

Filed on behalf of: The Rockefeller University

Paper No. _____

By: Salvatore J. Arrigo, Ph.D., J.D.
ARRIGO, LEE, GUTTMAN
& MOUTA-BELLUM LLP
2200 Pennsylvania Ave. NW,
4th Floor East
Washington, D.C. 20037
Telephone: 202.507.5889
Facsimile: 202.688.2790
E-mail: sal@arrigo.us

John D. Lopinski, Ph.D., J.D.
HODGSON RUSS LLP
40 Pearl Street, Suite 100
Buffalo, NY 14202
Telephone: 716.848.1430
Facsimile: 716.849.0349
E-mail: jlopinsk@hodgsonruss.com

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)

ROCKEFELLER OPPOSITION 1

TABLE OF CONTENTS

I. PRECISE RELIEF REQUESTED..... 1

II. LIST OF CITED EXHIBITS 1

III. STATEMENT OF MATERIAL FACTS..... 1

IV. ARGUMENT IN SUPPORT OF RELIEF REQUESTED 1

 A. Applicable Legal Principles 1

 B. Interferences were not “Replaced” by Derivation Proceedings 3

 C. Pre-AIA 35 U.S.C. § 135(a) Specifically Includes
 “Any Unexpired Patent” 4

 D. SNIPR Provides No Compelling Reason for
 Terminating the Interference..... 7

V. CONCLUSION 9

APPENDIX 1 – LIST OF CITED EXHIBITS 10

APPENDIX 2 – STATEMENT OF MATERIAL FACTS 11

TABLE OF AUTHORITIES

1 CASES

2 *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016)1

3 *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018)1, 2, 5, 6

4 STATUTES

5 AIA §3(n)(2)2, 3

6 Public Law 112-274, sec. 1(k)(3), 126 Stat. 2456 (Jan. 14, 2013)2, 4

7 35 U.S.C. § 6 (pre-AIA)2, 4, 6

8 35 U.S.C. § 102.....7, 8

9 35 U.S.C. § 103.....7, 8

10 35 U.S.C. § 135.....3

11 35 U.S.C. § 135(a)(pre-AIA) passim

12 37 C.F.R. § 41.121(b)3

13 37 C.F.R. § 41.208(b)3

14 OTHER AUTHORITIES

15 Standing Order ¶ 122.4.11

16 Standing Order ¶ 122.4.21

1 **I. PRECISE RELIEF REQUESTED**

2 SNIPR Motion 1 (Terminate Interference as Contrary to AIA) should be denied.

3 **II. LIST OF CITED EXHIBITS**

4 Pursuant to Standing Order ¶ 122.4.1, Appendix 1 includes a list of the cited exhibits.

5 **III. STATEMENT OF MATERIAL FACTS**

6 Pursuant to Standing Order ¶ 122.4.2, a Statement of Material Facts in support of this
7 Opposition is set forth in Appendix 2.

8 **IV. ARGUMENT IN SUPPORT OF RELIEF REQUESTED**

9 In SNIPR Motion 1, SNIPR moved to terminate the interference as contrary to the
10 America Invents Act (“AIA”) or, in the alternative for the Board to clarify that SNIPR’s claims
11 cannot be invalidated on any purported proof of prior invention. Rockefeller’s response is that
12 the interference is not contrary to the AIA and should not be terminated. 35 U.S.C. § 135(a)
13 (pre-AIA) fully supports maintaining this interference.

14 In addition, since SNIPR does not contest priority, no proof of prior invention is required
15 to invalidate SNIPR’s claims. Rather, SNIPR does not allege that it was first to invent. MF13;
16 JUNIOR PARTY UPDATED LIST OF MOTIONS (Paper No. 20). Nor was SNIPR the first to
17 file, as confirmed by designation of SNIPR as junior party in the interference. MF14;
18 REDECLARATION – 37 C.F.R. § 41.203(c)(Paper No. 17) at 1. Thus, SNIPR has conceded
19 priority. This is sufficient to invalidate SNIPR’s involved claims.

20 **A. Applicable Legal Principles**

21 Statutory interpretation begins with what the statute says. *Cuozzo Speed Techs., LLC v.*
22 *Lee*, 136 S. Ct. 2131, 2139 (2016). Where a statute’s language carries a plain meaning, the duty
23 of an administrative agency is to follow its commands as written. *SAS Inst., Inc. v. Iancu*, 138 S.

1 Ct. 1348, 1354-55 (2018). The statutory term “any” also has a plain ordinary meaning, referring
2 to every member of the class or group. *Id.*

3 35 U.S.C. § 135 (pre-AIA) is entitled “Interferences” and reads, in part:

4 (a) Whenever an application is made for a patent which, in the opinion of the
5 Director, would interfere with any pending application, or with any unexpired
6 patent, an interference may be declared and the Director shall give notice of such
7 declaration to the applicants, or applicant and patentee, as the case may be. The
8 Board of Patent Appeals and Interferences shall determine questions of priority of
9 the inventions and may determine questions of patentability. Any final decision, if
10 adverse to the claim of an applicant, shall constitute the final refusal by the Patent
11 and Trademark Office of the claims involved, and the Director may issue a patent
12 to the applicant who is adjudged the prior inventor. A final judgment adverse to a
13 patentee from which no appeal or other review has been or can be taken or had
14 shall constitute cancellation of the claims involved in the patent, and notice of
15 such cancellation shall be endorsed on copies of the patent distributed after such
16 cancellation by the Patent and Trademark Office.

17 MF9; 35 U.S.C. § 135(a) (pre-AIA). Additionally, 35 U.S.C. § 6 (pre-AIA) provides authority
18 for the Board to determine priority and patentability of invention in interferences proceedings
19 declared under section 135(a) after September 15, 2012, under 35 U.S.C. 135 (pre-AIA). MF8;
20 35 U.S.C. § 6 (pre-AIA); *see* Public Law 112-274, sec. 1(k)(3), 126 Stat. 2456 (Jan. 14, 2013).

21 Section 3(n)(2) of the AIA provides for applicability of the AIA’s changes to interference
22 practice:

23 (2) INTERFERING PATENTS.—The provisions of sections 102(g), 135, and 291
24 of title 35, United States Code, as in effect on the day before the effective date set
25 forth in paragraph (1) of this subsection, shall apply to each claim of an
26 application for patent, and any patent issued thereon, for which the amendments
27 made by this section also apply, if such application or patent contains or contained
28 at any time--

29 (A) a claim to an invention having an effective filing date as defined in section
30 100(i) of title 35, United States Code, that occurs before the effective date set
31 forth in paragraph (1) of this subsection; or

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

1 claim.

2 MF17; AIA § 3(n)(2).

3 As the moving party, SNIPR has the burden of proof to establish that it is entitled to the
4 requested relief. *See* 37 C.F.R. § 41.121(b). To be sufficient, SNIPR Motion 1 must provide a
5 showing, supported with appropriate evidence, such that, if un rebutted, would justify the relief
6 sought. *See* 37 C.F.R. § 41.208(b). SNIPR has not fulfilled this burden.

7 **B. Interferences were not “Replaced” by Derivation Proceedings**

8 On pages 2-6 of SNIPR Motion 1, SNIPR argues that the AIA replaced interferences by
9 derivation proceedings. Rockefeller’s response is that the AIA did not replace interferences by
10 derivation proceedings. Instead two versions of 35 U.S.C. § 135 were maintained – one directed
11 to interferences and the other directed to derivation proceedings. MF6; *See* 35 U.S.C. § 135; 35
12 U.S.C. § 135 (pre-AIA), AIA §3(n)(2).

13 Although the AIA replaced a first-to-invent system with a first-to-file system,
14 interferences were maintained for applications having an effective filing date prior to March 16,
15 2013. *See* 35 U.S.C. § 135 (pre-AIA), AIA §3(n)(2). Although a new Section 135 was created,
16 it is directed to derivation proceedings, which are not relevant to the current proceeding, and is a
17 distinct section. *See* 35 U.S.C. § 135. Thus, there are currently two applicable versions of
18 “35 U.S.C. § 135” – one of which that continues to be applicable to applications having an
19 effective filing date prior to March 16, 2013, *i.e.*, “pre-AIA.” MF6; *See* 35 U.S.C. § 135; 35
20 U.S.C. § 135 (pre-AIA), AIA §3(n)(2). These two sections coexist – one did not “replace” the
21 other. *Id.*

22 Consequently, interferences were explicitly maintained, not eliminated. MF7; 35 U.S.C.
23 § 135 (pre-AIA), AIA §3(n)(2). Nor did the AIA eliminate all references to interferences, but

1 explicitly maintained these references by conserving these sections as applicable “pre-AIA”
2 sections. *See e.g. id.* For example, the AIA also made clear that interferences would continue to
3 be conducted under the authority of the Board for those applications having an effective filing
4 date prior to March 16, 2013. MF8; 35 U.S.C. § 6 (pre-AIA); *see* Public Law 112-274, sec.
5 1(k)(3), 126 Stat. 2456 (Jan. 14, 2013).

6 SNIPR’s argument that the AIA included “changes eliminating interference proceedings
7 and replacing them with derivation proceedings” (Motion 1 at 4, lines 24-26) is in error.
8 35 U.S.C. § 135 (pre-AIA) was maintained and applies to Rockefeller’s application, which has
9 an effective filing date prior to March 16, 2013.

10 **C. Pre-AIA 35 U.S.C. § 135(a) Specifically Includes “Any Unexpired Patent”**

11 On pages 7-13 of SNIPR Motion 1, SNIPR argues that the AIA’s plain terms exclude
12 SNIPR’s patents from any interference proceeding. Rockefeller’s response is that the plain terms
13 of 35 U.S.C. § 135(a) (pre-AIA) include SNIPR’s patents.

14 In the AIA, Congress did not make any amendments to the text of 35 U.S.C. § 135(a)
15 (pre-AIA) to exclude applications filed after March 15, 2013. MF10; 35 U.S.C. § 135(a) (pre-
16 AIA). Rather, 35 U.S.C. § 135(a) (pre-AIA) still commands:

17 (a) Whenever an application is made for a patent which, in the opinion of the
18 Director, would interfere with any pending application, or with any unexpired
19 patent, an interference may be declared and the Director shall give notice of such
20 declaration to the applicants, or applicant and patentee, as the case may be. The
21 Board of Patent Appeals and Interferences shall determine questions of priority of
22 the inventions and may determine questions of patentability. Any final decision, if
23 adverse to the claim of an applicant, shall constitute the final refusal by the Patent
24 and Trademark Office of the claims involved, and the Director may issue a patent
25 to the applicant who is adjudged the prior inventor. A final judgment adverse to a
26 patentee from which no appeal or other review has been or can be taken or had
27 shall constitute cancellation of the claims involved in the patent, and notice of
28 such cancellation shall be endorsed on copies of the patent distributed after such
29 cancellation by the Patent and Trademark Office.

1 MF9; 35 U.S.C. § 135(a) (pre-AIA).

2 SNIPR does not argue that 35 U.S.C. § 135(a) (pre-AIA) does not apply to Rockefeller's
3 application. Rather, on pages 12-13, bridging paragraph, of SNIPR Motion 1, SNIPR concedes
4 this fact:

5 Unlike with SNIPR's patents, the Board accorded Rockefeller's application the
6 benefit of a February 7, 2013 filing date, suggesting Rockefeller's application
7 could include claims to an invention with an effective filing date before March 16,
8 2013. That may mean that Rockefeller's application could be subject to an
9 interference in a different proceeding, because AIA Section 3's changes would be
10 inapplicable to it. AIA § 3(n)(1); supra at 4-6 (explaining same). But even so, that
11 would not provide a basis for subjecting SNIPR's pure-AIA patents to an
12 interference.

13 Thus, although admitting that Rockefeller's application is subject to an interference under
14 35 U.S.C. § 135(a) (pre-AIA), SNIPR argues that their later filed patents are not. The fault with
15 SNIPR's arguments is that the AIA did not amend 35 U.S.C. § 135(a) (pre-AIA) to exclude
16 unexpired patents without an effective filing date prior to March 16, 2013. Rather, the statute
17 explicitly states that "Whenever an application is made for a patent which, in the opinion of the
18 Director, would interfere with any pending application, or with *any unexpired patent*, an
19 interference may be declared" MF9; 35 U.S.C. § 135(a) (pre-AIA)(emphasis added). Since
20 Congress neither eliminated 35 U.S.C. § 135(a) (pre-AIA) nor amended it to change the
21 applications and patents to which it refers, Congress clearly expected it to still apply to *any*
22 *unexpired patent*. See MF10; 35 U.S.C. § 135(a) (pre-AIA). The statutory term "any" means
23 every member of the class or group. *SAS*, 138 S. Ct. at 1354-55. SNIPR's involved patents fall
24 within this group - each of them is an "unexpired patent." MF11; Ex. 2003, Ex. 2004, Ex. 2005,
25 Ex. 2006, Ex. 2007 (face page of each). The Board must follow the statute's explicit command.
26 *SAS*, 138 S. Ct. at 1354-55.

1 Congress could have amended the text of 35 U.S.C. § 135(a) (pre-AIA) to exclude certain
2 classes of patents from interferences. However, it did not. *See* MF10; 35 U.S.C. § 135(a) (pre-
3 AIA). Thus, the statute’s explicit text must apply. *SAS*, 138 S. Ct. at 1354-55.

4 On pages 7-11 of SNIPR Motion 1, SNIPR argues that the AIA eliminated the Director’s
5 authority to declare an interference involving SNIPR’s claims. Rockefeller’s response is that the
6 AIA did not eliminate the Director’s authority. SNIPR recognizes that the AIA explicitly makes
7 exceptions to its application:

8 Subsection 3(n) makes plain that those changes took effect on March 16, 2013, and
9 apply to any pure-AIA patent, including all of SNIPR’s involved patents here. It
10 states that “[e]xcept as otherwise provided in this section, the amendments made
11 by this section shall take effect upon the expiration of the 18 month period
12 beginning on the date of the enactment of this Act.”

13 SNIPR Motion 1 at 8, lines 7-9 (emphasis added). The application of 35 U.S.C. § 6 (pre-AIA)
14 and 35 U.S.C. § 135(a) (pre-AIA) are two of these exceptions.

15 On pages 11-13 of SNIPR Motion 1, SNIPR argues that the Board lack’s authority
16 because SNIPR’s patents are “pure-AIA” patents. Rockefeller’s response is that the AIA
17 explicitly provides for the Director’s authority in 35 U.S.C. § 6 (pre-AIA) and 35 U.S.C. §
18 135(a) (pre-AIA).

19 On pages 12-13 of SNIPR Motion 1, SNIPR further argues that the Board cannot
20 determine priority of inventions because their patents are “pure-AIA” patents. Rockefeller’s
21 response is that the Board can determine priority of inventions. SNIPR does not alleges that it
22 was first to invent. MF13; JUNIOR PARTY UDPATED LIST OF MOTIONS (Paper No. 20).
23 Nor was SNIPR the first to file, as confirmed by designation of SNIPR as junior party in the
24 interference. MF14; REDECLARATION – 37 C.F.R. § 41.203(c)(Paper No. 17) at 1. Thus,
25 SNIPR has conceded priority.

1 As junior party, SNIPR’s failure to allege an earlier date than Rockefeller’s Provisional
2 application, or even Rockefeller’s later PCT application, forecloses SNIPR’s ability to challenge
3 Rockefeller’s filing dates as prior art. In fact, Rockefeller’s PCT application was published on
4 August 14, 2014 (MF15; Ex. 2010 at face page), which is more than one year earlier than the
5 earliest date accorded to SNIPR in this interference of May 3, 2016 (MF1; MF12;
6 REDECLARATION – 37 C.F.R. § 41.203(c)(Paper No. 17) at 5), barring SNIPR’s claims under
7 post-AIA 35 U.S.C. § 102 and 35 U.S.C. § 103. Consequently, priority is simply not at issue in
8 this interference.

9 **D. SNIPR Provides No Compelling Reason for Terminating the Interference**

10 On pages 13-14 of SNIPR Motion 1, SNIPR argues that even if the Board has the
11 authority, the Board should exercise its discretion to terminate this interference. Rockefeller’s
12 response is that there are many reasons to maintain this interference and, although it is SNIPR’s
13 burden, SNIPR has provided no convincing reason for the Board to terminate the interference.

14 The first reason given by SNIPR is “lack of statutory authority.” SNIPR Motion 1 at 14,
15 line 2. Since SNIPR’s premise for the Board using its discretion is that the Board actually has
16 authority, this reason makes no sense.

17 The second reason given by SNIPR is “undue costs.” SNIPR Motion 1 at 14, line 2.
18 SNIPR does not explain why these costs would be “undue.” In addition, all interferences involve
19 costs and SNIPR does not compare the potential alternatives to determine the patentability of
20 multiple parties owning issued patents to the same patentable subject matter, such as multiple
21 reexaminations or lawsuits. Moreover, by the time SNIPR’s Motion 1 is decided, there will be
22 very few additional costs for the parties. Thus, the Board using its discretion to avoid “undue
23 costs” after nearly all of the costs have already been accrued would serve no purpose.

1 The third reason given by SNIPR is “prejudice to SNIPR after filing applications that
2 SNIPR expressly chose to subject only to the AIA’s terms.” SNIPR Motion 1 at 14, line 2-3.
3 SNIPR does not explain how SNIPR made any express choice to subject any application only to
4 the AIA’s terms. That is, there is no indication that SNIPR had the opportunity to file any
5 application prior to March 16, 2013. More significantly, SNIPR does not identify to what the
6 precise “prejudice” it is referring. Nevertheless, Rockefeller assumes that the “prejudice” is
7 having their patents reevaluated for patentability in view of Rockefeller’s application and
8 invalidated. This does not appear to be a valid reason for the Board to use its discretion. Rather,
9 the entire point of the interference statute is to assure that the first inventor receives the patent –
10 not to allow a party that files applications many years later to receive multiple patents.

11 The fourth reason given by SNIPR is “the inability of the Board actually to resolve
12 invention priority.” SNIPR Motion 1 at 14, lines 3-4. Since the priority is not at issue in this
13 interference, this reason is irrelevant.

14 In fact, there are important reasons for the Board not to terminate this interference.
15 SNIPR’s five involved patents were all filed more than one year after Rockefeller’s PCT
16 application was published on August 14, 2014. MF15-MF16; Ex. 2010; Ex. 2003, Ex. 2004, Ex.
17 2005, Ex. 2006, Ex. 2007 (face page of each).

18 SNIPR does not allege that it was the first to invent or the first to file. Consequently,
19 SNIPR’s claims are barred under post-AIA 35 U.S.C. § 102 and 35 U.S.C. § 103. Nevertheless,
20 the USPTO issued each of SNIPR five involved patents. The alternative to maintaining this
21 interference is allowing Rockefeller’s application to issue as a patent to the same invention as
22 SNIPR’s patents. This result is antithetical to the basic patent law principle that only one patent
23 can issue for an invention.

APPENDIX 1 – LIST OF CITED EXHIBITS

| | | |
|---|-----------------|--|
| 1 | | |
| 2 | Ex. 2003 | U.S. Patent 10,582,712 |
| 3 | Ex. 2004 | U.S. Patent 10,463,049 |
| 4 | Ex. 2005 | U.S. Patent 10,506,812 |
| 5 | Ex. 2006 | U.S. Patent 10,524,477 |
| 6 | Ex. 2007 | U.S. Patent 10,561,148 |
| 7 | Ex. 2010 | PCT Publication WO 2014/124226 |
| 8 | Ex. 2012 | House of Representatives Report No. 112-98 |

1 5. The House Report found that the AIA would eliminate those costs and burdens
2 for parties subject to the Act's changes because priority in a first-inventor-to-file system depends
3 on "the filing date of an application," which "is an objective date, simple to determine." (Ex.
4 2012 at 40-41.)

5 **Rockefeller admits SNIPR MF5 only to the extent that the quotations can be found**
6 **in the House Report; otherwise denied.**

1 **Rockefeller Additional Material Facts**

2 6. There are currently two applicable versions of “35 U.S.C. § 135” – one of which
3 that continues to be applicable to applications having an effective filing date prior to March 16,
4 2013, *i.e.*, “pre-AIA.” *See* 35 U.S.C. § 135; 35 U.S.C. § 135 (pre-AIA), AIA §3(n)(2).

5 7. Interferences were explicitly maintained by the AIA. 35 U.S.C. § 135 (pre-AIA),
6 AIA §3(n)(2).

7 8. Interferences continue to be conducted under the authority of the Board for those
8 applications having an effective filing date prior to March 16, 2013. 35 U.S.C. § 6 (pre-AIA);
9 *see* Public Law 112-274, sec. 1(k)(3), 126 Stat. 2456 (Jan. 14, 2013).

10 9. 35 U.S.C. § 135(a) (pre-AIA) states, in part:

11 (a) Whenever an application is made for a patent which, in the opinion of the
12 Director, would interfere with any pending application, or with any unexpired
13 patent, an interference may be declared and the Director shall give notice of such
14 declaration to the applicants, or applicant and patentee, as the case may be. The
15 Board of Patent Appeals and Interferences shall determine questions of priority of
16 the inventions and may determine questions of patentability. Any final decision, if
17 adverse to the claim of an applicant, shall constitute the final refusal by the Patent
18 and Trademark Office of the claims involved, and the Director may issue a patent
19 to the applicant who is adjudged the prior inventor. A final judgment adverse to a
20 patentee from which no appeal or other review has been or can be taken or had
21 shall constitute cancellation of the claims involved in the patent, and notice of
22 such cancellation shall be endorsed on copies of the patent distributed after such
23 cancellation by the Patent and Trademark Office.

24 35 U.S.C. § 135(a) (pre-AIA).

25 10. In the AIA, Congress did not make any amendments to the text of 35 U.S.C. §
26 135(a) (pre-AIA). 35 U.S.C. § 135(a) (pre-AIA).

27 11. Each of SNIPR’s involved patents is an “unexpired patent.” Ex. 2003, Ex. 2004,
28 Ex. 2005, Ex. 2006, Ex. 2007 (face page of each).

1 12. The earliest date accorded to SNIPR in this interference is May 3, 2016.

2 REDECLARATION – 37 C.F.R. § 41.203(c)(Paper No. 17) at 5.

3 13. SNIPR does not allege a date of invention earlier than May 3, 2016. JUNIOR
4 PARTY UDPATED LIST OF MOTIONS (Paper No. 20).

5 14. SNIPR was designated as junior party in the interference. REDECLARATION –
6 37 C.F.R. § 41.203(c)(Paper No. 17) at 1.

7 15. Rockefeller’s PCT application was published as WO 2014/124226 on August 14,
8 2014. Ex. 2010 at face page.

9 16. The publication of Rockefeller’s PCT application is prior art to SNIPR’s patents
10 under post-AIA 35 U.S.C. § 102 and 35 U.S.C. § 103. Ex. 2010 at face page; Ex. 2003, Ex.
11 2004, Ex. 2005, Ex. 2006, Ex. 2007 (face page of each).

12 17. Section 3(n)(2) of the AIA provides for applicability of the AIA’s changes to
13 interference practice. AIA § 3(n)(2).

1 **CERTIFICATE OF SERVICE**

2 I hereby certify that the foregoing **ROCKEFELLER OPPOSITION 1** is being
3 served on Junior Party **SNIPR TECHNOLOGIES LIMITED** via the Interference Web
4 Portal (SO ¶ 105.3) by 5:00 PM Eastern Time on the 8th day of January, 2021.

5 /Salvatore J. Arrigo/
6 Salvatore J. Arrigo, Ph.D., J.D.
7 Reg. No. 46,063
8 Lead Counsel for The Rockefeller University
9 ARRIGO, LEE, GUTTMAN
10 & MOUTA-BELLUM LLP
11 2200 Pennsylvania Ave. NW
12 4th Floor East
13 Washington, D.C. 20037
14 Telephone: 202.507.5889
15 Facsimile: 202.688.2790
16 E-mail: sal@arrigo.us