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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN R. HARDISON and JAY B. BURR

Appeal 2013-010623
Application 11/197,808
Technology Center 1600


MILLS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal of the rejections of claims 62–139 under 35 U.S.C. § 134. The Examiner has rejected these claims for lack of written description and lack of enablement. In addition, four obviousness-type double patenting rejections are set forth in the Answer. Claims 81–82 are not rejected under 35 U.S.C. § 112, first paragraph; however, they are part of the obviousness-type double patenting rejections. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.
STATEMENT OF CASE

The present invention relates to methods of breeding *Poa arachnifera* and *Poa pratensis* hybrid plants, the *Poa arachnifera* and *Poa pratensis* hybrid plants per se, as well as the plant parts, including the seeds. The present invention further relates to *Poa arachnifera* and *Poa pratensis* hybrid seeds. Methods of using the hybrid plants and the hybrid seeds are also provided. The hybrid plants are particularly suitable for use in lawns, golf courses, sod, other turfs and forage.

Spec. ¶ 2.

While there have been prior hybrids of *Poa arachnifera* and *Poa pratensis* grasses, such as the Kentucky bluegrass variety “Reveille,” the Specification states that “Reveille has not experienced commercial success due to difficulties in seed production, in particular cotton webbiness on the seeds.” Spec. ¶ 6. The pending claims generally relate to hybrid plants derived from crossing *Poa arachnifera* and *Poa pratensis* that exhibit one of increased panicle openness or reduced panicle compactness and, optionally, reduced amount, density, and/or length of seed cotton webbing as compared to Reveille.2 App. Br. 33–44 (Claims App’x).

Claim

The following claim is representative.

62. A hybrid plant, or part thereof, derived from crossing *Poa arachnifera* and *Poa pratensis* grasses as plant parents, wherein the hybrid plant or its seed exhibits at least one of (i) an increased panicle openness as compared to Reveille or (ii) a

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1 Reg. no. CV-53. PI 603946.
2 A panicle is a loosely branched cluster of flowers. App. Br. n. 2; Spec. Figs. 7A–7C.
reduced panicle compactness as compared to Reveille; and optionally (iii) a reduced amount of cotton webbing on a seed of the hybrid plant as compared to Reveille; (iv) a reduced cotton webbing density on a seed of the hybrid plant as compared to Reveille; and/or (v) a reduced length of cotton webbing as a percentage of lemma length on a seed of the hybrid plant as compared to Reveille, and further wherein said hybrid plant is a F1 plant or a backcrossed hybrid plant derived from crossing said F1 plant and a *Poa arachnifera* or *Poa pratensis* plant.

App. Br. 33 (Claims App’x).

Cited References


Grounds of Rejection

1. Claims 62–80 and 83–139 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Ans. 4; Final Act. 2.

2. Claims 62–80 and 83–139 are rejected under 35 U.S.C. § 112, first paragraph, because the Specification, while being enabling for varieties HB-130, HB-342, HB-329 and HB-129, does not reasonably provide enablement for the full scope of hybrid plants derived from a cross between *P. arachnifera* and *P. pratensis*, wherein the plants have at least one of increased panicle openness
or reduced panicle compactness, progeny of the plants and methods of making the hybrid plants. Ans. 12; Final Act. 17.

3. Claims 62–136 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. PP 18,467. Ans. 17; Final Act. 23.


FINDINGS OF FACT

The Examiner’s findings of fact are set forth in the Answer at pages 3–45. The following facts are highlighted.

1. “Through genetic recombination, the progeny of the Poa arachnifera are heterozygous and heterogeneous. There are also basic morphological differences between panicles of male and female Poa arachnifera plants (other than the obvious absence of male or female reproductive parts).” (Spec. ¶ 3.)
2. Appellants argued in prosecution regarding Suplick-Ploense, a prior art reference cited in an earlier anticipation rejection, that “there are countless hybrids that can be created by crossing *P. arachnifera* Torr and *P. pratensis* L. The vast majority of these would not have the claimed characteristics. Only through selective breeding were Applicants able to obtain hybrids exhibiting the claimed traits.” See Ans. 21; p. 10, paragraph 3, and p. 11, paragraph 3 of Appellant's Supplemental Response filed Mar. 20, 2009.

PRINCIPLES OF LAW

The function of the written description requirement is “to ensure that the applicant had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.” *In re Blaser*, 556 F.2d 534, 537 (CCPA 1977). “It is not necessary that the application describe the claim limitations exactly, *In re Lukach*, [442 F.2d 967 (CCPA 1971)], but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations.” *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976).

A number of factors are relevant to evaluating the adequacy of disclosure for generic claims, including “the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue.”

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When a patent claims a genus using functional language to define a desired result, the specification must demonstrate that the applicant has made a generic invention that achieves the claimed result and do so by showing that the applicant has invented species sufficient to support a claim to the functionally-defined genus. . . . [A] sufficient description of a genus . . . requires the disclosure of either a representative number of species falling within the scope of the genus or structural features common to the members of the genus so that one of skill in the art can visualize or recognize the members of the genus.

Id. (internal quotation marks and citations omitted); see also In re Wallach, 378 F.3d 1330, 1335 (Fed. Cir. 2004) (“[F]unctional description can be sufficient only if there is also a structure-function relationship known to those of ordinary skill in the art.”); Enzo Biochem, Inc. v. Gen-Probe Inc., 323 F.3d 956, 964 (Fed. Cir. 2002) (recognizing PTO Guidelines explaining that “the written description requirement can be met by . . . ‘disclosure of sufficiently detailed, relevant identifying characteristics . . . i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics’”) (emphasis added and citation omitted).

Regardless whether a compound is claimed per se or a method is claimed that entails the use of the compound, the inventor cannot lay claim to that subject matter unless he can provide a description of the compound sufficient to distinguish infringing compounds from non-infringing compounds, or infringing methods from non-infringing methods.
In light of the history of biological deposits for patent purposes, the goals of the patent law, and the practical difficulties of describing unique biological materials in a written description, we hold that reference in the specification to a deposit in a public depository, which makes its contents accessible to the public when it is not otherwise available in written form, constitutes an adequate description of the deposited material sufficient to comply with the written description requirement of § 112, ¶ 1.

Enzo Biochem, Inc., 323 F.3d at 965.

“The enablement requirement ensures that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims. The scope of the claims must be less than or equal to the scope of the enablement. The scope of enablement, in turn, is that which is disclosed in the specification plus the scope of what would be known to one of ordinary skill without undue experimentation.” National Recovery Technols. Inc. v. Magnetic Separation Sys., Inc., 166 F.3d 1190, 1195–1196 (Fed Cir. 1999). Wands factors (i.e., quantity of experimentation necessary, amount of direction, presence or absence of working examples, nature of invention, state of prior art, relative skill of those in the art, predictability or unpredictability of the art, and breadth of the claims) are factual inquiries underlying the enablement conclusion. Enzo Biochem, Inc. v. Calgene Inc., 188 F.3d 1362, 1371 (Fed. Cir. 1999).
DISCUSSION

History and Background


Several years after Chakrabarty, 447 U.S. 303 (1980), the PTO Board of Patent Appeals and Interferences held that plants were within the understood meaning of “manufacture” or “composition of matter” and therefore were within the subject matter of §101. In re Hibberd, 227 USPQ 443, 444, 1985 WL 71986 (1985). It has been the unbroken practice of the PTO since that time to confer utility patents for plants. To obtain utility patent protection, a plant breeder must show that the plant he has developed is new, useful, and non-obvious. 35 U.S.C. § 101—103 (1994 ed. and Supp. V). In addition, the plant must meet the specifications of §112, which require a written description of the plant and a deposit of seed that is publicly accessible. See 37 CFR §§ 1.801—1.809 (2001).


As acknowledged in In re LeGrice,

[It] must be borne in mind that there are inherent differences between plants and manufactured articles. Should a plant variety become extinct one cannot deliberately produce a duplicate even though its ancestry and the techniques of cross-pollination be known. Manufactured articles, processes, and chemical compositions when disclosed are, however, susceptible to man-made duplication.

... The description of a plant in a plant patent or in a printed publication at best can only recite, as historical facts, that at one time a certain plant existed, was discovered in a certain manner,
and was asexually reproduced. This information may be interesting history, but cannot enable others to reproduce the plant.

In re LeGrice, 301 F.2d 929, 935 (C.C.P.A. 1962).

The production of seeds by cross-pollination does not assure the plant breeder that he has produced a true new plant variety having the characteristics desired. At this step, the principles of heredity and plant genetics introduce such variables that no two seeds from the parent cross can be expected to produce identical plants.

The functions of the chromosomes and genes in transmitting inheritable properties from parents to offspring in plant breeding are brought into play only when the nuclei from different parent plants fuse together to form, in the seed, the nucleus of the new plant. Differences in composition of the fusing nuclei produce an organism which differs from either parent. These differences may be due, for example, to the presence of a duplicated chromatin granule (gene) in one, which may be represented singly or not at all in the other.

Id. at 938.

Hybrid seeds are produced by crossing two inbred corn plants and are especially valuable because they produce strong and vibrant hybrid plants with selected highly desirable characteristics. . . . Hybrid plants, however, generally do not reproduce true-to-type, i.e., seeds produced by a hybrid plant do not reliably yield plants with the same hybrid characteristics. Thus, a farmer who wishes to continue growing hybrid plants generally needs to buy more hybrid seed.

J.E.M. Ag Supply Inc., 534 U.S. at 128.
Claim Scope

Before addressing the written description and enablement issues, we must determine the scope of claim 62. “The descriptive text needed to meet these requirements varies with the nature and scope of the invention at issue, and with the scientific and technologic knowledge already in existence.” Capon v. Eshhar, 418 F.3d 1349, 1357 (Fed. Cir. 2005) (emphasis added).

Pending claim 62 is directed to a hybrid plant, or part thereof, derived from crossing Poa arachnifera and Poa pratensis grasses as plant parents. The resulting hybrid plant from the cross, at a minimum, must exhibit at least one of (i) an increased panicle openness as compared to Reveille or (ii) a reduced panicle compactness as compared to Reveille. Appeal Br. 33 (Claims App’x); Spec. ¶ 6 (description of Reveille). Claim 62 places no requirements on the nature of the specific plant parents, and therefore claim 62 encompasses hybrid plants resulting from the cross between any Poa arachnifera and any Poa pratensis grasses that exhibits at least one of (i) an increased panicle openness as compared to Reveille or (ii) a reduced panicle compactness as compared to Reveille. In short, claim 62 recites a genus defined by a desired result. AbbVie, 759 F.3d at 1299.

Through genetic recombination, the progeny of the Poa arachnifera are heterozygous and heterogeneous, (leading to unpredictable phenotypic expression of plant traits). There are also basic morphological differences between panicles of male and female Poa arachnifera plants (other than the obvious absence of male or female reproductive parts). FF1.
Written Description

Appellants argue the claims in the following groups; 1) Claims 62-76 and 80; 2) Claims 77-79; 3) Claims 83-91; 4) Claims 92-113, 128-137, and 139; 5) Claims 114-119 and 126-127. Each of the independent claims of each grouping present similar written description issues, therefore we select claim 62 as representative of all groupings and the remaining claims stand or fall with claim 62. See 37 C.F.R. § 41.37(c)(1)(iv)(2014).

Examiner’s Arguments

The Examiner finds, and we agree, that the only deposited species that fall within the claimed genus of hybrids having increased panicle openness or decreased panicle compactness (i.e., HB-130, HB-342, HB-329 and HB-129) have *P. pratensis* “Geronimo” as a parent or grandparent. Ans. 5. The Examiner finds that:

Because the [claimed] genus is highly variant, [deposited] HB 129 and HB 130 plants are insufficient to describe the claimed genus of *P. arachnifera x P. pratensis* F1 hybrids and [deposited] HB329 and HB342 [plants] are insufficient to describe the claimed genus of backcross plants.

The claimed plants encompass transgenic *P. arachnifera x P. pratensis* plants, where the transgene(s) confer the claimed traits. Such genes are not described.

The specification describes no structure (genotype) as being required for reduced amount, density and length of cotton webbing on the seed, increased amount of panicle openness, and/or reduced panicle compactness. There is not even any indication in the specification if these traits are controlled by single or multiple genes and if the genes are recessive or dominant.

Further, while the specification discusses the desirability of the heat and drought tolerance traits that *P. arachnifera* can confer (see, e.g., ¶5), none of these or other *P. arachnifera* traits are claimed; only *P. pratensis* traits are claimed.
Id. 6. The Examiner further finds that

The specification also does not describe the structural features that distinguish *P. arachnifera x P. pratensis* F1 hybrid plants from other plants that have a *P. arachnifera x P. pratensis* hybrid in their genetic backgrounds. The specification also fails to describe the structural features that distinguish a F1 hybrid from a F2 hybrid.

Id. at 7.

**Appellants’ Arguments**

Appellants contend that

The instant application describes and claims novel hybrid plants, derived from crossing *P. arachnifera* and *P. pratensis*, having improved characteristics over Reveille, as well as methods for selecting such hybrid plants. (See id. at [011], [012], [025], [046].) The claimed hybrid plants are easy to identify because they exhibit either an increased panicle openness or a reduced panicle compactness, as compared to Reveille, and optionally other characteristics (e.g., a reduced amount of cotton webbing on a seed of the hybrid plant as compared to Reveille). The claims also relate to progeny of the hybrids, methods of producing the hybrid plants, and methods for screening hybrid plants for the improved characteristics.


Appellants further argue that

*P. arachnifera and P. pratensis* grasses are well known and characterized in the art. The specification teaches that, by hybridizing *P. arachnifera* plants selected for certain characteristics with *P. pratensis* plants selected for certain characteristics, hybrid plants having the claimed characteristics may be obtained. (Specification at [067-079].)

The specification teaches that *P. arachnifera* plants useful in making the claimed hybrid plants are selected based on “improved turf characteristics, including, but not limited to, increased tiller density, leaf color, and/or plant height, in
comparison to typical cultivars and wild types of *Poa arachnifera*” (id. at [055] and [068])—characteristics that one of skill in the art can readily measure and determine. For example, the National Turfgrass Evaluation Program (NTEP), submitted as Exhibit A to Appellants' Response dated September 7, 2010, provides a detailed description of how to measure “Turfgrass Quality.” Moreover, the USPTO routinely issues patents in which turf quality, tiller density, leaf color, and plant height are disclosed and claimed. The USPTO’s issuance of such patents shows that it recognizes that skilled artisans understand these characteristics and how to determine whether a particular characteristic is, for example, increased compared to a wild type cultivar. The specification also identifies specific *P. arachnifera* parent plants useful for the claimed hybridization methods, including Tx 10-10, Tx 7-23, and Tx-6-17. (See id. at [054].) Accordingly, in view of the specification and knowledge in the art, one of ordinary skill in the art would conclude that *P. arachnifera* parent plants are adequately described.

*Id.* at 12, 13 (footnotes omitted).

**Analysis**

We are not persuaded by Appellants’ arguments. Appellants argue that “[t]he specification teaches that, by hybridizing *P. arachnifera* plants selected for certain characteristics with *P. pratensis* plants selected for certain characteristics, hybrid plants having the claimed characteristics may be obtained. (Specification at [067-079].)” App. Br. 12. However, claim 62 does not limit *Poa arachnifera* and *Poa pratensis* parents to those having selected traits. Thus, the question with respect to this rejection is whether there is description sufficient to support, to a skilled artisan, all *Poa arachnifera* / *Poa pratensis* hybrids having the claimed resulting
characteristic. We agree with the Examiner that Appellants have not described or shown possession of the invention with respect to the full scope of hybrids claimed.

In particular, we find that the pending claims encompass a genus defined by a desired result (i.e., comparative panicle openness or compactness vis-à-vis Reveille) without providing “either a representative number of species falling within the scope of the genus or structural features common to the members of the genus [such] that one of skill in the art can visualize or recognize the members of the genus.” *AbbVie*, 759 F.3d at 1299 (internal quotation marks and citations omitted). In particular, as the Examiner points out,

A comparison to Reveille does not describe the relevant identifying characteristics of the parent plant species that confer the claimed traits.

A comparison to Reveille does not describe the relevant identifying characteristics of *P. arachnifera* and *P. pratensis* plants that necessarily, when crossed, produce progeny that have the claimed characteristics.

A comparison to Reveille does not describe the relevant identifying characteristics that distinguish progeny of HB-130, HB-342, HB-329 and HB-129 from other plants that have both *P. arachnifera* and *P. pratensis* in their genetic background and have the claimed traits.

A comparison to Reveille does not describe the relevant identifying characteristics that distinguish plants with the claimed traits and that are progeny of *P. arachnifera x P. pratensis* hybrid plants with the claimed traits from plants with the claimed traits and that are progeny of *P. arachnifera x P. pratensis* hybrid plants that do not have the claimed trait.

A comparison to Reveille does not describe the full scope of parents to be used in the claimed methods.
A comparison to Reveille does not describe a representative number of species over the full scope of the claims.

Ans. 20–21.

Nor do we find Appellants to have shown that the claimed hybrid characteristic is sufficiently demonstrated in the Specification or by deposit to characterize a generic invention. See Capon, 418 F.3d at 1359. While Appellants argue that the Specification suggests crossing parents having particular characteristics, the Specification has not shown that this is a feature common to hybrids having the claimed comparative panicle openness / compactness. Likewise, Appellants have deposited only four hybrid plants, all derived from a single P. pratensis variety (Geronimo), However, Appellants have argued that the vast majority of hybrids created by crossing specific P. arachnifera Torr and P. pratensis L varieties would not have the claimed characteristics (see, for example, pg 10, paragraph 3, and pg 11, paragraph 3 of Appellant's response filed 20 March 2009). Ans. 6, 28. Moreover, “[t]he production of seeds by cross-pollination does not assure the plant breeder that he has produced a true new plant variety having the characteristics desired. At this step, the principles of heredity and plant genetics introduce such variables that no two seeds from the parent cross can be expected to produce identical plants.” In re LeGrice, 301 F.2d at 938. In the present case, we also find that Appellants have not described sufficient hybrid species within the scope of claim 62.

Appellants urge that in Ex Parte C, the Board affirmed that identification of known parent lines to make a new hybrid progeny, coupled with a functional description of the progeny, provides adequate written
description; in particular, Appellants argue that the Board found that flower color, plant type, maturity group, and bacterial and nematode resistance provided an adequate description for a soybean variety. App. Br. 15–16.

This argument is not persuasive. In Ex Parte C, the Appellant claimed a specific soybean variety, which was described by at least five characteristics in the specification and further proposed to be described by deposit of the seed for the claimed variety in a public depository. In re C, 27 USPQ2d 1492, 1493–1495 (1992). The instant application, in contrast, claims any Poa arachnifera and Poa pratensis F1 or backcrossed hybrid described by a single characteristic, either increased panicle openness as compared to Reveille or reduced panicle compactness as compared to Reveille. Such a large genus is not and cannot be described by deposit of a limited, few seeds and the generalized description of the parent plants provided in the Specification. Ans. 25.

Appellants urges that Riverside Park, a non-Geronimo parent, is fully capable of producing progeny with the claimed characteristics, as taught in the Specification (App. Br. 22). However, Riverside Park is not mentioned or described in the Specification, and thus the Specification does not teach that it is capable of producing progeny with the claimed characteristics. Ans. 34.

In sum, Appellants have not provided a disclosure that has sufficiently detailed, relevant identifying characteristics, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. Appellants have not described or provided specific structure or
characteristics that identify the parental strains used to make the claimed hybrid within the full scope of the claims. Appellants have not provided sufficient disclosure to distinguish infringing hybrids from non-infringing hybrids, or infringing methods from non-infringing methods, or to show possession of the invention within the full scope of claim 62. Thus, we affirm the written description rejection of the Examiner for the reasons of record.

Enablement

Appellants do not argue the claims separately. Therefore, we select claim 62 as representative and the remaining claims stand or fall with claim 62. See 37 C.F.R. § 41.37(c)(1)(iv)(2014).

Examiner’s Arguments

The Examiner contends that the full scope of the pending claim 62 is not enabled. Ans. 12. More particularly, the Examiner finds that the specification, while being enabling for varieties HB-130, HB-342, HB-329 and HB-129, does not reasonably provide enablement for the full scope of hybrid plants derived from a cross between *P. arachnifera* and *P. pratensis*, wherein the plants have at least one of increased panicle openness or reduced panicle compactness, progeny of the plants and methods of making the hybrid plants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.
Id. The Examiner further reviews the enablement factors set forth in *In re Wands*, and finds that

in essence the breadth of the claims cover any breeder who would make any cross between *Poa arachnifera* and *Poa pratensis* and any backcross regardless of how many generations removed. This is because the claimed plants are not limited by genotype, parentage, filial generation, backcross generation, transformation generation, etc.

The nature of the invention involves plant breeding, which is recognized in the art to be highly unpredictable and except for certain narrow areas where the genetics has been worked out, is usually not reproducible. If homozygous variety A were crossed with homozygous variety B, and the progeny allowed to self for five generations, the phenotype and genotype of the F5 progeny would be totally unpredictable and irreproducible due to recombination of chromosomes. If heterozygous variety C were crossed with heterozygous variety D, the phenotype and genotype of the resulting progeny are unpredictable.

*Id.* at 12–13.

The state of the prior art is that crosses between *P. arachnifera* and *P. pratensis* have been made previously, as evidenced by Revellie [sic], the comparative variety. However the art remains unpredictable, especially since these traits they are claiming have not been mapped out genetically. Nothing is known about the genes required to exhibit these traits. If they are quantitative traits, then numerous genes would be required to interact with each other to reproduce the phenotype, which contributes tremendously to unpredictability. The level of ordinary skill in the plant breeding art is high; most breeders have PhDs with multiple years of postdocs and breeding

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*In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).
experience. The level of ordinary skill in the art is high because of the unpredictability that is associated with this field.

Id. 13.

\textit{Appellants’ Arguments}

Appellants argue that the instant specification contains ample disclosure to allow persons skilled in the art to practice the full scope of the claimed invention, including:

- Examples of specific parental plant lines useful in making the claimed hybrids (e.g., \textit{P. arachnifera} varieties Tx 10-10, Tx 7-23 and Tx-6-17, and \textit{P. pratensis} varieties Geronimo, Ascot, Abbey and Midnight);
- Physical traits of parental plants useful in making the claimed hybrid plants (e.g., \textit{P. arachnifera} parent with good turfgrass characteristics and \textit{P. pratensis} parent with good seed production characteristics);
- Methods of making the claimed hybrid plants (e.g., crossing \textit{P. arachnifera} and \textit{P. pratensis} plants having specific physical traits);
- Methods of distinguishing F1 progeny hybrids having the claimed characteristics from the prior art hybrid Reveille (e.g., increased panicle openness, decreased panicle compactness, reduced cotton webbing density, shorter lemma cotton length, superior germination and seed emergence scores, etc.); and
- Several hybrid plants having the claimed characteristics (e.g., HB-129, HB-130, HB-329, and HB-342).

Moreover, as discussed above, there is no dispute that, at the time the application was filed, the parental lines (i.e., the starting materials for producing the claimed hybrids) were well known in the art, as were \textit{P. arachnifera} x \textit{P. pratensis} hybrids and methods of selecting plants for desired characteristics. (See Office Action mailed Nov. 19, 2010, at 7.)

As such, while making and testing hybrid plants for the claimed characteristics may involve extensive experimentation, as in \textit{Kubin} such experimentation would have been routine
given the specification’s detailed disclosure and the knowledge in the art. Accordingly, the full scope of the claims are enabled.

App. Br. 29.

Appellants further argue that,

the specification discloses examples of non-Geronimo, *P. pratensis* parents including Ascot, Abbey, and Midnight. The specification also describes specific characteristics of *P. pratensis* parents (e.g., increased seed production) useful in making the claimed hybrids. Finally, the Examiner contends that the claimed method “requires *P. arachnifera* and *P. pratensis* plants that necessarily produce progeny” with the claimed characteristics, but that “[t]he specification fails to teach such parent plants.” *(Id. at 19-20.)* This is simply not true. As discussed above, the specification does teach parent plants that, when crossed, produce hybrid plants having the claimed characteristics. Examples of such parent plants include *P. arachnifera* varieties Tx 10-10, Tx 7-23, and Tx-6-17, and *P. pratensis* varieties Geronimo, Ascot, Abbey and Midnight. *(Specification at [054].)* The specification also teaches what characteristics of parent plants to select for (e.g., good turfgrass quality and/or seed production) in order to yield hybrid plants having the claimed characteristics. The specification also teaches how to select hybrid plants having those characteristics. And the specification discloses deposits of four such hybrid plants. There is little else Appellants could have provided to enable persons of ordinary skill to make and use the full scope of the invention.

*Id.* at 31.

Appellants argue that (1) the Specification shows how to compare panicle openness between the claimed hybrids and Reveille; and (2) in view of this disclosure, it would be routine to compare the panicle openness of other hybrid plants to Reveille. *See, e.g., id.* at 8, 9, 18. Accordingly,
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Appellants maintain that the Specification adequately describes the full scope of the claimed products and methods. Reply Br. 10.

Analysis

We agree with the Examiner that the Appellants have not enabled the full scope of the hybrids of claim 62. Appellants have not limited their broad claims to the parent plants *P. arachnifera* varieties Tx 10-10, Tx 7-23, and Tx-6-17, and *P. pratensis* varieties Geronimo, Ascot, Abbey and Midnight. Instead, one of ordinary skill in the art would be invited to perform undue experimentation and panicle comparison with a large number of *P. arachnifera* and *P. pratensis* varieties to determine if they produce a hybrid plant and if the hybrid exhibits at least one of (i) an increased panicle openness as compared to Reveille or (ii) a reduced panicle compactness as compared to Reveille. Nor do we find that Appellants have fully explained how the National Turfgrass Evaluation Program (NTEP), indicating a detailed description of how to measure “Turfgrass Quality, provides an explanation which reduces the amount of experimentation that needs to be done to determine whether *P. arachnifera* and *P. pratensis* parent varieties possess the characteristics necessary to produce the full scope of hybrids having the characteristic claimed. Based on Appellants’ disclosure we conclude that it would require undue experimentation to make and use the invention of claim 62, and that Appellants have not enabled the full scope of hybrids of claim 62.

Thus, we affirm the enablement rejection of the Examiner for the reasons of record.
Obviousness-type Double Patenting Rejections

Claims 62–136 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. PP 18,467.


Claims 81–91, 103–104, 109–115, 120–129, and 134–139 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. PP 21,045.


Analysis

The Examiner indicates in the Final Action, pp. 23–26 and Answer, p. 4, that the obviousness-type double patenting rejections are maintained, and that every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained. See also, 37 C.F.R. 41.39(a)(1).

Appellants do not argue any of the obviousness-type double patenting rejections on the merits; therefore, each of the obviousness-type double patenting rejections is summarily affirmed.
CONCLUSION

The Examiner’s lack of written description and lack of enablement rejections are affirmed for the reasons of record and herein.

The four pending obviousness-type double patenting rejections are summarily affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED