Plant Patent Queries

By Robert Starr Allyn *

What is a "plant"?

"A vegetable, an organized living being, generally without feeling and voluntary motion, and having, when complete, a root, stem and leaves."

Is a rose blossom or a peach, a berry or a mushroom or a nut—a "plant" within the law?

Does a United States "Plant" Patent give its owner the right to exclude others from importing or dealing in flowers, fruits or nuts, and if not, why not? Does the patent cover both plant and fruit or flower—or is a Plant Patent like a machine patent limited to the producer and must we have an amendment to the Act to cover the product of the new Plant?

It certainly does not exclude others from reproducing by seed if they can, because the protection is limited to asexually reproduced plants.

If I own a piece of land and you plant a nut which produces an unusual tree and a third party finds a new nut on the tree—who is the inventor, you or I or the third party? If so, why? And if not, why not? Are we joint inventors?

Is the grant of a patent on a tree applied for after two years sale of the fruit barred? If the plant was sold before the passage of the Plant Act is it patentable?

If I produce a new flower by crossing two varieties and you duplicate it by the usual methods, are we joint inventors? If you modify a plant by treating the buds or other parts by X-Ray or otherwise and I reproduce it asexually, who is the inventor?

If you produce a new plant and then patent it and subsequently your supply is destroyed or if you refuse to supply such plants what becomes of your patent? How

---

* Patent Attorney, New York, N. Y.

HeinOnline -- 15 J. Pat. Off. Soc'y 180 1933

is the public benefited by the patent? Has the progress of the arts and sciences been promoted?

If the new fruit or flower was on the market prior to May 23, 1930 can a valid patent be granted for the "plant"?

Some of these queries sound rather foolish but most of them will have to be answered sooner or later.

Of course, initially the Commissioner of Patents is responsible for the administration of the law and his rules must be satisfactory to the Secretary of Commerce and the President has directed the Secretary of Agriculture to furnish all necessary technical assistance. The Townsend-Purnell Plant Patent Act was passed by Congress and approved by the President on May 23, 1930.

Prior to January 1, 1933 fifty-one patents have been granted.

Of these	Flowers predominate	=	31
	Fruits	=	13
	Berries	=	5
	Nuts	=	1
	Mushrooms	=	1

20 are for roses, 5 are for carnations, 4 are for freesias, 2 dahlias, 5 plums, 4 peaches, 3 cherries, 1 grapes, 2 strawberries, 1 dewberry, 1 barberry, 1 brambleberry, 1 mushroom and 1 pecan.

The earliest filing date of the issued cases is that of Patent No. 2, issued October 13, 1931, filed July 1, 1930 by Frank Spanbauer, of North Kansas City, Mo. This claims "a rose—predominantly distinguished by petals which are scarlet crimson in color, semi-double in appearance and in which the outer petals are inclined to be cordate in shape." This is described as developed by crossing a General Jacqueminot with a Richmond. It will be noted, however, that the claim purports to cover the flower and not the plant! Query—can we safely reproduce the plant or can the owner enjoin a florist who sells cut flowers in New York which were grown in New Jersey by someone else?

HeinOnline -- 15 J. Pat. Off. Soc'y 181 1933

The first patent to be granted August 18th, 1931 on an application of Henry F. Bosenberg, has had considerable publicity. This claims a climbing rose, characterized by its everblooming habit. It is said to be an improvement on the Dr. Van Fleet, to which the new plant is identical as respects color and form of flower, general climbing qualities, foliage and hardiness. The supposed novelty is an "everblooming habit." "The same everblooming habits may be attained by breeding this new quality into other varieties of climbing roses"—how? Not a single word can be found in the patent as to how this quality was attained or how it could be attained? Is this valid? Why was such a statement allowed in the patent? It does not seem to us that the patent complies with Section 4888 of the Revised Statutes. Of course, Section 2 of the Act provides, "No plant patent shall be declared invalid on the ground of non-compliance with this Section (4888) if the description is made as complete as is reasonably possible." This is quite elastic, but the patent seems to have exceeded the elastic limit.

Patent No. 10 also claims exactly the same characteristic of the everblooming habit, but here we find at least an effort to tell how to produce it—i. e., crossing Paul's Scarlet Climber with Gruss an Teplitz. This patent shows scarlet blossoms. Why was this application not placed in interference with the application for Patent No. 1?

Patent No. 28 also claims a climbing rose of everblooming habit. This rose is, however, yellow, obviously not to be confused with the scarlet rose of No. 10.

Roses said to be protected by Patents No. 1 and No. 10 are already being advertised in current newspapers.

Many of the Plant Patents purport to be for "sports" found by the applicant. Again we fail to see how these patents comply with the law. The law as originally proposed provided for patents "to anyone who finding an already existing plant reproduced the same asexually." The Commissioner of Patents in his memo of March 8, 1930 to the Secretary of Commerce plainly indicated that this was of doubtful validity under Article 1, Sec-

HeinOnline -- 15 J. Pat. Off. Soc'y 182 1933

tion 8 of the Constitution. The Bill was then amended and the report of the Committee on Patents said, "The Bill does not provide for patents upon varieties of plants newly found by plant explorers or others growing in an uncultivated or wild state." Obviously the asexual reproduction of a sport does not require invention.

The history of the Plant Act plainly shows that it was not intended to protect mere "finds." A sport not created by the act of the inventor is clearly not his invention and he can not make an invention out of it by merely asexually reproducing it by the usual methods. The reproduction does not make a new plant. This is obvious from the fact that in several cases the patentee clearly admits that the original was a sport of a certain variety of plant which was proved to be permanently new by the usual act of asexual reproduction. He has not produced something new from the sport, but has duplicated nature's sport and claims that sport. Patent No. 25 is a good example of this type of patent. A newspaper write-up of this beautiful rose appeared in *The Hartford Courant,* of January 3, 1932, indicating that the rose was one of nature's freaks or sports.

The crossing of two unnamed seedlings and the crossing of an unnamed seedling with the pollen parent Souvenir de Claudius Pernet may sound as if the applicant had tried to comply with Section 4888, but we must confess to complete inability to profit by such a description. And yet these histories are to be found in issued patents.

A failure to give any history of the development may constitute a powerful background for the defense of an independent inventor. Doubtless this feature must have been considered in drafting the application. Either the inventor had no information or preferred to leave the public in the dark, as would appear to be sometimes done by foreign solicitors.

Several patents have been granted for alleged inventions by the late Luther Burbank, who died in 1926. All of these carefully describe the characteristic of the fruit and the trees and carefully claim the trees as distinguished from the fruit but do not even suggest how they

HeinOnline -- 15 J. Pat. Off. Soc'y 183 1933

were produced. One rather naively claims, "The plum tree herein described, characterized by the early ripening period of the fruit, as shown"! Strange to say not only is the early ripening period not "*shown*"—but it is not even mentioned in the specification!

The Pecan Patent No. 47 claims the nut, not the tree. While this is not described as a "sport" it was found "on my father's farm," says the applicant. This was originally rejected as a "mere find." The case, however, was later allowed after the unique argument that "the sudden death of the father was the deciding factor in causing the application to be made out as a single name application." The father planted the nuts, the son observed and reproduced the new variety!

Patent No. 4 was the first utilitarian patent—on a Thornless Dewberry or "Youngberry." "The sport was discovered growing in a ten acre field of Young dewberries with the parent vines heavily covered with thorns and the discovery was made in the summer of 1928 on plant 1 and row 27 in a plot of ground known as Hayden field that is located about one mile west of Chino, California." We suppose they did the best they could to comply with Section 4888, but why did they not tell us what day it was and the weather and how it took two people to discover what already existed? It doubtless is a very useful plant, but does it comply with the law? And again does the patent cover the fruit or only the plant?

It would appear that the Patent Office has arbitrarily determined that the inventor of a new and distinct variety of Plant can only have a single claim as in Design Patents. The writer has never felt that the rule was fair in Design cases. It is especially harsh in Plant cases. Again Patents Nos. 1 and 10 are horrible examples. As pointed out, the claims of these two patents are substantially identical. If No. 1 was entitled to the claim as drawn it would appear that he should also be entitled to a claim for the modified Dr. Van Fleet, a pink rose. Then the owner of Patent No. 10 should be entitled to a sub-claim limited to the scarlet everblooming climber although his broad claim might be invalid in view

HeinOnline -- 15 J. Pat. Off. Soc'y 184 1933

of prior Patent No. 1. In the latter case No. 10 might disclaim his broad claim and still have protection on the scarlet climber. On the other hand, of course, No. 10 with the present broad claim might file a "trick" disclaimer except to the scarlet variety. The writer, however, does not approve trick disclaimers and agrees with Judge Tuttle in Trailer, 54 F. 2nd, 691, that they are invalid. Some day I hope that the Patent Office will decline to accept a trick disclaimer and force a court consideration of a mandamus.

While the horticulturist may have rather definite ideas as to what constitutes an "everblooming habit" we suspect that the legalist will not have any difficulty in developing a serious argument.

Then, too, we shall have nice questions for the experts. "A better flavor" may be an adequate characteristic for a patent, but we wonder who can describe it? Pray tell me, what does an onion taste like? Please describe the odor of the rose which you purchased on the 15th day of June 1932?

The possibilities of humor as to the "flowers that bloom in the spring" etc. are quite unlimited. Who will say that a patent may not be granted for a bread and milk plant produced by crossing a bread fruit tree with a milkweed by the dark of the moon?

An interesting question of infringement may also arise as to two cherry tree patents. The fruit of Patent No. 29 ripens from ten days to two weeks *later* than the true Montmorency and No. 30 ripens ten days to two weeks *earlier* than the Montmorency. As the ripening period, of course, depends upon the soil and climate it would appear necessary to grow a true Montmorency alongside of the alleged infringement in order to make the rather nice comparison.

Many of the flowers are extraordinarily beautiful and some of the patents show wonderful skill of the artist and the reproducer.

It seems clear to us that mere "found sports" are not within the intent of the law—and if they are, that the law transcends the Constitutional authority of Congress.

HeinOnline -- 15 J. Pat. Off. Soc'y 185 1933

It is obvious that many novel and interesting problems may have been started.

It doesn't seem to me that the flower or fruit necessarily goes with the plant, nor do I think Congress intended to protect the product of the plant. The question is, of course, enormously important. Process and machine patents do not protect the products. If it is possible to asexually reproduce the plant from the flower (or such part of the plant as goes with the flower) that is quite another question.

Dr. Joseph Rossman in an article published in the January 1931 issue of this JOURNAL discusses the background of the new law and many of its possibilities and also the Patent Office procedure.

Mr. Robert C. Cook, Editor of the *Journal of Heredity,* has some interesting comments on the subject of Plant Patents published in the *Journal of Heredity* in August 1930 and republished in this JOURNAL in January 1931, accompanied by a list of books on Plant Breeding and Heredity. Mr. Cook also has a very instructive article in the October 1931 issue of his Journal on the First Plant Patent.

Anyone wishing to get a better background of the new law should read up the reports of the Senate and House Committees, which considered the subject, i. e., Senate Report 315, April 2, 1930 on S. 4015, introduced by Senator John G. Townsend, Jr., of Delaware, and the House Report 1129, April 10, 1930, both of the 2nd Session of the 71st Congress, and also the extracts from the hearings of the House, dated April 9, 1930, on H. R. 11372, introduced by Congressman Fred S. Purnell, of Indiana.

Apparently Senate Bill 4015 superceded S. 3530. It also appears that House Bill 11372 superceded H. R. 9765 and that on May 13, 1930 the Chairman of the Patent Committee of the House obtained unanimous consent to take up Senate Bill 4015, which was then passed. A motion to reconsider was laid on the table and the record shows "a similar House Bill was laid on the table." Presumably the latter bill referred to was H. R. 11372.

HeinOnline -- 15 J. Pat. Off. Soc'y 186 1933