

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INARI AGRICULTURE, INC.,
Petitioner,

v.

CORTEVA AGRISCIENCE LLC,
Patent Owner.

Case No. IPR2024-01014
Patent No. 8,901,378

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE**

PO does not dispute that Barbour anticipates/renders obvious the Challenged Claims absent entitlement to an April 2004 priority claim. Nor does PO offer evidence establishing enablement of its claims as of its April 2004 application filing date. PO cannot dispute that the claimed TC1507 germplasm (1) was *never* deposited *prior to issuance*, yet (2) could *not* be independently reproduced based on the April 2004 Application's disclosure alone. PO instead argues that *PO's own commercialization* of TC1507 somehow excuses PO's failure to enable its claims through the deposit of seed *prior to issuance*. No such end-around USPTO seed deposit procedures exist, and the Board has no power to pronounce one here.

PO's TC1507 sales were subject to extensive contractual restrictions, such that PO "always retained" critical "elements of legal control" over the seeds. EX1003, 542-543 (emphasis original). This is the antithesis of the seed deposit system, which ensures the public's *unrestricted* access—free of patent owner control—to the seeds upon patent issuance. Only such unrestricted access guarantees the *quid-pro-quo* underlying §112(a).

Lacking any relevant authority, PO oddly attempts to retroactively cure its enablement failure via Barbour's *February 2006* publication date. PO at 21. But Petitioner's 102 showing is immaterial to whether PO's application was sufficiently enabled for *§112(a) purposes* as of its *April 2004* filing date. PO ignores the two-year difference—much less offers evidence bridging it. PO also

fails to establish that seed enablement standards under §112 mirror those under §102. PO's argument—stressing the lack of “controlling precedent” (POPR at 1)—only confirms that no one else has been caught doing what PO attempted here. This is no excuse for failing to enable its application in accordance with USPTO seed deposit requirements. (MPEP 2164.05(a) – *Specification Must Be Enabling as of the Filing Date*)

Nor is discretionary denial warranted under 325(d). Nothing in the record indicates the Examiner considered PO's commercialization of TC1507 to enable the April 2004 Application. Yet such commercialization is the *only* basis PO offers to excuse the lack of a deposit—notwithstanding PO's contrary admissions to the EPO. Plainly this enablement question was never before considered.

I. Restricted Commercialization Cannot Substitute for a Public Deposit

As Petitioner explained (Petition at 2-4, 29-41) and PO does not dispute, the Challenged Claims concern a random transgenic “event” that POSAs could not practice as of the April 2004 Application's filing date without the actual TC1507 germplasm. PO indisputably did not deposit such seeds *prior to issuance*. PO instead argues that its application enables the Challenged Claims because PO had started to *commercialize* TC1507 as “Herculex 1.” POPR at 18-40. But as PO admits, PO's Herculex 1 sales are subject to contractual restrictions—making them fundamentally different from proper deposits under USPTO regulations. Crediting

PO's end-around would wrongly permit PO to both enjoy patent protection and *then* retain proprietary control over TC1507 once the '378 Patent expires. The seed deposit system protects the public, and most particularly, American farmers, from such blatant abuses of the U.S. patent system. And in any event, the PTAB has no power to rewrite USPTO seed deposit regulations to create new exceptions.

A. Regardless - Barbour Concerns a Later Date and a Different Legal Standard

To address Barbour's enablement under §102, Petitioner presented evidence that “[b]y 2006” POSAs could have obtained bulk corn on the open market *after harvest* (a new generation of seeds—not subject to PO's contractual restriction) and then used PCR-based DNA detection to identify TC1507 germplasm. Petition at 53-57; *see also* POPR at 20, 29, 35 (“corn *harvested* from TC1507”) (emphasis original); POPR at 21 (“following harvest”).

Setting aside PO excusing itself from PTO seed deposit requirements in the first instance, as a factual matter, the state of the art as of Barbour's February 2006 publication date is not the same as April 2004. Indeed, evidence Petitioner cited to establish Barbour's enablement under §102 postdated the April 2004 Application. Petition at 55-57. PO offers no counter-evidence or argument attempting to bridge the twenty-two-month gap between April 2004 and February 2006. PO instead ignores the issue entirely.

PO simply mischaracterizes Petitioner as contending “that the same

application can be simultaneously enabling and not enabling.” POPR at 32.

Petitioner’s actual point—which PO never addresses—is that while the corresponding Barbour publication in 2006 theoretically permits a POSITA to obtain TC1507 through the multi-step process Petitioner detailed, this is still years-after-the application filing and lack of the necessary seed deposit. *Application enablement is determined as of the filing date*. MPEP 2164.05(a)¹.

II. The Examiner Never Considered PO’s Commercialization Theory

Discretionary denial under 325(d) is inappropriate because the Examiner never considered the dispositive enablement issue. As explained above, the April 2004 Application does not enable the Challenged Claims and the Examiner made no corresponding enablement findings as to Barbour, or any other intervening art.

PO confuses the issue by citing the Examiner’s enablement rejection and the subsequent withdrawal of that rejection following PO’s amendment. POPR at 11-12. That enablement analysis had nothing to do with the April 2004 Application and *whether the Challenged Claims were entitled to priority under §120*. Indeed, “examiners...cannot be expected to scrutinize the prosecution history of an application and each parent application to determine whether the application would have met § 120’s requirements.” *Nat. Alternatives*, 904 F.3d at 1380.

¹ This argument also ignores the Barbour 103 Grounds in any event.

Nor did the Examiner make any finding that PO's commercialization of TC1507/Herculex I was relevant to the enablement analysis. While PO cites expected prior art "search strings" that include these terms (POPR at 12), nothing connects them to enablement-related analysis of any sort. In other words, the Examiner never "articulated" any "consideration of the art or arguments in the record" related to TC1507/Herculex I. 89 Fed. Reg. 28,693, 28,700 (Apr. 19, 2024) (Director's notice of proposed rulemaking concerning §325(d)).²

Even if the Board reached part two of *Advanced Bionics*, PO simply cannot rely on commercialization. As §1.808(a)(2) reflects and as the USPTO has explained in similar cases, transgenic seed deposits must be "irrevocably and ***without restriction***³ released to the public ***upon patent issuance***." EX1023, 5-6 (rejecting claims because specification lacked required confirmation). But as PO explained to the EPO, TC1507 was commercialized subject to contractual restrictions so extreme they meant that the "plant was not publicly available at all." EX1003, 519; *see also id.*, 543. The Board has no power to pronounce a "commercialization" exception to seed deposit regulations.

² Petitioner cited this notice (Petition at 68), but PO ignores it.

³ PO's suggestion that deposits may be subject to "restriction" (POPR at 29) flies in the face of this long-standing USPTO practice and indeed §1.808(a)(2) itself.

Date: October 07, 2024

/Scott A. McKeown/
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on October 07, 2024, I will cause a copy of the foregoing document, including any exhibits or appendices filed therewith, to be served via electronic mail, as previously consented to by Patent Owner, upon the following:

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