plaintiff's jurisdictional contentions seem eminently well-reasoned, the defendant's presentation of reasonably relevant NLRB or court authority requires dismissal.[22] Prudent plaintiffs will avoid this eventuality by inserting in the complaint, where possible, specific allegations negating exclusive NLRB jurisdiction, *e.g.*, that the business is not in interstate commerce, or that the union involved is not a labor organization.[23] This tactic will usually cast a heavy burden on a defendant claiming pre-emption.[24] However, while advantageous to the plaintiff, such an approach can easily endanger judicial efficiency, for determination of the jurisdictional issue is likely to become a virtual trial on the merits.[25] This danger is especially prevalent where the plaintiff seeks to avoid immediate pre-emption by alleging that the controversy involves sufficient violence to allow the state to grant relief under its police power.[26] At this point the solution can lie only in the discretion of the trial court. While judicial efficiency and the avoidance of federal-state conflict are vital objectives, the trial court should also recognize the injustice of denying an immediate judicial remedy merely because the defendant raises a tenuous claim of "arguable" pre-emption.

Martin B. Dickinson, Jr., S.Ed.

PATENTS—PRIOR PUBLICATION—APPLICATION OF SECTION 102(B) TO PLANT PATENTS—Appellant applied for a plant patent on two roses[1] which he had developed. The Patent Office Board of Appeals affirmed the final rejection of the application on the basis of section 102(b)[2] of the patent statute. Pictures and classifications of the varieties of roses sought to be patented had appeared in printed publications[3] more than one year before appellant's

22 Principal case at 184.

23 See, *e.g.*, Freight Drivers Union v. Quinn Freight Lines, Inc., 195 F. Supp. 180 (D. Mass. 1961).

24 See, *e.g.*, Cox v. Superior Court, 52 Cal. 2d 855, 346 P.2d 15 (1959).

25 See, *e.g.*, Portland Web Pressmen's Union v. Oregonian Publishing Co., 188 F. Supp 859 (D. Ore.), *aff'd*, 286 F.2d 4 (9th Cir. 1960), *cert. denied*, 366 U.S. 912 (1961); Wilson & Co. v. United Packinghouse Workers, 181 F. Supp. 809 (N.D. Iowa 1960).

26 The jurisdictional issue as to whether such violence has occurred ordinarily involves the same factual determination upon which the plaintiff bases his substantive claim. See Michelman, *State Power To Govern Concerted Employee Activities*, 74 HARV. L. REV. 641, 664 (1961).

1 Rosa Floribunda plants, application serial numbers 709,127 and 709,128, filed Jan. 15, 1958.

2 35 U.S.C. § 102(b) (1958): "A person shall be entitled to a patent unless . . . (b) the invention was described in a printed publication . . . more than one year prior to the date of application for patent in the United States . . . ."

3 A printed publication is anything that is printed and made accessible to any part of the public. See, *e.g.*, Rosenwasser v. Spieth, 129 U.S. 47 (1889); Interchemical Corp. v. Sinclair & Carroll Co., 50 F. Supp. 881, 890 (S.D.N.Y. 1943). However, the mere existence of a printed thing is not a printed publication. See Britton v. White Mfg. Co., 61 Fed. 93 (C.C.D. Conn. 1894); Cottier v. Stimson, 20 Fed. 906 (C.C.D. Ore. 1884).

application.[4] On appeal, *held*, reversed. In order to bar issuance of a plant patent, a description in a printed publication must convey such knowledge as to place the invention within the public domain. *In re LeGrice*, 301 F.2d 929 (C.C.P.A. 1962).

The provisions of the statute pertaining to plant patents grant to whomever invents or discovers and asexually reproduces any distinct and new variety of plant[5] the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.[6] In addition, they require that all of the provisions relating to patents for other inventions, except where specifically excluded, shall be applicable to plant patents.[7] Thus, in order to qualify for the granting of a plant patent, petitioner must, among other things, satisfy section 102(b),[8] which determines one of the requisite conditions for the existence of patentable novelty. Since the application of section 102(b) to plants had not been adjudicated prior to this case, the arguments presented by both parties were based substantially on policy. These arguments can be resolved into two issues. The first is whether the description under section 102(b), in order to bar patentability of inventions in general, must be so complete as to enable a person skilled in the art or science to which it appertains to practice the invention, while the second issue is whether the construction of section 102(b), when applied to plants, should be the same as that applied to patents for other inventions. The respondent asserted that a mere description, although insufficient to place the plant in the public domain, would be adequate to bar the issuance of the patent,[9] while the petitioner argued that the requisite description to bar patentability must be an "enabling" one.[10] There is force to the reasoning in support of both of these positions; however, the latter, accepted in the principal case, seems to be the more compelling and necessary conclusion. This is true not only from a simple resolution of the issues on the basis of precedent, but from a consideration of the practical consequences which result from each of the two contradicting interpretations when viewed in the light of the policies and goals of the patent system.

The question of whether an enabling description is required under section 102(b) for all patents, other than plants, is of prime importance to the basic purposes of the patent system. There is no logical foundation in the

4 1949 NAT'L ROSE SOC'Y ANNUAL OF ENG. 155, and 1954 NAT'L ROSE SOC'Y ANNUAL OF ENG. 156, 157.

5 Congress in using the word "plant" was speaking in the common language of the people and did not use the word in its strict scientific sense. *In re* Arzberger, 27 C.C.P.A. (Patents) 1315, 112 F.2d 834 (1940).

6 35 U.S.C. §§ 161, 163 (1958).

7 35 U.S.C. § 161 (1958).

8 See note 2 *supra*.

9 Brief for Appellee, p. 5.

10 Brief for Appellant, p. 22. An "enabling" description must contain and exhibit a substantial representation of the patented improvement so as to enable any person skilled in the art or science to which it appertains to make, construct, and practice the invention. Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 555 (1870). See principal case at 936.

field of patents for following a "mere description" test. The theory behind the publication bar of section 102(b) is that, once an invention has been placed in the public domain, no one shall be permitted to recapture it by means of a patent monopoly.[11] Thus, if the description is not enabling, it is clear that the invention has not been placed in the public domain, and patentability should not be barred. This is illustrated by the familiar practice of viewing the patent grant as being analogous to a contract.[12] If the disclosure is an enabling one, the patent should not be issued since the public derives no benefit thereby and there is no consideration given by the applicant for the grant of such a limited monopoly.[13] In accordance with this view, the majority of cases have required that, in order to invoke the restriction contemplated by section 102(b), the description must be such as to enable one who is skilled in the particular art to duplicate the invention.[14] These decisions are reinforced by the writers, who are unanimous in their recognition of the desirability of this position.[15] Thus, compelled by the weight of authority and the logical development underlying it, the court in the principal case found it necessary to criticize and distinguish those decisions which had held that section 102(b) does not require an enabling description.[16]

Despite the absence of any authority clearly contrary to the proposition that an enabling description is also required to bar plant patents, the court's conclusion in that regard should be examined in the light of the congressional intent and the public policy underlying the patent laws. Unfortunately, the fact that the Plant Patent Act was passed in great haste, coupled with the lack of any clearly pertinent manifestations of congressional intent, leads to the conclusion that the problem presented by the principal case was probably not recognized, and almost certainly was not

11 1 SMITH, PATENT LAW vii (1954).

12 ALLYN, THE FIRST PLANT PATENTS 18, 19 (1934).

13 *Id.* at 19.

14 Eames v. Andrews, 122 U.S. 40, 66 (1887); Downton v. Yeager Milling Co., 108 U.S. 466 (1883); Seymour v. Osborne, 78 U.S. (11 Wall.) 516, 555 (1870); Wisconsin Alumni Research Foundation v. George A. Breon & Co., 85 F.2d 166 (8th Cir.), *cert. denied*, 299 U.S. 598 (1936); Young Radiator Co. v. Modine Mfg. Co., 55 F.2d 545 (7th Cir. 1931); De Cew v. Union Bag & Paper Corp., 57 F. Supp. 388 (D.N.J. 1944).

15 CURTIS, PATENTS § 294 (4th ed. 1873); 1 ROBINSON, PATENTS §§ 325-30 (1890); 1 WALKER, PATENTS § 50 (Deller ed. 1937).

16 Cohn v. United States Corset Co., 93 U.S. 366 (1876). Court of Customs and Patent Appeals: *In re* Attwood, 45 C.C.P.A. (Patents) 824, 253 F.2d 234 (1958); *In re* Baranauckas, 43 C.C.P.A. (Patents) 727, 228 F.2d 413 (1955); *In re* Inman, 43 C.C.P.A. (Patents) 709, 228 F.2d 229 (1955); *In re* Kebrich, 40 C.C.P.A. (Patents) 780, 201 F.2d 951 (1953); *In re* Shackell, 39 C.C.P.A. (Patents) 847, 194 F.2d 720 (1952); *In re* Michalek, 34 C.C.P.A. (Patents) 1124, 162 F.2d 229 (1947); *In re* Stoll, 34 C.C.P.A. (Patents) 1058, 161 F.2d 241 (1947); *In re* Crosley, 34 C.C.P.A. (Patents) 882, 159 F.2d 735 (1947); *In re* Fink, 20 C.C.P.A. (Patents) 716, 62 F.2d 103 (1932); *In re* Marden & Rentschler, 18 C.C.P.A. (Patents) 1119, 48 F.2d 428 (1931). Circuit and District Courts: Merck & Co. v. Marzall, 197 F.2d 206 (D.C. Cir. 1952); Shell Dev. Co. v. Watson, 149 F. Supp. 279 (D.D.C. 1957), *aff'd*, 252 F.2d 861 (D.C. Cir. 1958); General Elec. Co. v. De Forest Radio, 17 F.2d 90 (D. Del. 1927); One-Piece Bifocal Lens Co. v. Bisight Co., 246 Fed. 450 (D. Md. 1917), *decree modified*, 259 Fed. 275 (4th Cir.), *cert. denied*, 249 U.S. 606 (1919).

resolved by Congress at the time of passage.[17] On the other hand, when viewed from the standpoint of the public interest, it can be seen that the result in the principal case more nearly conforms to the goals of the patent system. It has been stated that the purposes of the patent grant are to encourage and reward inventors,[18] expand the general distribution of the invention for the benefit of the public,[19] and to make it finally available to all after seventeen years.[20] The relevant theory is that a patent is similar to a contract, the consideration for the grant by the government being the disclosure to the public of something worthwhile which would not otherwise have been known.[21] When considered from the standpoint of patent policy, the practical consequences of denial of a plant patent, merely on the basis of a prior but non-enabling description, are significant. If the plant application is denied, the applicant is faced with two choices. He must either place the plant on the market, making excessive charges for specimens in order to avail himself of his only opportunity for financial reimbursement before clippings of his plant are reproduced and marketed by another in competition, or he must keep the original plant off the market so as to avoid competition with another subsequently patented plant, created by him from the original plant, and possessing the desirable features of the original. Neither of these results is in the public interest or within the basic philosophy of the patent statute. The first alternative would lead to high prices and limited distribution, while the second would make the plant inaccessible to the public in favor of a substitute. On the other hand, the uniform application of section 102(b) to all inventions, including plants, would allow for the rewarding of the inventor and a wider distribution to the public at a lower price, without recapturing anything already made available to the public in the prior publication.

The ramifications resulting from the court's application of section 102(b) are twofold. The first is the effect it will have on clarifying the standard

17 See ALLYN, *op. cit. supra* note 12, at 57. The intent of Congress was to encourage the invention and discovery of new plants by providing agriculture with the same opportunity as that provided by the patent system to the manufacturing industry. H.R. REP. No. 1129, 71st Cong., 2d Sess. 1 (1930). The intent to place agriculturists on the same level as others can arguably be relied upon for the proposition that Congress intended § 102(b) to be applied in the same manner for all patents. However, the fact that this intent is limited to the "practicable" lends credence to the argument that only the same opportunity, and not the same tests, should apply. And although § 162 of the act [35 U.S.C. § 162 (1958)] provides that the disclosure of a plant patent application need only present as complete a description as is reasonably possible, thus intimating that Congress was aware of the virtual impossibility of providing an enabling description of a plant, any conclusion therefrom as to a possible congressional resolution of the problem is mere conjecture.

18 *E.g.*, Lever Bros. Co. v. Procter & Gamble Mfg. Co., 139 F.2d 633, 639 (4th Cir. 1943); Rubber Tire Wheel Co. v. Milwaukee Rubber Works Co., 154 Fed. 358 (7th Cir), *cert. granted*, 207 U.S. 589, *petition for cert. dismissed*, 210 U.S. 439 (1907).

19 *E.g.*, Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 330-31 (1945); Chicago Steel Foundry Co. v. Burnside Steel Foundry Co., 132 F.2d 812, 816 (7th Cir. 1947).

20 35 U.S.C. § 154 (1958).

21 See ALLYN, *op. cit. supra* note 12, at 18, 19.

applied to all patents under section 102(b). Although this court cannot overrule the Supreme Court or the other circuits, its handling of the principal case should cause a reconsideration of the loose language used in the interpretation of this section, and may well influence those courts to adopt the test which requires an enabling description. The second ramification of the court's decision is more closely related to the initial problem of the principal case, in that it results from the struggle to find an acceptable solution of how to apply section 102(b) to plants. Under the court's decision many problems are still present and unsolved. The anomaly of having section 102(b) prohibit an impossibility when applied to plant patents is still present, because an enabling description of a plant cannot be made.[22] In addition, there is no way to prevent the patentee from extending his monopoly by advertising and showing the plant for many years, and then, after a demand has been created, applying for patent protection. And finally, the contract analogy fails because the consideration given by the patentee can be negated by the disappearance or extinction of the plant, as there is no guarantee provided by an enabling disclosure that the patented item will ever enter the public domain.

The remedy for these problems, as well as others, cannot be handled by the courts within the present statutory framework. A feasible solution seems possible only through remedial legislation. As an initial step it might be well to abolish the applicability of substantive provisions to both plant and other patents, since there is no logical reason why the goal of the patent system cannot be effectuated without relating the general provisions of title 35 to plant patents. A chapter with autonomous provisions would immediately relieve the existence of the section 102(b) "anomaly" and others which might be latently present. In addition, in order to assure that the plant will not become extinct before expiration of the patent, a provision could be enacted requiring the placement of a sample with the patent office, so that clippings would be available to the public. If physical and economic factors would limit the applicability of this provision, a compulsory licensing system could be initiated. Another possible provision which might be enacted would be one which would cause the length of the term of protection of the patent to be decreased by the delay between the date of prior publication and the filing of the patent application. This would not only curb the possible problem of the extension of patent protection, but would provide for the encouragement of the statutory standard which provides for the granting of patents only to "new" varieties.[23] Although these recommendations for remedial legislation are far from comprehensive, they do evidence the need for a new approach based on a reexamination of the plant patent provisions.

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22 This is true under the restrictions of today's scientific knowledge; however, advancements in this area are likely to result from the active research in the field. See principal case at 939 n.7.

23 35 U.S.C. § 161 (1958).