

## LEXSEE 227 USPQ 443

Ex parte Kenneth A. Hibberd, Paul C. Anderson and Melanie Barker.

Appeal No. 645-91 from Art Unit 331.

Application for Patent filed September 4, 1984

Serial No. 647,008. Tryptophan Overproducer Mutants of Cereal Crops.

Board of Patent Appeals and Interferences

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August 9, 1985, Heard  
September 18, 1985, Decided

[\*1]

Before Serota, Calvert, Spencer, Smith and McCandlish, Examiners-in-Chief.

**COUNSEL:**

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Primary Examiner - Robert E. Bagwill.

**OPINIONBY: SMITH****OPINION:**

Smith, Examiner-in-Chief.

This is an appeal from the examiner's decision finally rejecting claims 239 through 243, 249 through 255 and 260 through 265 as unpatentable under *35 USC 101*. Claims 1 through 238 have been cancelled, and claims 244 through 248, 256 through 259, and 266 through 270 have been allowed.

The subject matter on appeal relates to maize plant technologies, including seeds (claims 239 through 243), plants (claims 249 through 255) and tissue cultures (claims 260 through 265) which have increased free tryptophan levels, or which are capable of producing plants or seeds having increased tryptophan content. Claims 239, 249 and 260 are representative of the three groups of rejected claims and are reproduced as follows:

239. A maize seed having an endogenous free tryptophan content of at least about one-tenth milligram per gram dry seed weight and capable of germinating into a plant capable of producing seed having an endogenous free tryptophan [\*2] content of at least about one-tenth milligram per gram dry seed weight.

249. A maize plant capable of producing seed having an endogenous free tryptophan content of at least about one-tenth milligram per gram dry seed weight, wherein the seed is capable of germinating into a plant capable of producing seed having an endogenous free tryptophan content of at least about one-tenth milligram per gram dry seed weight.

260. A maize tissue culture capable of generating a plant capable of producing seed having an endogenous free tryptophan content of at least about one-tenth milligram per gram dry seed weight, wherein the seed is capable of

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germinating into a plant capable of producing seed having endogenous free tryptophan content of at least about one-tenth milligram per gram dry seed weight.

There are no rejections based on prior art; rather, claims 239 through 243, 249 through 255 and 260 through 265 are rejected solely under 35 USC 101. It is the examiner's position that the claims drawn to seeds and plants, 239 through 243 and 249 through 255, respectively, comprise subject matter which is inappropriate for protection under 35 USC 101 because the subject matter of plants and seeds [\*3] is within the purview of the Plant Variety Protection Act of 1970 administered by the U.S. Department of Agriculture, 7 USC 2321 et seq. The examiner's position with respect to claims 260 through 265 drawn to tissue cultures is that such subject matter is inappropriate for protection under 35 USC 101 because it is within the purview of the Plant Patent Act of 1930, 35 USC 161. The examiner asserts that, to the extent that the claimed subject matter can be protected under the Plant Variety Protection Act (PVPA) or the Plant Patent Act (PPA), protection under 35 USC 101 is not available. n1

n1 Claims directed to hybrid seeds, claims 244 through 248, and to hybrid plants, claims 256 through 259, have been allowed because the PVPA and the PPA exclude such subject matter. 35 USC 161 and 7 USC 2402(a). The examiner also allowed claim 266 drawn to a method for producing a tryptophan overproducing maize plant and claims 267 through 270 drawn to methods for producing hybrid seeds.

We shall not sustain this rejection. Preliminarily, we note that the Supreme Court has interpreted the scope of 35 USC 101 in the recent case of *Diamond v. Chakrabarty*, 447 U.S. 303, 206 [\*4] USPQ 193 (1980) which involved a rejection of claims to a micro-organism under 35 USC 101 on the ground that Section 101 was not intended to cover living things such as micro-organisms. In determining the scope of Section 101 the Supreme Court began with the language of the statute n2, interpreted words as taking their ordinary, contemporary, common meaning unless otherwise defined, and was careful not to "read into the patent laws limitations and conditions which the legislature has not expressed." 447 U.S. 308, 206 USPQ 196. The Court noted that the use of the expansive terms "manufacture" and "composition of matter" modified by the comprehensive "any" indicated that Congress "plainly contemplated that the patent laws would be given wide scope." The Supreme Court also noted that the legislative history of Section 101 supports a broad construction and cited the Committee Reports accompanying the 1952 Act which indicate that Congress intended statutory subject matter to "include anything under the sun that is made by man." S. Report No. 1979, 82d Cong., 2d Sess. 5 (1952); H.R. Report No. 1923, 82d Cong., 2d Sess. 6 (1952). Thus, the Court held at 447 U.S. 309, 206 USPQ 197, that [\*5] the involved micro-organism plainly qualified as patentable subject matter.

n2 The language of 35 USC 101 is as follows:

§ 101. Inventions patentable

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.

The examiner acknowledges in his answer that, in view of the decision in *Diamond v. Chakrabarty*, *supra*, it appears clear that Section 101 includes man-made life forms, including plant life. Moreover, the examiner's allowance of claims drawn to hybrid seeds and hybrid plants is a further indication that the examiner considers the scope of Section 101 to include man-made plant life. The examiner asserts in his answer, however, that by enacting the PPA in 1930 and the PVPA in 1970 "Congress has specifically set forth how and under what conditions plant life covered by these Acts should be protected." The examiner contends that the only reasonable statutory interpretation is that the PPA and PVPA, which were later in time and more specific than Section 101, each carved out from Section [\*6] 101, for specific treatment, the subject matter covered by each. Thus, it is the position of the examiner that the plant-specific Acts (PPA and PVPA) are the exclusive forms of protection for plant life covered by those acts.

We disagree with these contentions that the scope of patentable subject matter under Section 101 has been narrowed or restricted by the passage of the PPA and the PVPA and that these plant-specific Acts represent the exclusive forms of protection for plant life covered by those acts. The position taken by the examiner presents a question of statutory construction concerning the scope of patentable subject matter under 35 USC 101, i.e., has the scope of Section 101 been narrowed or restricted by reason of the enactment of the plant-specific Acts.

In cases of statutory construction we begin, as did the Court in *Diamond v. Chakrabarty*, *supra*, with the language of the statutes. The language of Section 101 has been set forth, *supra*, and has been interpreted by the Supreme Court to

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include everything under the sun that is made by man. The examiner does not point to any specific language in the plant-specific Acts to support his position that [\*7] the plant-specific Acts restrict the scope of patentable subject matter under Section 101. We have examined the provisions of the PPA and the PVPA and we find, as did appellants, that neither the PPA nor the PVPA expressly excludes any plant subject matter from protection under Section 101. Accordingly, we look next to the legislative histories of the plant-specific Acts to determine whether there is any clear indication of Congressional intent that protection under the plant-specific Acts be exclusive.

The examiner does not refer to the legislative histories of the plant-specific Acts to support his position as to the intent of Congress. Rather, he merely asserts, e.g., at page 2 of his answer, that ". . . it is clear that Congress intended a 'distinct and new variety of plant' covered by the Plant Patent Act to be something apart from the statutory categories of invention embraced by Section 101" and at page 3 ". . . the only reasonable statutory interpretation is that each [PPA and PVPA] carved out from Section 101, for specific treatment, the subject matter covered by each." However, as noted by appellants at page 17 of their brief, there is nothing in the legislative histories [\*8] of the plant-specific Acts from which one could conclude that Congress intended to remove from protection under Section 101 any subject matter already within the scope of that section. Rather, the Senate Committee on the Judiciary concluded on September 29, 1970 in its Report on Senate bill S.3070 in which it recommended passage of the Plant Variety Protection Act that ". . . it does not alter protection currently available within the patent system."

The Supreme Court in *Diamond v. Chakrabarty*, *supra*, addressed the legislative history and purpose of the plant-specific Acts and noted that prior to 1930 there were two obstacles to obtaining patent protection on plants. The first was the belief that plants, even those artificially bred, were products of nature not subject to patent protection; the second was the fact that plants were thought not amenable to the "written description" requirement of the patent law. The Supreme Court noted that Congress addressed both of these obstacles in enacting the PPA. Congress explained at length its belief that the work of the plant breeder "in aid of nature" was patentable invention, and it relaxed the written description requirement [\*9] in favor of a description "as complete as is reasonably possible." In our view, the Supreme Court's analysis of the legislative history of the plant-specific Acts makes it clear that the legislative intent of these acts was to extend patent protection to plant breeders who were stymied by the two noted obstacles.

We find no explicit support in the legislative history for the notion, advanced by the examiner, of an intent to restrict or limit the scope of patentable subject matter available pursuant to 35 USC 101. The examiner tacitly admits such lack of explicit support for his notion of legislative intent by his failure to refer to the legislative history and by the following statement in his Supplemental Examiner's Answer:

When Congress carved out and established distinct forms of protection for certain plants, they implicitly excluded protection of these plants under Section 101. (Emphasis added). Thus, the examiner's rejection in the final analysis is based on an implied narrowing of Section 101, i.e., an implied partial repeal of Section 101 based on the passage of the plant-specific Acts.

The examiner's contention that Section 101 has been "implicitly" narrowed [\*10] or partially repealed by implication is not persuasive. The overwhelming weight of authority is to the effect that repeals by implication are not favored and that when there are two acts on the same subject n3 the rule is to give effect to both unless there is such a "positive repugnancy" or "irreconcilable conflict" that the statutes cannot coexist. This "cardinal rule" of statutory construction was set forth by the Supreme Court in *United States v. Borden Co.*, 308 U.S. 189 at 198-99 (1939) as follows:

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 *United States v. Tynen*, 11 Wall. 88, 92; *Henderson's Tobacco*, 11 Wall. 652, 657; *General Motors Acceptance Corp. v. United States*, 286 U.S. 49, 61, 62. The intention of the legislature to repeal "must be clear and manifest." *Red Rock v. Henry*, 106 U.S. 596, 601, 602. It is not sufficient, as was said by Mr. Justice Story in *Wood v. United States*, 16 Pet. 342, 362, 363, "to establish that subsequent laws cover some or even all of the cases provided for by [\*11] [the prior act]; for they may be merely affirmative, or cumulative, or auxiliary." There must be "a positive repugnancy between the provisions of the new law, and those of the old; and even then the old law is repealed by implication only pro tanto to the extent of the repugnancy." See, also, *Posados v. National City Bank*, 296 U.S. 497, 504.

n3 The examiner asserts in his Supplemental Examiner's Answer that the statutes in question do not cover the "same subject." However, it is illogical and inconsistent for the examiner to assert on the one hand that the

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plant-specific Acts implicitly narrowed the scope of patentable subject matter under Section 101 and on the other hand to assert that the statutes do not deal with the "same subject."

In the absence of such "positive repugnancy" or "irreconcilable conflict" that the statutes cannot coexist and we find none, both statutes, i.e., Section 101 and the plant-specific Acts must be given full effect. Indeed, it is our duty to regard each as effective, as the Supreme Court held in *Morton v. Mancari*, 417 U.S. 535 (1973). After noting the cardinal rule that repeals by implication are not favored, the Supreme [\*12] Court stated at 551:

The 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. "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.'" *United States v. Borden Co.*, 308 U.S. 188, 198 (1939).

These principles of statutory construction were followed in a recent decision of the Court of Appeals, Federal Circuit, *Roche Products, Inc. v. Bolar Pharmaceutical Co.*, 733 F.2d 858, 221 USPQ 937 (Fed. Cir. 1984), cert. denied, U.S. , 225 USPQ 792 (1984). In *Roche* the Court stated as follows (733 F.2d 864, 221 USPQ 941):

Simply because a later enacted statute affects in some way an earlier enacted statute is poor reason to ask us to rewrite the earlier statute. Repeals by implication are not favored. See, e.g., *Mercantile National Bank v. Langdeau*, 371 U.S. 555, 565, 83 S.Ct. 520, 525, 9 L.Ed.2d 523 (1963). Thus, "courts are not at liberty [\*13] 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 examiner in his answer cited *Bulova Watch Co. v. U.S.*, 365 U.S. 753 (1961) and *Morton v. Mancari*, *supra*, for the proposition that a specific statute controls over a general statute where there is a conflict. We find no application of this principle to the facts involved here because before a specific statute can be found to control over a general statute, there must first be an irreconcilable conflict between them, as the Supreme Court made clear in the *Morton* case. As noted, *supra*, since we find no such irreconcilable conflict, it is our duty to give effect to both Section 101 and the plant-specific Acts.

In an attempt to show a conflict, the examiner points in his answer to provisions of the plant-specific Acts which differ from Section 101. He notes, for example, that (1) the PVPA contains both research (experimental use) and farmer's [\*14] crop exemptions, while Section 101 does not explicitly contain such exemptions; (2) the PVPA spells out infringement in great detail and includes a compulsory licensing provision, while no such Congressional guidance exists under Section 101 protection; (3) the PVPA limits protection to a single variety, whereas the opportunity for greater and broader exclusionary rights exists under Section 101 protection; (4) under 35 USC 162 (PPA), the applicant is limited to one claim in formal terms to the plant described, whereas there is no such limitation on coverage under Section 101; and (5) under 35 USC 163 (PPA), the plant patent conveys the right to exclude others from asexually reproducing the plant, or selling or using the plant so produced. However, this analysis by the Examiner merely serves to indicate that there are differences in the scope of protection offered by Section 101 and the plant-specific Acts. In our view, such differences fall far short of what would be required to find an irreconcilable conflict or positive repugnancy that would mandate a partial repeal of Section 101 by implication.

Nor does the fact that subject matter patentable under Section 101 overlaps with [\*15] subject matter protectable under the plant-specific Acts provide a basis for concluding that there is irreconcilable conflict between the statutes. There is ample precedent that the availability of one form of statutory protection does not preclude (or irreconcilably conflict with) the availability of protection under another form. For example, in *In re Yardley*, 493 F.2d 1389, 181 USPQ 331 (CCPA 1974) the Court held that there was an overlap between statutory subject matter under the copyright statute and statutory subject matter under the design patent statute. Such overlap was not found to be an irreconcilable conflict by the Court; rather, the overlap was viewed as an indication that Congress intended the availability of both modes of protection. In so holding the Court stated at 493 F.2d 1395-96, 181 USPQ 336:

The Congress, through its legislation under the authority of the Constitution, has interpreted the Constitution as authorizing an area of overlap where a certain type of creation may be the subject matter of a copyright and the subject matter of a design patent. We see nothing in that legislation which is contradictory and repugnant to the intent of the framers [\*16] of the Constitution. Congress has not required an author-inventor to elect between the two modes which it has provided for securing exclusive rights on the type of subject matter here involved. If anything, the concurrent availability of both modes of securing exclusive rights aids in achieving the stated purpose of the constitutional provision.

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The examiner urges that protection under 35 USC 101 under the circumstances of this case would be a violation of Article 2 of the International Union for the Protection of New Plant Varieties (UPOV). As pointed out by appellants, however, UPOV is an Executive Agreement that has not been ratified by the Senate. Such agreements are not treaties within the Constitution, and are not the Supreme Law of the Land. Valid enactments of Congress, such as Section 101, override conflicting provisions of international executive agreements, irrespective of which came first in point of time. *United States v. Capps, Inc.*, 204 F.2d 655 (4th Cir. 1953), aff'd on other grounds, 348 U.S. 296 (1955); Restatement (Second) of the Foreign Relations Law of the United States, § 144(1) (1965).

The examiner acknowledges that an executive agreement [\*17] cannot modify a federal statute, but urges, nevertheless, that the agreement can and should be considered "in interpreting a statute on which it bears." This argument overlooks the fact that the Supreme Court in *Diamond v. Chakrabarty*, *supra*, has already interpreted this scope of Section 101 to cover everything under the sun made by man. n4 In our view, the examiner is asking for an implied partial repeal of Section 101 on the basis of an executive agreement. To do so would, in our opinion, elevate the agreement to a status superior to an Act of Congress, i.e., Section 101, contrary to the spirit of *United States v. Capps, Inc.*, *supra*, and we decline to do so.

n4 The record does not reflect whether, or to what extent, the Chakrabarty decision was considered when the decision was made to adhere to the international agreement.

In his rejection of claims 260 through 265 drawn to tissue cultures, the examiner contends that the claims to tissue cultures are drawn to "asexual propagating material" and may, therefore, be protected under the PPA under Section 161. We disagree, and the rejection of claims 260 through 265 is, therefore, reversed for the [\*18] additional reason that tissue cultures are not "plants" within the purview of 35 USC 161. The Court of Customs and Patent Appeals in its decision in *In re Bergy*, 596 F.2d 952, 201 USPQ 352 (CCPA 1979), vacated as moot sub nom. *Diamond v. Chakrabarty*, *supra*, interpreted the meaning and scope of the term "plant" in the PPA as having its common, ordinary meaning which is limited to those things having roots, stems, leaves and flowers or fruits. In our view, tissue cultures manifestly do not come within the noted "common, ordinary meaning" of the term "plants" and are, therefore, not within the scope of the PPA (35 USC 161).

#### Motion to Strike

Appellant's motion to strike the Supplemental Examiner's Answer on the ground that there is no provision in the "Patent Laws" or "Rules of Practice" for a paper in rebuttal to Appellant's Reply Brief is denied. In the circumstances presented in this appeal, we consider it desirable to have the complete views of the Examiner and the appellant in the written record.

#### New Ground of Rejection

The following rejection is made pursuant to the provisions of 37 CFR 1.196(b):

Claims 243, 253 and 264 are rejected as unpatentable [\*19] under the first paragraph of 35 USC 112. The subject matter covered by these claims is described in terms of an assigned accession number for seeds deposited with In Vitro International, Inc. The disclosure is inadequate to enable one skilled in the art to make and use the invention set forth in claims 243, 253 and 264. Assuming that seeds may be deposited in the same manner as micro-organisms to comply with 35 USC 112, there is insufficient evidence in the record as to the availability of the deposited seeds. The depository here, In Vitro International, Inc., is not a recognized public depository, as was the case in *In re Argoudelis*, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970). Nor is there evidence here indicating that In Vitro International, Inc., is under a contractual obligation to maintain the seeds deposited in a permanent collection and to supply samples to anyone seeking them once the patent issues.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR 1.197). Should appellants elect to have further prosecution before [\*20] the examiner in response to the new rejection under 37 CFR 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire one month from the date of this decision.

37 CFR 1.136(a) does not apply.

The decision of the examiner is reversed.

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REVERSED 37 CFR 1.196(B)

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