



**VOSSIUS & PARTNER**

Patentanwälte Rechtsanwälte mbB

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### **Case Note Regarding Revocation of Broad Institute's CRISPR-Cas Patent in Europe**

The Broad Institute et al. (Broad) obtained a number of European patents for certain aspects of CRISPR-Cas technology that Vossius & Partner have opposed on multiple grounds on behalf of CRISPR Therapeutics AG. The first of these, EP-B1 2771468, was revoked on January 17, 2018, based on lack of novelty. The Opposition Division of the European Patent Office (EPO) agreed with CRISPR and numerous other opponents that Broad had fundamental deficiencies with multiple priorities claimed through their international PCT application upon which the European patent was based.

Although Broad complained about the strictness of applicable EPO rules regarding priority claims, they also effectively admitted during the oral proceedings that their actions were not even a mistake, and that they had in fact intentionally excluded a Rockefeller University scientist (Dr. Luciano Marraffini) who was named in their original US priority applications.

Broad also acknowledged that the relevant priority practices and jurisprudence of the EPO have been consistently applied since 1978, but effectively requested that the EPO change its long-standing procedures in order to accommodate Broad's prior choices, and more importantly preserve corresponding priority rights that were undercut by their decision to exclude the Rockefeller scientist.

Broad subsequently argued that the EPO's practices and jurisprudence are based on Articles of the European Patent Convention (EPC) that are inconsistent with the Patent Cooperation Treaty (PCT) and the Paris Convention (PC), which was first adopted in 1883 and so has been applied for more than 130 years. In fact, a simple comparison of these provisions reveals that the key provisions (e.g. Article 87 EPC and Article 4(A) PC) are essentially identical in all relevant respects. Indeed, this identity is not a coincidence but was designed to allow overall harmonization of the international patent process, including that of Europe and the United States, using well-known and simply to apply procedures.

After the Opposition Division of the European Patent Office rejected Broad's arguments and requests, and ruled that their priority claims were defective, Broad did not attempt to defend novelty of their granted claims against cited prior art. After the granted claims were found to be non-novel, Broad was also offered the opportunity to defend novelty using any of 64 auxiliary requests they had previously submitted, which contained a variety of alternative claims and subject matter. Broad chose to not attempt to defend the novelty of any of these claims in the proceedings, and as result CRISPR's and other opponents' additional attacks on these auxiliary claims were not addressed because the claims were not defended.

Among other key issues, there are earlier patent applications and prior art documents relating to the CRISPR-Cas9 technology that are pertinent to the assessment of lack of novelty and lack of inventive step of what Broad claimed as their invention. By effectively refusing to defend the novelty of their main or any auxiliary claims (which were consequently not admitted), Broad prevented having any such prior art substantively addressed – thereby avoiding two additional days of scheduled EPO proceedings that would have considered further attacks of CRISPR and other opponents, including the lack of novelty and/or inventiveness of their claims relative to the prior art.

Broad's European patent was then revoked in its entirety. To the extent that the revocation of this first patent was based on legal matters rather than addressing the additional substantive attacks on their claims, that was because Broad effectively prevented the additional substantive matters from being reached in these proceedings.

Broad has appealed the decision against them. However, obtaining a decision by the Technical Board of Appeals can take several years. In addition, although their refusal to specifically defend any auxiliary claim requests cut short these opposition proceedings, all of their auxiliary claim requests have been deemed inadmissible. However, in any appeal the lack of their auxiliary claim requests would seem to be problematic because, even if the decision on priority were for some reason reversed, the Opposition Division had already determined in its preliminary opinion that Broad's granted claims also lacked basis in the originally filed patent application.

Fundamental defects including priority deficiencies also affect numerous other Broad patents that have been granted in Europe and are now being opposed by CRISPR and other parties.

Pending any appeal, this and any other revoked patents will be unenforceable.

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