LAW360®

Portfolio Media. Inc. | 111 West 19th Street, 5th floor | New York, NY 10011 | www.law360.com
Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@law360.com

PTAB Can't Interfere With AIA Patents, Fed. Circ. Says

By **Dani Kass**

Law360 (July 14, 2023, 8:21 PM EDT) -- An interference was the wrong proceeding to decide whether SNIPR Technologies or Rockefeller University invented particular gene-editing technology first, as the former's patents were covered by the interference-free America Invents Act, the Federal Circuit said Friday.

The three-judge panel reversed the Patent Trial and Appeal Board's November 2021 **decision** to invalidate SNIPR's patents, saying the board's conclusion that Rockefeller came up with the invention first doesn't hold up when the method of review was inappropriate. The U.S. Patent and Trademark Office director, who ultimately oversees the PTAB, **intervened** in the **appeal** to defend the board's ruling.

"Because pure AIA patents may not be part of interferences, the director erred by subjecting the SNIPR patents to an interference," the **precedential opinion** states.

The patents are directed to selectively killing bacteria through the gene-editing technology, clustered regularly interspaced short palindromic repeats — better known as CRISPR. Denmark's SNIPR is doing work on treating antibiotic-resistant bacterial infections. Rockefeller University, which focuses on biomedical research, is working on killing specific bacteria in a mixed population.

The America Invents Act significantly altered the patent landscape when it went into effect in 2013, turning the country from a place where the first party to invent something was entitled to the patent rights, to one where the rights go to the first party to file a patent application. Patents with effective dates before March 2013 are considered pre-AIA patents, subject to pre-AIA law-like interferences.

Here, SNIPR's patents are post-AIA, while Rockefeller's patent application is pre-AIA. The PTAB had said interference proceedings were allowed because the pre-AIA patent application interferes with post-AIA patent claims.

The AIA has only one exception allowing interferences — for patents that mix pre-AIA and post-AIA claims — meaning the PTAB got it wrong, according to the Federal Circuit. Having that explicit exception is one piece of proof that Congress actively chose not to allow other exceptions, the court added.

"There is no hint of congressional intent to expose pure AIA first-inventor-to-file patents and applications to interferences," the opinion states. "To the contrary, the purpose and history behind the AIA reinforce our understanding of the text. Congress was dead set on eradicating interferences for new applications, criticizing them as lengthy, expensive and requiring companies to maintain extensive documentation and systems to prove the date of their invention."

Additionally, the Federal Circuit said it wouldn't be fair to issue and examine SNIPR's patents under the terms of the AIA and then try to cancel them under different requirements.

If Rockefeller wants to challenge SNIPR's patents, it can do so through AIA systems, including inter partes reviews, post-grant reviews and ex-parte reexaminations. In those proceedings, the older patent application would most likely be considered prior art to the latter, "thus ensuring that two patents for the same invention will not be granted under the two different regimes," the Federal Circuit said.

SNIPR's leader, Jasper Clube, said they're "delighted" by the ruling.

"This ruling determines that five contested patents that SNIPR holds will remain in place, that none of SNIPR's patent portfolio can be subjected to an interference again, and that SNIPR's patents will not be judged by the old first-to-invent standard," said Clube, who is identified as a patent attorney, co-inventor and co-founder of the company.

Rockefeller attorney, Salvatore J. Arrigo III, said they're evaluating how to move forward, but that they're not completely disappointed. While the court may have ruled against it on the big picture, the details of the merits analysis were often in its favor, the Arrigo Lee Guttman & Mouta-Bellum LLP attorney said.

"There's a number of conclusions in the opinion, which we're very much in agreement and very pleased." Arrigo said, citing its patent application counting as prior art as an example.

A representative for the USPTO declined to comment Friday.

The SNIPR patents-at-issue are U.S. Patent Nos. 10,463,049; 10,506,812; 10,561,148; 10,524,477; and 10,582,712. Rockefeller's application is No. 15/159,929.

Circuit Judges Raymond T. Chen, Evan Wallach and Todd M. Hughes sat on the panel for the Federal Circuit.

SNIPR is represented by Brian R. Matsui, Seth W. Lloyd, Parisa Jorjani and Matthew Kreeger of Morrison & Foerster LLP.

Rockefeller is represented by Salvatore J. Arrigo III and Harry J. Guttman of Arrigo Lee Guttman & Mouta-Bellum LLP.

The USPTO is represented in-house by Sarah E. Craven, Thomas W. Krause, Monica Barnes Lateef, Amy J. Nelson and Farheena Yasmeen Rasheed.

The case is SNIPR Technologies Limited v. Rockefeller University, case number 22-1260, in the U.S. Court of Appeals for the Federal Circuit.

--Additional reporting by Britain Eakin. Editing by Philip Shea.
