United States Copyright Office
Library of Congress · 101 Independence Avenue SE · Washington, DC 20559-6000 · www.copyright.gov

October 26, 2011

Nishan Kottahachchi, Esq.
Cooley, Godward & Kronish, LLP
777 6th St. NW
Washington, DC 20001-3703

Re: FISCINNE, SR1-82423069
FISVINCI, SR1-82423037
Correspondence ID: 1-4UGPVE

Dear Mr. Kottahachchi:

On behalf of the Copyright Office Review Board I am responding to your request for reconsideration of the Registration Program's refusal to register two genetically produced Poinsettia plants. The copyright claims are submitted on behalf of your client Syngenta Participations AG. The deposit is photographs of two distinct Poinsettia plants. The photographs are clearly copyrightable as photographs. However, your correspondence makes it clear that you are not seeking registration for the photographs. The letter submitted with your original application stated you were "seeking copyright protection for the visual appearance of the plants themselves." In your letter for second reconsideration you state "applicant claims authorship of the actual genetically modified plants." The Review Board has carefully examined and reviewed all the arguments submitted in support of registration of these two plants. The Board has concluded that neither the visual appearance of the living plants or the genetic modifications of the plants can be considered "original works of authorship fixed in any tangible medium of expression..." as provided in section 102(a) of the copyright law. Instead, these two living plants are "discoveries" excluded under section 102(b) of the copyright law. For these reasons, the Board affirms the denial of registration.

I. ADMINISTRATIVE RECORD

A. Initial submissions

On July 30, 2008, two VA applications, a cover letter, and photographs of two Poinsettia plants were hand delivered to the Copyright Office. The cover letter the Copyright Office received from you stated that the copyright claimant was "seeking copyright protection for the visual appearance of the plants themselves." The letter further clarified that the VA form was used "because no other Copyright Office form or option on the form is suitable for these types of works." Letter of Kottahachchi to Copyright Office of 7/30/2008 at 1.

On December 9, 2009, Joy Burns, Registration Specialist in the Visual Arts Division, wrote you a letter refusing registration because the living plants lacked the authorship necessary to support a copyright claim. Letter from Burns to Kottahachchi of 12/9/2009 at 1. She stated that copyright protects original works of authorship that are fixed in some physical form. Citing *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), she stated that the term "original" meant that the work was independently created by the author (as opposed to copied from other works), and that it possessed at least a minimal degree of creativity. In order to satisfy the requirements, she said that works of the visual arts must contain a minimum amount of pictorial, graphic or sculptural

authorship. She clarified further that copyright does not protect coloring, familiar shapes, symbols and designs, and, citing to section 102(b) of the copyright law, copyright could not extend to any idea, concept, system, or process which may be embodied in a work. In closing, she stated that the term "authorship" implies that, for a work to be copyrightable, it must owe its origin to a human being, and that materials produced by plants or animals are not copyrightable.

B. First request for reconsideration

By Memorandum dated March 9, 2010, Peter Willsey of your firm sought reconsideration of the refusal to register. Memorandum from Willsey to the Copyright Office of 3/9/2010 at 1. He began by stating that the two plant varieties satisfied the copyright requirements of fixation, originality, and authorship necessary to obtain copyright protection. *Id.* at 1.

He recited the definition of fixation in section 101 of the copyright law, and asserted that the specialist did not dispute fixation. *Id.* at 2. He stated that both the hybrid Poinsettia and the induced mutated Poinsettia "are sufficiently permanent and stable physical forms that permit the Works to be perceived by a consumer for a period of weeks or even months depending on the life of the plants, which is clearly more that the transitory duration required by the Copyright Act. *Id.* at 2. He further argued the Works satisfied the fixation requirement because the plants could reproduce, pointing out that both had obtained patents in which the ability of reproduction was one of the primary requirements. *Id.* at 3.

He stated that the Works satisfy the originality requirement because the plants were independently created by the Applicant. Additionally, he asserted the plants met the minimal degree of creativity because the plants were not found in nature, and they combined a number of visual features in a creative way. *Id.* at 4. He clarified the Fisvinci Hybrid Poinsettia Plant was bred to exhibit certain visual features, while Fiscinne Induced Mutated Poinsettia was created by induced mutation, also to produce certain visual effects. *Id.* at 4.

He declared the applicant was "author" of the plants because they owed their existence to the author. *Id.* at 6. He elaborated that the plants came to existence only as a result of the author's independent efforts to create new and unique Poinsettia plants through hybrid breeding and induced mutation.

On July 8, 2010, Ms. Virginia Giroux-Rollow, Attorney Advisor for the Registration and Recordation Program, responded to your first appeal for reconsideration of the refusal to register. Letter from Giroux-Rollow to Kottahachchi of 7/8/2010 at 1. Ms. Giroux-Rollow began by stating that the Copyright Office was unable to register the two plants because plants, like human beings and animals, are living things not subject to copyright protection, citing section 102(a) of the copyright law. *Id.* at 1.

Referring to Mr. Willsey's references to the patent law, she stated that it did not follow that because a work was entitled to patent protection, it is necessarily copyrightable. *Id.* at 1. She also referred to section 102(b) of the copyright law, excluding from copyright "any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." While stating"that the breeder is the author of the genetically induced process" and "that the resulting plants were fixed in their expression" she nevertheless concluded the "living plants, like a human being or an animal,

which in some cases are produced through a genetic process, are simply not subject matter for copyright protection." *Id.* at 1-2.

Ms. Giroux-Rollow distinguished *Prestige Floral v. California Artificial Flower Co.*, 201 F. Supp. 287 (S.D.N.Y. 1962) cited by Mr. Willsey as involving a three-dimensional sculpture of a likeness of a lilac flower, which was very different from the living plant. *Id.* at 2. In closing, she stated the two living plants you were seeking to register were not among the categories of works listed in section 102(a).

C. Second request for reconsideration

In a Memorandum dated October 8, 2010, you appealed for second reconsideration to this Board presenting a number of arguments supporting registration. Memorandum of Kottahachchi to the Review Board of 10/8/2010 at 1. You contend that the sole basis for refusal to register was the conclusion that "plants, like human beings and animals are 'living things' that are not subject to copyright." You dispute this conclusion by asserting that section 102(a) does not contain any prohibition against copyright protection for genetically modified plants. *Id.* at 1.

You state that the primary basis of rejection in the first reconsideration was the lack of a category specifically specifying living plants. You criticize this position by arguing that "creating genetically modified plants did not exist when the Copyright Act was passed into law, and that Congress intended the categories to be "illustrative and not limitative," citing Nimmer on Copyright. *Id.* at 1-2.

You argue further that the Copyright Office's Circular 1 provides that the categories are "viewed broadly." You assert that it is telling that computer programs are considered "literary works" and maps and architectural drawings fall within the category of "pictorial, graphic, and sculptural" works. *Id.* at 2.

You state that while you recognize that your client's living plants "are novel works of authorship, unlike the more traditional works that are commonly registered by the Copyright Office," there was no justification provided for the rejection other than that the works were living plants. *Id.* at 3. You assert that the Copyright Act and legislative history supports registration of the living plants since "they are a form of new creative expression that satisfy the requirements of authorship, originality, and fixation necessary for copyright protection." *Id.* at 3.

In part II of your Memorandum, you argue that the requirement of authorship has been satisfied because your client claims authorship of the actual genetically modified plants, and not the process of hybrid breeding or induced mutilation. Citing the Memorandum written in the first reconsideration, you state that "plant breeding is largely an artistic and creative endeavor very much akin to sculpting or painting." *Id.* at 5.

In part III of your Memorandum, you assert that originality is satisfied and that *Prestige Floral v. California Artificial Flower Co.,* 201 F. Supp. 287 (S.D.N.Y. 1962) directly supports the conclusion that the plants are copyrightable. You begin by pointing out that Ms. Giroux-Rollow did not challenge originality. You then state that extending copyright to the plastic lily in *Prestige Floral* was new at the time, and when challenged, the Court looked to "analogous situations," such as statutes of dogs, and floral designs, to uphold the copyright. Likewise, you reason that the

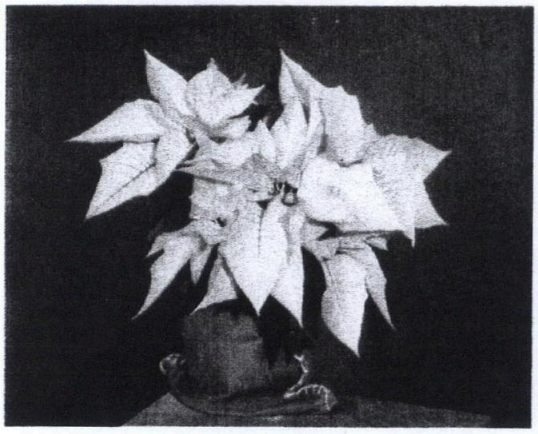
likenesses of these genetically modified Poinsettia plants are new, and yet have been created by exercising "independent artistic judgement and technical skill in hybrid breeding and induced mutation to create a new form of creative expression -unique and original modified living Poinsettia plants that are substantially different from any naturally occurring plants." *Id.* at 7. Like extending protection to the newly available plastic lily, a similar extension, you conclude, should be provided to these two new plant varieties.

In part IV of your Memorandum, you argue that your client's living plants are fixed"because the plants are reproducible and thus fixed." You clarify that you are not arguing that the plants are copyrightable because they received a patent, and you assert that Giroux-Rollow conceded fixation. *Id.* at 8. In closing, you state that your client has "conclusively demonstrated that it has met the requirements of fixation, originality, and authorship necessary to obtain copyright protection for the Works." *Id.* at 8.

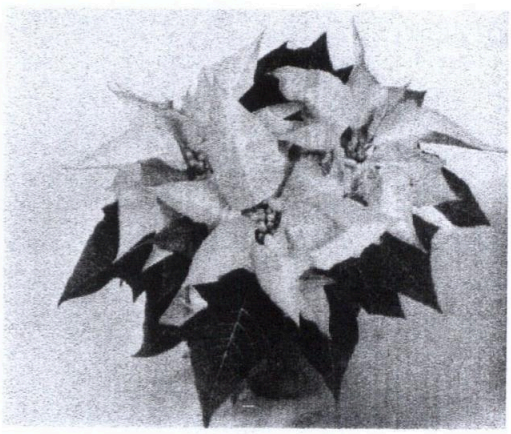
II. DECISION

A. Reproduction of the work

Before proceeding with our discussion of the Review Board's determination, we provide below reproductions of the photographs deposited depicting the likeness of the two varieties of Poinsettia on which copyright is being sought.



FISCINNE



FISVINCI

B. Nature of the Copyright Claim.

In considering second requests for reconsideration, the Review Board conducts a de novo review which takes a fresh look at issues concerning whether the copyright claim in issue can be registered. The Board studies carefully the deposit of the work, and the arguments raised by the applicant and the two staff members who previously considered registration of the claim. As you acknowledged in your Memorandum in support of your second request reconsideration, your application for registration of living plants presents a claim for "novel works of authorship, unlike

the more traditional works that are commonly registered by the Copyright Office." Memorandum at 3. Both the examiner and the Attorney-Advisor concluded that living plants could not be the proper subject of copyright. The Review Board agrees with this conclusion, and this letter will provide a more detailed statement of the authorities supporting this position.

In studying your various statements concerning these applications, it appears to the Review Board that you are advancing two alternative bases of protection. First, you seek protection for the general appearance of the two plants, arguing the appearance is attributable to genetic modifications created by your client. Second, your emphasis on having created "genetically modified plants" unknown to nature implies that you may be seeking protection in the genetic code of the plants. Under either theory, copyright protection can not be extended.

1. Genetically modified plants are not works of authorship under section 102(a), but instead discoveries under section 102(b).

(a) Background

Applying principles of federal intellectual property protection to the creations of humans requires an analysis as to the purpose of the creation. This is evident from the language of Article I, Section, Clause 8 of the U.S. Constitution, which grants Congress the power:

> To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Under this clause, a clear dichotomy is drawn between authors who promote the useful arts through their writings, and inventors who promote the progress of Science through their discoveries. The Supreme Court has been making clear that this dichotomy exists since the founding of the nation.

Baker v. Selden, 101 U.S. 99 (1979), addressed the separate domains of patent and copyright. *Baker* decided whether a copyright in a book describing a system of book-keeping could be extended to protect the system itself. Due to the distinction between the patent law and the copyright law, the court held that it could not. The Court expressed its reasoning as follows:

> To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government.

Id. at 102.

* * * * * * * * *

> The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters-patent.

Id. at 105.

* * * * * * * * *

> This conclusion to which we have come is that blank account-books are not the subject of copyright; and that the mere copyright of Seldon's book did not confer upon him the exclusive right to make and use account-books, ruled and arranged as designated by him and described and illustrated in said book.

Id. at 107.

The basic principles articulated in *Baker* were restated in the landmark decision of *Feist Publications v. Rural Telephone Service Co.*, 499 U.S. 340 (1991). While your letter in support of your second request for reconsideration relies heavily upon statements made by the *Feist* court, you failed to cite important statements by the Court regarding the uncopyrightability of facts. On this issue, *Feist* states as follows:

> No one may claim originality as to facts. This is because facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discover its existence. To borrow from *Burrow-Giles [Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).], one who discovers a fact is not its "maker" or "originator." The discoverer merely finds and records.

Id. at 347 (citations and quotation marks omitted).

In a similar vein, Professor Nimmer explains in his copyright treatise:

> The "discoverer" of a scientific fact as to the nature of the physical world, an historical fact, a contemporary news event, or any other "fact," may not claim to be the "author" of that fact.... The discoverer merely finds and records. He may not claim that the facts are "original" with him, although there may be originality in the manner of reporting, *i.e*, the "expression," of the facts. As copyright may only be conferred upon "authors," it follows that discoveries as facts *per se* may not be the subject of copyright.

1-2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.03[E] (2008).

(b) Section 102 of the 1976 Copyright Act.

Section 102(a) establishes copyright protection "in original works of authorship fixed in any tangible medium of expression, now known or later developed,..." Both the House and Senate Reports on the 1976 Act provide that this statutory language "is intended to incorporate without change, the standard of originality established by the courts under the present copyright statute." H.R. Rep. No. 94-1476, 94th Cong. 2d Sess. p.51(1976); S. Rep. No. 473, 94th Cong. 1st Sess. p.50 (1975).

Both Congressional Reports make the subtle point that authorship identified in the list of categories which is presented in different formats as the result of technological advancement is to be accorded protection under the copyright law, while completely new forms of authorship must wait for Congressional amendment to the copyright law in order to receive protection. This basic position is stated in the Reports as follows:

> The history of copyright law has been one of gradual expansion in the types of works accorded protection, and the subject matter affected by this expansion has fallen into two general categories. In the first scientific discoveries and technological developments have made possible new forms of creative expression that never existed before. In some of these cases the new expressive forms – electronic music, filmstrips, and computer programs, for example – could be regarded as an extension of copyrightable subject matter Congress had already intended to protect, and were thus considered copyrightable from the outset without the need of new legislation. In other cases, such as photographs, sound recordings, and motion pictures, statutory enactment was deemed necessary to give them full recognition as copyrightable works.
>
> Authors are continually finding new ways of expressing themselves, but it is impossible to foresee the forms that these new expressive methods will take. The bill does not intend either to freeze the scope of copyrightable technology or to allow unlimited expansion into areas completely outside of the present congressional intent. Section 102 implies neither that the subject matter is unlimited nor that new forms of expression within the general area of subject matter would necessarily be unprotected.
>
> The historic expansion of copyright has also applied to forms of expression which, although in existence for generations or centuries, have only gradually come to be recognized as creative and worthy of protection. The first copyright statute in this country, enacted in 1790, designated only "maps, charts, and books"; major forms of expression such as music, drama, and works of art achieved specific statutory recognition only in later enactments. Although the coverage of the present statute is very broad, and would be broadened further by explicit recognition of all forms of choreography, there are unquestionably other areas of existing

> subject matter that this bill does not propose to protect but that future Congresses may want to.

H.R. Rep. at 51-52; S. Rep. at 50-51. "The distinction drawn in the statute is one between new ways of expressing currently copyrightable subject matter and new subject matter, the former being protected without the need for statutory revision, the latter requiring an amendment." 2 Patry on Copyright § 3:60 (2011).

You contend that "the science involved in creating genetically modified plants did not exist when the Copyright Act was written and passed into law decades ago." Kottachachchi Memorandum at 1. This assertion is your primary explanation for the failure of Congress to designate a specific category for "living plants" in section 102(a) of the copyright law. Even if this questionable assertion were correct, the above Congressional Reports make clear that unless living plants "could be regarded as an extension of copyrightable subject matter Congress had already intended to protect," there would be no basis for extending copyright protection to living plants.

Moreover, it seems clear that production of different plant varieties had been in existence for many years before Congress enacted the 1976 Copyright Act. In 1930, Congress enacted the Plant Patent Act to protect novel asexually reproduced plant varieties. B. Wright, *Plant Genetic Engineering and Intellectual Property Protection,* University of California, Division of Agriculture and Natural Resources (2006) at 1. Your client has secured plant patent protection under this Act for both varieties of Poinsettia plants. In 1970, Congress enacted the Plant Variety Protection Act of 1970, giving breeders up to 25 years of exclusive control over new, distinct, uniform, and stable sexually reproduced or tuber propagated plant varieties. 7 U.S.C. §§ 2321-2582. As a result, Congress enacted intellectual property legislation specifically dealing with plant varieties twice before the 1976 Copyright Act was enacted. Moreover, the Memorandum of Mr. Willsey in characterizing the "authorship" behind plant breeding cites to Allard, *Principles of Plant Breeding* (1960) and Lewis, *The Science of Plant Breeding*, NATURE (1945). Willsey Memorandum at 9. Since these works were published respectively in 1960 and 1945, it appears clear that the science of breeding plants was within the scope of knowledge in 1976 when the Copyright Act was enacted.

The conclusion that section 102 excludes new varieties of living plants is reinforced by the exclusion of "discoveries" in section 102(b). The exclusions enumerated in section 102(b) were inserted into the statute by an amendment of the Revision Bill in 1969. General Revision of the Copyright Law, S. 543, 91st Cong. 1st Sess. [Committee Print] (December 10, 1969). Section 102(b) provides:

> In no case does copyright protection of an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

Although both decisions below relied in part on section 102(b), your letter in support of your second request for reconsideration contains no discussion of that section, so no argument has been presented to the Review Board as to why this provision does not squarely apply to these two new plant varieties. You have identified what you believe is your client's authorship as "a combination of the technical expertise and artistic judgment used to create, select, and cultivate new, unique, and

aesthetically pleasing visual details in Poinsettia plants, which are not ordinarily found in nature and which would not exist but for Applicant's skill in hybrid breeding and induced mutation." Kottachachchi Memorandum at 5. The applicant has made discoveries of two new plant varieties, and as discoveries they are precluded from copyright protection by virtue of section 102(b). Moreover, the genetic coding, which apparently has been modified by the experiments of Ms. Zerr, becomes a scientific fact once it is embedded in living issue. Finally, even if the exclusions for discoveries and scientific facts are momentarily forgotten, extending copyright protection to the living plants would create a monopoly for all the ideas behind Ms. Kerr's experiments, and would therefore be uncopyrightable by virtue of the merger doctrine. *See New York Mercantile Ex. v. Intercontinental Exchange*, 497 F.2d 109, 116-118 (2nd Cir. 2007).

2. Works of nature cannot support a copyright claim.

In asserting copyright protection for the general appearance of the two Poinsettia plants, you imply that the owner of the patent is the sole "author" of the appearance. As a living plant, however, its appearance is always changing, and is greatly affected by the environment, such as available light, watering, level of nutrients in the soil, age of plant, etc. Moreover, no matter how many of these two varieties are grown, no two plants of the same variety will ever be **identical** to another plant of the same variety. Even with similar genetic coding, each will have an individuality inherent in living things as they go through their life cycle. Authors of copyrightable works must be human; works owing their form to the forces of nature cannot be copyrighted. 2 William Patry, *Patry on Copyright* § 3.19 n.1 (2010). Similarly, *Compendium of Copyright Office Practices II*, § 202.02(b) (1984) provides as follows:

> Human author. The term "authorship" implies that, for a work to be copyrightable, it must owe its origin to a human being. Materials produced solely by nature, by plants, or by animals are not copyrightable.

Your Memorandum contends that the case of *Prestige Floral v. California Artificial Flower Co.,* 201 F. Supp. 287 (S.D.N.Y. 1962), in which a plastic lily was protected as a copyrightable sculpture, is a "closely analogous situation" to the two living plants in issue here. Memorandum at 7. The Review Board believes that the case is useful to show the vast differences between a sculpted plastic lily and a living plant passing through its life cycle. As regards the plastic lily, an artist sculpted the leaves and flower, and likely applied color to both. The shape and coloring of the sculpture was "fixed" in the plastic. While the authorship in this instance was relatively humble, it was none the less clearly sculptural authorship and deserving of copyright protection. With respect to the two new plant varieties, Ms. Zerr did not sculpt the leaves and flower, or add the color. That was done by natural processes inherent in living plants. The asserted "author" worked as a scientist to discover two new varieties of Poinsettia plants. Her technical skill may be far superior to that of the sculptor who created the modest plastic flower. However, the skill that was applied was of a different nature- that of an inventor. Discoveries are clearly addressed in the copyright law by an exclusion provided in section 102(b).

3. Analysis of the work

The application of principles of federal intellectual property protection to the creations of humans requires an analysis as to the purpose of the creation. This is evident from the language of

Article I, Section, Clause 8 of the U.S. Constitution providing as follows:

> To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Under this clause a clear dichotomy is drawn between authors who promote the useful arts through their writings, and inventors who promote the progress of Science through their discoveries. Courts have been making clear that this dichotomy exists since the founding of the nation. *See generally, Baker v. Selden*, 101 U.S. 99 (1979).

The deposit photographs capturing the likenesses of FISCINNE and FISVINCI are clearly copyrightable as photographs because the likenesses have been fixed in a tangible medium of expression. Moreover, textual works may be created explaining various matters relating to these two plant varieties and that expression would also be copyrightable. That too would constitute a work of authorship. In this instance, however, you are seeking protection in the creation of two new plant varieties. Such creation clearly falls within the realm of "discoveries" and is excluded by copyright protection from both the absence of any Congressional intent in section 102(a) to recognize protection, and the specific exclusion in section 102(b) for discoveries.

CONCLUSION

For the reasons stated above, the Copyright Office Review Board concludes that FISCINNE and FISVINCI cannot be registered for copyright protection. This decision constitutes final agency action.

Sincerely,

/S/

David O. Carson
General Counsel
for the Review Board
United States Copyright Office