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**IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

United States Court of Appeals
For The Federal Circuit

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COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

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**HORBALY
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PIONEER HI-BRED INTERNATIONAL, INC.

Plaintiff-Appellee

v.

**J.E.M. AG SUPPLY, INC., (doing business as Farm Advantage, Inc.)
FARM ADVANTAGE, INC., LARRY BENZ, MERLE PRUETT
(doing business as Siouxland Seeds, Inc.) KEVIN WOLFSWINKEL,
TIM KAMSTRA; and TOM EISCHEN SEED & CHEMICALS,
*Defendants-Appellants.***

Appeal from decisions of the United States District Court for the
Northern District of Iowa in 98-CV-4016, Senior Judge Donald E. O'Brien

**CORRECTED BRIEF FOR PLAINTIFF-APPELLEE
PIONEER HI-BRED INTERNATIONAL, INC.**

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CERTIFICATE OF INTEREST

Counsel for Plaintiff-Appellee, PIONEER HI-BRED INTERNATIONAL, INC., certifies the following:

1. The full name of every party represented by me is: Pioneer Hi-Bred International, Inc.
2. The name of the real party in interest represented by me is the same as above.
3. The parent companies, subsidiaries (except wholly-owned subsidiaries), and affiliates that have issued shares to the public, of the party represented by me are: E.I. du Pont de Nemours and Company owns 20% of Pioneer Hi-Bred International, Inc.; and Pioneer Hi-Bred International, Inc. owns 7% of Curagen, Inc.
4. The names of all law firms and the partners or associates that appeared for the party now represented by me in the trial court or agency or are expected to appear in this court are: Edmund J. Sease and Daniel J. Cosgrove of the firm Zarley, McKee, Thomte, Voorhees and Sease, 801 Grand Avenue, Suite 3200, Des Moines, Iowa 50309 have appeared at the trial court on behalf of Pioneer Hi-Bred International, Inc. Herbert H. Jervis, Vice President & Chief Intellectual Property Counsel for Pioneer Hi-Bred International, Inc., 7100 N.W. 62nd Avenue, P.O. Box 1000, Johnston, Iowa 50131 also appears on the brief.

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STATEMENT OF RELATED CASES

Pursuant to Fed.Cir.R. 47.5, the Plaintiff-Appellee states that: (1) there was no other appeal in or from the same civil action or proceeding previously before this or any other appellate court under the same or similar title; and (2) there is no other case known to counsel to be pending in this or any other court that will directly affect or be directly affected by this Court's decision in the pending appeal. However, this Court's decision may directly affect all pending cases or appeals which involve patentability, infringement and/or validity of any plant-related patents issued pursuant to Section 101 of Title 35, the Patent Act. Plaintiff-Appellee is a party to some of these cases at the District Court level.

**STATEMENT OF SUBJECT MATTER AND
APPELLATE JURISDICTION**

The statutory basis for jurisdiction of the trial court is 28 U.S.C. § 1338.

The statutory basis for jurisdiction of this Court on appeal is 28 U.S.C. § 1295, as well as 28 U.S.C. § 1292, as this is an interlocutory appeal from the United States District Court for the Northern District of Iowa.

STATEMENT OF THE ISSUE

Whether utility patents relating to plants developed by human intervention are proper statutory subject matter under 35 U.S.C. § 101?

STATEMENT OF THE CASE

1. Nature of the Case.

Defendants-Appellants (collectively "Farm Advantage") appeal from the August 19, 1998 order of the United States District Court for the Northern District of Iowa, No. C98-4016-DEO, denying their Motion For Summary Judgment.

On February 20, 1998, Plaintiff-Appellee Pioneer Hi-Bred International, Inc. ("Pioneer") brought a patent infringement suit against Farm Advantage for infringement of seventeen utility patents. Each of the utility patents allegedly infringed have claims directed to corn hybrids developed by Pioneer that were sexually produced. The patented plant inventions are embodied in various corn hybrids provided or commercialized throughout the United States by Pioneer.

Farm Advantage is a reseller (purchase and then sell to customers) of many products. Pioneer alleges that Farm Advantage has resold Pioneer-brand seed corn in violation of the limited label license contained on each bag of seed. Farm Advantage filed a motion for summary judgment on March 30, 1998 seeking to

invalidate all of the claims of the patents-in-suit on the sole basis that the claims did not fall within the classes of permissible statutory subject matter protected by 35 U.S.C. § 101.

2. The Course of the Proceeding.

The Complaint in this action was filed February 20, 1998. Almost immediately, on March 30, 1998, Defendants filed a Motion for Summary Judgment seeking to invalidate the patents-in-suit under their theory that the patents were not proper statutory subject matter under 35 U.S.C. § 101.

A hearing was held on April 30, 1998. The Court issued its Order denying Farm Advantages' Motion for Summary Judgment on August 19, 1998. Farm Advantage sought to amend the Order so that it could receive consideration for interlocutory appeal. The Court granted the Motion to Amend the Order on August 31, 1998 and certified the issues for interlocutory appeal.

Thereafter, Farm Advantage sought permission to appeal the Order with this Court, and interlocutory appeal was granted on October 27, 1998.

3. Disposition Below.

The trial court, after oral argument from the parties and consideration of all the evidence, denied Farm Advantages' Motion for Summary Judgment. The pertinent portion of that ruling reads as follows:

[T]his Court is persuaded that it must find that the Plant Variety Protection Act is not the sole and exclusive method of protecting seed

corn. It boils down to the fact that it is Congress' job to answer this question. At no place in any of the statutes does it say that seed corn plants cannot be given a patent. At no place in the statutes does it say that you cannot have both patent and PVPA protection. At no place in the law does it say that you have to make an election of one or the other, section 101 or the P.V.P.A.

(A23)

Senior Judge Donald E. O'Brien, in drafting his order, carefully reviewed the legislative histories, as well as the case law surrounding the interpretation of 35 U.S.C. § 101, including Diamond v. Chakrabarty, 447 U.S. 303, 100 S.Ct. 2204, 65 L.Ed.2d 144, 206 U.S.P.Q. 193 (1980), In re Bergy, 596 F.2d 952, 201 U.S.P.Q. 352 (C.C.P.A. 1979), and the Board of Appeals decision in Ex parte Hibberd, 227 U.S.P.Q.2d 443 (PTO Bd. Pt. App. & Int. 1985). The District Court concluded:

This Court finds no explicit support in the legislative history for the premise, advanced by the defendants', of an intent to restrict or limit the scope of patentable subject matter available pursuant to 35 U.S.C. § 101. Congress's intention in adopting the PPA and PVPA was to extend patent protection to an area not often able to meet the requirements of 35 U.S.C. § 112, given the then limits of plant science. History demonstrates, however, that in those instances where inventors showed they could define a reproducible plant meeting the limits of § 112, plant patents were issued under § 101. An early example of this is the Boehm patent, U.S. Patent 2,048,056 (1936) (Plaintiff's Exhibit D) [A86]. Today, the requirements of § 112 can be met through a written description combined with a deposit of the invention as required for some microorganisms. Manual of Patent Examining Procedure § 2403.02 (6th ed. 1997). In passing the PVPA and PPA, Congress maintained the broad language of § 101 in order to recognize, reward, and encourage developments in plant breeding that were capable of someday meeting the enablement requirements. See Chakrabarty, 447 U.S. at 312-315.

(A15)

In ruling on this matter, the lower court reaffirmed the broad interpretation that has been accorded section 101 by the Supreme Court. Because the continued vitality of the Patent Act depends greatly on the scope of section 101 and its ability to encompass those innovations which cannot now be anticipated, this broad interpretation is correct and the lower court should be affirmed.

SUMMARY OF THE ARGUMENT

The plain and unambiguous meaning of 35 U.S.C. § 101 is that any invention falling within one of the four enumerated categories of statutory subject matter are entitled to patent protection provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103, and 112. It is clear that Congress did not intend to place any restrictions on the statutory subject matter for which a patent may be obtained beyond those specifically recited. Instead, as the Supreme Court has acknowledged on several occasions, Congress intended that § 101 extend to protect "anything under the sun that is made by man."

Ignoring the statutory history of the 1952 Patent Act itself, and using strained readings of case law and legislative history of subsequent Congresses, Appellant's attempt to import a limitation into section 101 where none was intended and none is stated by Congress. In fact, it is quite clear that the enactment of the 1970 Plant Variety Protection Act and the 1930 Plant Patent Act did not alter the protection available in the Title 35 United States Code, but merely extended protection to innovations which, given the limits of science and technology of the time, had difficulty in meeting the requirements of 35 U.S.C. § 112.

Given the expansive coverage of section 101 and the express intent of Congress that subsequent legislation would not alter that scope, section 101 must

remain sufficiently broad in scope to encompass "anything under the sun that is made by man."

ARGUMENT

I. STANDARD OF REVIEW

Whether human developed plants are proper statutory subject matter under 35 U.S.C. § 101 is a matter of both claim construction and statutory construction which this Court reviews de novo. State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1370, 47 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1998).

II. STATUTORY SUBJECT MATTER DEFINED BY 35 U.S.C. § 101 INCLUDES INVENTIONS RELATING TO PLANTS

All seventeen plant utility patents have at least one claim directed to hybrid plants capable of sexual reproduction. The authority for granting patents on such subject matter is 35 U.S.C. § 101, Diamond v. Chakrabarty, 447 U.S. 303, 100 S. Ct. 2204, 65 L.Ed.2d 144, 206 U.S.P.Q. 193 (1980) and the United States Patent Office ("PTO") holding in Ex parte Hibberd, 227 U.S.P.Q. 443 (PTO Bd. Pt. App. & Int. 1985).

Since Hibberd, the PTO has routinely and regularly issued utility patents related to plants.¹ The question before this Court is whether utility patents for

1. "Utility patents" refer to patents granted under the authority of 35 U.S.C. § 101 subject matter and are to be distinguished from "design patents" and "plant patents"

sexually reproduced plants fall within the subject matter protected in 35 U.S.C.

§ 101, which provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As the Supreme Court recognized in Diamond v. Chakrabarty: "In choosing such expansive terms as 'manufacture' and 'composition of matter,' modified by the comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope." Diamond v. Chakrabarty, 447 U.S. at 308, 100 S. Ct. at 2207, 206 U.S.P.Q. at 197 (1980) (recognizing that patentable subject matter under 35 U.S.C. § 101 includes discoveries of altered living organisms that are the result of a human's handiwork).

The patent act of 1793, authored by Thomas Jefferson, defined statutory subject matter as "any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement [thereof]." Act of Feb. 21, 1793, § 1, 1 Stat. 319. The 1793 Act embodied Jefferson's philosophy that "ingenuity should receive a liberal encouragement." Writings of Thomas Jefferson, 75-76 (Washington Ed. 1871). Subsequent patent statutes in 1836, 1870, and 1874

granted under specific statutory authority of 35 U.S.C. §§ 171 and 161 respectively.

employed this same broad language. In 1952, when the patent laws were recodified, Congress replaced the word "art" with "process," but otherwise left Jefferson's language intact. The committee reports accompanying the 1952 Act show that Congress intended statutory subject matter to "include anything under the sun that is made by man." S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952).

Insisting on a more specific congressional intent when construing section 101 would conflict with the Constitutional and Congressional purpose of stimulating the creation of new technologies and their progressive development.

As the Supreme Court noted in 1859:

The true policy and ends of the patent laws enacted under this government are disclosed in that article of the Constitution, the source of all these laws, viz.: 'to promote the progress of science and the useful arts,' contemplating and necessarily implying their extension, and increasing adaptation to the uses of society.

Kendall v. Winsor, 62 U.S. (21 How.) 322, 328, 16 L. Ed. 165 (1859) (emphasis added). When Congress has made a choice of language which fairly brings a given situation within a statute, it is unimportant that the particular application may not have been contemplated by the legislators. Barr v. United States, 324 U.S. 83, 90, 65 S. Ct. 52, 525, 89 L. Ed. 765 (1945).

For over 200 years the words of section 101 have been liberally construed to include unforeseen developments in technology. As Judge Rich, the drafter of the 1952 Patent Act, suggested:

[T]he Founding Fathers and the Congresses of the past century could not have foreseen the technologies that have allowed man to walk on the moon, switch travel from the railroads to heavier-than-air craft, fill our houses with color TV, cure normally fatal diseases with antibiotics produced by cultures of molds (microorganisms), and give to school children at small cost pocket calculators with which they can produce square roots in microseconds through complex electronic circuitry on an 'IC' (integrated circuit) so small the circuits are not visible to the naked eye.

In re Bergy, 596 F.2d 952, 974, 201 U.S.P.Q. 352, 372 (C.C.P.A. 1979).

A perfect example of how the language of section 101, as interpreted by the courts and relevant administration tribunals, is sufficiently malleable to accommodate changes in technology is shown by the Supreme Court's recognition of living organisms as patentable subject matter in Diamond v. Chakrabarty, 447 U.S. at 314, 100 S. Ct. at 2210, 206 U.S.P.Q. at 199. Chakrabarty, coming twenty-seven years after J. D. Watson and Frances Crick unraveled the structure of the DNA molecule, finally brought the patent laws in line with the new biological frontiers. Because of similar advances in plant technology, recognition of sexually reproduced plants as patentable subject matter under 35 U.S.C. § 101 soon followed. Ex parte Hibberd, 227 U.S.P.Q. 443 (PTO Bd. Pt. App. & Int. 1985).

In Hibberd, this exact question was presented to the Patent and Trademark Office Board of Appeals and Interferences. The examiner took the position during

prosecution that claims drawn to seeds and plants comprised subject matter which was inappropriate for protection under 35 U.S.C. § 101. Ex parte Hibberd, 227 U.S.P.Q. at 444. The decision by the examiner was reversed. Id. at 448.

Appellants take a similar, but slightly unique approach to the same argument. In Hibberd, the examiner rejected the claims because, it was argued, the Plant Patent Act of 1930 and the Plant Variety Protection Act of 1970 "each carved out" the subject matter from section 101. Id. at 444. Here, Appellants argues that these statutes did not carve out anything from section 101. Instead, they contend, these statutes were enacted to grant protection where none existed before.

However, there simply was no gap in protection in section 101 to be remedied. As discussed above, and as clearly shown in the statutory history, section 101 was drafted to allow protection of subject matter which included "anything under the sun that is made by man."

III. RULES OF STATUTORY CONSTRUCTION PRECLUDE NARROWING THE SCOPE OF PROTECTION AFFORDED UNDER 35 U.S.C. § 101

As mentioned recently by this Court:

The repetitive use of the expansive term "any" in § 101 shows Congress' intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. Indeed, the Supreme Court has acknowledged that Congress intended § 101 to extend to "anything under the sun that is made by man." . . . Thus, it is improper to read limitations into § 101 on the

subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations.

State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373, 47 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1998). Appellants incorrectly attempt to read into the Patent Act various exclusions derived from the mere existence of other acts, specifically the 1930 Plant Patent Act ("PPA") and the 1970 Plant Variety Protection Act ("PVPA").

A. The History Of Patents For Plants

Until the 1930 Plant Patent Act ("PPA"), "plants were regarded as products of nature, unaffected by the hand of man, and thus not subject to patent protection." In re Bergy, 596 F.2d 952, 982, 201 U.S.P.Q. 352, 379 (C.C.P.A. 1979). However, after Luther Burbank made famous the art of plant breeding, Congress enacted the PPA "to apply the patent system where it had not been applied before in an effort to fuel the fire under plant breeding and to protect the experimenters in that as yet nonindustrial field." Id. at 981.

In overcoming the "product-of-nature" limitation, Congress explained at length its belief that the work of the plant breeder "in aid of nature" was patentable invention. S. Rep. No. 315, 71st Cong., 2d Sess., 6-8 (1930); H.R. Rep. No. 1129, 71st Cong., 2d Sess., 7-9 (1930). Sexually reproduced plants were not included under the 1930 Act because it was mistakenly believed new varieties could not be produced true-to-type through seedlings, i.e., plants which were not predictably

reproducible or capable of "true breeding." Diamond v. Chakrabarty, 447 U.S. at 313; 100 S. Ct. at 2210; 206 U.S.P.Q. at 199.

By 1970, Congress, acting quicker than the PTO, recognized that true-to-type or true breeding sexual reproduction was possible, thus eliminating the lack of predictable reproducibility barrier which had previously excluded sexually reproduced plants from patentability under the patent statute. See generally 35 U.S.C. § 112. Eventually the PTO also recognized that advances in biological sciences could be formulated in a way to meet the requirements under 35 U.S.C. § 112. The "problem" therefore never was exclusion from the definition of 35 U.S.C. § 101 as statutory subject matter, but the perceived inability of inventor's to satisfy the written description and enablement requirements of section 112.

B. The 1930 Plant Protection Act Did Not Amend 35 U.S.C. § 101.

In 1930 Congress expressed its purpose for the Plant Patent Act in terms of its desire to extend the benefits of the patent system to the field of agriculture.

I. Purposes of the Bill

The purpose of the bill is to afford agriculture, so far as practicable, the same opportunity to participate in the benefits of the patent system as has been given industry, and thus assist in placing agriculture on a basis of economic equality with industry. The bill will remove the existing discrimination between plant developers and industrial inventors.

S. Rep. No. 315 at 1 (1930) and H. Rep. No. 1129 at 1 (1930).

The statute was narrowly written to extend protection to certain plants, not because they were not proper subject matter under section 101, but rather because, at the time of enactment, it was generally thought impossible for plant breeders to meet the enablement and written description requirements² of 35 U.S.C. § 112. Chakrabarty, 447 U.S. at 312, 100 S. Ct. at 2209, 206 U.S.P.Q. at 198 (citing Hearings on H.R. 11372 before the House Committee on Patents, 71st Cong., 2d Sess., 4, 7 (1930)). The 1930 Act was clearly an effort to apply the patent system to an area where it had not been fully applied before, especially in light of the "product-of nature" rejection. In re Bergy, 596 F.2d at 981, 201 U.S.P.Q. at 379.

C. The Enactment Of The 1970 PVPA Likewise Did Not Amend 35 U.S.C. § 101.

Appellant further attempts to rewrite section 101 through misapplication of the 1970 Plant Variety Protection Act ("PVPA") legislative history. Appellant claims that because the legislative history of the PVPA states generally that no protection was available in 1970 for sexually reproduced plants, this somehow writes in an implied exclusion under section 101 of the patent statute. While the PVPA legislative history may properly be used to interpret that statute, because it

2. Today the requirements of section 112 can be met through a written description combined with a deposit of the invention as is required for some microorganisms. Manual of Patent Examining Procedure § 2403.02 (7th ed. 1998).

was enacted under a separate title, having different requirements and providing different protection, that history cannot be used to interpret, much less rewrite, Title 35 (the utility patent statute) without a clear manifestation, that it was intended to limit Title 35.

It is clear from a reading of the legislative history of the PVPA that there was no affect on the scope of section 101 by its enactment. Specifically, Congress provided: "The Committee accordingly has examined S. 3070 and finds that it does not alter protection currently available within the patent system." S. Rep. No. 91-1246, p. 2.

In fact there are several references throughout the legislative histories of the PVPA and other acts which clearly demonstrate that Congress knew that utility patents were an alternative form available. For example, during testimony it was stated:

It must be observed that, today, breeders have two forms of varietal protection available to them: the Patent Act offering legal protection for a sexually-produced plant varieties and, secondly, biologic protection arising from the utilization of hybridization techniques.

S. 3070, at 61.

In those instances where inventors showed they could define a reproducible plant meeting the limits of 35 U.S.C. § 112, patents on plants were issued under 35 U.S.C. § 101, e.g., Boehm, U.S. Patent 2,048,056 (1936) (A86); Maan, U.S. Patent 4,143,486 (1979) (A89); and Hayward U.S. Patent 4,406,086 (1983) (A99). Prior

to the PVPA, utility patents were being granted for methods of treating and breeding plants. An early example is the Boehm patent (A86) which describes a method of hybridizing plants that includes two product-by-process claims which begin "the plant which"

D. Appellants' Arguments to Limit § 101 Are Strained

"Simply because a later enacted statute affects in some way an earlier enacted statute is poor reason to ask [a court] . . . to rewrite the earlier statute. Repeals by implication are not favored." Roche Products, Inc. v. Bolar Pharmaceutical Co., 733 F.2d 858, 864, 221 U.S.P.Q. 937, 941 (Fed. Cir. 1984) (overruled by 271(e) on other grounds)) (citing Mercantile Nat'l Bank v. Langdeau, 371 U.S. 555, 565, 83 S. Ct. 520, 525 (1963)). Thus, "courts are not at liberty to pick and choose among congressional enactments, and when two statutes are capable of coexistence, it is the duty of the courts, absent a clearly expressed congressional intention to the contrary, to regard each as effective." Morton v. Mancari, 417 U.S. 535, 551, 94 S. Ct. 2474, 2483, 41 L. Ed.2d 290 (1974). The utility patents, plant patents and the PVPA not only coexist, but have coexisted for the past twenty-eight years. Surely Congress knows this and could have enacted an express exclusion if it wished!

It is a cardinal principle of construction that repeals by implication are not favored. When there are two acts upon the same subject, the rule is to give effect to both if possible. The intention of the legislature to repeal "must be clear and manifest." It is not sufficient as was said by

Mr. Justice Story to establish that subsequent laws cover some or even all of the cases provided for by [the prior act]; for they may be merely affirmative, or cumulative, or auxiliary.

United States v. Borden Co., 308 U.S. 188, 198, 60 S.Ct. 182, 188 (1939)(citations omitted). Farm Advantage points to no clear manifest statement that the PVPA was intended to exclude all sexually reproduced plants from the patent statute.

Appellants seemingly gloss over the Senate Committee on Judiciary's conclusion in recommending passage of the PVPA that "it [the PVPA] does not alter protection currently available within the patent system." See Ex parte Hibberd, 227 U.S.P.Q. at 445. To wipe out a portion of the patent statute written by Thomas Jefferson, which has gone virtually untouched for over two hundred years, without even a single express word from Congress, is ludicrous. A similar improper use of legislative history was denounced by Justices Jackson and Frankfurter when they said:

[Courts should reach their decisions] by analysis of the statute instead of by psychoanalysis of Congress. When we decide from legislative history what Congress probably had in mind, we must put ourselves in the place of a majority of congressmen and act according to the impression we think this history should have made on them.... That process seems to me not interpretation of a statute but creation of a statute.

United States v. Public Utilities Comm'n of Cal., 345 U.S. 295, 319, 73 S. Ct. 706, 719, 97 L. Ed. 1020 (1953) (Jackson, J., concurring) (emphasis added).

The laws of Statutory Construction required that section 101 be construed independently, not on the basis of after-the-fact comments made by a subsequent

Congress. Section 101, however, has already been construed broadly to cover "anything under the sun that is made by man." Appellants can identify no reason to disturb that construction.

IV. INTELLECTUAL PROPERTY RIGHTS CAN BE PROTECTED BY MORE THAN ONE STATUTORY SCHEME

A. The Various Methods of Protecting Plant Matter Differ Significantly in Scope

Appellant argues that granting patent protection to sexually reproducing plants under 35 U.S.C. § 101 amounts to vetoing Congress' enactment of the Plant Variety Protection Act of 1970. This analysis is flawed for two reasons. First, the scope of protection afforded claims under 35 U.S.C. § 101 is broader than the scope of protection under the alternatives. There are good reasons why someone may choose one form over the other, such as the ability or inability to meet the requirements under 35 U.S.C. § 112.

Second, Appellants' analysis focused solely on the restrictions of each individual protection, completely ignoring any analysis as to the differences in the requirements for obtaining protection and wrongly assumes that if one form of protection is available then the other is not. There are important differences between the legal standards that must be satisfied to receive a utility patent and the legal standards that must be satisfied to receive a certificate under the PVPA. Unlike the PVPA, the utility patent law requires that in addition to novelty, an

invention must be nonobvious. See 35 U.S.C. § 103. The use of "nonobviousness" as a second threshold beyond novelty is what makes the process of obtaining a plant utility patent more difficult. Infringement, and remedies associated with it, vary. Compare 35 U.S.C. § 271 with 7 U.S.C. § 2541. Also, in return for a utility patent, the inventor must provide sufficient information on the invention "to enable any person skilled in the art . . . to make or use the same." 35 U.S.C. § 112 (1995). This disclosure requirement can now be routinely satisfied by depositing a sample in an approved repository with unrestricted access.³ M.P.E.P. 2403.02 (6th ed. 1997). This rule on deposits is not applicable to applications filed under the Plant Patent Act (35 U.S.C. §§ 161-64). Id. The PTO is of the view that a deposit is not required under the present provisions of 35 U.S.C. § 162. Further, while a deposit

3. Appellants' raise a new argument that these patents-in-suit are invalid because of their failure to comply with 35 U.S.C. § 112 and that the deposit requirements are inadequate. Courts have previously recognized the necessity and desirability for a deposit to supplement the written disclosure. See In re Argoudelis, 434 F.2d 666, 168 U.S.P.Q. 99 (C.C.P.A. 1970). However, that argument is not the subject of this interlocutory appeal and beyond the scope of this opposition, which appropriately deals with these issues properly raised below and in appellant's opening brief. United States v. Stanley, 483 U.S. 669, 677, 107 S.Ct. 3054, 3060 97 L.Ed.2d 550 (1987).

of seed in a repository is required, the deposit is not publicly available. Under the PVPA there is no enablement requirement. See 7 U.S.C. § 2422 ("the application must contain the named description of the variety, its genealogy and breeding procedure, if known").

Appellants cite to this Court's decision in Imazio as lending support to their position. However, in Imazio this Court held only that plant patents issued under 35 U.S.C. § 161 are limited in scope to asexual progeny of a plant variety. Imazio Nursery, Inc. v. Dania Greenhouses, 69 F.3d 1560, 1568, 36 U.S.P.Q.2d 1673, 1680 (Fed. Cir. 1995). While Imazio discusses the obvious differences between the PPA and the PVPA, it does not shed light on the construction accorded section 101, or support Appellants' argument that section 101 no longer covers "anything under the sun made by man."

B. Examples Of Two Or More Legal Protections For The Same Intellectual Property.

There is ample precedent that the availability of one form of statutory protection does not preclude the availability of protection under another form. See Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 485-87, 94 S. Ct. 1879, 1888-89, 181 U.S.P.Q. 673, 680-681 (1974) (expressly holding that trade secret and patent protection can peacefully coexist); Mazer v. Stein, 347 U.S. 201, 217, 74 S. Ct. 460, 470, 1100 U.S.P.Q. 325, 333 (1954) (holding that patentability of manufactured article does not bar copyright as a work of art); Pioneer Hi-Bred Int'l

v. Holden Foundation Seeds, 35 F.3d 1226, 1242-43, 31 U.S.P.Q.2d 1385, 1399 (8th Cir. 1994) (recognizing that the PVPA did not preempt Iowa state trade secret law as applied to sexually reproduced plants); Ropat Corp. v. McGraw-Edison Co., 535 F.2d 378, 381, 191 U.S.P.Q. 556, 558 (7th Cir. 1976) (noting that the patent laws provide that a design patent and a utility patent may well be issued on the same construction); In re Yardley, 493 F.2d 1389, 181 U.S.P.Q. 331 (C.C.P.A. 1974) (holding that protection under the copyright statute and the design patent statute may simultaneously coexist); Application of Mogen David Wine Corp., 328 F.2d 925, 140 U.S.P.Q. 575 (C.C.P.A. 1964) (holding that design patent owner was not precluded from obtaining trademark during life of the design patent).

The fact that subject matter patentable under section 101 may overlap with subject matter protectable under the PVPA does not provide a basis for concluding that there is irreconcilable conflict between the statutes. Ex parte Hibberd, 227 U.S.P.Q. 443, 446 (PTO Bd. of Pat. App. & Int. 1985). Such overlap is an indication that Congress intended the availability of both modes of protection. In re Yardley, 493 F.2d at 1395-96, 181 U.S.P.Q. at 336. Congress has not required an inventor to elect between two modes for securing protection of the subject matter involved. If anything, the concurrent availability of both modes of securing exclusive rights aids in achieving the stated purpose of the Constitutional provision for patent protection. Id. It also is analogous to the practice of issuing design and

utility patents on the same device, providing both statutes are met. See Ropat Corp., 535 F.2d at 381, 191 U.S.P.Q. at 558.

C. The Lower Court Correctly Ruled That Section 101 Should Be Broadly Construed

The lower court, Senior Judge Donald E. O'Brien, correctly pointed out that the statutes do not exclude plant matter from utility patents, and the statutes do not say an inventor cannot receive both patent and PVPA protection. (A23) There is no election requirement. Interestingly, Judge O'Brien, who also ruled that the PVPA did not preempt Iowa trade secret law (see Pioneer Hi-Bred Int'l v. Holden Foundation Seeds, 35 F.3d 1226, 31 U.S.P.Q.2d 1385 (8th Cir. 1994)⁴) found that the patent statutes and the PVPA have been amended at least eighteen times since 1980 and Congress has "not amended nor crafted any specific statute limiting the interpretation that in light of Chakrabarty, Section 101 extends utility patent protection to sexually reproduced plants." (A21) Judge O'Brien also states: "If in fact Ex parte Hibberd was contrary to the views of Congress, they have had ample time since 1985 to correct this practice." (A21)

Congress has clearly not excluded plant matter from protection under section 101. Appellants should not be allowed to use what has been referred to as

4. In fact, the Eighth Circuit rejected similar arguments concerning preemption by the PVPA in Holden, 35 F.3d at 1242-43, 31 U.S.P.Q.2d at 1399.

"expansive prose about the previously unavailable benefits to be derived from extending patent protection to plants" (Chakrabarty dissent by Justice Brennan, 447 U.S. at 320, 100 S.Ct. at 2214) to read an exclusion into a statute where none exists, and where the interest requires that it remain as broad as possible.

CONCLUSION

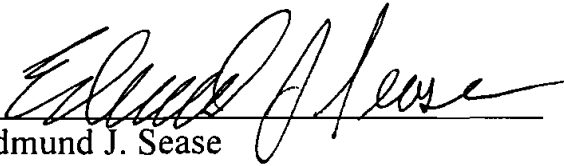
For over 200 years the language of section 101 has been interpreted broadly to encourage the development of new technologies and advances. The protection provided by section 101 extends to the plant breeder who is willing to share her discovery with the world. As Thomas Edison said, "[n]othing that Congress could do to help farming would be of greater value and permanence than to give the plant breeder the same status as the mechanical and chemical inventors." S. Rep. No. 315, 71st Cong., 2d Sess., 3 (1930).

Like the Constitution from which it originates, the patent statute is a living and breathing Act. It is intended to protect ideas which, by definition, are novel and unforeseen, and the Patent Act cannot be interpreted as rigidly (and as inappropriately) as Appellants request. As technology advances, so must the promotion of that new technology be advanced by a liberal interpretation of the Patent Act. Rare is the occurrence where Congress has restricted section 101. When Congress has taken such drastic action it has done so expressly and with good reason. See 42 U.S.C. § 2181. Nowhere in the PPA or the PVPA is there any language which restricts the parameters that "anything made under the sun by man is patentable subject matter." See Chakrabarty, 447 U.S. at 309, 100 S. Ct. at 2207-08, 206 U.S.P.Q. at 197.

For at least the last fifteen years the law has recognized plant utility patents as statutory subject matter. To hold otherwise now would invalidate thousands of issued plant utility patents and upset commercial relationships that exist between individuals, universities, and corporations.

If Hibberd was contrary to the views of Congress, lawmakers have had ample time since 1985 to correct this practice, including major revisions to the Patent Act in 1995 (in response to GATT) and the Omnibus Patent Bill which makes the most sweeping changes to the Patent Act in almost 30 years (including provisions for strengthening the PPA). However, Congress has not elected to exclude plant patents under section 101 and is silent on that issue in the current legislation. Appellant should be resoundly denied this defense, which is contrary to legislative history, precedent, and customary PTO practice.

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CERTIFICATE OF COMPLIANCE

The below signed attorney hereby certifies that the attached brief complies with the Fed. R. App. P. 32(a)(7)(B). There are 6,776 words in the attached brief, including footnotes.



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CERTIFICATE OF SERVICE

The undersigned certifies that two copies of this Corrected Answer were served upon the following counsel of record by depositing the copies via Federal Express and addressed as set forth below on the 25th day of March, 1999:

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