More About Plant Patents

By Robert Starr Allyn*

IT would appear from Mr. Robb's recent article published in the October issue of the Journal that my previous queries on Plant Patents only scratched the surface. We seem to agree that *many* of the patents thus far issued are probably invalid because they fail to claim the "plants" per se. In trying to cover the fruit or blossoms per se they have overstepped the law. The remedy, of course, is by reissue.

We also seem agreed that the Plant Patent Act is the basis of long needed protection to the inventors and discoverers of new plants. We differ radically, however, as to the scope and adequacy of the law and the way it has thus far been administered. Indeed, if Mr. Robb is correct in some of his conclusions the situation is much worse than I had supposed. If my comments, ironic or otherwise, serve to clarify or improve matters, I shall be more than repaid for my studies. If a house is poorly built or upon poor foundations, it may have to be torn down and rebuilt. Mr. Robb's theory seems to be "don't shoot the performer—he is doing his best." When, however we pay to see a performance we have a right to criticise and as I see it we, as attorneys, have a duty to criticise where we consider it necessary. I am not hampered, however, in my criticism by any interest in the parentage of the Plant Patent Act or in its specific applications.

Mr. Cook's articles on the subject I believe constitute a most valuable commentary. While he does not claim to be a patent expert he has clearly pointed out many of the inconsistencies and errors botanically and otherwise in the Plant Patents as issued. He points out also the dangers in the present divided authority between the Patent Office and the Department of Agriculture. One department can very well say, "I know nothing of Plants" and the other "I know nothing of Patents!" The public pays the bill.

* Patent Attorney, New York.

I can see no reason why with all the experience of more than 100 years in patents we should deliberately go back to the ignorance of the 1800's in drafting and administering a mere amendment to the law in the 1900's. Honest criticism ought to be of use even now.

Mr. Robb is hardly complimentary to the Patent Office Examiners by his implications on the subject of chemists and electrical engineers. Even if some of the Examiners are not professional chemists or engineers when they enter the Patent Office, they at least have been educated in physics and chemistry and must have a very considerable engineering knowledge in order to pass the necessary examinations. I do not recall, however, that botany or horticulture are required subjects. I think it has been customary so far as possible to assign Examiners to work for which they are especially fitted. It would seem that the same sort of selection or assignment should apply to the Plant Patent division. I doubt if there is any other division in the Patent Office where such fundamental errors as pointed out by Mr. Cook could slip through.

I agree with Mr. Robb that the law protects only against pirating plants *per se* and here again I think the law is inadequate. I see no reason why one who has produced a new fruit or flower or vegetable should not be entitled to the same protection as the maker of a new golf ball, lollipop or other food product. The inventor should be able to pursue the copier where the product is sold as well as where the plant is grown. It may be very difficult to prove the plant infringement act but it should be easy to prove duplication of a new product.

I am glad that Mr. Robb agrees with me that the Commissioner has erroneously limited each Plant Patent to a single claim and I hope that others will impress upon the Commissioner their opinions. The rule seems to me purely arbitrary and should be recast.

There are, I am sorry to say, several important points on which I can not agree with Mr. Robb. Some of these are rather abstruse but I think worth consideration.

First: The general purpose of this law can not be so different from that of any other patent and copyright law, namely, "to promote the progress of science and useful arts." The special intent of Congress was to give to plant breeders the same sort of protection as we try to give to inventors of mechanical, chemical and electrical improvements. The mere finding of an existing machine, compound or variety of plant, however, is not an invention or discovery according to our laws. The law as proposed was intended to cover mere finds and the broad provision was stricken out after adverse comment by Commissioner Robertson. The mere finding of a new variety does not make one a plant breeder. If the law does cover a mere find then it ought not make any difference whether the finder is a professional plant breeder or an amateur. I suppose if the "find" were valuable the finder would ipso facto become a professional!

As originally proposed the law would have included the following, "Provided, that the words, 'invented' and 'discovered' as used in this section (4886), 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." This doubtless (if constitutional) would have covered "mere finds"—that is, those newly found varieties, the production of which is due to a freak of nature without human aid. The elimination of this provision was undoubtedly intended to mean that a patent could cover only such new and distinct varieties as were produced by the aid of man.

A new machine or composition is not a patentable invention or discovery under our law unless its creation involves the exercise of the inventive faculty.

Second: Mr. Robb seems to be basically unsound in his understanding of the purpose of the specification of a Plant patent. He treats the subject as if the provision for Plant Patents were a separate section of the law and that the specification and claims should follow rules of their own. I am inclined to believe that they should be provided for by a separate section of the law. Unfortunately, however, they have been injected into sections

of the law which have been interpreted many times to have quite definite meanings. Mr. Robb says the purpose of the "Plant Patent specification is to enable identification of the variety and determination of infringements thereof." I am anxious to know where he gets authority for this. He also says "the law only requires that the invention itself shall be fully described and not the preceding art or genus." "The law requires only a reasonable disclosure of the features of novelty of the invention or discovery itself so the public may avail of the invention when the monopoly expires and, pending that time, recognize with fair accuracy the scope of the monopoly."

I am surprised that one familiar with the intricacies of the patent law should overlook the requirements of Section 4888 of a written description of the supposed invention or discovery "and of the manner and process of working, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; * * * and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery."

These requirements apply to Plant inventions as well as to all others. It is true that the difficulty of such full, clear and concise descriptions in the case of plant inventions led to the addition of the so-called saving clause, "No plant patent shall be declared invalid on the ground of non-compliance with this section if the description is made as complete as is reasonably possible."

It does not seem to me, however, that a Plant Patent can be valid where *no* attempt whatever is made to furnish any information as to the parentage or method of producing the new variety of plant. Failure to keep a record of the parentage of plants does not speak very well for the scientific spirit of a supposed inventor. It may be annoying—but it is not impracticable or impossible. Of course, if the so-called invention is a mere find the parentage may be unknown—and then in my

opinion is unpatentable. A true plant breeder should not be excused for slovenly methods.

If some other form of specification is expected in the case of Plant Patents, then the law should be amended. The purpose of a specification is to comply with the law!

Third: The form of many claims which have been approved by the Patent Office in my opinion does not comply with the law. It should distinctly claim the part or improvement which is new—and not by a general reference to the descriptive part. To claim the new and distinct variety of plant as described adds nothing whatever to the specification. Those patents already issued can, of course, be reissued as to the form of claim.

Fourth: Mr. Robb overlooked the basis of my criticism of one of the Burbank patents. The sole novel characteristic of the plum tree claimed was "the early ripening period of the fruit, as shown." I have reread the patent and have not been able to discover any reference whatever to the ripening period either in the drawing or in the description. Such an error should have been detected at least by the Examiner. Furthermore, any plum tree which has an early ripening period would be covered by the claim. The claim, therefore, is broader than the invention and fails to point out the real novelty of the invention, if any.

A similar fault will be found in Patents Nos. 1 and 10 on the Everblooming Climbing Rose. Apparently these plants are not the same and yet the claims are alike which proves that they do not distinctly claim the novel features of the inventions as required by the law.

Fifth: Infringement: In general unauthorized manufacture, use or sale of an invention as described and claimed (or its equivalent) constitutes infringement of the rights granted by the patent, i. e., the right to exclude others. Mr. Robb states, "Of course it must be understood that the infringing plant will necessarily be a propagated reproduction of the original patented plant." Mr. Robb further says, "Now, of course, if a propagator can independently (with the assistance of nature) produce a duplication of a patented variety, he is free to do so, * * * So far as the question of possible accusation of infringement of the patent is con-

cerned, the owner of the unpatented plant has the defense by way of proof that his variety is not a propagation of the patented plant." If this is a correct interpretation of the law it is most unfortunate. But I do not agree that it is correct. I find nothing whatever in the law to support such an unfair limitation on a Plant Patent. Certainly there is no such defense suggested in Section 4920. If Mr. Robb is correct the patent owner can sue only a plant breeder and must prove that the offending plant was actually asexually reproduced from one of the original patented plants. It will be extremely difficult if not impossible in most cases to prove this. Identity with or equivalency to the patented plant should be proof of infringement (unless licensed). Section 4884 gives to Plant owners the same rights to exclude others from the patented field as to other patent owners and in addition the Plant Patent owner can prevent others from asexually reproducing even from a licensed plant or from any other plant.

If Mr. Robb is correct one may import from abroad the new and patented variety of plant and sell it with impunity. In fact it will be possible to sue only the actual grower. It is true that he does not say this but these conclusions seem to me to inevitably flow from his reasoning. If one must prove that the plant was a reproduction of the original plant it must be that reproduction is the sine qua non of infringement. The growing or sale of a plant in one district which was created in another district would appear to be free. I can not believe that this was the intent of the law makers or the proper interpretation of the law. If it is the law—then the law should be changed to provide adequate protection.

The law quite clearly entitles the patentee to the right to exclude others from making, using and selling the patented invention or discovery and including in the case of Plant Patents the exclusive right to asexually reproduce the invention. It is true that the report of the Congressional Committee on Patents appears to convey the idea that the bill would not cover reproduction from

seeds. The English language in the law, however, is too clear for discussion. If it had been intended to limit the scope of the grant to reproduction from the original it would have been so easy to state it. As it stands either the Congressional Committee gave no thought to the language of the Act or thought that no one would notice that their report and the proposed Act did not correspond. The discussion on the floor of the House and Senate shows that no particular attention was paid to the terms of the proposed law. It would have been scarcely honest to tell the plant breeder that it was proposed to give him the same reward as to the engineering or industrial inventor and then frame the Act so that the plant breeder could not sue a dealer or an orchardist or florist who sold or used plants produced by others.

It is apparent that the Commissioner of Patents does not agree with Mr. Robb on the scope of Plant Patents for the form of the grant to the Patentee is:

> the exclusive right to make, use, and vend the said invention throughout the United States and the Territories thereof.

We can not find here any such limitation as suggested by Mr. Robb.

Sixth: Mr. Robb discusses at some length the importance of protecting the "professional" finders of new varieties apparently upon the theory that such a finder is the owner and therefore entitled to keep his secret. This is certainly contrary to our whole patent system. This theory will account for many of the peculiar cases already considered and leads to absurd conclusions and ridiculous contradictions. If the owner is entitled to a patent then a corporation can apply for a patent. Or suppose one person owns the land and the plant breeder leases it. If the breeder raises an "annual" he may own it. If he creates grafts on old stock trees the breeder does not own the tree. Then I suppose the land owner would be the inventor according to Mr. Robb's theory although he may not even know that there is a new variety of apple on the place. He agrees that the chance find of a plant explorer or a "wild variety" is not patentable but if a cultivated tree produces a sport then the

owner of the tree is entitled to a patent although the owner has done nothing to create the sport! This seems to me absurd. It seems to me that the plant explorer is more entitled to a patent for his discovery than a mere finder of a natural sport in his own or in a hired garden.

I wonder who, according to Mr. Robb's theory, the inventor is in the case of a new variety created by grafting X on a tree owned by Y.

I have no objection to the grant of patents on sports, mutants or hybrids provided the inventor has done something to create the new variety. I can see no reason to reward the owner of real estate for what accidentally grows on his land—neither do I see why the landlord should be considered the inventor of a new plant which may be grown by his clever tenant. Neither can I see any sound sense in granting a patent to a man who claims to be a professional plant breeder and refusing a patent to an amateur plant lover who performs the same act, i. e., seeing and reproducing something which nature has produced without any thought on the part of the discoverer. I suppose if the amateur decides to become a pro he can get a patent on what he has merely "found."

I am inclined to think that Congress has the power to grant patents on new plants and their products merely found or discovered by the applicant if, in the opinion of Congress, this would promote the progress of science or the useful arts. Congress apparently has the right to define—an author or inventor and to define what a writing or discovery is. It has expanded the general idea of a "writing" to include photographs, phonograph records, etc. The Supreme Court has said that Congress may define "intoxicating liquor" to mean a beverage containing more than one-half of one percent of alcohol. Why can Congress not define "discovery" to include the bringing to public notice of a hitherto unknown plant or its product? In the absence of such definition or declaration by Congress, in my opinion, "mere finds" or discoveries are not patentable. And, by the way, should not plant patents be issued for terms longer than seventeen years because of the fact that asexual reproduction is such a slow process?