

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INARI AGRICULTURE, INC.,
Petitioner,

v.

CORTEVA AGRISCIENCE LLC,
Patent Owner.

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

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

The law is clear: a claimed invention must be enabled as of its filing date. M.P.E.P. § 2164.05(a); *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1345 (Fed. Cir. 2000). For claims where a biological sample may be required to enable the invention, enablement can be shown as of the filing date by depositing the material or otherwise establishing it is known and readily available *as of the date of issuance* of the patent. *In re Lundak*, 773 F.2d 1216, 1220-22 (Fed. Cir. 1985); *Feldman v. Aunstrup*, 517 F.2d 1351, 1355 (CCPA 1975); *Ajinomoto*, 228 F.3d at 1345-46 (Fed. Cir. 2000); 37 C.F.R. § 1.802(b); M.P.E.P. §§ 2402, 2404.01; POPR (Paper 9), 18-19, 25-27. That is exactly what occurred here. Petitioner's own evidence demonstrates that the claims it challenges were fully enabled as of the April 2004 filing date. Petitioner did not challenge written description as of that date. POPR, 25. Thus, the published Barbour application is not prior art. Pet., 5, 47-57, 64, 67; POPR, 17-25.

Petitioner's Reply (Paper 10) does not change these facts or cure the deficiencies in the Petition. Contrary to Petitioner's assertion, this proceeding does not present any issues of "first impression." EX3001. In reply, Petitioner disagrees with the Examiner's enablement analysis and fails to address relevant standards. Petitioner's repeated argument that *only* a deposit can satisfy the enablement requirement is contrary to *In re Wands*, 858 F.2d 731, 736 (Fed. Cir. 1988), which is binding on the Board. It is also contrary to USPTO rules and additional precedent.

Tellingly, Petitioner once again fails to address the relevant legal standards, including the “known and readily available” alternative to a biological deposit. 37 C.F.R. § 1.802(b); M.P.E.P. § 2404.01.¹

Here, even if the Examiner had required a deposit, none was necessary because biological material embodying TC1507 was—by Petitioner’s own acknowledgement—“known and readily available” before the issuance of the ’378 patent. POPR, 17-25. Indeed, *Petitioner* argued and presented evidence that “corn *harvested* from TC1507 plants continued to express the TC1507 event and was indisputably commercially available following the 2003, 2004, and 2005 growing seasons,” and that “[s]uch corn was sold as a commodity—without any contractual

¹ Petitioner’s statement that Patent Owner has stressed “the lack of ‘controlling precedent’” is disingenuous at best. Reply, 2 (purporting to characterize Patent Owner’s Preliminary Response at 1). Patent Owner’s statement stressed *Petitioner’s* failure to cite any relevant controlling precedent supporting its position that an application can be both enabling for § 102 while not enabling under § 112 for the same claims. POPR, 1. And Patent Owner cited plenty of precedent. POPR, 32-35, 36-37 (citing *Rasmusson v. SmithKline Beecham Corp.*, 413 F.3d 1318, 1325-26 (Fed. Cir. 2005); *In re Hafner*, 410 F.2d 1403, 1405 (CCPA 1969)); *see also* POPR 26-27 (citing *In re Lundak*; *Feldman*; *Ajinomoto*); M.P.E.P. § 2402.

restrictions.” Pet., 52; *see also id.*, 49, 50, 55. This is the definition of known and readily available at the applicable time to enable the claimed invention as of the *filing date*. *See* POPR, 17-25. Petitioner’s own admission supports this legal standard.

Petitioner attempts to downplay its own admissions by shifting its position based on alleged “extensive contractual restrictions” on the commercially-available seed. Reply, 1. The Board can deny institution, however, without ever addressing the effect of commercial restrictions because of Petitioner’s own statement that “corn *harvested* from TC1507 plants continued to express the TC1507 event and was indisputably commercially available . . . without any contractual restrictions” before issuance of the ’378 patent. Pet., 52-53; EX1007, ¶¶ 131-134. That recognized access alone meets the known and readily available alternative to requiring a biological deposit, if the Examiner had even required one. POPR, 17-25.

Even if relevant, which they are not, Petitioner has not proffered sufficient support either factually or legally that such restrictions contravened the known and readily available standard. First, Petitioner has not tied the evidence of restrictions that it relies upon to any purported restrictions as of the issue date. *See* EX1003, 543. Second, Petitioner cites no legal authority that seed deposits, and by analogy, commercial sales to support enablement cannot be subject to restrictions. Reply, 1-2. As Petitioner well knows, seed deposits (*e.g.*, obtained from ATCC) are not

entirely without use restrictions contrary to its statements in reply. *Id.* Thus, even if Petitioner had not admitted that TC1507 was known and available without restriction in downstream corn products, which it did (Pet., 52-53), restrictions on the seeds do not immediately preclude a finding of being known and readily available.²

Petitioner’s assertion that Patent Owner has not bridged any alleged gap between 2004 and Barbour misses the mark. Reply, 1, 3. There is no gap to bridge—Petitioner’s own evidence of enablement of Barbour in 2006 for the purposes of § 102 establishes enablement *as of the April 2004 filing date* as Patent Owner demonstrated in its Preliminary Response. POPR 17-25, 32-35.

In addition, the Examiner’s consideration of enablement during prosecution is, for all intents and purposes, the same question as to “***whether the Challenged Claims were entitled to priority under §120.***” Reply, 4 (emphasis in original). The Office expressly considered enablement of the claims, which necessarily assesses whether the specification as-filed enabled the claims. The application that became the ’378 patent is part of the same transaction as the parent and, as Petitioner’s own

² Petitioner’s argument regarding an alleged proprietary control “once the ’378 Patent expires” (Reply, 3) is a new argument not raised in the Petition. Regardless, it is not relevant to any issue before the Board. *See* 37 C.F.R. § 1.808; M.P.E.P. § 2410 (rules requiring access from issuance for the term of the patent).

case demonstrates, constitutes one continuous application within the meaning of the law under § 120. *See Nat. Alts. Int’l, Inc. v. Iancu*, 904 F.3d 1375, 1382 (Fed. Cir. 2018). Accordingly, consideration of and a finding of enablement by the as-filed specification equates to consideration of entitlement to priority under § 120. Consistent with the USPTO’s proposed rulemaking, the Examiner “articulated” a rejection based on enablement and issued an Office Action detailing “consideration of the art or arguments in the record.” EX1002, 161-163; *Compare* POPR, 8-17 with Reply, 5.

Moreover, Petitioner offers no evidence of any material error in the Office’s examination of the very issue it challenges in its Petition. In fact, Petitioner admits that the Examiner was aware of the commercial embodiment of TC1507. Reply, 5. Therefore, putting aside that the Petition should be denied on the merits, the Board would be well within its discretion to deny institution under § 325(d).

Finally, denying institution does not require the Board to “pronounce a ‘commercialization’ exception to seed deposit regulations.” *See* Reply, 1, 5. Office rules and practice have already established such a standard. 37 C.F.R. § 1.802(b); *see also* M.P.E.P. § 2404.01. In fact, “[i]f an applicant has adequately established that a biological material is known and readily available, the Office will accept that showing.” M.P.E.P. § 2404.01. Petitioner itself made that showing here. Accordingly, Patent Owner respectfully requests denial of institution.

Respectfully submitted,

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By: /Erin M. Sommers/

Erin M. Sommers, Reg. No. 60,974
(Lead Counsel)

Kathleen A. Daley, Reg. No. 36,116
(Backup Counsel)

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

901 New York Ave. NW
Washington, DC 20001-4413
(202) 408-4000

Counsel for Patent Owner
Corteva Agriscience LLC

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Patent Owner's Sur-Reply to Petitioner's Reply to Patent Owner's Preliminary Response** was served on October 15, 2024, via e-mail directed to counsel of record for the Petitioner at the following:

Scott A. McKeown (Reg. No. 42,866)
Oona M. Johnstone (Reg. No. 68,177)
Zhiyun Ge (Reg. No. 73,869)
Thomas F. Foley (Reg. No. 76,384)
Charles T. Steenburg (*Pro Hac Vice Pending*)
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206
Phone: (617) 646-8000
Fax: (617) 646-8646
SMcKeown-PTAB@WolfGreenfield.com
OJohnstone-PTAB@WolfGreenfield.com
Jean.Ge@WolfGreenfield.com
TFoley-PTAB@WolfGreenfield.com
Charles.Steenburg@WolfGreenfield.com

Petitioner has agreed to electronic service.

Dated: October 15, 2024

/William Esper/
William Esper
Legal Assistant and PTAB Coordinator
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP