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Field bean cultivar named enola

Case Study D – Field bean cultivar named *enola* / POD-NERS – *Patent for yellow bean or enola*

Title of the invention	Field bean cultivar named <i>enola</i>
Assignee/Proprietor	POD-NERS LLC
The patent	US5894079A – pdf file of the patent

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Abstract

This Patent Application entitled, “*Field Bean Cultivar Named Enola*,” was filed on November 15, 1996, by [POD-NERS LLC](#), listing Larry M. Proctor as an inventor. This Patent Application is related to a new field bean variety that produces distinctly colored yellow seed, which remains relatively unchanged by season. It was granted by the United States Patent and Trademark Office (USPTO) on April 13, 1999 (Patent No. 5,894,079). However, a patent reexamination request was filed by the International Center for Tropical Agriculture (CIAT), Columbia, where the USPTO’s Board of Patent Appeals and Interferences (PTAB) held Proctor’s patent to be invalid for being obvious. Further, the case went to the United States Court of Appeals for the Federal Circuit (CAFC), wherein it was finally held that the claims of Proctor’s patent are invalid for being obvious, and the patent was cancelled on January 25, 2011.

Case Study D

In 1994, Mr. Larry Proctor purchased a package of Mexican beans of various colours, separated out the yellow ones, and spent three years selectively breeding the plants. He then named his line “*Enola*” and obtained patent protection for the bean, its plant, its pollen, and the method of producing it.

There were two categories of claims covering the Enola bean. One group of claims was directed to beans with a yellow coat described as within a narrow range of shades of yellow on a particular colour chart. The other group was directed to a bean “designated Enola as deposited in” the American Type Culture Collection under a specified accession number. The claims of the Patent Application Proctor’s were also directed to a plant produced from an Enola seed and a method for producing the plant by crossing parent plants, at least one of which originally came from an Enola seed.

The field bean cultivar Enola, as claimed in Proctor’s patent (Patent No. 5,894,079) exhibited superior characteristics over other classes of field bean cultivars. The distinctly yellow colored bean seeds of Enola were edible for human consumption. Unlike other dry field beans which have a gritty type of texture and taste, the bean seeds of Enola had a smooth texture and taste. Additionally, the bean seeds of Enola had the ability to take on a large volume of water when soaked prior to cooking. Furthermore, the bean seeds of Enola were found to cook up faster, in approximately one-half the time, of other dry field beans.

Following the grant of Proctor's patent, a request for reexamination was made on December 20, 2000 by the International Center for Tropical Agriculture (CIAT), Columbia. The USPTO's Board of Patent Appeals and Interferences (Board), by order dated April 29, 2008, held Proctor's patent to be invalid on multiple grounds, including that the invention thereunder was obvious, and violative of 35 USC §103(a)¹. The Board determined that a well-known yellow bean called "Azufrado Peruani 87" was disclosed in a prior art document and that it appeared to have substantially similar characteristics as the Enola plant and seed. The Board noted that the common characteristics of both included that they are yellow-seeded cultivars.

Aggrieved by the said decision of the Board, the matter was appealed to the United States Court of Appeals for the Federal Circuit (CAFC). The CAFC reaffirmed the Board's decision and held that Mr. Proctor followed normal and well-established agricultural methods and techniques to arrive at the instant invention. A person of ordinary skill in the art seeking to reproduce and improve the yellow beans originating from Mexico would have followed the same steps taken by Mr. Proctor (plant the beans, harvest the resulting plants for their seeds, planting the latter seeds, and repeat the process two more times). It was held that there is no indication that by taking these steps Mr. Proctor sought to provide beans of the particularly narrow range of yellow that the claims of Proctor's patent specified. The CAFC thus upheld the decision of the Board and held that the claims of Proctor's patent are invalid for being obvious. Moreover, the patent was held inactive because as it was anticipated by the traditional knowledge and genetic resources of indigenous peoples and farming communities in Mexico.

¹ 35 USC §103(a) Non-obvious subject matter: A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.