

PLANT PATENTS

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On May 23, 1930, a bill was passed by both the Senate and the House and approved by President Hoover. Thus came into being the Townsend-Purnell Plant Patent Act of 1930. As a result of this act, the law in regards to patentable inventions was amended to read as follows:

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, *or who has invented or discovered and asexually reproduced any distinct and new variety of plant other than a tuber-propagated plant*, not known or used by others in this country, * * * * *."

Under the present law, there are two basic fundamental requirements to be met in obtaining a plant patent:

1. One must invent or discover a new variety of plant other than a tuber-propagated plant.
2. One must asexually reproduce this newly invented or discovered variety of plant.

A new variety of plant can be either a sport, mutant or hybrid, but it must be capable of being asexually reproduced. There are no limitations placed on the method of asexual reproduction. Any one of the commonly known methods, such as grafting, cut slips or root clusters will meet the statutory requirement. The main object is to reproduce the new variety of plant true to form.

However, the problem becomes extremely vexing when one attempts to determine whether or not these fundamental requirements have been met. This is primarily due to an apparent lack of interest on the part of those persons interested in agriculture. This apparent lack of interest is seen from the fact that as of December 12, 1950, there have been issued a mere 999 plant patents, and as of today there has been but one plant patent infringement action to enforce the right so granted. During that same period, there have issued 773,349 mechanical patent, and there have been innumerable infringement actions to enforce these rights.

Thus, in order to determine what acts will meet the fundamental requirements one must look to the Congressional record. From a look at this record, it is possible to gain a small insight as to just what was intended by Congress when it approved the Townsend-Purnell Plant Patent Act of 1930.

The Bill, as first presented to Congress, was worded in a manner quite different from the present law and contained the following provision:

“* * * Provided, that the words 'invented' and 'discovered' as used in this section, in regard to asexually reproduced plants, shall be interpreted to include invention and discovery in the sense of finding a thing already existing and reproducing the same as well as in the sense of creating.”

After considering the Bill, Congress amended it so as to read in its present form.

In the Senate Report accompanying the amendment, the following comments were made:

“As to the two amendments, one adds to the bill the usual separability clause and the other *eliminates from the scope of the bill patents for varieties of plants which exist in an uncultivated or wild state*, but are newly found by plant explorers or others.”

Thus, the present Plant Patent Act clearly excludes the patenting of any plant found existing in an uncultivated or wild state.

However, this still leaves unanswered the important question of obtaining a patent on a plant which is found in a cultivated state. In regard to this particular question, the Senate Report made the following statements:

“There is a *clear and logical distinction* between the discovery of a *new variety of plant* and of certain inanimate things, such, for example, as a new and useful natural mineral. The mineral is created wholly by nature unassisted by man and is likely to be discovered in various parts of the country; * * * its free use by the respective owners should of course be permitted. On the other hand, a plant discovery *resulting from cultivation is unique*, isolated, and is not repeated by nature, nor can it be reproduced by nature unaided by man, and such discoveries can only be made available to the public by encouraging those who own the single specimen to reproduce it asexually and thus create an adequate supply.

“It is obvious that nature originally creates plants but it cannot be denied that man often controls and directs the natural processes and produces a desired result. In such cases the part played by nature and man cannot be completely separated or weighed or credited to one or the other. Nature in such instances, unaided by man, does not reproduce the new variety true to type.

“* * * The chemist who invents the composition of matter must avail himself of the physical and chemical qualities inherent in the materials used and of the natural principles applicable to matter. Whether or not he is aware of these principles does not affect the question of patentability. * * * as is true of many of the most important inventions, he may accidentally discover the product, perhaps in the course of the regular routine of his work. He does not have to show, for instance, that he mixed the elements and expected them to produce the particular composition of matter. He may simply find the resulting product and have the foresight and ability to see and appreciate its possibilities and to take steps to preserve its existence.

“The same considerations are true of the plant breeder. He avails himself of the natural principles of genetics and of seed and bud variations. * * * He may test and experiment with them on a variety of proving grounds. He may promote natural cross-pollination by

growing the parent plants in juxtaposition. * * * In the case of sports, the plant breeder not only cultivates the plants but may subject them to various conditions of cultivation to encourage variations, as, for example, in some recent developments, the subjection of the plants to the effects of X-rays or to abnormal fertilization. Finally, the plant breeder must recognize the new and appreciate its possibilities either for public use or as a basis for further exercise of the art of selection.

"Moreover, it is to be noted that the committee has by its amendment in striking out the patenting of 'newly found' varieties of plants, eliminated from the scope of the bill those wild varieties discovered by the plant explorer or other person who has in no way engaged either in plant cultivation or care and who has in no other way facilitated nature in the creation of a new and desirable variety.

"* * * As to patents the doubt is only as to one word 'inventors.' The word 'discovery' aptly describes the situation when a new and distinct variety of plant is found, and 'inventors' is certainly as elastic a word as 'authors'."

At the same time the House in its approval of the bill as amended made the following statements in its report:

"These cultivated sports, mutants, and hybrids are all included in the bill, and probably embrace every new variety that is included. The exclusion of a wild variety, the chance find of the plant explorer, is in no sense a limitation on the usefulness of the bill to those who follow agriculture or horticulture as a livelihood and who are permitted under the bill to patent their discoveries."

From this brief review of the Senate and House reports, it is quite obvious that there are a vast number of unanswered questions. These questions will remain unanswered so long as those interested in agriculture and horticulture remain in their shell and are reluctant to assert their rights.

One of the most vital yet unanswered questions is: Just how much cultivation must be done in order that a new and distinct variety of plant will fall beyond the class of so-called "wild variety"? A liberal interpretation of the law would indicate that a mere watering or slight cultivation of a plant would be sufficient. At the same time a strict view of the law would require a far greater expenditure or effort toward the developing of a new plant.

As a matter of fact, the Patent Office has been granting patents where the original plant is the result of a bud mutation, find, or chance seedling and has been subsequently asexually reproduced. However, the most important question of whether or not a court will hold these to be valid patents is still unanswered.

In the one and only plant patent case to date (Cole Nursery Co. v. Youdath Perennial Gardens, Inc., District Court N.D. Ohio E.D. May 1936, 17 F. Supp. 159) the patent was held invalid on the ground that the plant was in public use prior to May 1930. However, in deciding that case, the court made the following statement:

"The use of nature and knowledge of propagation of plant life seems to me to have been the forces behind the development of the upright variety of barberry. I am not

prepared to accord invention to the result produced by such uses in respect of the upright barberry; but if it were otherwise, the fact of the knowledge and existence of the plant prior to the amendment of May 1930, and its prior public use, would fatally impair its validity."

Although this statement by the court does not have any legal effect, since the case was decided on different grounds, it is at least a fair insight as to what might be required by the courts. Definitely, this Ohio court was all in favor of a very strict interpretation of the law, and would have required a great deal of cultivation.

Thus, as the law presently stands, it appears that the Patent Office will issue a plant patent on a found seedling or the like which is the result of some slight cultivation. However, the one plant patent case indicates that such patents will, if brought before the court, be declared invalid. It must be remembered, though, that this is not the law, but merely the opinion of this one court. It will take a number of court cases and perhaps a decision by the Supreme Court before any definite answer can be given to this all-important question.

As to the second fundamental requirement, it is necessary that the new and distinct variety of plant shall have been asexually reproduced prior to the application for patent. This is necessary in order to insure an adequate supply of the new and distinct variety of plant. Obviously, it would be fatal to grant a patent for a new and distinct variety unless the variety had been demonstrated to be susceptible of asexual reproduction. Of course, theoretically under laboratory conditions it is probable that all plants can be asexually reproduced, but it is hardly to be expected that a patent will be applied for unless at the time of application the plant can be asexually reproduced upon a commercial scale or else there is reasonable expectation that it can be so reproduced in the near future.