

PATENTS

EX PARTE HIBBERD: ANOTHER LANDMARK DECISION

NEW YORK—At long last, “everything under the sun made by man” (a phrase coined by the 82nd Congress) is potentially patentable. In October, the United States Patent and Trademark Office (PTO) reversed its 50-year stance, and ruled that plants *can* be patented under the general patent statute. The landmark decision, *Ex parte Hibberd*, complements the 1980 ruling (*Diamond v. Chakrabarty*) that microorganisms are patentable.

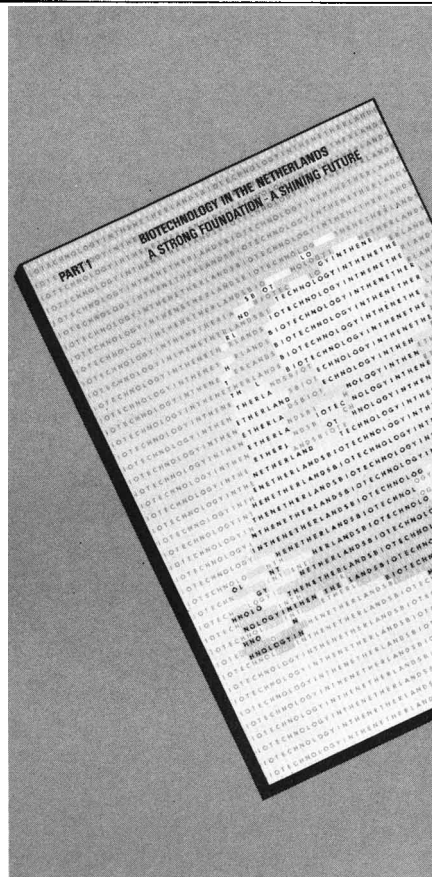
Section 101 of the general patent law includes a very broad definition of what can be protected by patents. In *Diamond v. Chakrabarty* the Supreme Court stated that living things created by man were not products of nature (which by definition are not patentable). Many patent practitioners concluded that the language and reasoning used by the Supreme Court are as applicable to inventions claiming plants as to those claiming microorganisms. The PTO, however, interpreted the statutes differently, and has been rejecting claims directed to plants, plant cells, and seeds as inappropriate subject matter for general patent protection. The PTO argued that the Plant Protection Act (PPA) of 1930 and the Plant Variety Protection Act (PVPA) of 1970 were created “to afford agriculture, as far as practicable, the same opportunity to participate in the benefits of the patent system as has been given industry.” The PTO argued that, not only is the general patent law inappropriate for protection of plants, but that it actually *conflicts* with the PPA and the PVPA.

The test case that reversed this position involved the patent application filed by Molecular Genetics Research and Development Limited Partnership (a subsidiary of Molecular Genetics, Minnetonka, MN) in September 1984 for “Tryptophan Overproducer Mutants of Cereal Crops.” The subject matter relates to corn plant technologies, including seeds, plants, and tissue cultures, which have increased free tryptophan levels, or which are capable of producing plants or seeds having increased free tryptophan levels. The patent examiner originally rejected this application, not on the basis of prior art, but on the position that the PPA and the PVPA are the exclusive forms of protection for plant life.

Why was this application chosen for the test case rather than any of the others that have been submitted to the PTO in the last several years? Thomas E. Freibell, an associate at

Pennie & Edmonds (New York, NY) who helped prepare the appeal, speculates that it may be for at least one of the following reasons. First, there was no prior art involved. Second, there was no contention as to the time of deposit of the seed. Third, this patent application covers all three categories of plants under question—seed, tissue culture, and plant. Freibell and S. Leslie Misrock (senior partner at Penne & Edmonds) successfully argued

that neither the PPA nor the PVPA *exclude* any plant subject matter from protection under Section 101 of the patent law. Moreover, there is nothing in the legislative histories of the two acts to indicate that Congress intended that protection under the plant-specific acts be exclusive. There is no conflict between the general and specific statutes: when two statutes can coexist, the courts must regard each as effective.



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The PPA covers asexually reproduced plants, with the express exception of tuber-propagated plants. The PPA was originally enacted as an amendment to the general patent law. The patents which issue protect distinct and new plant varieties. One and only one variety is covered per patent: this variety must be distinguishable from all others by at least one characteristic. The patent application (filed with the PTO) must describe in complete detail all features of the variety to the fullest extent known; this description must be accompanied by color photographs. No deposit of the plant material is required. The patent can only be infringed by asexual reproduction of the variety. There are no experimental or breeder's rights exceptions.

The PVPA protects sexually reproduced plants, with the specific exclusion of fungi, bacteria, and first generation hybrid (F₁) plants. The PVPA is administered by the Department of Agriculture through the Plant Variety Protection Office. The novel variety—including plants, transplants, and seeds—must be distinct, uniform, and stable. It must also have been sexually reproduced before a certificate is issued. A deposit of seed must accom-

pany the application, and the applicant must agree to replenish the seeds periodically as required. The certificate protects only a single variety, and gives the owner the right to control the sales, importation and sexual multiplication of the variety. There are exemptions for farmers and for plant breeding and research purposes.

Under the PPA and PVPA, each patent or certificate specifically covers one, and only one, new variety. General patents, by contrast, may contain a number of claims of varying scope and subject matter. General patent applications commonly claim a broad, generic concept of an invention: within the application there is often a series of more detailed and specific claims to certain variations in the concept. Claims can be taken toward an "assemblage" as a whole, and also to individual components of this "assemblage." These patent applications must be definitive and enabling: they must describe the best mode known by the inventor to practice the invention. The description of the invention must be such that it enables someone skilled in the field to make or use the invention without undue experimentation. If the invention

can't be described in words that will enable its definitive identification, then it can be placed in a public depository. Until recently, the PTO required that this deposit be made at the time the application is filed. The recent ruling by the U.S. Court of Appeals on the Lundak patent application (*BioTechnology* 3: 971, Nov. '85), however, has relaxed this requirement: apparently, deposit of material is not now required until the patent issues. —Jennifer Van Brunt

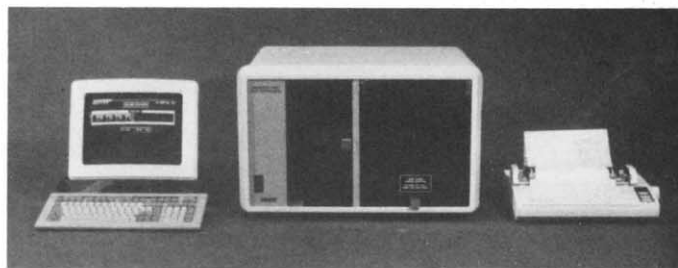
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