

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERARDU C. M. BENTVELSEN,
HERICUS G. W. STEMKENS
and PIETER TJEERTES

Appeal No. 95-2920
Application 07/999,172¹

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and LORIN, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed December 28, 1992. According to applicants, this application is a continuation of Application 07/746,525, filed August 16, 1991; which is a continuation of Application 07/402,583, filed September 1, 1989, now abandoned.

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 19-45, all the claims remaining in the application.

Claims 19, 20, 26, 30, 31, 32, 39 and 45 are representative:

19. A diploid seed propagatable Pelargonium peltatum plant whose petals express at least one of the anthocyanidins pelargonidin or paeonidin.

20. A plant according to claim 19 wherein the chromatographically determined content of the pelargonidin and paeonidin is at least 1% of the total anthocyanidin content.

26. Seeds produced by the plant of claim 19.

30. A diploid seed propagatable Pelargonium peltatum plant containing a factor resulting in male sterility.

31. A plant according to claim 30 wherein the male sterility is genetic male sterility.

32. A plant according to claim 31, further expressing in its petals at least one of the anthocyanidins selected from the group consisting of pelargonidin and paeonidin.

39. Seed produced by the plant of claim 31.

45. A seed propagated diploid Pelargonium peltatum plant comprising:
a) a factor resulting in male sterility;
b) at least one of the anthocyanidin pigments, pelargonidin and paeonidin, expressed in the plant petals;
c) seed produced by said plant and
d) propagating material thereof.

The references relied on by the examiner are:

Duffett et al. (Duffett)	PP 3,874	Apr. 27, 1976
Jacobsen	PP 6,602	Feb. 14, 1989
Jacobsen	PP 6,605	Feb. 14, 1989
Craig	PP 6,220	July 12, 1988

Appeal No. 1995-2920
Application 07/999,172

Gugino

PP 6,286

Sep. 13, 1988

Horn et al. (Horn), "Chromosome Numbers And Fertility Of Ivy-Leaved Geraniums (Pelargonium-Peltatum-Hybrids), International Symposium EUCARPAI Breeding and Propagation of Ornamental Plants, pp. 20-29 (Sept. 16-18, 1986).

The claims stand rejected as follows:

I. Claims 20 through 23 and 33 through 36 under 35 U.S.C. § 112, first paragraph, as lacking an adequate written description and an enabling disclosure.

II. Claim 19 under 35 U.S.C. § 102(b) as anticipated by Jacobsen '605 or Jacobsen '602.

III. Claim 30 under 35 U.S.C. § 102(b) as anticipated by Gugino.

IV. Claims 30 and 31 under 35 U.S.C. § 102(b) as anticipated by, or, in the alternative, under 35 U.S.C. § 103 as obvious over Horn.

V. Claims 32 through 37 and 39 through 45 under 35 U.S.C. § 103 as obvious over Horn and Craig.

VI. Claim 38 under 35 U.S.C. § 103 as obvious over Horn and Duffett.

VII. Claims 19 through 29 under 35 U.S.C. § 103 as obvious over Duffett and Craig.

We reverse.

DISCUSSION

Written Description and Enablement

Claims 20 through 23 and 33 through 36 are drawn to diploid seed propagatable Pelargonium peltatum (P. peltatum) wherein the chromatographically determined content of the pigments pelargonidin and paeonidin is at least 1%, 5%, 10% or 25% of the total anthocyanidin content. The rejection of these claims under 35 U.S.C. § 112, first paragraph, is set forth on page 4 of the Answer. If we understand the examiner's position correctly, it is that the specification does not adequately describe the relationship between pigment levels expressed as percentages and the relative levels of pigments shown in the examples. The examiner questions whether the "preferred plants were actually obtained."

If in making the latter comment the examiner is requiring appellants to have reduced to practice each possible plant within the scope of the claims, such a position is legally incorrect. The specification need only teach one skilled in the art how to make and use the claimed invention. How the specification does so, whether by way of the written word or actual examples, is of no moment. In the absence of a fact-based analysis from the examiner why the specification does not enable one skilled in the art to make and use the claimed invention, the rejection cannot be sustained.

Anticipation and Obviousness

All of the claims on appeal are directed to the annual ornamental plant Pelargonium peltatum (commonly known as the ivy-leafed geranium), its seeds and propagating material. Individual claims require that the plants exhibit certain characteristics, for

example: expression of the pigments pelargonidin and/or paeonidin (resulting in scarlet, red, salmon or rose colored petals); male sterility (the native plant is a hermaphrodite); day neutrality; white center spots; or various combinations of these. All of the claims, however, require the plants to be “diploid seed propagatable.” Read in light of the specification, the most plausible interpretation of this term is that the plants can be propagated indefinitely, by seed, from generation to generation.

See the Specification, page 2, second paragraph; page 8; and Breeding Schemes 1 through 5.

There are four rejections under 35 U.S.C. § 102 (b) and three under 35 U.S.C. § 103: according to the examiner, claim 19 is anticipated by Jacobsen '605 or Jacobsen '602; claim 30 is anticipated by Gugino; and claims 30 and 31 are anticipated by Horn.² Claims 32 through 37 and 39 through 45 would have been obvious over Horn and Craig; claim 38 would have been obvious over Horn and Duffett; and claims 19 through 29 would have been obvious over Duffett and Craig.

Our determination of the patentability of the claims on appeal is hampered by the examiner's failure to specifically address all of the claim limitations in the rejections (notably, the limitation that the plants be diploid seed propagatable is addressed only in

² The examiner rejected claims 30 and 31 in the alternative as obvious over Horn, but provided no analysis under 35 U.S.C. § 103.

response to appellants' arguments). Our consideration of the issues is further complicated by the examiner's lack of specificity in identifying the portions of the references relied upon (for example, Horn discusses at least 12 diploid Pelargonium peltatum cultivars, but the examiner does not point to any one in particular in any rejection).

Jacobsen '605 and Jacobsen '602 disclose P. peltatum plants with red and pink petals, respectively. Both plants display androecium and gynoecium (male and female reproductive organs), but the references make no mention of fruit or pollen.

Gugino discloses red-petaled P. peltatum plants; the plants display androecium and gynoecium, but the reference indicates that no pollen was apparent, and that the ovaries appeared to be non-functional.

Horn teaches that one of the main reasons for the slow progress in breeding ivy-leafed geraniums is "the sterility of many cultivars . . . possibly caused by their hybrid origin." See page 28. Of 52 cultivars, many of which were "sterile, self or cross incompatible," only the Ville de Paris family appears to be diploid, male sterile and capable of setting seed. It does not, however, produce a viable F₁ generation upon crossing with a pollen parent as the seed deteriorates before ripening. Indeed, according to Horn, most of the common P. peltatum cultivars known at the time arose asexually as somatic mutants of the Ville de Paris family. See pages 23 and 26, and Tables 2 and 3.

Craig discloses a Pelargonium x hortorum hybrid bedding geranium with petals containing pelargonidin and paeonidin.

Duffett discloses a fertile red-petaled P. peltatum cultivar with reduced sensitivity to day length.

Appellants argue essentially that none of the references teaches “a diploid seed propagatable *P. peltatum* plant whose petal[s] express at least one of the anthocyanidins pelargonidin or paeonidin or a diploid seed propagatable plant containing a factor resulting in male sterility” and that “the secondary references add nothing to the Horn et al reference” as they “merely disclose plants of the genus *Pelargonium* which express some of the desired characteristics that could be utilized in Appellants’ invention.” See the Brief, pages 12 through 14.

In responding to these arguments, the examiner does not dispute that the references are silent with respect to whether the cultivars are diploid seed propagatable, but counters that it is appellants’ burden “to establish that the plant, not the plant patent . . . does not anticipate the claimed invention.” See the Answer, page 11. The examiner adds that “relying on the written description . . . and not the plant per se [places] an unfair burden on the Office to establish that a plant with both male and female reproductive organs is or is not fertile” and that fertility, or the lack of it, “is an inherent aspect of the plants that can be easily determined” but that “[t]here is no evidence on the record that Appellants have

attempted to obtain the plants of '602 or '605. . . nor obtain a statement from the inventor or assignee to establish if the plants are fertile or not." See the Answer, pages 9 and 10.

Thus, the issue to be resolved in deciding this appeal is not whether any of the references inherently discloses a cultivar with the requisite characteristics, rather, the issue comes down to determining where the burden rests in establishing whether or not the prior art plants are diploid seed propagatable.

It is well settled that the initial burden of establishing unpatentability rests on the examiner, In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Thus, the examiner is charged with establishing that an anticipatory reference meets every limitation of a claimed invention. However, in an apparent reference to In re Best, 562 F.2d 1252, 195 USPQ 430, (CCPA 1977), the examiner argues that requiring the examiner to establish that the prior art plants are inherently diploid seed propagatable places an unfair burden on the Office as the examiner is not in a position to observe the prior art plants per se. As set forth in In re Best, 977 F.2d at 1255, 24 USPQ2d at 433:

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product Whether the rejection is based on 'inherency' under 35 U.S.C. § 102, on 'prima facie obviousness' under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products [footnote omitted].

Nevertheless, we do not agree that the facts of this case, as developed on this record, justify shifting the burden of proof to appellants. Horn, already of record, indicates that propagation of P. peltatum by seed is the rare exception in breeding ivy-leafed geraniums, and that one of the main reasons for the slow progress in this area is “the sterility of many cultivars.” Viewed in this light, the silence of the prior art references on the issue of propagation by seed is conspicuous. We emphasize that our decision is based solely on a review of the record before us. On this record, it is not reasonable to shift the burden to appellants to establish whether or not the prior art plants are in fact diploid seed propagatable. Accordingly, the rejections under 35 U.S.C. §§ 102(b) and 103 are reversed.

REVERSED

SHERMAN D. WINTERS)
Administrative Patent Judge)
)
)
)
WILLIAM F. SMITH) BOARD OF PATENT

Appeal No. 1995-2920
Application 07/999,172

Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
HUBERT C. LORIN)
Administrative Patent Judge)

Mr. Tom Hoxie, Esq.
Novartis Corporation
Patent Department
3054 Cornwallis Road
Research Triangle Park, NC 27709-2257