

Berkeley Appeals PTAB Ruling In MIT, Broad CRISPR Dispute

By **Melissa Daniels**

Law360, Los Angeles (April 13, 2017, 7:43 PM EDT) -- Researchers from the University of California, Berkeley and the University of Vienna on Wednesday appealed a Patent Trial and Appeal Board decision finding no overlap between their CRISPR patents and those of the Massachusetts-based Broad Institute, furthering the IP battle between elite teams of scientists over the revolutionary gene-editing technology.

The Berkeley team and the Massachusetts team — consisting of the Broad Institute, the Massachusetts Institute of Technology and Harvard University — had each argued to the PTAB that they were the first to invent the efficient CRISPR-Cas9 technology, a groundbreaking method of genome editing that could aid in the treatment of genetic diseases and help combat hunger by producing stronger crops.

But the PTAB in a February per curiam ruling found the Broad team's research contained patentably distinct subject matter from the Berkeley team's technology, allowing them to keep the IP rights to their research.

On Wednesday, the Berkeley team, which is led by Jennifer Doudna and Emmanuelle Charpentier of the Max Planck Institute for Infection Biology, filed a notice with the PTAB announcing its appeal to the Federal Circuit. The team said in a press release it will be represented by former U.S. Solicitor General Donald B. Verrilli, now of Munger Tolles & Olson LLP.

"Ultimately, we expect to establish definitively that the team led by Jennifer Doudna and Emmanuelle Charpentier was the first to engineer CRISPR-Cas9 for use in all types of environments, including in non-cellular settings and within plant, animal and even human cells," said Edward Penhoet, a special adviser on CRISPR to the University of California president and Berkeley chancellor.

The Broad Institute responded to the move in a press release saying it expects the appellate court to affirm the PTAB ruling, as no facts have changed and its patent claims remain distinct from those in Berkeley's application.

"Importantly, the Federal Circuit does not independently weigh the facts determined by the PTAB," the Broad said. "To overturn the PTAB decision, the Court would need to decide that the PTAB committed an error of law or lacked substantial evidence to reach its decision. Given the careful and extensive factual findings in the PTAB's decision, this seems unlikely."

CRISPR, which stands for Clustered Regularly Interspaced Short Palindromic Repeats, represents a major

breakthrough in the field of genome editing, as it is less costly and easier to use than previous methods.

The Broad Institute was issued several patents for the technology in 2014, while the Berkeley group's application is still pending. Though the Berkeley team applied for a patent in May 2012, the Broad team, led by MIT's Feng Zhang, filed applications several months later, and requested and expedited review.

Last month, the Berkeley team saw a win at the European Patent Office when it announced its intention to grant a patent on the same technology at issue in the PTAB case. The Berkeley team said Wednesday it plans to continue pursuing applications in the United States and elsewhere claiming the CRISPR-Cas9 technology and its application in non-cellular and cellular settings, including eukaryotic cells.

Brian Nolan, a patent attorney for Mayer Brown LLP who specializes in life sciences and is unaffiliated with either research team, told Law360 that Berkeley's appeal was an anticipated step. He said the continued judicial challenges emphasize the importance of the technology, as it is envisioned the technology could lead to drugs that could make billions of dollars.

"It makes sense to them, from a commercial perspective, to do their best to secure as many of their rights as they can," he said.

Even in its early stages, the case is one to watch not just for attorneys but for the life sciences industry overall because of the potential commercial repercussions, Nolan said.

"So many pharmaceutical companies have decided that CRISPR is a revolutionary path to follow that it's important to understand where the rights are going to end up," he said.

The patents issued to the MIT group are U.S. Patent Numbers 8,697,359; 8,771,945; 8,795,965; 8,865,406; 8,871,445; 8,889,356; 8,895,308; 8,906,616; 8,932,814; 8,945,839; 8,993,233; and 8,999,641. The patent application by the University of California group is application number 13/842,859.

The Broad Institute, MIT and Harvard are represented by Steven R. Trybus, Harry J. Roper and Paul Margolis of Jenner & Block LLP. The Broad Institute is also represented by Raymond Nimrod of Quinn Emanuel Urquhart & Sullivan LLP.

The University of California and the University of Vienna will be represented in the appeal by Donald B. Verrilli of Munger Tolles Olsen LLP. They are also represented in the matter by Todd R. Walters, Erin M. Dunston and Travis W. Bliss of Buchanan Ingersoll & Rooney PC, and Li-Hsien Rin-Laures, Sandip H. Patel and Greta Noland of Marshall Gerstein & Borun LLP.

The appeal is University of California v. Broad Institute Inc., case number 17-1907, in the U.S. Court of Appeals for the Federal Circuit. The PTAB case is the Broad Institute Inc. et al. v. the Regents of the University of California et al., patent interference number 106,048.

--Additional reporting by Suevon Lee, Ryan Davis and Vin Gurrieri. Editing by Breda Lund.