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1 **I. REQUESTED RELIEF**

2 Junior Party SNIPR hereby moves to terminate this interference as contrary to the
3 America Invents Act (“AIA”) (Pub. L. No. 112-29, 125 Stat. 284 (2011)) or, in the alternative,
4 for the Board to clarify that SNIPR’s claims cannot be invalidated based on any purported proof
5 of prior invention because prior invention by another does not bar patentability for SNIPR’s
6 claims.

7 **II. INTRODUCTION**

8 In the AIA, Congress eliminated interference proceedings for patents claiming
9 inventions, like SNIPR’s here, with effective filing dates only after the AIA’s effective date. By
10 eliminating interference proceedings for such patents, Congress made clear that the Director has
11 no authority to include those patents in an interference. Indeed, for patents claiming inventions
12 with effective filing dates only after the AIA’s effective date, Congress also eliminated the bar in
13 35 U.S.C. § 102(g) based on prior invention by another. Without that bar, an interference
14 involving such a patent cannot actually resolve an invention priority dispute under
15 Section 102(g) because showing that someone else invented the claimed invention first would
16 not invalidate the patent. The Board should thus terminate this interference or, at the least, make
17 clear that SNIPR’s claims cannot be invalidated based on any purported proof of prior invention
18 by Rockefeller.

19 **III. FACTUAL BACKGROUND**

20 SNIPR’s involved patents claim inventions with earliest possible effective filing dates
21 after March 16, 2013. (Fact ¶ 1; Paper No. 17 at 5; Exs. 2003-2007; AIA § 3(n)(1).) The Board
22 has accorded Senior Party Rockefeller University (“Rockefeller”) the benefit of three priority
23 applications, the earliest one filed February 7, 2013. (Fact ¶ 2; Paper No. 17 at 5.) Thus, this re-

1 declared interference involves SNIPR’s post-AIA patents and a Rockefeller application claiming
2 benefit to a pre-AIA application. AIA § 3(n).

3 **IV. STATUTORY BACKGROUND**

4 **A. The AIA Replaced Interference Proceedings With Derivation Proceedings**

5 The AIA brought sweeping changes. It converted the United States from a “first to
6 invent” patent system to a “first inventor to file” patent system. AIA § 3(o), (p). To do so, the
7 AIA dismantled the previous interference regime and replaced it with a new derivation regime.
8 *Id.* Interference proceedings were inherently tied to a first-to-invent system since those
9 proceedings resolved priority disputes over who was the first to invent. Pre-AIA 35 U.S.C.
10 § 135. Consistent with a first-inventor-to-file system, derivation proceedings determine whether
11 an earlier filer independently invented the claimed subject matter. AIA § 3(h), (i), (j).

12 Congress intended the change from interference to derivation proceedings to be
13 comprehensive. The AIA eliminated all references to interferences in title 35 of the United
14 States Code. AIA § 3(j). It completely rewrote 35 U.S.C. § 135. That section was previously
15 titled “Interferences” and was triggered “[w]henever an application is made for a patent which,
16 in the opinion of the Director, would interfere with any pending application, or with any
17 unexpired patent.” Pre-AIA 35 U.S.C. § 135(a); AIA § 3(i). If those circumstances arose, the
18 Director could declare an interference to decide “questions of priority of the inventions.” Pre-
19 AIA 35 U.S.C. § 135(a). The new Section 135 is titled “Derivation proceedings.” Post-AIA 35
20 U.S.C. § 135; AIA § 3(i). To trigger it, an “applicant for patent may file a petition” setting forth
21 “the basis for finding that an individual named in an earlier application as the inventor or a joint
22 inventor derived such invention from an individual named in the petitioner’s application.” Post-
23 AIA 35 U.S.C. § 135(a)(1). If the Director grants the petition, the Patent Trial and Appeal Board
24 conducts a proceeding to determine “whether an inventor named in the earlier application

1 derived the claimed invention from an inventor named in the petitioner’s application.” *Id.*
2 § 135(d). Congress similarly rewrote 35 U.S.C. § 291 to create a new private civil action for
3 “Derived Patents” that replaces the previous action for “Interfering Patents.” *Compare* pre-AIA
4 35 U.S.C. § 291, *with* post-AIA 35 U.S.C. § 291; AIA § 3(h).

5 Congress also rewrote Section 102 to eliminate requirements specific to interference
6 proceedings and add exemptions consistent with derivation proceedings. Before the AIA,
7 Subsection 102(g) barred patentability if, “during the course of an interference,” another party
8 showed priority of invention by proving prior conception, combined with reduction to practice
9 and reasonable diligence (where applicable); it similarly allowed prior art based on priority of
10 invention. Pre-AIA 35 U.S.C. § 102(g)(1), (2). The AIA eliminated that subsection and no
11 longer requires, as a condition of patentability, that a person have been the first to make the
12 invention, i.e., the first to invent. Post-AIA 35 U.S.C. § 102; AIA § 3(b). Instead, revised
13 Section 102 exempts the effects of otherwise invalidating prior art if a party can show that the
14 prior art discloses subject matter obtained “directly or indirectly from the inventor or a joint
15 inventor.” Post-AIA 35 U.S.C. § 102(b)(1), 102(b)(2); AIA § 3(b).

16 The House Report accompanying the final bill explains some reasons behind these
17 changes. (Ex. 2012 at 40-41.) The Report found that interference proceedings were “lengthy,
18 complex and costly administrative proceeding[s]” that “can take years to complete” and “require
19 extensive discovery.” (Fact ¶ 3; Ex. 2012 at 40-41.) Even the bare threat of an interference
20 proceeding imposed undue costs: “because it is always possible that an applicant could be
21 involved in an interference proceeding, companies must maintain extensive recording and
22 document retention systems in case they are later required to prove the date they invented the
23 claimed invention.” (Fact ¶ 4; Ex. 2012 at 40-41.) The AIA sought to eliminate those costs and

1 burdens for parties subject to the Act’s changes because priority in a first-inventor-to-file system
2 depends on “the filing date of an application,” which “is an objective date, simple to determine.”
3 (Fact ¶ 5; Ex. 2012 at 40-41.)

4 **B. The AIA Specifies Exactly Which Applications And Patents Are Affected By**
5 **The Change From Interference To Derivation Proceedings**

6 Congress adopted express rules for when the transition from the old interference
7 proceedings to the new derivation proceedings would happen and which patents and patent
8 applications would be affected. First, in paragraph (1) of AIA Subsection 3(n), Congress
9 explained that the AIA’s changes would apply based on the effective filing date of the claimed
10 invention in a patent application:

11 (1) IN GENERAL.—Except as otherwise provided in this section, the
12 amendments made by this section shall take effect upon the
13 expiration of the 18-month period beginning on the date of the
14 enactment of this Act, and shall apply to any application for patent,
15 and to any patent issuing thereon, that contains or contained at any
16 time—

17 (A) a claim to a claimed invention that has an effective filing
18 date as defined in section 100(i) of title 35, United States Code,
19 that is on or after the effective date described in this paragraph;
20 or

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

24 Congress thus ensured that the AIA’s changes to Title 35 broadly apply, including the changes
25 eliminating interference proceedings and replacing them with derivation proceedings (*supra*
26 at 2-3)—those changes “shall apply” to “any application” or “any patent” claiming “at any time”
27 at least one invention with an effective filing date on or after March 16, 2013, the date 18 months
28 after the AIA’s enactment (or referencing another application or patent that does so). AIA
29 § 3(n)(1); Manual of Patent Examining Procedures § 2159.02 (MPEP). A claimed invention’s

1 “effective filing date” is either the patent or application’s actual filing date, or the filing date of
2 the earliest application to which it has priority. AIA § 3(a)(2) (codified at 35 U.S.C. § 100(i));
3 MPEP § 2151.

4 The AIA provides only one limited exception to that broad coverage:

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

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

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

19 AIA § 3(n)(2). By its plain terms, this paragraph applies to a narrow subset of applications and
20 patents—those claiming a mix of inventions with different effective filing dates, some before
21 March 16, 2013, and others after (or referencing applications or patents that do so). That is, for
22 “the amendments made by this section” (meaning AIA Section 3) to “also apply,” an application
23 or patent must claim at least one invention with an effective filing date on or after March 16,
24 2013 (or reference an application or patent that does). AIA § 3(n)(1), (n)(2); MPEP §§ 2151,
25 2159.02. But if the application or patent also claims at least one invention with “an effective
26 filing date” that “occurs before” March 16, 2013 (or references an application or patent that
27 does), then the provisions of paragraph (2) also apply. AIA § 3(n)(2); MPEP §§ 2151, 2159.03.

28 In Subsection 3(n), Congress thus created three categories of applications or patents and
29 subjected them to three different patentability regimes. A first category is pure pre-AIA—if an

1 application or patent claims only inventions with effective filing dates before March 16, 2013
2 (and references only applications or patents that do too), it is exempt from Section 3’s changes
3 altogether. Such pure pre-AIA applications and patents are governed entirely by pre-AIA
4 versions of 35 U.S.C. §§ 102, 135, and 291, including the provisions governing interferences. A
5 second category is pure AIA—if an application or patent claims only inventions with effective
6 filing dates after March 16, 2013 (and references only applications or patents that do too), all of
7 Section 3’s changes apply and no pre-AIA provisions of 35 U.S.C. § 102, 135, or 291 do. There
8 is no provision for interference proceedings for such pure-AIA applications and patents. The
9 third category is a mix of pre- and post-AIA—if an application or patent includes some claims to
10 inventions with pre-AIA effective filing dates and some claims to inventions with post-AIA
11 effective filing dates (or references applications or patents that do), Section 3’s changes to 35
12 U.S.C. § 102 and other patentability provisions generally apply. But although the AIA and its
13 changes to Title 35 generally govern those applications and patents, the provisions of previous
14 “sections 102(g), 135, and 291” governing interference proceedings also continue to apply. AIA
15 § 3(n)(2); MPEP §§ 2151, 2159.03. For only that final, narrow category of applications and
16 patents did Congress contemplate a dual regime of pre- and post-AIA law in which interference
17 proceedings could apply to applications and patents otherwise subject to the AIA’s changes.

18 **V. REASONS FOR THE RELIEF REQUESTED**

19 **A. Legal Standards**

20 Statutory interpretation begins with “what” the statute “says.” *Cuozzo Speed Techs., LLC*
21 *v. Lee*, 136 S. Ct. 2131, 2139 (2016). And when the statute’s language is plain, it ends there too:
22 “Where a statute’s language carries a plain meaning, the duty of an administrative agency is to
23 follow its commands as written, not to supplant those commands with others it may prefer.” *SAS*
24 *Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1354-55 (2018). The statutory term “shall” has a plain

1 meaning that “is both mandatory and comprehensive” and “generally imposes a nondiscretionary
2 duty.” *Id.* The statutory term “any” also has a plain ordinary meaning, referring to “‘every
3 member of the class or group.’” *Id.* (emphasis by Supreme Court; citation omitted). Agencies
4 must follow these plain meanings and may not override them based on “power appear[ing]
5 nowhere in the text.” *Id.*

6 **B. The AIA’s Plain Terms Exclude SNIPR’s Patents From Any Interference**
7 **Proceedings Because They Claim Inventions With Effective Filing Dates**
8 **Only After March 16, 2013**

9 The Board should terminate this interference because SNIPR’s patent claims cannot be
10 subject to interference under the AIA’s plain terms. When Congress said that the AIA’s
11 changes, including those eliminating interference proceedings, *shall* apply to *any* patents, like
12 SNIPR’s here, that claim inventions having effective filing dates only after March 16, 2013, it
13 meant what it said—those patents can only be subject to proceedings described in the AIA, not
14 proceedings the AIA eliminated. That is true regardless of whether different rules apply to
15 Rockefeller’s application. The AIA makes clear that Congress expected that different rules
16 would apply to different applications and patents based on effective filing dates. Because
17 SNIPR’s patents claim only inventions with effective filing dates post-dating the AIA, they can
18 never be subject to an interference.

19 **1. The AIA Eliminated The Director’s Statutory Authority to Declare**
20 **An Interference Involving SNIPR’s Claims**

21 Under the AIA’s plain terms, the Director lacks authority to declare an interference
22 involving a pure-AIA application or patent, one claiming inventions with effective filing dates
23 only after March 16, 2013 (and referencing only applications or patents that do the same). Start
24 with the AIA’s plain text: Section 3, Subsection (j), is titled “Elimination of References to
25 Interferences” and eliminates the previous references to interferences in Title 35. AIA § 3(j).

1 And in the neighboring subsections, Congress replaced the old Section 135 authorizing the
2 Director to initiate an interference proceeding with a new Section 135 authorizing only a
3 derivation proceeding. AIA § 3(b), (h), (i), (j). Once those changes took effect and for the
4 applications and patents to which they apply, no statutory authority authorizes the Director to
5 declare an interference proceeding.

6 Subsection 3(n) makes plain that those changes took effect on March 16, 2013, and apply
7 to any pure-AIA patent, including all of SNIPR’s involved patents here. It states that “[e]xcept
8 as otherwise provided in this section, the amendments made by this section *shall* take effect upon
9 the expiration of the 18 month period beginning on the date of the enactment of this Act.” AIA
10 § 3(n)(1) (emphasis added). Because Congress enacted the AIA on September 16, 2011,
11 Section 3’s changes became effective on March 16, 2013. 125 Stat. 284; MPEP § 2159.
12 Subsection 3(n)(1) further specifies that, beginning on that date, those changes “*shall* apply to
13 *any* application for patent, and to *any* patent issuing thereon, that contains or contained at any
14 time a claim to a claimed invention that has an effective filing date . . . that is on or after the
15 effective date described in this paragraph.” AIA § 3(n)(1) (emphases added). A claimed
16 invention’s “effective filing date” is either the patent’s actual filing date, or the filing date of the
17 earliest application to which the patent is entitled to a right of priority or benefit. 35 U.S.C.
18 § 100(i)(1); AIA § 3(a)(2).

19 Here, the Board determined that the earliest filing date to which SNIPR’s patents claim
20 benefit is May 3, 2016. (Fact ¶ 1; Paper No. 17 at 5; Exs. 2003-2007.) That means the earliest
21 effective filing date for all of SNIPR’s claimed inventions here is May 3, 2016. 35 U.S.C.
22 § 100(i)(1). Thus, not only is there at least one claim of each patent claiming an invention with
23 an effective filing date after March 16, 2013, every claim of every involved SNIPR patent does

1 so. Subsection 3(n)'s "comprehensive" and "mandatory" terms such as "shall" and "any" thus
2 dictate that Section 3's changes apply to SNIPR's patents, including the change eliminating any
3 authority to declare an interference involving these patents. *SAS*, 138 S. Ct. at 1354-55; MPEP
4 §§ 2151, 2159.02.

5 Other provisions of the AIA confirm that Congress eliminated the Director's authority to
6 subject pure-AIA patents like SNIPR's to an interference proceeding. *SAS*, 138 S. Ct. at 1355
7 (agencies should look to statutory "text and context"). For one, Subsection 3(n) shows Congress
8 knew how to subject applications and patents filed after March 16, 2013, to interference
9 proceedings when it wanted to—by making the pre-AIA versions of 35 U.S.C. § 135, 291, and
10 102(g) apply to the applications or patents. AIA § 3(n)(2). But rather than do so for all post-
11 AIA applications and patents, Congress did so for only a narrow subset of applications and
12 patents, those that "contain[] or contained at any time" a "claim to an invention having an
13 effective filing date" before March 16, 2013, or "a specific reference" to a patent or application
14 "that contains or contained at any time such a claim." AIA § 3(n)(2); MPEP § 2159.03. That
15 carve-out is inapplicable here because, according to the Board's determination, the earliest
16 effective filing date for any existing or prior claimed invention in any SNIPR involved patent is
17 May 3, 2016, and all patents include and have only ever included priority references to patents or
18 applications for which the same is true. (Fact ¶ 1; Paper No. 17 at 5; Exs. 2003-2007.)
19 Congress's choice to apply interference proceedings to a limited subset of post-AIA patents and
20 applications, but not those here, further shows Congress's intent to exclude SNIPR's pure-AIA
21 patents from any interference proceeding.

22 Subsections (o) and (p) also attest that the AIA put an end to interference proceedings for
23 pure-AIA patents. Those subsections spell out Congress's goals, that it specifically intended to

1 “convert[] the United States patent system from ‘first to invent’ to a system of ‘first inventor to
2 file.’” AIA § 3(o), (p). Doing so would “promote the progress of science and the useful arts,”
3 “improve the United States patent system,” and “harmoniz[e]” the “United States patent system
4 with the patent systems commonly used in nearly all other countries throughout the world.” *Id.*
5 Yet interference proceedings—which inquire into “priority of the inventions”—are relics of a
6 “first to invent” system that Congress concluded is inferior to the first-to-file system adopted by
7 the AIA. Pre-AIA 35 U.S.C. § 135(a); AIA § 3(o), (p).

8 Indeed, eliminating interference proceedings for post-AIA patents was more than just a
9 byproduct of Congress’s shift to a first-inventor-to-file patent system—it was a direct goal of the
10 Act. The House Report accompanying the final bill criticized interference proceedings as
11 “lengthy, complex and costly administrative proceeding[s]” that “can take years to complete”
12 and “require extensive discovery.” (Fact ¶ 3; Ex. 2012 at 40-41.) And it criticized the costs that
13 the threat of interference imposed on parties: “because it is always possible that an applicant
14 could be involved in an interference proceeding, companies must maintain extensive recording
15 and document retention systems in case they are later required to prove the date they invented the
16 claimed invention.” (Fact ¶ 4; Ex. 2012 at 40-41.) Congress wanted to eliminate interferences to
17 avoid those problems and give greater certainty and predictability to applicants. (Fact ¶ 5;
18 Ex. 2012 at 40-41.)

19 The Patent and Trademark Office’s own practices reflect Congress’s intent. The Office’s
20 regulations, as applied in the Application Data Sheet under 37 C.F.R. § 1.76, require applicants
21 filing a transition application to state expressly whether the application “(1) claims priority to or
22 the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at
23 any time, a claim to a claimed invention that has an effective filing date on or after March 16,

1 2013.” Form PTO/AIA/14; 37 C.F.R. §§ 1.55(k), 1.78(a)(6), (d)(6). If the applicant makes this
2 statement, “this application, with a filing date on or after March 16, 2013, will be examined
3 under the first inventor to file provisions of the AIA.” *Id.* By choosing not to make such a
4 statement, the applicant foregoes priority claims to, for example, foreign-filed applications pre-
5 dating March 16, 2013, in exchange for the certainty and cost-savings Congress promised in the
6 AIA.

7 Subjecting a pure-AIA patent to an interference would perpetuate the problems with
8 interferences that Congress sought to avoid and undermine applicants’ and patentees’ reasonable
9 reliance interests. It would continue imposing the costs and delays associated with interferences
10 long after the AIA became effective. It would impose those costs on parties who filed
11 applications under the promise of a new system and those who affirmatively decided against
12 making priority claims to pre-AIA applications. And it would wrongly punish parties that took
13 Congress at its word and ended the extensive recording and document retention Congress said
14 would no longer be necessary under a first-inventor-to-file system; such parties would be
15 subjected to priority disputes that they fairly understood Congress to have eliminated.

16 The AIA’s text, context, and purpose all require the same conclusion—the Director lacks
17 authority to declare an interference involving SNIPR’s patents. The Board thus should terminate
18 this proceeding.

19 **2. Even If The Director Has Authority To Declare An Interference**
20 **Involving Rockefeller’s Claims, That Would Only Confirm The Lack**
21 **Of Authority To Include SNIPR’s Claims In Such A Proceeding**

22 In initiating this interference, the Board relied on the Director’s authority to declare an
23 interference involving Rockefeller’s application. (Paper No. 17 at 1-2.) Unlike with SNIPR’s
24 patents, the Board accorded Rockefeller’s application the benefit of a February 7, 2013 filing
25 date, suggesting Rockefeller’s application could include claims to an invention with an effective

1 filing date before March 16, 2013. That may mean that Rockefeller’s application could be
2 subject to an interference in a different proceeding, because AIA Section 3’s changes would be
3 inapplicable to it. AIA § 3(n)(1); *supra* at 4-6 (explaining same). But even so, that would not
4 provide a basis for subjecting SNIPR’s pure-AIA patents to an interference.

5 First, the plain statutory text provides that patents claiming only inventions post-dating
6 the AIA cannot be subject to an interference proceeding under any circumstance. *Supra* at 7-10.
7 It is no answer to point to pre-AIA 35 U.S.C. § 135, which authorizes the Director to declare an
8 interference “[w]henver an application is made for a patent which, in the opinion of the
9 Director, would interfere with any pending application, or with any unexpired patent.” The
10 statute’s text requires two applications, or one application and one patent, to declare an
11 interference. That means both interfering applications, or both the interfering application and
12 patent, must be subject to pre-AIA Section 135’s terms for the Director to have authority to
13 declare an interference. When instead the statute is a nullity for one allegedly interfering
14 application or patent, as here, nothing in pre-AIA Section 135 authorizes an interference based
15 on a single pre-AIA application.

16 The pre-AIA statutory text shows that an interference is unauthorized on the facts here
17 for another reason. Pre-AIA Section 135 requires that the Board “shall determine questions of
18 priority of the inventions” in an interference. But the Board cannot do so when one application
19 or patent in the proceeding is a pure-AIA application or patent. That is because determining
20 priority of inventions depends on 35 US.C. § 102(g), which barred patentability if “during the
21 course of an interference” another inventor proves “that before such person’s invention thereof
22 the invention was made by such other inventor and not abandoned, suppressed, or concealed.”
23 Although that bar would apply to an application claiming inventions with effective filing dates

1 before March 16, 2013, it is inapplicable to pure-AIA applications and patents, like SNIPR's
2 here. AIA § 3(n). The current version of Section 102 that governs pure-AIA applications and
3 patents lacks any equivalent patentability bar. AIA § 3(b); Post-AIA 35 U.S.C. § 102; MPEP
4 §§ 2151, 2159.03. Thus, were the Board to conduct an interference involving a pure-AIA patent,
5 it could not actually determine priority of invention under pre-AIA 35 U.S.C. § 102(g) against
6 the pure-AIA patent and declare that patent invalid for lack of priority: nothing in post-AIA
7 Section 102 (or any other section) requires priority of invention as a condition of patentability.
8 An interference in the circumstances here would thus be a one-sided affair—the Board could
9 declare Rockefeller's claims unpatentable based on Section 102(g) but not SNIPR's. Nothing in
10 either post- or pre-AIA patent law suggests Congress authorized such a proceeding.

11 Nor is there any practical reason to subject pure-AIA patents to interference proceedings
12 because of another party's filing date. The AIA gives the Director numerous other tools for
13 reviewing patents and applications—if the relevant conditions are met, the Director can declare a
14 derivation proceeding for a pending application or issued patent or institute post-grant or *inter*
15 *partes* reviews for issued patents. Post-AIA 35 U.S.C. §§ 135, 314, 324. Given that broad
16 authority, there would be no benefit to subjecting pure-AIA patents to interference proceedings
17 based on another application's status.

18 **C. Even If SNIPR's Patents Could Be Included In An Interference, The Board**
19 **Should Exercise Discretion To Terminate Here And At Least Should Clarify**
20 **That Rockefeller Cannot Invalidate SNIPR's Patents Based on Priority Of**
21 **Invention**

22 Although for all the above reasons the Director has no authority to include SNIPR's
23 patents in this interference, even if he had that authority, the Board should exercise its discretion
24 to terminate here. Pre-AIA Section 135 speaks permissively, allowing that “an interference may
25 be declared” for patents and applications subject to its terms. The agency thus has discretion not

1 to declare an interference or to terminate this interference without proceeding further. For all the
2 reasons given—the lack of statutory authority, the undue costs and prejudice to SNIPR after
3 filing applications that SNIPR expressly chose to subject only to the AIA’s terms, the inability of
4 the Board actually to resolve invention priority, and more—the Board should exercise its
5 discretion in the circumstances here and terminate this proceeding. *Supra* Section V.B. At the
6 very least, because pre-AIA 35 U.S.C. § 102(g) does not bar patentability for SNIPR’s claims,
7 the Board should clarify that any priority of invention showing by Rockefeller cannot invalidate
8 SNIPR’s claims. AIA § 3(b), (n); Post-AIA 35 U.S.C. § 102; *supra* at 12 (explaining same).

9 **VI. CONCLUSION**

10 For all these reasons, the Board should terminate this interference or, in the alternative,
11 clarify that SNIPR’s claims cannot be invalidated based on any purported proof of prior
12 invention.

Dated: October 16, 2020

Respectfully submitted,

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1 **CERTIFICATE OF SERVICE**

2 I hereby certify that on October 16, 2020, at the time generated by the e-filing system, I
3 electronically filed the foregoing **SNIPR MOTION 1** through the Interference Web Portal,
4 constituting service pursuant to SO 105.3, on counsel of record:

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Dated: October 16, 2020

Respectfully submitted,

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Appendix 1

List of Exhibits for SNIPR Motion 1 (Terminate Interference as Contrary to AIA)

Exhibit	Description
Exhibit 2003	U.S. Patent No. 10,582,712 (the “712 patent”)
Exhibit 2004	U.S. Patent No. 10,463,049 (the “049 patent”)
Exhibit 2005	U.S. Patent No. 10,506,812 (the “812 patent”)
Exhibit 2006	U.S. Patent No. 10,524,477 (the “477 patent”)
Exhibit 2007	U.S. Patent No. 10,561,148 (the “148 patent”)
Exhibit 2012	House of Representatives Report No. 112-98

Appendix 2

Statement of Material Facts for SNIPR Motion 1 (Terminate Interference as Contrary to AIA)

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4 1. All of SNIPR’s involved patents claim only inventions with effective filing dates
5 after March 16, 2013, and specifically reference only patents or applications that do the same.
6 (Paper No. 17 at 5; Exs. 2003-2007 (cover of each).)

7 2. The Boarded accorded Rockefeller’s Application 15/159,929 the benefit of three
8 priority applications, the earliest one filed before March 16, 2013. (Paper No. 17 at 5.)

9 3. The House Report accompanying the America Invents Act found that interference
10 proceedings are “lengthy, complex and costly administrative proceeding[s]” that “can take years
11 to complete” and “require extensive discovery.” (Ex. 2012 at 40-41.)

12 4. The House Report found that even the bare threat of an interference proceeding
13 imposed undue costs: “because it is always possible that an applicant could be involved in an
14 interference proceeding, companies must maintain extensive recording and document retention
15 systems in case they are later required to prove the date they invented the claimed invention.”
16 (Ex. 2012 at 40-41.)

17 5. The House Report found that the AIA would eliminate those costs and burdens
18 for parties subject to the Act’s changes because priority in a first-inventor-to-file system depends
19 on “the filing date of an application,” which “is an objective date, simple to determine.”
20 (Ex. 2012 at 40-41.)