Plant Patents—R.I.P.*

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INTRODUCTION

On November 3, 1995 owners of U.S. plant patents, and the U.S. patent system, received a devastating blow.

The decision by the Court of Appeals for the Federal Circuit in *Imazio Nursery Inc. v. Dania Greenhouses*, 36 U.S.P.Q. 2d 1673, (reversing the trial court[1]), created a new form of protection for "inventors" carved out of the U.S. patent law. Henceforth holders of U.S. plant patents will no longer have the same rights as granted by utility and design patents, but rather a right more similar to copyright rights but administered through the Patent and Trademark Office. In a decision that carefully avoids common sense, *Imazio* stands for the proposition that to establish infringement of a plant patent it is necessary to prove that the accused plant is derived from, i.e. a copy of, the actual plant which prompted the filing of the application for plant patent. This is a requirement not imposed on any other class of invention. Yet this judicial revision of the U.S. patent law has not raised the ire of patent bar or the affected industry. With such far reaching effect it should be expected that the patent bar would speak with a unified voice to object to this decision and the damage it does but virtually no response can be heard. Perhaps the lack of response by patent practitioners can be attributed to the paucity of oxen gored by the decision but the lack of response by the horticultural industry is more difficult to explain. If industry silence is due to a lack of awareness of the *Imazio* decision's impact on the investment and effort in creating new plant varieties and on business, then relevant trade associations and patent bar share responsibility.

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* A critique of *Imazio v. Dania Greenhouses*, 36 U.S.P.Q. 2d 1673 (Fed. Cir. 1995) . All views expressed are those of the author and should not be ascribed to the firm of Christie, Parker & Hale, L.L.P. or its clients.

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1 *Imazio v. Dania Greenhouses*, 29 U.S.P.Q. 2d 1217 (N.D. Calif.), jury held patent valid and infringed; found willful infringement; attorney fees awarded to Imazio.

HeinOnline -- 79 J. Pat. & Trademark Off. Soc'y 516 1997

There is presently pending in Congress legislation to extend the plant patent grant to "parts of the plant" in recognition of the problems faced by industry in the United States concerning importation of plant parts such as fruit, flowers, etc. produced by plants of patented varieties grown outside the country. This effort is laudable and would represent an important benefit to plant patent holders but the value of this amendment is significantly reduced if the burden of proving infringement remains as announced by the appellate court in the *Imazio* case. Proving derivation of plants in a foreign country would be even more formidable than this country. We should think about this before we start celebrating if this law is passed.

BACKGROUND

The *Imazio* decision contains a useful description of the history of the Plant Patent Act, known as the Townsend-Pernell Plant Patent Act when passed by Congress May 13, 1930 (signed by President Hoover May 23, 1930). This was the first legislation in the world to grant patent rights for plant "inventions". When enacted, the plant patent protection was provided as amendments to the general patent law, i.e. Section 4884 of the revised statutes, was amended to recite:

> Every patent shall contain . . . a grant to the patentee . . . of the exclusive right to make, use and vend the invention or discovery (including in the case of a plant patent the exclusive right to asexually reproduce the plant).

and Section 4886 of the revised statutes was amended to recite:

> Any person who has invented or discovered any new and useful art, machine . . . or who has invented or discovered and asexually reproduced any distinct and new variety of plant other than a tuber propagated plant, . . . may . . . obtain a patent therefor.

It is noteworthy that as described in Section 4886 the subject matter for which a patent may be obtained is a "new variety of plant", whereas the right set forth in Section 4884 applies to "the plant".

In the 1952 Patent Act the plant provisions were included as a separate chapter of the statute. Section 4886 was embodied in 35 U.S.C. 161 and Section 4884 is part of Section 35 U.S.C. 163, but the "exclusive right to asexually reproduce" was changed to the "right to exclude others".

> *35 U.S.C. § 161* Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated spores, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an

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uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.
The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided. (July 19, 1952, ch. 950, §1, 66 Stat. 804; Sept. 3, 1954, ch. 1259, 68 Stat. 1190.)
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. (July 19, 1952, ch. 950 §1, 66 Stat. 804.)

THE DECISION

Although the court could just have easily pronounced that the "plant" referred to in Section 163 is the plant of the "variety" mentioned in Section 161, it chose to do the opposite and ignore the word "variety" in Section 161 which defines what may be patented. This election by the court then sets the basis for the final outcome, notwithstanding that common sense should have dictated otherwise.

It is acknowledged in *Imazio* that the statute itself does not define "variety" but rather than consider, and adopt, the common and technical definition of "variety" which existed at the time plant Patent Act was enacted and continues to exist today[2], the court chose to look at

2 That "variety" is used as a taxonomical term is confirmed by the legislative history of the Plant Patent Act.

> In order for the variety of plant to be distinct it is not necessary that it be a variety of a new species. A variety of plant may be patented if it is a new and distinct variety either of an existing or of a new species, or if it is an entirely new species of plant.

H.R. Rep. No. 1129, 71st Cong., 2d Sess. 5 (1930), App. 105.

At trial, petitioners and respondents' botanical experts agreed that the International Code of Nomenclature for Cultivator Plant—1980 ("International Code") sets forth an accepted definition of a cultivated variety or "cultivar". Fed. Cir. Referring to the horticultural variety as "Cultivar," Article 10 of the international Code has the following definition:

> The international term *cultivar* denotes an assemblage of cultivated plants which is clearly distinguished by any characters (morphological, physiological, cytological, chemical, or others), and which, when reproduced (sexually or asexually), retains its distinguishing characters. The cultivar is the lowest category under which names are recognized in this Code. This term is derived from *cultivated variety*, or their etymological equivalents in other languages.

Older definitions are consistent with that set forth in the International Code. For example, *HORTUS, A concise Dictionary of Gardening, General Horticulture and Cultivated Plants in North America*, The MacMillan Company, New York 1930, defines "variety" as:

> VARIETY. *A group or class of plants subordinate to a species.*... There are two classes or ranges of varieties,—those displaying rather marked differences in nature, and those presenting only small more or less temporary or artificial differences useful to the gardener. The former class is entitled to Latin botanical names, as *Rosa carolina* var. *glandulosa*, whereas the horticultural varieties of roses mostly (and properly) receive vernacular names....

Note 1 of Article 10 of the International Code specifically addresses the question of whether independently derived plants can be of the same variety.

"Note 1 *Mode of origin is irrelevant* when considering whether two populations belong to the same or to different cultivars."

some selected portions of the legislative history. However, even after so doing, the court concluded that "the legislative history does not answer the question of what 'variety' means in terms of whether a single plant or a range of plants is protected by a plant patent . . . ", despite the clear reference to "variety" as a taxonomic term in the legislative history.

It is evident that the court relied only on excerpts from the legislative history and that no portion of the legislative history referred to in *Imazio* actually supports the decision reached by the court.

1. The first excerpt from the legislative history referred to in *Imazio* discusses that new varieties fall into three classes—sports, mutants and hybrids. However, the excerpt uses the word "variety":

> A plant or portion of plant may suddenly assume an appearance or character distinct from that which normally characterizes the *variety* or species. In a second class of cases the mutants, the new and distinct *variety*, results from seedling variation by self-pollination of species. In a third class of cases, the hybrids, the new and distinct *variety* results from seedlings of cross pollenization of two species, two varieties, or a species and a variety. (emphasis added)

The foregoing in and of itself should have lead the court to conclude that Congress fully understood the definition of "variety" but that definition was not the one ultimately used by the court in *Imazio*.

2. A second quotation from the legislative history actually discusses what is required for the "new variety" to be distinct:

> . . . The characteristic that may distinguish a new *variety* would include, among others, those of habit; immunity from disease; resistance to cold, drought, heat, wind, or soil conditions; color of flower, leaf, fruit, or stems; flavor; productivity, including ever-bearing qualities in case of fruits; storage qualities; perfume; form; and ease of asexual reproduction. Within any one of the above of other classes of characteristics the differences which would suffice to make the *variety* a distinct *variety*, will necessarily be differences of degree. (emphasis added)

Once again, the foregoing should have been sufficient guidance to the court that Congressional definition of variety was not "a single plant". Instead, the court chose to find significance in the requirement that to be patentable, the plant of the new variety shall have been asexually reproduced, thereby confusing a requirement for patentability, as discussed below, with what constitutes infringement.

3. In the third legislative history excerpt in the opinion the court found that the legislative history stated that the patent right granted is a right to propagate the new *variety* by asexual reproduction. Although

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when the 1952 Patent Act was enacted, the right to asexually reproduce was amended to the right to "exclude others from asexually reproducing", it should be noted that the legislative history still acknowledges that the right applies to "*the new variety*".

4. The next excerpt of the legislative history quoted by the court appears below; note that "variety" is used again and again ignored by the court:

> It is not only necessary that the new and distinct *variety* of plant shall have been invented or discovered, but it is necessary that it shall have been asexually reproduced prior to the application for patent.

Following this quotation, the court states "As discussed below, the additional requirement [of asexual reproduction] informs the scope of protection of plant patents and hence the meaning of "variety" in § 161".

In fact, the only thing that can be derived from the legislative history is that it is not only necessary that the new and distinct variety of the plant shall have been invented or discovered but that *to obtain a patent* it is necessary that the plant shall have been asexually reproduced prior to the application for patent. This is perfectly logical since it is only by asexual reproduction through succeeding generations that the distinguishing characteristics of the new variety can be confirmed. However, as in the case with other classes of invention, "patentability shall not be negatived by the manner in which the invention was made", 35 U.S.C. 103.

The court's conclusion that legislative history reference to asexual reproduction "informs the scope of protection" is amazing. How does requiring asexual reproduction before application for patent direct the meaning of variety"? How does a requirement for applying for patent protection affect the scope of the patent grant? Does a requirement for conception and reduction to practice (actual or constructive) affect the scope of a utility patent claim?

5. The next legislative history excerpt in *Imazio* discusses that the patent right granted concerns asexual reproduction as distinguished from sexual reproduction but, once again, Congress refers to "variety", not a single plant:

> The legislative history further states that [w]hether the new variety is a sport, mutant, or hybrid, the patent right is a right to propagate the new variety by asexual reproduction. It does not include the right to propagate by seeds. This limitation in the right granted recognizes a practical situation and *greatly narrows the scope*

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of the bill. Whether the new variety is a hybrid, mutant or sport, there is *never more than one specimen of it produced except through asexual reproduction.* For example, without asexual reproduction there would have been *but one* true McIntosh or Greening apple tree. These *varieties* of apples could not have been preserved had it not been through human effort in the asexual reproduction of the two original trees. They could not have been reproduced true to the type by nature through seedlings. (Court's emphasis).

Unfortunately, the court does not pursue this excerpt further, if it did, it would have found the following:

The bill, therefore, proposes to afford through patent protection an incentive to asexually reproduce new *varieties.* Many varieties of apples equally as valuable as the McIntosh or Greening have undoubtedly been created and disappeared beyond human power of recovery because no attempt was made to asexually reproduce the new varieties. *The present bill by its patent protection proposes to give the necessary incentive to preserve new varieties.* (emphasis added).

6. The last quotation from the legislative history merely repeats that plants sought to be patented:

"... must be asexually reproduced in order to have their identity preserved ...".

None of the legislative history referred to in *Imazio* contain any support whatsoever for the notion that the plant patent grant does anything but provide the right to exclude others from asexually reproducing the variety, even though the word "variety" is not expressly included in 35 U.S.C. 163, since the patent right available under 35 U.S.C. 161 is for a new "variety". In fact every legislative history excerpt in the *Imazio* decision actually supports a completely opposite conclusion than that reached in this decision. Furthermore, no where in the decision does the Court discuss or otherwise refute that the term "variety" should be construed other than in a technical, taxonomical sense and should be interpreted to encompass more than just clones of a single plant.

The principal justification for the court's decision rests in a conclusion that the requirement for asexual reproduction for *patentability* somehow requires the term "variety" to be defined in terms of a single plant and ultimately the court concludes that:

Due to the asexual reproduction prerequisite, plant patents cover a single plant and its asexually reproduced progeny.

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INFRINGEMENT

As a consequence of the conclusion, the court states that the scope of the claim of the patent is "asexual progeny" of the plant shown and described in the patent specification. Thus, the court disagreed with the District Court's holding that infringement is shown if the patentee can prove that the alleged infringing plant has the same essential characteristics as the patented plant. Now, according to the appellate court, for purposes of plant patent infringement, the patentee must prove that the alleged infringing plant is an asexual reproduction, i.e., that it is a progeny of, the patented plant. To support this decision, the court refers to various commentaries but this is nothing more than an attempt to justify the decision by relying on the views of others rather than independent analysis which should form the basis of any court decision, especially one as far reaching as this. The decision should be based on analysis, not by a vote of commentators. Furthermore, the appellate court did not include the "vote" of the *Imazio* trial court or the trial court that decided *Pan American Plant Co., v. Matsui*, 198 U.S.P.Q. 462 (N.D. Cal. 1977) which interpreted the law the same as the *Imazio* trial court.

Having concluded that the statute requires asexual reproduction of the patented plant for there to be infringement, it therefore followed in the court's judgment that a defense of the plant patent infringement is that the alleged infringing plant is not an asexual reproduction of the patented plant. Unfortunately, this then requires the patent owner to prove that the accused plant(s) is derived from the plant which was the basis for filing the plant patent application.

INDEPENDENT CREATION

Nothing better illustrates the inadequate analysis reflected in *Imazio* than the discussion that independent creation is a defense to plant patent infringement. The trial court reasoned that it would be hard for a patentee to refute evidence of independent creation because all such evidence would be in defendant's control. However, this rational and uncontrovertible statement of the trial court is rejected by the appellate court "*because it is contrary to the plain meaning of the statute.*" What plain meaning of the statute? Most of the *Imazio* decision discusses alleged ambiguity of the statute in use of the terms "variety" and "plant" in different sections of the law. Moreover, the court itself indicates the difficulty it had in determining which interpretation of the statute it should accept. In fact, it is acknowledged that the Plant Patent

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Act does not define "variety" and it is thus necessary "for this court to review the legislative history for guidance". Therefore, how can the appellate court reject the trial court's reasoning out-of-hand because it is not based on the "plain meaning of the statute"?

WHAT ELSE IS WRONG WITH THE APPELLATE COURT'S ANALYSIS IN *IMAZIO*

The *Imazio* decision does not follow the basic rules of statutory construction. The phrase "variety of plant" in Section 161 must mean something other than a single plant for this section to have meaning. Congress in 1930, could not have intended proof of genetic identity to be a requisite for plant patent infringement. The requirement of asexual reproduction to obtain a plant patent does not alter the meaning of "variety."

A. The basic rule of statutory construction is that, absent a clearly expressed legislative intention to the contrary, words in a statute are to be interpreted according to their ordinary meaning.[3] "Congress is presumed to have known the basic rules of statutory construction when enacting legislation".[4] Therefore, to presume that Congress did not mean that the term "variety" should be interpreted according to its ordinary and accepted meaning is a fundamental flaw of the decision. As used in Section 161, "variety" is not an ambiguous term, it is a taxonomical classification below the category of "species". The term "variety" refers to a group of plants within a species which can be distinguished from other plants of the species by one or more observable characteristics. No accepted definition requires identity among the plants in a variety, a single plant has not and has never been the ordinary meaning of "variety". Congress should be presumed to have included the phrase "variety of a plant" in Section 161 for a reason and that these words have meaning.[5]

If Congress had intended the scope of a plant patent to be limited to a single plant and its genetically identical asexually reproduced progeny, it would have been a simple matter to use the word "plant" instead of "variety" in Section 161. Interpreting variety to mean a single plant

3 *American Tobacco Co. v. Patterson*, 102 S. Ct. 1534 (1982).

4 *Quaker State Oil Refining Corp. v. U.S.*, 994 F.2d 824, 832 (Fed. Cir. 1993), rehearing in banc, denied, (1993).

5 *United States v. Merrasche*, 75 S. Ct. 513 (1955). "It is our duty 'to give effect, if possible, to every clause and word of a statute' . . ." (Quoting *Montclair v. Ramsdell*, 2 S. Ct. 391 (1883)).

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renders the phrase "variety of plant" in Section 161 superfluous.[6]

B. Inventors of other classes of invention are granted the rights under the patent law to exclude others from making, using or selling the claimed invention. Independent development of an invention by an accused infringer is irrelevant to the enforcement of a utility patent.[7] However, contrary to congressional intent, the interpretation of the plant patent law in *Imazio* establishes, rather than removes, discrimination between inventors of plant inventions and inventors of other forms of invention. Placing a burden upon the plant patent holder to prove genetic identity between the accused and the patented plants and permitting a claim of independent creation as a defense to plant patent infringement denies plant breeders crucial protection which is available for other classes of invention. Congress specially stated that, "except as otherwise provided, laws pertaining to patents for inventions apply to patents for plants". If Congress meant to carve out an exception to the general patent law permitting independent creation to be a defense to a claim of plant patent infringement it would have said so, and it did not. Since the statute makes it clear that the general patent law applies to plant patents (Section 161), why then should a defense not accepted for other infringement of patents be permissible for plant patents?

C. Perhaps the greatest fallacy of the *Imazio* decision is that Congress could not possibly have intended proof of genetic identity or derivation to be a requirement to establish plant patent infringement. At the time the law was enacted in 1930 there were no tests or technology available that could prove conclusively that two plants were genetically identical. Therefore, if genetic identity was intended to be the burden of proof, the only way that a plant patentee could prove infringement of an accused plant in 1930 was to show actual derivation by tracing a chain of propagation from patentee's stock of plants. This is a virtually impossible burden of proof. Unless the accused infringer admitted derivation or there were eyewitnesses who could and would establish derivation, it would be next to impossible to show genetic identity. There is nothing in the legislative history suggesting any intent to place such an impossible burden on a plant patent owner. On this issue the trial court's reasoning reflects more common sense:

6 35 U.S.C. 271(a) Infringement of Patent

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell or sells any patented inventions, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

7 *Kewanee Oil Co., v. Bicron Corp.*, 94 S.Ct. 1879 (1974).

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This court does not believe that independent creation is a proper defense to patent infringement and, for that reason, adopts the standard enunciated in *Pan-Am.* It has been long recognized that the public interest is served by encouraging aggressive discovery. That is why patents are intended not only to reward the patentee for his discovery or invention, but also to reward him for quickly completing it. But if the economic rewards flowing from a patent were subject to erosion by an undeterminable number of subsequent inventors who could show independent creation, the potential inventor may not be as willing to invest large quantities of time and money pursuing his ideas. Moreover, there is more risk that the courts' recognition of an independent creation defense would inadvertently entice deliberate infringement, with a fraudulent defense of independent creation asserted. This defense would often prove difficult to rebut, since the evidence will generally lie exclusively within the control of the person asserting the defense.

D. The *Imazio* court was also not impressed with the fact that the Plant Variety Protection Act (PVPA) of 1970 uses the term "variety" just as the Plant Patent Act. However, as stated by the U.S. Supreme Court in *Asgrow Seed Co. v. The Winter Boer*, 115 S. Ct. 788, 790 (1995), the PVPA was intended to provide "patent like protection to novel varieties of sexually reproduced plants (that is, plants grown from seeds) which parallels the protection afforded asexually reproduced plant *varieties* (that is, *varieties* reproduced by propagating or grafting) under Chapter 15 of the Patent Act". (emphasis added).

Sexually reproduced offspring do not have the same genetic identify as their parents. Accordingly, genetic identity is not and cannot be a requirement for a group of plants to constitute a "variety" under the PVPA. All that is required is that the plants have the same essential and distinctive characteristics. This is clear from the definition of the term variety.[8] According to the PVPA definition, the term variety means "a plant grouping within a single botanical taxon of the lowest known rank that, . . . can be defined by the expression of characteristics resulting from a given genotype or combination of genotypes distinguished from any other plant grouping by the expression of at least one characteristic and considered as a unit with regard to the suitability of

8 PVPA at 7 U.S.C. § 2401(a)(9) (Supp 1995):

The term "variety" means a plant grouping within a single botanical taxon of the lowest known rank, that, without regard to whether the conditions for plant variety protection are fully met, can be defined by the expression of the characteristics resulting from a given genotype or combination of genotypes, distinguished from any other plant grouping by the expression of at least one characteristic and considered as a unit with regard to the suitability of the plant grouping for being propagated unchanged. A variety may be represented by seed, transplants, plants, tubers, tissue culture plantlets, and other matter.

This definition is entirely consistent with the definition of cultivated variety (cultivar) in the international Code.

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the plant grouping for being propagated unchanged''. This definition is entirely consistent with the definition of cultivated variety (cultivar) in the International Code of Nomenclature.

Where Congress uses the same form of statutory language in different statutes having the same general purpose, courts normally presume that Congress intended the same interpretation to apply in both instances.[9] However, the *Imazio* court concluded that the two statutes differed significantly in their purpose, i.e. asexual reproduction vs. sexual reproduction, and therefore concluded that Congress did not intend the term ''variety'' to have the same meaning in both statutes. It is obvious that it is not correct that the statutes have different purposes; they differ only in the subject matter covered by the laws and the statement is inconsistent with *Asgrow*; ''to provide patent-like protection to novel varieties of plants''. Furthermore, the PVPA provides that it is an infringement of the right granted by the PVPA to

> perform any of the foregoing acts in even instances in which the novel *variety* is multiplied other than sexually, except in pursuance of a valid United States plant patent . . .

That a novel *variety* which is the subject of protection under PVPA could be multiplied in the pursuance of a valid plant patent'' is recognition that a valid plant patent could coexist with a PVPA Certificate of protection on the same variety which could only be true if ''variety'' is interpreted in the same manner in both statutes.[10]

Under the Federal Circuit's interpretation, a plant patent and PVPA protection could not coexist on the same ''variety'' because the *Imazio* decision says that term means something different in each statute. Thus, according to *Imazio* each of the many genetically dissimilar plants of a variety protected under PVPA would constitute a separate and individual variety under the Plant Patent Act and thus, if asexually reproducible, would require many plant patents to cover under the Plant Patent Act what one Certificate of Protection covers under the PVPA.

E. Another issue not considered in the *Imazio* decision is the plant patent claim. As indicated in 35 U.S.C. 163:

> The claim in the specification shall be in formal terms to the plant shown and described.

9 *Northcross v. Board of Education*, 93 S. Ct. 2201 (1973).

10 A Certificate of Protection is the official grant under the PVPA.

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Thus, a plant patent applicant has little flexibility in crafting a claim for the application. Moreover, in practice, most plant patents have claims that include the language "substantially as shown and described" which has historically been accepted by the Patent and Trademark Office as satisfactory compliance with 35 U.S.C. 163. In the *Imazio* case, the claim in U.S. Plant Patent No. 5,336 was as follows:

> 1. A new variety of Heather persoluta, *substantially as herein shown and described* particularly characterized by its profuse production of blooms over the entire length of the stem beginning early in December." (emphasis added).

Though the appellate court in *Imazio* acknowledged and reproduced the sole claim of U.S. Plant Patent No. 5,336, there was no discussion of the effect of the claim in determining infringement, notwithstanding that it is well settled patent law that the claims are the measure of the invention. "Claims may not be construed one way in order to obtain allowance and in a contrary way against infringers"[11], and, it would be hoped, vice versa.

Had Section 163 and the *Imazio* plant patent claim been properly considered, it would have been clear that: 1) Congress did not establish proof of derivation as a requirement for infringement and, 2) that the trial court standard setting the burden of proof for infringement as requiring a showing that the accused plant had the "same essential characteristics" as the patented variety, was correct.

Since it is undisputable that no absolutely effective technology existed in 1930 when the first plant patent statutes were enacted in law, there was no capability to determine the derivation or genetic identity of a plant. It is therefore incredible that this requirement is presumed to have been the intention of Congress. However, since the law also provides that the patent claim should be for the plant "as shown and described", absent a genetic description in the plant patent itself there could be no expectation that the scope of the plant patent claim should be defined in terms of descriptive information not already present in the patent. Furthermore, the fact that the PTO allows latitude in connection with the claiming of the plant variety, i.e. "*substantially* as shown and described", it is more than reasonable to conclude that the PTO itself regards the patent claim as not being limited only to the precise description of the plant in the application. This is entirely logical since it is clear that phenotypic expression may vary with variations in environmental and cultural conditions which would occur even among

11 *Tandon Corp. v. U.S. Int'l Trade Comm.*, 4 U.S.P.Q. 2d (Fed. Cir. 1987).

HeinOnline -- 79 J. Pat. & Trademark Off. Soc'y 527 1997

known genetically identical plants. The *Imazio* appellate court did not explain why an accused plant that was embraced by the claim of U.S. Plant Patent No. 5,336 was nonetheless outside the scope of the claim for infringement purposes. Thus, the court totally ignored the affect of the patent claim on the question of infringement, a practice not acceptable with respect to patents for other classes of invention, and notwithstanding the explicit instruction in the statute that the provisions of the title relating to patents for inventions shall apply to patents for plants, except as otherwise provided. Nothing in the statutes in fact provides otherwise with respect to patent infringement and claim construction or interpretation. Is a DNA "fingerprint" now required to provide a full description of the variety in a plant patent?

CONCLUSION

At a time when the creation of new plant varieties exhibiting valuable characteristics such as higher yields, improved disease resistance, increased production of particular chemicals, and even new esthetically pleasing plants and flowers, are being and will continue to be developed, the *Imazio* appellate decision significantly contradicts the precise purpose for which the Plant Patent Law was enacted. The Plant Patent Act was intended to encourage developers of new varieties by rewarding them with the right to exclude others from asexually propagating that variety. The Federal Circuit's ruling diminishes that reward immeasurably. If plants having the same essential characteristics as the patented variety can be produced by others with impunity, the plant patent does not provide the exclusive right which the Plant Patent Act was intended to grant. Not only does this result fail to provide the incentive to develop new plant varieties, it jeopardizes the plant patent system and, indirectly, the entire patent system. It is also contrary to the spirit of Article 1, Section 8, of the U.S. Constitution which established the basis for granting patents to inventors and discoverers.

Since the U.S. Supreme Court has decided not to consider the *Imazio* appellate decision, the only remedy available is through legislation. A simple amendment to the Plant Patent Act to replace the word "plant" in 35 U.S.C. 163 (and 35 U.S.C. 162) with the term "variety" would make it difficult for a future court to repeat the illogic of the *Imazio* appellate decision and would provide plant patents with the scope to which they are entitled.

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