

## **Pioneer Hi-Bred International, Inc. v. Monsanto Technology LLC (Fed. Cir. 2012)**

By [Donald Zuhn](#) -- February 28, 2012



Today, the Federal Circuit affirmed a decision by the Board of Patent Appeals and Interferences holding that in an interference between Pioneer Hi-Bred International's U.S. Patent No. 6,258,999 and Monsanto Technology's U.S. Application No. 11/151,700, Monsanto was not time-barred under 35 U.S.C. § 135(b)(1) and Monsanto's '700 application claims were entitled to seniority.

Pioneer's '999 patent, which issued on July 10, 2001, claims the benefit of U.S. Application No. 07/205,155, which was filed on June 10, 1988. Claim 1 of the '999 patent recites:

1. A fertile transgenic *Zea mays* plant comprised of stably incorporated foreign DNA, wherein said foreign DNA consists of DNA that is not from a corn plant and that is not comprised of a T-DNA border.

Monsanto's '700 application, which was filed June 13, 2005, claims the benefit of U.S. Application No. 07/467,983, which was filed on January 22, 1990. Claim 1 of the '700 application recites:

1. A fertile transgenic *Zea mays* plant containing heterologous DNA which is heritable, wherein said heterologous DNA confers a beneficial trait to the plant, wherein said beneficial trait is selected from the group consisting of pest resistance, stress tolerance, drought resistance, disease resistance, and the ability to produce a chemical, wherein the plant expresses a selectable marker gene, and wherein the plant is from a subsequent generation of a plant that is re-generated from a selected transformed cell.

Following the Board's declaration of an interference between all of the claims in Pioneer's '999 patent and twelve claims in Monsanto's '700 application, Pioneer moved for judgment, arguing that the claims of the '700 application were time-barred under § 135(b)(1). That section states that:

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Because the claims of the '700 application were not presented to the USPTO prior to July 10, 2002 (*i.e.*, one year from the date on which the '999 patent issued) -- the critical date -- Pioneer contended that it was entitled to a determination of priority. The Board, however, denied Pioneer's motion, holding that the interfering claims in Monsanto's '700 application related back to claims in the '983 application, which were presented before the critical date.



Monsanto also filed a motion, seeking to deny Pioneer the benefit of the '155 application, arguing that the '155 application did not contain sufficient disclosure supporting the claims involved in the

interference. The Board granted Monsanto's motion, making Monsanto the senior party, and Pioneer stipulated to judgment in favor of Monsanto. Pioneer then appealed the Board's decision to the Federal Circuit.

On appeal, Pioneer argued that the Board erred in relying on multiple pre-critical date claims to support Monsanto's later claim. While the Board recognized that no single claim in the '983 application contained all of the limitations of claim 1 in Monsanto's '700 application, the Board determined that multiple claims from a pre-critical application, operating together, could serve as the basis for showing that a later claim was actually made before the one-year bar of § 135(b)(1). In particular, the Board held that when claims 1, 7-9, 12, 16, and 18 of the pre-critical '983 application were taken together (as shown in the comparison below), they were "sufficiently congruent" with the claims presented in Monsanto's '700 application to overcome the § 135(b)(1) time bar.

Monsanto '700 Claim 1	Claims from Prior Monsanto '983 Application
1. A fertile transgenic <i>Zea mays</i> plant containing heterologous DNA which is heritable,	1. A fertile transgenic <i>Zea mays</i> plant containing heterologous DNA which is heritable.
wherein said heterologous DNA confers a beneficial trait to the plant,	...
wherein said beneficial trait is selected from the group consisting of pest resistance, stress tolerance, drought resistance, disease resistance, and the ability to produce a chemical,	7. The plant of Claim 1 wherein said heterologous DNA encodes a beneficial trait to the plant.
wherein the plant expresses a selectable marker gene,	8. The plant of Claim 7 wherein said beneficial trait is selected from the group consisting essentially of promoting increased crop food value, higher yield, reduced production cost, pest resistance, stress tolerance, drought resistance, disease resistance, and the ability to produce a chemical.
and wherein the plant is from a subsequent generation of a plant that is regenerated from a selected transformed cell.	9. The plant of Claim 1 which expresses a selectable marker gene.
	...
	13. The seed produced by the plant of Claim 1 which inherit the heterologous DNA.
	...
	16. The R2 and higher generations of the plant of Claim 1.
	...
	18. The plant of Claim 1 which is produced from transgenic seed produced from a fertile transgenic plant using cross-breeding techniques.
	...

Pioneer also argued that the claims of the '983 application recite inventions that are so different that the Board erred in holding these claims to be "sufficiently congruent." In particular, Pioneer contended that the Board erred in determining that claim 9 and claims 7 and 8 of the '983 application were directed to the same invention. Finding no error in the Board's determination, the Federal Circuit concluded that "the pre-critical date claims here demonstrate intent to claim an invention reflecting both the limitations of claims 7 and 8 and of claim 9." The Court agreed with the Board that "nothing in claim 9 indicates a choice away from the limitations of claim 7 or claim 8."

Pioneer also found fault with the Board's analysis as to claims 13, 16, and 18 of the '983 application, arguing that these claims did not support the limitation of claim 1 of Monsanto's '700 application that "the plant is from a subsequent generation of a plant that is regenerated from a selected transformed cell." As the Court noted, this language limits the claim to all generations of the subject plant beyond the initial progenitor (*i.e.*, R1 and higher generations). Once again agreeing with the Board, the Court noted that:

Claim 16 specifically reaches the "R2 and higher generations." And while there is no claim expressly reciting an "R1" generation, Monsanto '983 claim 13 addresses the seed necessary to give rise to that generation and claim 18 limits the plant of Monsanto '983 claim 1 so that it is itself an "R1" plant.

Pioneer closed by arguing that the Board erred in denying Pioneer the benefit of the '155 application. The basis of the Board's decision was the lack of disclosure of an enabled embodiment satisfying the requirement in claim 1 of Pioneer's '999 patent that the "foreign DNA . . . is not comprised of a T-DNA

border." The Court found no error in the Board's conclusion that Monsanto met its burden of showing that Pioneer's '155 application could not serve as a constructive reduction to practice of the '999 patent claim (*i.e.*, it did not disclose any enabled embodiment of the later claim), and that Pioneer failed to overcome this showing. The Court stated that:

Reviewing the Pioneer '155 application, we agree with the Board that it includes no express discussion of T-DNA borders at all. In its briefs and argument on appeal Pioneer presented no serious contention that the foreign DNA described in that application would inherently not comprise a T-DNA border, which is the only other way the required embodiment could be found.

The Court therefore affirmed the Board's decision that Monsanto's '700 application claims were entitled to seniority.

*Pioneer Hi-Bred International, Inc. v. Monsanto Technology LLC* (Fed. Cir. 2012)

Panel: Circuit Judges Prost, Clevenger, and Reyna

Opinion by Circuit Judge Clevenger

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