Molecular Breeding **2**: 95–96, 1996.

News and Views

Recent United States developments in plant patents

Richard H. Kjeldgaard and David R. Marsh
Howrey and Simon, 1299 Pennsylvania Avenue, N.W., Washington, D.C. 20004, USA

Received 27 November 1995; accepted in revised form 9 January 1996

There are a number of different forms of intellectual property protection that have in the past been of interest to those involved with plant-based technology: utility patents, plant patents, plant variety protection certificates, and trade secrets (a review of the different forms of protection available to plant-base technology can be found in the journal *Plant Cell*, 6.11: 1524–1528 (1994)).

For plants and plant products resulting from recombinant DNA technology, utility patents are usually considered the most valuable form of intellectual property. Even when the plant or plant product is the product of conventional breeding techniques, utility patents are usually the most valuable form of intellectual property. These conclusions have recently been reinforced by a U.S. Appeals Court decision that significantly reduces the protection afforded by plant patents. This news item discusses that court's decision.

Plant patents have been available for some plants since 1930, when Congress enacted the Plant Patent Act (35 U.S.C. § 161–164). Advocates of legislation to extend patent protection to plants, including Thomas Edison and Luther Burbank, wanted to provide the same kind of protection to plant inventions that had long been available to industrial inventions. A plant patent is a property right granted by the United States government that gives its owner the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced for a limited period of time. Due to the recent passage of legislation associated with the General Agreement on Tariffs and Trade, the length of time a plant patent holder can exclude others will depend on whether the plant patent application was filed after June 7, 1995. If the plant patent application was filed after June 7, 1995, the holder of the plant patent has the right to exclude others, once the plant patent has issued, for a period of twenty years from when the patent was filed. However, if the plant patent application was filed prior to June 8, 1995, the patent holder has the right to exclude others, once the plant patent has issued, for seventeen years after the plant patent has issued or twenty years from when the plant patent was filed.

Not all plants fall within the statutory subject matter for which plant patents may be issued. The Plant Patent Act limits protection to asexually reproduced plants, apparently based on the belief that sexually reproduced plants could not be reproduced true-to-type. Furthermore, not all asexually reproduced plants may obtain plant patents as the act excludes coverage of tuber-propagated plants such as the potato.

In addition to asexual reproduction the requirements for patentability under the Plant Patent Act are distinctiveness, novelty, nonobviousness and disclosure. Prior to the enactment of The Plant Patent Act, plants were not considered amenable to the detailed description requirement necessary for utility plants. Perhaps for this reason, The Plant Patent Act specifically exempts plant patents from the detailed description associated with utility patents requiring only that the description be 'as complete as reasonably possible'.

To obtain a plant patent, the distinctiveness of the plant may be established by either biochemi-

cal or morphological characteristics. Although the distinctiveness requirement of a plant patent was not one of the issues considered by the Federal Circuit, the plant patent at issue in the litigation provides an illustration of a plant characteristic that might be considered distinct. The patent holder, Imazio Nursery, Inc., was the owner of United States Plant Patent No. 5,336 and the subject of that patent was a variety of heather known as *Erica Sunset*. According to the patent, this variety of heather was discovered in 1983 and differed from other heather of the species *persoluta* in that it consistently bloomed in December and January rather than March and April, and as such filled a commercial niche by providing a source of heather blossoms during the holiday season (*Imazio Nursery, Inc., v. Dania Greenhouses*, 29 U.S.P.Q.2d (BNA) 1217 (N.D.Cal. 1992)).

In November 1995, the Federal Circuit clarified the exclusionary scope of protection available to holders of plant patents (*Imazio Nursery v. Dania Greenhouses*, 69 F.3d 1560 (Fed. Cir. 1995). Prior to the Federal Circuit opinion in *Imazio*, courts were split as to whether a plant patent should cover independently derived plant material with the same characteristics as the plant covered by the plant patent or be limited to material that was derived directly from the patent holder's stock.

The pertinent provision of the patent statute states that 'whoever invents or discovers and asexually reproduces any distinct and new variety ... may obtain a patent ... ' (35 U.S.C. § 161). Critical to the Federal Circuit's ultimate decision were the meaning of the words 'variety' and 'asexually reproduces' and the relationship between these words. The patent holder asserted that the term 'variety' should be interpreted in its technical, taxonomical sense to mean all plants having the same essential and distinct characteristics. In contrast, the alleged infringer asserted that Congress did not afford plant protection to a range of plants but intended only to protect a single plant.

The Federal Circuit was unable to determine which meaning of the word 'variety' Congress intended without considering what Congress intended by the use of the term 'asexually reproduces'. From a consideration of the debate associated with the adoption of the Plant Patent Act in 1930, the Federal Circuit concluded that Congress intended to limit protection to a single plant and as such 'variety' should be interpreted to mean the asexual progeny of the claimed plant.

Based on its interpretation of the meaning of the words 'variety' and 'asexually reproduces', the Federal Circuit held that for the purposes of plant patent infringement, that the patentee must prove that the alleged infringing plant is the progeny of the patented plant. In light of the statement by the Federal Circuit that the scope of a plant patent is limited to the progeny of the patented plant, evidence showing that the accused plant has the same essential characteristics as the patented plant will be insufficient to establish infringement. As such, proof that a party independently derived the accused plant will be a defense to a plant patent infringement suit. A patentee will be required to establish that the accused variety was actually asexually derived from the patented plant.

The statement by the Federal Circuit that the protection available to the holder of a plant patent is limited to a right to exclude only those who have derived their material from the plant patent holder's stock makes independent creation a complete defense to an infringement action. This is quite different than the situation that exists for utility patents. It has long been established that the rights of a holder of a utility patent may be infringed even when the accused article was independently derived. Moreover, whereas a plant patent is limited to a single claim, a utility patent can have many claims to different variations of the invention. After the *Imazio* decision, utility patents even more clearly than before provide a broader form of protection that can encompass more than just the asexual progeny of the patented plant.