

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Doudna *et al*

CONFIRMATION NO.: 8182

APPLICATION NO.: 13/842,859

ART UNIT: 1653

FILING DATE: March 15, 2013

EXAMINER: Not yet assigned

TITLE: Methods and Compositions for RNA-Directed Target DNA Modification and For RNA-Directed Modulation of Transcription

Filed via EFS-Web

**PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE RULES IN
ORDER TO PERMIT JOINT REPRESENTATION IN A PATENT
APPLICATION**

This is a petition under 37 C.F.R. § 1.183 to suspend the requirement of 37 C.F.R. § 1.32(b)(4) that the applicant sign the power of attorney.

Emmanuelle Charpentier is one of seven named inventors on this application and is an applicant on this application. (See Exhibit A, Filing Receipt). This petition is filed on behalf of Ms. Charpentier to request that the U.S. Patent and Trademark Office (USPTO) accept the attached power of attorney appointing her own representative to prosecute this application before the USPTO, separate and apart from any representative(s) appointed by the remaining six inventors or their assignees.

Ms. Charpentier submits that this is an extraordinary situation where justice requires waiver of the requirement of 37 C.F.R. § 1.32(b)(4) that the applicant sign the power of attorney because Ms. Charpentier's interest in the application is materially different from the interests of the remaining inventors.

As set forth in the attached Declaration of Ms. Charpentier ("the Declaration"), Ms. Charpentier's co-inventors include Jennifer A. Doudna, Martin Jinek, Krzysztof Chylinski, James Harrison Doudna Cate, Wendell Lim, and Lei Qi.

As set forth in the Declaration, Ms. Charpentier believes that Jennifer A. Doudna, Martin Jinek, James Harrison Doudna Cate, Wendell A. Lim, and Lei S. Qi are under an obligation to assign their rights in this application to The Regents of the University of California ("the University of California"). However, as stated in the Declaration, unlike these five inventors,

Ms. Charpentier is under no obligation to assign her rights in this application to the University of California, nor does she intend to assign her right to the University of California.

Because Ms. Charpentier is not under an obligation to assign and has no intention of assigning her rights to the University of California, Ms. Charpentier submits that her interests in this application are materially different from the interests of the applicants/inventors having an obligation to assign to the University of California and cannot be adequately represented by someone acting on their behalf or on behalf of the University of California. For example, patent prosecution decisions changing the pending claims could affect the inventorship and the ownership rights in this application, prejudicing Ms. Charpentier if she is not adequately represented as those decisions are made.

As set forth in the Declaration, Krzysztof Chylinski has assigned his rights in this application to The University of Vienna ("Vienna"). However, as stated in the Declaration, unlike Krzysztof Chylinski, Ms. Charpentier is not under an obligation to assign her rights in this application to Vienna, nor does she intend to assign her rights to Vienna.

Because Ms. Charpentier is not under an obligation to assign and has no intention of assigning her rights to Vienna, her interests in this application are materially different from those of Krzysztof Chylinski and Vienna, and cannot be adequately represented by someone representing Krzysztof Chylinski or Vienna.

Accordingly, for all these reasons, granting this petition for joint representation would be in Ms. Charpentier's best interests and in the in the interests of justice. Therefore, Ms. Charpentier requests that the Office waive the requirement of 37 C.F.R. § 1.32(b)(4) in this instance and accept the appointment of her representative in the prosecution of this application before the U.S. Patent and Trademark Office.

Ms. Charpentier and her appointed representatives look forward to coordinating and cooperating in the prosecution of this application with those representatives appointed by the remaining inventors, or their assignees. To this end, Ms. Charpentier waives the right to receive correspondence in this application and understands that the Office will send all correspondence for this application to the correspondence address currently of record in this application.

Accompanying this petition is the requisite fee of \$200.00 at the small entity rate under 37 C.F.R. § 1.17(f) as required by 37 C.F.R. § 1.183. Applicant believes no further fees are due in connection with this submission. Nevertheless, if Applicant is in error, the Director is

authorized to charge Attorney's Deposit Account No. 07-1700 for any further fees required for the submission of this paper only.

The Examiner is invited to telephone the undersigned representative to discuss any issues or concerns related to this petition.

Date: June 11, 2013

Tel. No.: 617.570.1963

Fax No.: 617.523.1231

Respectfully submitted,

/Brian A. Fairchild/

Brian A. Fairchild

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL. FEE REC'D	ATTY. DOCKET NO.	TOT. CLAIMS	IND. CLAIMS
13/842,859	03/15/2013	1653	0.00	BERK-187	155	22

CONFIRMATION NO. 8182

84220

UC Berkeley - OTL

Bozicevic, Field & Francis LLP

1900 University Avenue, Suite 200

East Palo Alto, CA 94303

FILING RECEIPT



0000000061122324

Date Mailed: 05/16/2013

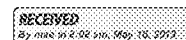
Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Inventor(s)

Jennifer A. Doudna, Berkeley, CA;
 Martin Jinek, Berkeley, CA;
 Emmanuelle Charpentier, Berkeley, CA;
 Krzysztof Chylinski, Berkeley, CA;
 James Harrison Doudna Cate, Berkeley, CA;
 Wendell Lim, San Francisco, CA;
 Lei Qi, Albany, CA;

Applicant(s)

Jennifer A. Doudna, Berkeley, CA;
 Martin Jinek, Berkeley, CA;
 Emmanuelle Charpentier, Berkeley, CA;
 Krzysztof Chylinski, Berkeley, CA;
 James Harrison Doudna Cate, Berkeley, CA;
 Wendell Lim, San Francisco, CA;
 Lei Qi, Albany, CA;



Assignment For Published Patent Application

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA, Oakland, CA
 UNIVERSITY OF VIENNA, Vienna, AUSTRIA

Power of Attorney: None

Domestic Applications for which benefit is claimed - None.

A proper domestic benefit claim must be provided in an Application Data Sheet in order to constitute a claim for domestic benefit. See 37 CFR 1.76 and 1.78.

Foreign Applications for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <http://www.uspto.gov> for more information.) - None.

Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.

If Required, Foreign Filing License Granted: 05/08/2013

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 13/842,859**

Projected Publication Date: To Be Determined - pending completion of Missing Parts

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

METHODS AND COMPOSITIONS FOR RNA-DIRECTED TARGET DNA MODIFICATION AND FOR RNA-DIRECTED MODULATION OF TRANSCRIPTION

Preliminary Class

435

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications: No

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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community; serves as an ombudsman for existing and potential investors; advocates on behalf of U.S. cities, states, and regions competing for global investment; and counsels U.S. economic development organizations on investment attraction best practices. To learn more about why the United States is the best country in the world to develop technology, manufacture products, deliver services, and grow your business, visit <http://www.SelectUSA.gov> or call +1-202-482-6800.

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TITLE: Methods and Compositions for RNA-Directed Target DNA Modification and For RNA-Directed Modulation of Transcription

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**DECLARATION OF EMMANUELLE CHARPENTIER ACCOMPANYING
PETITION UNDER 37 C.F.R. § 1.183 TO SUSPEND THE RULES IN
ORDER TO PERMIT JOINT REPRESENTATION IN A PATENT
APPLICATION**

My name is Emmanuelle Charpentier. I am an inventor of the subject matter of the above-identified patent application and an applicant for the above-identified patent application.

The remaining inventors on this application are Jennifer A. Doudna, Martin Jinek, Krzysztof Chylinski, James Harrison Doudna Cate, Wendell Lim, and Lei Qi.

I believe that Jennifer A. Doudna, Martin Jinek, James Harrison Doudna Cate, Wendell Lim, and Lei Qi are under an obligation to assign their rights in this application to The Regents of the University of California ("the University of California") and have been asked to execute an assignment of their rights to the University of California.

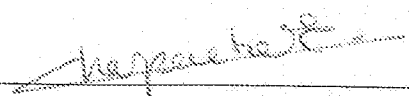
I am not under an obligation to assign my rights in this application to the University of California, nor do I intend to assign my rights in this application to the University of California.

I am aware that Krzysztof Chylinski has assigned his rights in this application to The University of Vienna ("Vienna").

I am not under an obligation to assign my rights in this application to Vienna, nor do I intend to assign my rights in this application to Vienna.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful and false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code.

Date: June 7, 2013


Emmanuelle Charpentier

LIBC/4902272.2