motion should result in the termination of this interference.

8
9 (*See id.* at 1:4–8; *see also id.* at 6:21–23.)

10 SNIPR does not explain why the benefit date accorded to Rockefeller as the
11 earliest constructive reduction to practice of the count is necessarily determinative
12 of whether the interference should be terminated under the AIA. Section 3(n)(2) of
13 the AIA provides that pre-AIA 35 U.S.C. §§ 102(g) and 135 remain in effect for
14 each claim in an application or patent containing a claim with an effective filing
15 date under 35 U.S.C. § 100(i) or referencing under 35 U.S.C. §§ 120, 121, or
16 365(c) an application or patent with such a claim. *See* AIA § 3(n)(2). The
17 effective date of the AIA does not contemplate the subject matter of a count or
18 benefit accorded to a party as a constructive reduction to practice of it. SNIPR
19 fails to provide sufficient basis in its motion for its assertion that if Rockefeller is
20 not accorded benefit as to Count 1 for its provisional application, it necessarily
21 follows that Rockefeller’s claims are not encompassed by AIA § 3(n)(2).

22 Furthermore, in its Motion 4, SNIPR seeks only to deny Rockefeller benefit
23 of the date of its provisional application, filed 7 February 2013. (*See* SNAIPR
24 Motion 4, Paper 28, 1:2–4.) Even if we grant this motion, Rockefeller will retain
25 benefit of the date of its international application, filed 7 February 2014. (*See*
26 Redeclaration, Paper 17, 5.) The filing date of Rockefeller’s international

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1 application is earlier than the earliest benefit accorded to SNIPR as a constructive
2 reduction to practice of the count – 3 May 2016. (*See id.*) Thus, SNIPR would
3 remain junior party even if we grant SNIPR Motion 4 and we would still enter
4 judgment on priority against SNIPR in the absence of a priority statement.

5 Accordingly, we dismiss SNIPR Motion 4 as being moot.

6

7 *III. SNIPR Motion 6 – Designation of Claims as Not Corresponding to the*
8 *Count*

9 SNIPR argues that claim 19 of involved patent 10,582,712, claim 22 of
10 involved patent 10,524,477, and claim 24 of involved patent 10,463,049 should be
11 designated as not corresponding to Count 1. (*See* SNIPR Motion 6, Paper 30, 1:2–
12 5.) “A claim corresponds to a count if the subject matter of the count, treated as
13 prior art to the claim, would have anticipated or rendered obvious the subject
14 matter of the claim.” 37 C.F.R. § 41.207(b)(2). Thus, it is SNIPR’s burden to
15 show that the subject matter of Count 1 does not anticipate or render obvious the
16 subject matter of the recited claims.

17 Each of the claims argued by SNIPR includes the limitation “reduces the
18 growth of the host cells by at least 5-fold.” (*See* SNIPR Motion 6, Paper 30, 2:6–
19 11.) SNIPR must show that claims to methods involving modifying a targeted
20 sequence in a mixed population of bacteria wherein the method reduces the growth
21 of the host cells by at least 5-fold is not obvious over methods of modifying a
22 targeted sequence in a mixed population of bacteria “whereby the host cells are
23 killed or growth of the host cells is reduced” or whereby targeted bacteria are

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1 killed,” as recited in Count 1. (Declaration, Paper 1, 6.)

2 SNIPR argues that as well as failing to recite the specific requirement of an
3 at least 5-fold reduction in growth in the argued claims, Count 1 provides only
4 generic limitations on growth reduction, which do not render the claims obvious.
5 (See SNIPR Motion 6, Paper 30, 2:24–3:11.) According to SNIPR, “[n]othing
6 about the generic statements in Count 1 taught or suggested to a person of ordinary
7 skill in the art that the growth of bacteria would be reduced by at least five-fold in
8 a mixed population of different bacterial species.” (*Id.* at 3:8–10.) SNIPR relies
9 on the testimony of Dr. Dantas,² who merely restates SNIPR’s assertion. (See
10 Dantas Decl., Ex. 2001, ¶ 139.) SNIPR does not direct us to testimony by
11 Dr. Dantas that explains why an at least five-fold growth reduction would not be
12 obvious given a method that produces growth reduction in general.

13 SNIPR argues further, relying on Dr. Dantas’s testimony, that the prior art
14 would not have suggested growth of bacteria would be reduced by at least five-fold
15 in a mixed population of different bacterial species. (See SNIPR Motion 6,
16 Paper 30, 3:7–11, citing Dantas Decl., Ex. 2001, ¶ 139.) SNIPR reviews prior art
17 references, concluding that “none of these prior art references taught or suggested
18 using a CRISPR-Cas system to target bacteria in a mixed population of bacterial

² SNIPR presents the testimony of Gautam Dantas, Ph.D.² (See Declaration of Gautam Dantas, Ph.D. (“Dantas Decl.”), Ex. 2001.) Dr. Dantas is a professor who has received grants and awards and has published peer reviewed articles in fields related to the subject matter of the interference. (See Dantas Decl., Ex. 2001, Appendix A.) We find Dr. Dantas qualified to provide opinion testimony, in general, on the subject matter of the interference and give weight to his testimony as appropriate.

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1 species with a reasonable expectation of success” because the prior art provides
2 results only for a mixture of bacteria of a single species. (*Id.* at 3:21–23, citing
3 Dantas Decl., Ex. 2001, ¶¶ 25, 128.)

4 We are not persuaded by SNIPR’s argument because it does not explain why
5 Count 1 itself does not render the argued claims obvious. (*See* Rockefeller Opp. 6.
6 Paper 116, 2:14–16.) An analysis of correspondence to a count necessarily
7 involves a discussion of the subject matter of the count and the claims. Prior art
8 can be cited to show what one of ordinary skill in the art would have known or
9 understood, but the main issue is whether the subject matter of the count renders
10 obvious the subject matter claimed, not whether the prior art does. SNIPR’s
11 argument that the extent of growth inhibition observed within a single-species
12 population would not have led a person of ordinary skill in the art to expect similar
13 levels of growth inhibition in multi-species populations, does not address the
14 subject matter of Count 1, which includes SNIPR’s claim to mixtures of two
15 bacterial subpopulations “wherein the first bacterial sub-population comprises a
16 first bacterial species and the second bacterial sub-population comprises host cells
17 of a second bacterial species.” (*See* Declaration, Paper 1, 6.)

18 SNIPR acknowledges that the SNIPR claim recited in Count 1 expressly
19 states that every host cell is either killed or has its growth reduced, but argues that
20 the claim does not require all of the host cells to be killed. (SNIPR Reply 6,
21 Paper 156, 2:6–8.) SNIPR argues further that the SNIPR claim in Count 1 does not
22 indicate the entire population of host cells is killed. (*See id.* at 3:25–4:1.)
23 According to SNIPR, the specific requirement of reducing the bacterial growth by

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1 at least five-fold is not necessarily present and a range of growth reduction is not
2 recited in Count 1. (*See id.* at 4:1–22.)

3 We are not persuaded by any of SNIPR’s arguments. Instead of directing us
4 to evidence, such as testimony from Dr. Dantas explaining why one of ordinary
5 skill in the art would not have considered growth reduction by at least five-fold to
6 be obvious when “growth of the host cells is reduced,” SNIPR argues that
7 Rockefeller has not proven it would have been obvious. (*See* SNIPR Reply 6,
8 Paper 156, 1:18–4:22, 6:2–3 (“Rockefeller has not demonstrated that the broader
9 claim 1 anticipates or renders obvious the narrower claims at issue.”)) SNIPR
10 argues that Count 1 does not anticipate the argued claims because it does not recite
11 a species with the scope of the argued claims, but this does not explain why one of
12 ordinary skill would not have considered the argued claims to have been obvious.
13 (*See id.* at 4:23–24.) SNIPR fails to meet its burden in seeking the requested relief.
14 *See* 37 C.F.R. §§ 41.208(b) and 41.121(b).

15 Accordingly, we deny SNIPR Motion 6.

16
17 *IV. Priority*

18 As explained above, we deny SNIPR Motion 1, arguing that the interference
19 should be terminated as contrary to the AIA. Thus, we determine that SNIPR is
20 subject to 35 U.S.C. §§ 102(g) and 135 in this proceeding. We are not persuaded
21 that in the particular circumstances before us we are relieved of the mandate in 35
22 U.S.C. § 135(a) to determine priority between the parties.

23 To prevail on priority as junior party, SNIPR must show that it has a date if

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1 invention earlier than Rockefeller. SNIPR failed, though, to file a priority motion
2 asserting date earlier than Rockefeller’s earliest accorded benefit date. This was
3 not merely an oversight because SNIPR “[a]dmitted that [it] has not alleged any
4 date of invention because that term has no statutorily defined meaning or relevance
5 for SNIPR’s claims. . . .” (See SNIPR Reply 2, Paper 152, Appendix 2, 3:17–20.)
6 Thus, SNIPR has confirmed that it does not contest priority over Rockefeller.

7 “If a junior party fails to file a priority statement overcoming a senior party’s
8 accorded benefit, judgment shall be entered against the junior party absent a
9 showing of good cause.” 37 C.F.R. § 41.204(a)(3). Given the confirmation of its
10 intention to not make a priority showing, SNIPR cannot make argue there is good
11 cause why it did not file a priority statement. Accordingly, we enter judgment
12 against SNIPR as to Count 1.

13

14 *V. Other Motions*

15 SNIPR Motion 2 – Unpatentability under 35 U.S.C. § 112

16 SNIPR argues that Rockefeller’s involved claims are unpatentable for failing
17 to meet the written description and enablement requirements of 35 U.S.C. § 112,
18 first paragraph. (See SNIPR Motion 2, Paper 27, 1:22–2:3.) Because SNIPR
19 concedes priority, we need not and do not reach this motion.³

³ In response to an order to explain why SNIPR Motion 2 should not be treated as presenting a threshold issue under 37 C.F.R. § 41.201 (Paper 164), Rockefeller provided facts to show that it had presented claims to the same subject matter of its involved claims before SNIPR’s patents were issued or the applications that became its involved patents were published. (See Rockefeller Response to Order

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1 Accordingly, we DISMISS SNIPR Motion 2 as being moot.

2

3 SNIPR Motion 5 – To Substitute the Count

4 SNIPR argues in its Motion 5 that Count 1 should be replaced with proposed
5 Count 2. (*See* Paper 29.) SNIPR does not assert that any application is an earlier
6 constructive reduction to practice of proposed Count 2, does not assert an earlier
7 date of invention in regard to proposed substitute Count 2, and argues that the same
8 claims that correspond Count 1 would correspond to this proposed count. (*See*
9 SNIPR Motion 6, Paper 29, 6:26–27 (“To the extent that the SNIPR remaining
10 claims correspond to the first alternative of Count 1, they also correspond to
11 Proposed Count 2.”) As explained above, in the absence of a priority statement,
12 we would enter judgment against SNIPR as to proposed Count 2, if we granted
13 Motion 5, because SNIPR does not argue that proposed Count 2 has any effect on
14 priority or claim correspondence.

15 Accordingly, we dismiss SNIPR Motion 5 as being moot.

16

to Show Cause, Paper 166, 3:3–18.) Under that specific facts of this interference, where SNIPR did not argue to the contrary when given an opportunity, we do not treat any issue in SNIPR Motion 2 as a threshold issue. (*See* Order Authorizing Motions and Setting Times, Paper 21, 3:5–7 (“In this motion and in Motion 2, SNIPR may argue the issues addressed should be considered as threshold issues.”).)

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1 Rockefeller Motions

2 Rockefeller filed three motions. In Motion 1 Rockefeller argues that
3 SNIPR's claims are unpatentable for lack of written description under 35 U.S.C.
4 § 112, first paragraph, (Paper 81) and in Motion 2 Rockefeller argues that SNIPR's
5 claims are indefinite under 35 U.S.C. § 112, second paragraph, (Paper 82).
6 Because of the determination that SNIPR's claims are unpatentable for lack of
7 priority, these motions are moot and we do not reach these motions.

8 Rockefeller filed Motion 3, contingent on the grant of SNIPR Motion 2, to
9 add a claim to its involved patent (Paper 100). Because we do not reach SNIPR
10 Motion 2, we do not reach this motion either.

11 Accordingly, we DISMISS Rockefeller Motions 1, 2, and 3.

12 During the course of the proceeding, Rockefeller sought authorization to file
13 motions to add claims of other SNIPR applications as corresponding to the count.
14 (*See* Order, Paper 144, and Memorandum, Paper 145.) Because the interference
15 was well under way at the time, with motions and oppositions having already been
16 filed, a decision on authorization of these motions was deferred. As indicated,
17 because Rockefeller is involved in this interference based on an application,
18 Rockefeller has an opportunity to address SNIPR's lately issued patents before an
19 examiner during ex parte prosecution. Accordingly, we do not authorize further
20 briefing regarding other SNIPR applications or patents that have issued from them.

21

22 *VI. Conclusion*

23 In summary:

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1 we DISMISS Rockefeller Motions 1, 2, and 3 as being moot;
2 we DENY SNIPR Motions 1 and 6; and
3 we DISMISS SNIPR Motions 2, 4, and 5 as being moot.
4 We enter judgment against SNIPR in a separate paper.

cc (via e-mail):

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNIPR TECHNOLOGIES LIMITED

(Inventors: Jasper Clube, Morten Sommer, Christian Grøndahl, Eric Van Der Helm, Ruben Vazquez-Uribe)

Junior Party

(Patents 10,463,049; 10,506,812; 10,561,148; 10,524,477; 10,582,712),

v.

THE ROCKEFELLER UNIVERSITY

(Inventors: David Bikard and Luciano Marraffini)

Senior Party

(Patent Application 15/159,929).

Patent Interference No. 106,123 (DK)

Judgment

37 C.F.R. § 41.127(b)

Before, SALLY GARDNER LANE, JAMES T. MOOORE, and
DEBORAH KATZ, *Administrative Patent Judge*.

KATZ, *Administrative Patent Judge*.

Interference 106,128

1 In the Decision on Motions issued concurrently, we deny SNIPR
2 Technologies Limited (“SNIPR”) Motion 1, seeking to terminate the interference
3 as contrary to the Leahy-Smith America Invents Act (Pub. L. No. 112-29, 125 Stat.
4 284 (2011)) (“AIA”), and deny SNIPR Motion 5, seeking to have claims
5 designated as not corresponding to the count. (*See* Paper 167.) Because SNIPR is
6 Junior Party and failed to assert a date of invention earlier than the date accorded to
7 Senior Party The Rockefeller University, we enter judgment against SNIPR. (*See*
8 *id.*)

9 It is

10 ORDERED that judgment on priority is entered against SNIPR as to
11 Count 1, the sole Count of the interference (*see* Redeclaration, Paper 17, 2–4);

12 FURTHER ORDERED that claims 1–27 of patent 10,463,049, 1–23 of
13 patent 10,506,812, claims 1–25 of patent 10,524,477, claims 1–16 of patent
14 10,561,148, and claims 1–51 of patent 10,582,712, which correspond to Count 1,
15 are canceled; (*see* Redeclaration, Paper 17, 4–5; 35 U.S.C. § 135(a);

16 FURTHER ORDERED that the parties are directed to 35 USC § 135(c) and
17 37 C.F.R. § 41.205 regarding the filing of settlement agreements;

18 FURTHER ORDERED that a party seeking judicial review timely serve
19 notice on the Director of the United States Patent and Trademark Office; 37 C.F.R.
20 §§ 90.1 and 104.2. *See also* 37 C.F.R. § 41.8(b). Attention is directed to *Biogen*
21 *Idec MA, Inc., v. Japanese Foundation for Cancer Research*, 785 F.3d 648, 654–57
22 (Fed. Cir. 2015) (determining that pre-AIA § 146 review was eliminated for
23 interference proceedings declared after September 15, 2012); and

Interference 106,128

1 FURTHER ORDERED that a copy of this judgment be entered into the
2 administrative records of Rockefeller application 15/159,929 and SNIPR patents
3 10,463,049; 10,506,812; 10,561,148; 10,524,477; 10,582,712.

4

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