No. 12-580

In the Supreme Court of the United States

WALTER F. BEINEKE, PETITIONER

v.

DAVID J. KAPPOS, DIRECTOR, PATENT AND TRADEMARK OFFICE

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

Section 161 of Title 35 of the United States Code provides that "[w]hoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than * * * a plant found in an uncultivated state, may obtain a patent therefor." The question presented is as follows:

Whether Section 161 entitles petitioner to patents on two century-old oak trees that grew from acorns in a wooded pasture without human intervention.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1-23) is reported at 690 F.3d 1344. The opinions of the Board of Patent Appeals and Interferences (Pet. App. 24-49) are unpublished. Prior opinions of the Board of Patent Appeals and Interferences are available at 2008 WL 2951696 and 2008 WL 2942147.

JURISDICTION

The judgment of the court of appeals was entered on August 6, 2012. The petition for a writ of certiorari was filed on November 5, 2012 (a Monday). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. In 1930, Congress enacted the Plant Patent Act, 35 U.S.C. 161 *et seq.* The Act originally provided that any person "who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant" could apply for a patent on the new variety of plant.[1] Act of May 23, 1930, ch. 312, § 1, 46 Stat. 376. The Senate report accompanying the bill expressed Congress's intent to "afford agriculture, so far as practicable, the same opportunity to participate in the benefits of the patent system as has been given industry." S. Rep. No. 315, 71st Cong., 2d Sess. 1 (1930) (*1930 Report*).[2] The report explained that, through plant breeding and horticulture, "man often controls and directs the natural processes and produces a desired result," and that such efforts should be rewarded because "a plant discovery resulting from cultivation is unique, isolated, and is not repeated by nature, nor can it be reproduced by nature unaided by man." *Id.* at 6-7. The report also explained, however, that Congress did not

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[1] "Tuber-propagated plants," such as the Jerusalem artichoke and Irish potato, were excluded from patent-eligibility because they are propagated by the same part of the plant that is sold as food.

[2] When it enacted the Plant Patent Act, Congress believed that plants would not be entitled to patent protection under the more general provision that is now codified as 35 U.S.C. 101. See *J.E.M. Ag Supply, Inc.* v. *Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 134 (2001) ("This does not mean, however, that prior to 1930 plants could not have fallen within the subject matter of § 101. Rather, it illustrates only that in 1930 Congress *believed* that plants were not patentable under Section § 101, both because they were living things and because in practice they could not meet the stringent description requirement.").

intend to authorize patents for "those wild varieties discovered by the plant explorer or other person who has in no way engaged either in plant cultivation or care and who has in no other way facilitated nature in the creation of a new and desirable variety." *Id.* at 7.

In 1954, Congress amended the statute to, *inter alia*, extend patent protection to "seedling plants developed by chance." S. Rep. No. 1937, 83d Cong., 2d Sess. 1 (1954) (*1954 Report*). The Senate report explained that, under the amendment, a plant breeder could seek patent protection for a seedling the breeder had not intended to create only if the seedling resulted from some activity on the part of the plant grower. *Id.* at 2 ("It is the considered opinion of those who have studied this matter that a grower of plants who, through no particular efforts of his own other than perhaps by accident, develops a new plant which is, nevertheless, due to his activity, should be entitled to patent such plant in the same manner as though he had deliberately planned the result achieved.").

The 1954 amendment thus authorized the issuance of patents for "newly found seedlings," while making explicit that "cultivated sports, mutants, [and] hybrids" were patent-eligible[3] and expressly excluding from patent eligibility plants found "in an uncultivated state." Act of Sept. 3, 1954, ch. 1259, 68 Stat. 1190; see Pet. App. 14-15 (explaining, based on legislative history of the 1930 Act, that cultivated sports, mutants, and hybrids had been patent-eligible even before the 1954

[3] "Sports" result from bud variation; "mutants" result from seedling variation during self-pollenization; and "hybrids" result from cross-pollenization. Pet. App. 15 n.6. Sports, mutants, and hybrids retain their unique characteristics through asexual reproduction. *Ibid.* (citing *1954 Report* 3).

amendments). The amended statute, which is codified at 35 U.S.C. 161, provides: "Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title." 68 Stat. 1190.

2. In 1980, petitioner first noticed two white oak trees, both more than 100 years old, in the yard of someone else's house, which had been built approximately 50 years earlier. Pet. App. 2-3, 28. Petitioner observed that the trees appeared to have superior qualities as compared to other white oak trees, including excellent timber quality and strong central stem tendency. *Id.* at 2. Petitioner collected acorns from the trees, planted the acorns, determined that the resulting trees had the same superior qualities, and asexually reproduced the original trees. *Id.* at 3. He then applied for plant patents for both original trees. *Ibid.*; Supp. Pet. App. P1-P24.

The patent examiner at the United States Patent and Trademark Office (PTO) rejected petitioner's patent claims because petitioner had found the trees "in an uncultivated state" and therefore did not meet the requirements of 35 U.S.C. 161. See Pet. App. 3. Petitioner argued that the trees were found in a cultivated state because the yard in which he had found them was cultivated at the time of discovery. *Ibid.* The examiner rejected that argument, concluding that petitioner had not supplied sufficient evidence that the trees were in a cultivated state. *Ibid.*

Petitioner appealed to the Board of Patent Appeals and Interferences (Board). In 2008, a divided Board upheld the patent examiner's determinations. Pet. App. 3; *Ex parte Beineke*, No. 2007-3882, 2008 WL 2942147 (B.P.A.I. July 30, 2008); *Ex parte Beineke*, No. 2007-4215, 2008 WL 2951696 (B.P.A.I. July 31, 2008).[4] The Board held that, by excluding plants "found in an uncultivated state" from patent eligibility under Section 161, Congress intended to limit that provision's protection to plants that came to exist as the result of (intentional or unintentional) human efforts such as plant breeding, gardening, and horticulture. 2008 WL 2942147, at *6-*7. Congress did not intend, the Board concluded, "to cover a tree that grew up in a wooded pasture, without any apparent human involvement, merely because a house was later built nearby and a lawn was grown around the tree." *Id.* at *7. The Board determined that petitioner could not obtain patents for the trees because nothing about their existence or condition was the result of human effort. *Ibid.*

Administrative Patent Judge Lebovitz, joined by Chief Administrative Patent Judge Fleming, dissented. 2008 WL 2942147, at *9-*15. They would have interpreted Section 161's exclusion of patents for plants "found in an uncultivated state" as referring not to the state of the plant, but to the state of the region or area in which the plant was found. *Id.* at *10. Applying that interpretation of Section 161 to this case, they would have held that, because petitioner had discovered the two white oak trees at issue on a

[4] Because the Board's initial decisions in the two appeals are identical in all material respects, this brief cites only to the decision in appeal No. 2007-3882.

cultivated lawn, he was eligible to obtain patents on the two trees. *Id.* at *13-*15.

Petitioner filed a request for continued examination and submitted additional evidence to the examiner in an attempt to prove that the oak trees were in a cultivated state when first encountered. Pet. App. 5, 25. The examiner again rejected the claims, *ibid.*, and an expanded Board affirmed the examiner's renewed rejection of petitioner's claims, *id.* at 24-49. The Board found that the two white oak trees had begun growing in a wooded pasture and that petitioner had "provided no evidence that anyone ever cultivated" the trees. *Id.* at 28, 41. Although petitioner alleged that the lawn on which the trees stood had been cultivated, the Board determined that petitioner had presented no factual evidence that "any watering or fertilization [of the lawn] had any effect on the state of" the trees. *Id.* at 29, 42.

Administrative Patent Judge Schafer concurred. Judge Schafer expressed the view that any post-planting cultivation of the two trees was irrelevant because Section 161 required that "the parent plant came into existence as the result of man's cultivation." Pet. App. 33, 46. Judge Lebovitz again dissented, explaining that he viewed the phrase "uncultivated state" in Section 161 as referring to the state of the land surrounding the plant, not to the state of the plant itself. *Id.* at 33-36, 47-49.

3. The court of appeals affirmed. Pet. App. 1-23. Petitioner argued that his "discovery" of the plants at issue entitled him to patents on the plants because Section 161 does not require that any human have played a role in the creation of a plant in order for it to be patentable. See *id.* at 7. The PTO argued that a

plant is patent-eligible only if human activity (intended or accidental) played a role in the creation of the plant. See *ibid.*

Although the court of appeals did not agree entirely with either party's interpretation of Section 161, it agreed with the PTO that the oak trees at issue are not entitled to patent protection under Section 161. Pet. App. 7-23. The court first inquired whether the trees were patentable under the 1930 version of the Plant Patent Act, which required that the patent applicant have "invented" or "discovered" the new plant. *Id.* at 7-18. The court concluded that, under the 1930 version of the statute, a plant was patent-eligible only if it had been "created in its inception by human activity, i.e., it must be the result of plant breeding or other agricultural or horticultural efforts." *Id.* at 8. The court also read the 1930 statute to require that the person seeking the patent be the "inventor" or creator of the plant. *Ibid.* The court concluded that petitioner "ha[d] not demonstrated that he fulfills either of these requirements." *Ibid.*

The court of appeals further held that, when Congress enacted the Plant Patent Act in 1930, its "understanding [was] that patent protection was available only for plants resulting from human creative efforts by the patent applicant, and not for found plants." Pet. App. 15. The court concluded that, because petitioner had not demonstrated that the oak trees "were in any way the result of his creative efforts or indeed anyone's creative efforts," the trees "do not fall within the scope of those plants protected by the 1930 Act." *Id.* at 18.

The court of appeals also held that the 1954 amendments to the Plant Patent Act did not change prior

law in a way that would allow petitioner to obtain patents on the two white oak trees. Pet. App. 18-23. The court explained that Congress's 1954 addition of protection for "newly found seedlings" did not assist petitioner's cause because petitioner had conceded that the oak trees were not newly found seedlings. *Id.* at 19. Because the oak trees do not fall within the expanded protection for "newly found seedlings," the court found it unnecessary to decide whether the trees would fall within the exception to patentability for plants "found in an uncultivated state." *Id.* at 23.

ARGUMENT

Petitioner argues (Pet. 3-8) that the court of appeals erred in interpreting 35 U.S.C. 161 as providing patent protection only to a person who has created a new and distinct plant, not to a person who has found such a plant and has recognized its special qualities. The court of appeals correctly held that petitioner was not entitled to a patent, and its decisions does not conflict with any decision of this Court or of any other court of appeals. Further review is not warranted.

1. The court of appeals correctly held that petitioner cannot obtain patents on two trees (both more than 100 years old) that grew from acorns in a wooded pasture without the aid of human intervention. Petitioner happened upon these trees decades after they were seedlings, recognized their superior qualities, and asexually reproduced them. But he does not contend that he—or any other human—intervened in any way to affect the trees' characteristics. Rather, the trees are a product of nature. The court of appeals correctly rejected petitioner's argument that he is entitled to patents on the trees merely because he rec-

ognized the superior qualities with which nature had endowed them.

This Court has repeatedly (and recently) affirmed that "a new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter" under the general patent provision of 35 U.S.C. 101. *Mayo Collaborative Servs.* v. *Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012) (*Mayo*) (quoting *Diamond* v. *Chakrabarty*, 447 U.S. 303, 309 (1980)); see *id.* at 1293 ("'[L]aws of nature, natural phenomena, and abstract ideas' are not patentable.") (quoting *Diamond* v. *Diehr*, 450 U.S. 175, 185 (1981)); *Funk Bros. Seed Co.* v. *Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948) ("[P]atents cannot issue for the discovery of the phenomena of nature."). The Court has never squarely held that the same principle bars issuance of a patent under Section 161 for a naturally occurring plant. There is no reason to believe, however, that plants not patent-eligible under the broader Section 101 would be eligible under the "very limited coverage" provided by Section 161. *J.E.M. Ag Supply, Inc.* v. *Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124, 133 (2001) (*J.E.M.*). On the contrary, this Court has noted that, with the exception of the written-description requirement, an applicant seeking a patent under Section 161 "must meet all of the requirements for [a patent under Section] 101." *Id.* at 133 n.6.

It is evident from the text and history of Section 161 that Congress intended Section 101's prohibition on the patentability of natural phenomena to apply to Section 161 as well. When Congress expressly extended patent protection to plants in 1930, it did so by amending the general patent provision that is now codified as Section 101. See 46 Stat. 376. This Court

had made clear by that time that natural phenomena were not eligible for patent protection. See *Le Roy* v. *Tatham*, 55 U.S. (14 How.) 156, 175 (1853); *O'Reilly* v. *Morse*, 56 U.S. (15 How.) 62, 112-120 (1854). Nothing in the plant-protecting language Congress added to the general patent provision indicates that plants would be subject to more favorable treatment than the "useful art, machine, manufacture, or composition of matter" that was otherwise protected. § 1, 46 Stat. 376. To the contrary, the Senate report accompanying the 1930 bill stated that the amendments were not intended to extend patent protection to "wild varieties discovered by the plant explorer or other person who has in no way engaged either in plant cultivation or care and who has in no other way facilitated nature in the creation of a new and desirable variety." *1930 Report* 7.

Petitioner is no different from the "plant explorer" who discovers a wild variety of plant that no person has cultivated or otherwise caused (intentionally or accidentally) to exist. Although petitioner recognized certain characteristics in the trees that nature had created, he does not contend that he ever acted "in aid of nature" to further their development. *Chakrabarty*, 447 U.S. at 312. Petitioner emphasizes (see Pet. 7-8) that he asexually reproduced the trees. But asexual reproduction does not transform the original trees from a product of nature into a human invention. Petitioner seeks patents on the original trees, and asexual reproduction does not alter the characteristics of those trees. Natural trees, like naturally occurring minerals, are not subject to patent protection. See *Mayo*, 132 S. Ct. at 1293.

As the court of appeals correctly concluded, see Pet. App. 18-19, Congress did not extend patent protection to naturally occurring plants when it amended the Plant Patent Act in 1954. In 1952, Congress recodified the Plant Patent Act as Section 161, separating it from the general patent provision of Section 101. See Act of July 19, 1952, ch. 950, 66 Stat. 792, 804; *J.E.M.*, 534 U.S. at 133. The recodification "was merely a housekeeping measure that did nothing to change the substantive rights or requirements for a plant patent." *J.E.M*, 534 U.S. at 133. The 1954 amendments, in turn, explicitly authorized the issuance of patents for "cultivated sports, mutants, hybrids, and newly found seedlings" that had been "invent[ed] or discover[ed] and asexually reproduce[d]." 35 U.S.C. 161. The amendments also explicitly excluded from patent eligibility "plant[s] found in an uncultivated state." *Ibid.*

Petitioner has conceded that the century-old oak trees he found were not "seedlings." See Pet. App. 19. With respect to "cultivated sports, mutants, [and] hybrids," the 1954 amendments did not change prior law, but simply clarified the rule that had been in effect since 1930. See *id.* at 14-15. In any event, petitioner does not contend that the oak trees at issue here were "cultivated sports, mutants, [or] hybrids." Petitioner nevertheless relies on the language of the 1954 amendments to argue that a plant need not have been "creat[ed]" to be eligible for patent protection under Section 161, as amended, see Pet. 3-7. But because the trees at issue here do not fall within any of the categories of plants that the 1954 amendments declare to be patent-eligible, those amendments cannot plausibly be construed to alter the pre-existing

understanding that plants created in nature without human intervention are not patentable. That is particularly so in light of the clarification that Section 161 does not extend to "plant[s] found in an uncultivated state." The 1954 amendments therefore provide no support for petitioner's effort to obtain patents on century-old, naturally occurring trees.

2. Petitioner does not contend that the court of appeals' decision conflicts with any decision of this Court or of any other court of appeals. Petitioner argues that the court of appeals' decision conflicts with the Board's 1957 decision in *Ex parte Moore*, 115 U.S.P.Q. 145. Although there is some tension between the reasoning of the two decisions, such tension does not warrant this Court's intervention because the result in this case would have been the same even under the Board's reasoning in *Moore*.

The PTO has always understood that naturally occurring plants are not patentable, and the Board's 1957 decision in *Moore* is not to the contrary. The issue on appeal in *Moore* was whether the patent applicant, who had noticed a new variety of peach tree growing in a friend's yard, had "discover[ed]" the tree within the meaning of Section 161. 115 U.S.P.Q. at 146. The Board determined that the word "discovers," as used in Section 161, means not merely finding a new plant, but also appreciating "that the plant is a distinct and new variety." *Id.* at 147. The Board held on that basis that the applicant was the "original, first and sole inventor or discoverer" of the new variety, and that he was therefore entitled to a patent, even though he had played no role in cultivating the tree. *Ibid.*

In the present case, the court of appeals concluded that patent protection under the 1930 version of the Act is available only to plants "that were created as a result of plant breeding or other agricultural and horticultural efforts *and* that were created by the inventor, that is, the one applying for the patent." Pet. App. 18; see *id.* at 8-10. The court explained that petitioner "meets neither of these requirements." *Id.* at 18.[5] The second of those requirements is inconsistent with the Board's reasoning in *Moore*. That aspect of the court's analysis, however, did not affect its ultimate disposition of this case.

In *Moore*, the peach tree at issue had been "cultivated" by the owner of the yard in which the tree had appeared as a seedling. 115 U.S.P.Q. at 146. The tree therefore had been cultivated in its inception, albeit by a person other than the patent applicant. *Ibid.* In stark contrast, there is no evidence in this case of any human intervention or cultivation at the inception of the trees at issue, which had been growing for more than 100 years before petitioner recognized them as a new variety of oak tree, and which had been growing for decades in a wooded pasture before a house was built nearby. Thus, as the court of appeals correctly concluded, the trees at issue here are products of nature, not eligible for patents.

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[5] Under the 1954 amendments, which extended protection to "newly found seedlings," the court concluded that "seedlings did not need to have been created by a plant breeder so long as they were discovered by the applicant on cultivated land." Pet. App. 20. Because petitioner conceded that the trees at issue were not "newly found seedlings," the court concluded that "the trees in question do not fall within the broadened protection of the 1954 amendments." *Id.* at 23.

The question presented in *Moore* was whether the patent on a new plant variety that was undoubtedly patentable could be granted to the person who had first recognized the new variety for what it was, even though he was not the individual who had cultivated the peach tree. The court of appeals' analysis in this case suggests that the court would have answered that question differently than did the Board in *Moore*. See Pet. App. 18 (stating that patent protection under Section 161 is available only for plants "that were created by * * * the one applying for the patent"). But even if the court of appeals had agreed with the conclusion that the Board reached in *Moore*, it would have held that the oak trees at issue here were not patent-eligible because they were not cultivated by petitioner or anyone else. Thus, even if a conflict between the Federal Circuit and the Board could in some circumstance warrant this Court's intervention, no such conflict exists in this case.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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