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PATENTS

The More Things Change, the More They Remain the Same!

By Charles L. Gholz and Lisa M. Mandrusiak

Nineteen years ago the senior author of this article wrote that, despite the presence in the rules governing interferences of 37 C.F.R. § 1.651(a) giving the administrative patent judge handling an interference authority to ''set a time for filing motions (§ 1.635) for additional discovery under § 1.687(c)'' and 37 C.F.R. § 1.687(c) giving the APJ authority to ''order additional discovery, as to matters under the control of a party within the scope of the Federal Rules of Civil Procedure,'' there really was nothing in interferences that a district court litigator would recognize as discovery.

In the first place, what the board called discovery other than ''additional discovery'' really wasn't discovery at all. It was simply the opportunity to review prior to the deposition of an adverse witness the documents on which that witness was going to rely during that deposition. Highly desirable no doubt, but that's not discovery. Discovery is the opportunity to review documents and things that opposing counsel hopes that you will never, ever see and to depose witness that opposing counsel hopes that you will never, ever get to talk to.

In the second place, 37 C.F.R. § 1.687(c) didn't authorize you to simply go to your opponent and tell him or her what you wanted to see and/or who (under his or her control) you wanted to talk to. It only authorized you to go to the APJ and attempt to persuade him or her that ''the interest of justice . . . require[d]'' him or her to order one's opponent to cough up the document, thing or witness in question—and the APJs very seldom agreed that interferents had made the proper showing.

Well, 19 years have passed, and, as evidenced by what's going on in *Broad Institute, Inc. v. Regents of the University of California*, Int. No. 106,048 (the ''CRISPR'' interference), nothing has changed.

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The views expressed herein are those of the authors and are not necessarily shared by their employer or its clients.

What UC Asked For

Whoever made the CRISPR invention (a subject on which the authors express no opinion), once the word got around among biotechies that laboratories at the University of California (UC) and the Broad Institute (and perhaps other institutions) were working on CRISPR, there was an explosion of interest in the biotech community, and numerous laboratories began work on many aspects of the commercialization of what we will refer to as ''the basic idea.'' (Note that we are carefully not referring to that basic idea as ''the basic invention,'' since we also express no opinion as to whether that basic idea was a patentable invention.) At the risk of over-simplification, we will describe ''the basic idea'' as a new method of cutting-and-pasting portions of genetic sequences of prokaryotic cells in test tubes using CRISPR to locate and target a desired replacement sequence and ''the commercializable invention'' (i.e., what everyone was seeking) as a method of cutting and pasting portions of genetic sequences of eukaryotic cells in situ in human beings using the same CRISPR technology.

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UC argued that its inventors (Drs. Doudna and Charpentier) had had the basic idea and that, once the basic idea got around, multiple other laboratories (notably including both Dr. Zhang's laboratory at Broad and another laboratory at Broad run by a Dr. Church) had quickly and easily moved on to the commercializable invention—or, at least—to various aspects of the commercializable invention. Broad, on the other hand, argued that Drs. Zhang and Church had commenced their eukaryotic work before they got wind of what Drs. Doudna and Charpentier were doing and were in fact successful prior to a key publication (''the Jinek 2012 publication'') emanating from UC.

To prove its version of history and/or to disprove Broad's version of history, UC wanted to subpoena and examine two individuals. We will refer to UC's paper asking for authorization to subpoena those two individuals as UC's motion for discovery, although the panel actually ordered a more complex two-step process.

As explained in Paper No. 795, the first individual that UC wanted to subpoena was Dr. Lin. Dr. Lin was a student of Dr. Zhang's who was working on CRISPR in Dr. Zhang's laboratory at the relevant time. However, Dr. Lin subsequently applied for a job with Dr. Doudna, allegedly offering to give Dr. Doudna (and, hence, UC) documents in his personal possession that were inconsistent with Broad's version of history in return for that job. To add spice to the stew, Dr. Lin was about to be returned to China if he couldn't get another job in the United States. UC had an email from Dr. Lin to Dr. Doudna that contained Dr. Lin's allegations, but Broad (not unreasonably) objected to that email as hearsay.

The second individual that UC wanted to subpoena was Dr. Church, the colleague of Dr. Zhang's at Broad who had his own lab that had also worked successfully on commercializing the basic idea, perhaps independently of Dr. Zhang's lab and perhaps jointly with Dr. Zhang's lab. Since the real parties-in-interest disputed the relationship (or lack of relationship) between the two labs, UC wanted to talk to Dr. Church, whom it said it expected ''to confirm and elaborate upon his prior public comments that neither he nor any of the other co-authors of . . . [an article describing those successes] were aware of work being performed in Dr. Zhang's laboratory.'' The CRISPR interference Paper No. 795 at page 2. Not surprisingly, Dr. Church was not about to confirm any of those ''public comments'' unless required to testify by the board.

What the Panel Wrote

The first thing to be said about the panel's disposition of UC's motion for discovery is that it didn't require Broad to respond to UC's inflammatory contentions. In fact, it didn't even authorize Broad to file a response to defend itself if it wanted to do so. (There is nothing in the record to suggest that Broad asked either the panel or the individual APJ handling the interference for the opportunity to defend itself and/or its employees.)

The second thing to be said about the panel's disposition of UC's motion is that it was per curiam. None of the three judges on the panel (APJs Richard E. Schafer, Sally Gardner Lane, and Deborah Katz) would take personal responsibility for what the panel said and did.

On the merits, the panel disposed of UC's motion as follows:

> ''The standard for granting requests [for additional discovery] is high and requires specific bases for expecting that the discovery will be productive. Bd.R. 150(a) & (c)(1).'' Standing Order (''SO'') ¶ 150.2
>
> UC asserts that it requires testimony from Dr. Lin to address Broad's allegations in Broad Opposition 4 in opposition to UC's argument that the Jinek 2012 publication ''triggered and guided the work'' of the Broad scientists and that the Broad scientists had commenced their work in 2011. * * * Similarly, UC argues that it requires testimony from Dr. Church to address the challenge in Broad Opposition 4 on the issue of whether research groups, particularly Dr. Church's group, ''moved the Type-II CRISPR-Cas system into eukaryotic cells before December 12, 2012.'' * * *.
>
> UC Motion 4 * * * seeks to be accorded the benefit of priority of earlier applications as constructive reductions to practice of the count. UC fails to explain why testimony from either Dr. Lin or Dr. Church regarding the timing of actual work done by Broad scientists would be productive in regard to its arguments regarding the disclosure of UC's earlier applications. Thus, whether or not the requested discovery would address Broad's specific arguments, UC has failed to show that it would present a basis for discovery that would be productive to the issues of its Motion 4.
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> * * *
>
> UC also argues that[,] if authorized to file a motion [to be authorized to subpoena Drs. Lin and Church], it would show compelled testimony is necessary to address Broad's objections to UC's evidence. * * * UC asserts that Broad has objected to certain exhibits * * * as being impermissible hearsay, but UC does not explain where these exhibits were relied upon or what arguments they were used to support. Without more explanation, we are not persuaded that testimonial evidence would be productive in addressing objections to this evidence. UC asserts that this evidence is ''highly relevant evidence to determine whether Broad's assertions are true.'' * * * Without any explanation of how or where this evidence was used, UC has failed to show why at this stage of the interference[,] when priority is not yet at issue and given the motions before us regarding benefit, substitution of the count, and interference-in-fact, such testimony would be productive.
>
> UC has not explained why there would be a sufficient basis for a motion . . . for subpoena[s]. Accordingly, UC's request for such a motion is DENIED. [The CRISPR interference Paper No.801 at pages 2-3, as amended by Paper No. 803.]

Comments

(1) Far be it for us to suggest that the panel was being purposefully obtuse in order to save on labor. However, it does seem to us that, assuming that Their Honors read Broad's Opposition 4 before deciding UC's motion for discovery, they would have seen how Broad relied on the evidence to which UC wished to respond. Moreover, it seems to us that, if Their Honors understood how Broad relied on that evidence, the relevance of the testimony UC hoped to obtain from Drs. Lin and Church would have been perfectly obvious.

(2) In light of the panel's heavy reliance on the explanations that Their Honors found lacking in UC's motion, we also suggest that, as long as the APJs give counsel few enough pages in motions of this sort, they can *always* find something lacking in counsel's explanations! Thus, the technique of giving counsel ridiculously few pages in which to argue complex issues may be a major labor-saver for Their Honors. (We note that, in this instance, UC was authorized only five pages. See the CRISPR interference Paper No. 792 at 3.)

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(3) Returning to the 19 years that have passed since the senior author of this article first published an article complaining about the absence of effective discovery in interferences, we concede the fact that, during those 19 years (and before the start of those 19 years), the U.S. Court of Appeals for the Federal Circuit has let the APJs get away with refusing to grant meaningful discovery in the overwhelming majority of interferences despite the fact that their decisions on motions for discovery are merged into the final judgment and are, hence, reviewable on appeal. See, e.g., *Crown Packaging Technology, Inc. v. Reexam Beverage Can Co.*, 559 F.3d 1308, 1311, 90 U.S.P.Q.2d 1186, 1188 (Fed. Cir. 2009) (''this court has recognized that an earlier, non-appealable order may be considered to be 'merged' into a subsequent final judgment. *See Glaros v. H. H. Robertson Co.*, 797 F.2d 1564, 1573 [230 U.S.P.Q.2d 393, 399] (Fed. Cir. 1986).'').

(4) However, we think that, at long last, a case has arisen involving enough money so that it may be worth taking a merged decision denying discovery to the Federal Circuit—depending, of course, on what (if any) reliance the panel places in its decision on the merits on Broad's evidence that UC was seeking to counter via the sought-for subpoenas of Drs. Lin and Church.

(5) Of course, the final decision in the CRISPR interference (whether that final decision is by the board, by the Federal Circuit on appeal from the board's decision, or by the Supreme Court on petition for certiorari from the Federal Circuit's decision) will put an end to the controversy between the real parties-in-interest over the patentability of the claims now in issue and any subsequent claims of those parties that are not patentably distinct from those claims. See Gholz and Englehart, *B&B Hardware, Inc. v. Hargis Industries, Inc. Leaves Patent Law Unscathed!*, 90 Patent, Trademark & Copyright Journal 2258 (June 5, 2015), discussing the preclusive effect of judgments in interferences as between the real parties-in-interest.

(6) However, the final decision in the CRISPR interference will surely *not* put an end to the many follow-on controversies between whichever real party-in-interest wins the interference and the many, many interested third parties. Given the astounding amount of money in play, *someone* is going to depose Drs. Lin and Church on the issues concerning which UC wanted to depose them!

(7) The absence of effective discovery is, of course, not just a problem for interferents. The panel's decision in *Wi-Fi One, LLC v. Broadcom Corp.*, IPR2013-00601 (P.T.A.B. Jan. 24, 2014) (opinion by APJ Easthom for a panel that also consisted of APJs Clements and Deshpande), affirmed sub nom *Wi-Fi One, LLC v. Broadcom Corp.*, 837 F.3d 1329, 120 U.S.P.Q.2d 1126 (Fed. Cir. 2016), makes it clear that it is equally a problem for participants in other inter partes proceedings before the board.