



U.S. Plant Patents and the Imazio Decision

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Overview of U.S. Protection Options

1. Plant Patents
2. Utility Patents
3. Plant Variety Protection
4. Contract Law and Licenses
5. Trade Secrets
6. Trademarks

U.S. Plant Patent Act

- Enacted in 1930
- For asexually propagated plants ONLY
- Protection is for a term of 20 years from the date of filing
- Over 20,000 Plant Patents granted

New Plant Variety

35 U.S.C. §161

“Whoever invents or discovers and asexually reproduces any distinct a new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefore, subject to the conditions and requirements of this title.”

Examples of Plant Propagation

Asexual propagation:

- Vegetative cuttings
- Layering
- Division
- Grafting
- Tissue culture

Sexual propagation:

- Crossing a male plant with a female plant
- Crossing the ovule of one plant with the pollen from a different plant to produce seed

Some Possible Sources of New Plant Varieties

1. Product of plant breeding
2. Discovery of a spontaneous mutation of unknown causation
(mutation can be part of a plant or a whole plant)
3. A mutation induced by man
(by chemicals, x-ray, etc.)
4. Discovery of new plant while present in a
“cultivated area” (an area tended by man)

Commonly Protected Plants

1. Ornamental plants of all types other than those that are reproducible from seeds
2. Fruit trees
3. Berry plants
4. Shrubs

Plant Patent Act

Before 1998 Amendment

35 U.S.C. §163

In the case of a Plant Patent the grant shall be of the **right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.**

Plant Patent Act

After 1998 Amendment

35 U.S.C. §163

In the case of a Plant Patent the grant shall be of the right to exclude others from asexually reproducing the plant, and from using, **offering for sale**, or selling the plant so (asexually) reproduced, **or any of its parts, throughout the United states**, or from importing the plant so (asexually) reproduced, or any parts thereof, **into the United States.**

Scope of Protection Provided by a U.S. Plant Patent

Right to Exclude Others from:

1. Asexual reproduction of protected plant
2. Offering plant for sale
3. Selling the plant
4. Offering plant parts for sale
(e.g. fruit or cut flowers)
5. Importing the plant to the U.S.
6. Importing plant parts to the U.S.

Scope of Protection *continued*

- The protected plant is the variety shown and described in the Plant Patent
- A plant having a different combination of characteristics is outside the Plant Patent
- If a patented plant is obtained from an authorized source in the absence of an agreement to the contrary, it may be used as a parent plant to produce a different variety. The descendants would be outside the Plant Patent grant.
- A mutation of the patented plant that is discovered or induced could be potentially patented by its inventor as a new or different variety.

Enforcement of U.S. Plant Patent Protection

Owner can bring legal action:

- a) In a U.S. Federal District Court, or
- b) With Federal Trade Commission in Washington, D.C. if being imported from abroad.

District Court Remedies:

- a) Money damages (3x if willful infringement)
- b) Injunctive relief (court order to stop)

Federal Trade Commission Remedy:

Exclude infringing plants from entering U.S.

Enforcement of Plant Patents Rarely Done in U.S.

- Plant Patents are generally respected in the U.S.
- Litigation to enforce Plant Patents is rare
- The Imazio Decision
(36 USPQ2d 1673 of 1995)

Imazio Nursery (1995 CAFC Decision)

Imazio Nursery PP5,336
Heather 'Erica Sunset'

Discovered in 1978 as a seedling of unknown parentage grown in a cultivated field.

Characteristics: Early blooming, reaching full bloom more than one month before the parent plant begins to bloom.

Coastal Nursery

Sale of 'Holiday' Heather (unpatented)

Defining “Variety” - Imazio

§161

Patents are granted to “whoever invents or discovers and asexually reproduces any distinct and new variety of plant.”

Imazio – Argued the term “variety” was intended that a Plant Patent cover “all plants of that new and distinct variety, i.e., all plants having the same essential and distinctive characteristics.”

Imazio attorneys argued “variety should be construed in its technical, taxonomic sense and should be construed to encompass more than just clones of a single plant.”

Defining “Variety” - Coastal

Coastal argued “variety” should be construed as “something different from others of the same general kind.”

Coastal maintains that by the use of the term “variety,” Congress did not intend to afford plant protection to a range of plants but intended only to protect a single plant.

Plant Patent Act Does Not Define Variety

So the Court looks to legislative history of the Plant Patent Act in legislative records of Congressional hearings, and debate on pending legislation.

Court Determines new and distinct varieties that fall into 3 categories:

1. Sports – bud variation, need seed variation
2. Mutants – seedling variation
3. Hybrids – seedlings of cross pollination of 2 varieties

New Variety Must be Distinct

- A new variety must be distinct and have characteristics clearly distinguishable from other existing varieties.
- Congress intended distinct and new cultivated sports, mutants, hybrids, and newly found seedlings to be entitled to separate plant protection.
- Legislative history does not answer the question of what “variety” means; whether a single plant or a range of plants, is protected by a Plant Patent.

New Variety Must be Reproduced Prior to Filing a Patent Application

In addition to being distinct and new, a patentable plant must also be asexually reproduced.”

Senate Report 5

“It is not only necessary that the new and distinct variety of plant shall have been invented or discovered, but it is also necessary that this variety shall have been asexually reproduced prior to filing the plant application.

The Legislative History Further States:

- The patent right granted is a right to propagate the new variety by asexual reproduction.
- It does not include the right to propagate by seeds.
- Court states that whether the new variety is a sport, mutant, or hybrid, the patent right granted is a right to propagate the new variety by asexual reproduction.

Asexual Reproduction Requirement

Court decides “It is clear from legislative history that as a result of the asexual reproduction requirement, only a single plant, i.e., reproduction from one original specimen in the words of Congress, is protected by a plant patent.”

In another case, *Diamond v. Chakrabarty*, this court indicated that asexual reproduction was required in the Plant Patent Act because it was believed that new varieties could not be reproduced true-to-type through seed.

Imazio Decision

Court concludes, “Due to the asexual reproduction prerequisite, plant patents cover a single plant and its asexually reproduced progeny. The result of asexual reproduction is a plant that is genetically identical to its parent.”

Court concludes, “the scope of a plant patent is the asexual progeny of the patented plant variety.”

Requirement for Infringement

Therefore, for purpose of Plant Patent infringement, the patent holder must prove the alleged infringing plant is an asexual reproduction of the protected plant, that is, that it is the progeny of the patented plant.

Due to the asexual reproduction prerequisite, Plant Patents cover a single plant and its asexually reproduced progeny. The result of asexual reproduction is a plant that is genetically identical to its parent.

The statute requires asexual reproduction of the patented plant for there to be infringement.

If Potential Infringement – What Can a Patent Holder Do?

Usual Procedure:

1. Carefully review all facts, gather data and information
2. Send letter to alleged infringer
3. Negotiate a settlement agreement with alleged infringer

If You Need to File a Lawsuit

1. Carefully design side by side comparisons of varieties in greenhouse and/or field
2. Obtain DNA fingerprints of protected and alleged infringing variety
3. Argue to court there is no way the alleged infringing variety could have been produced without asexually reproducing the plant patented variety
4. Depending on DNA and side by side comparison data, have reasonable chance of proving infringement
5. Similar steps needed to prove EDV in PBR

Why are There so Few Lawsuits Filed Regarding U.S. Plant Patents?

Survey of U.S. Flower Companies

- U.S. Plant Patents are well respected
- Having a Plant Patent increases the royalty paid by licensee often by 5x to 10x
- They have not had any reason to file lawsuits, the U.S. system is working well
- Cost of U.S. Plant Patent is much cheaper than Canadian PBR and EU CPVR

Survey continued

1. Companies have strong concerns about the total cost for Canadian PBR and CPVR – too expensive
2. Do not like the annual annuity payments needed for PBR and CPVR
3. Do not like the extra costs for doing the trials required prior to receiving a PBR
4. PBR process is very expensive which restricts these companies in what they can protect
5. No deposit required at the time of filing a PBR – prevents accurate evaluations later on “what is the original protected variety.”

Other Protection Options to Consider

1. Good license agreements which specify ownership of any mutation or sport derived from a protected plant
2. Maintain your trademarks so competition can not use your trademarks

Conclusions

1. U.S. Plant Patents are respected and lawsuits are rare
2. Imazio Decision - enforcement is difficult
3. Prove asexual reproduction
4. Plant Patents protect a single plant and its asexually reproduced progeny
5. Evidence needed is similar to proving an EDV

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