

**PRESENTATION:**

**THE EXPERIMENTAL USE EXCEPTION  
AND THE U.S. PLANT VARIETY  
PROTECTION ACT**

**Mark Janis\***

I would like to talk about plants, and in particular, corn. I am from Iowa and live in the middle of the largest corn-producing region of the world, so maybe this will not surprise you: in addition to corn production, there is an awful lot of research and development on plant biotechnology throughout the Mid-Western United States and the state of Iowa. There are very significant private expenditures on research and development.

Of all aspects of plant biotechnology, I decided to pick corn. I picked a particular development from a company called Pioneer Hybrid, the world's largest seed corn producer. As part of its effort to develop new corn varieties, Pioneer Hybrid creates new inbred lines of corn, which are parent lines used to produce hybrid corn, their commercial product. One of their inbred lines is designated KM5. I will refer to it later in my discussion. KM5 has various desirable traits, but for our purposes, what is of interest is that KM5 is protected under legislation called the Plant Variety Protection Act (PVPA),<sup>1</sup> which is similar to plant breeder's rights in other parts of the country.

The PVPA is of interest because this legislation has an expressed statutory research exemption, an experimental use exemption. Some might argue that this statutory research exemption could be a model for a statutory research exemption in the U.S. utility patent regime, at least as it applies to plants. I want to explore this argument with you and discourage you from making it – because it is flawed.

First, I will give you some background in order to put this research exemption into the context of the PVPA. The exemption itself is much like the ones that we have already discussed, and it reads much like the exemption in the German Patent Law. The exemption states that the use and reproduction of a protected variety for plant breeding or other *bona fide* research shall not constitute an infringement of a PVPA certificate. It is very generic language; because of this, it might be tempting for people to lift that language out of its context and suggest that it could be used in the utility patent regime.

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<sup>1</sup> 7 U.S.C. 2321.

I do not think that its language should be lifted, because the PVPA strikes a very different statutory bargain than does the utility patent regime. For example, protectability under the PVPA requires a very low quality disclosure as compared to the utility patent regime. There is no enabling disclosure requirement in the PVPA. There is no obviousness requirement for protection under the PVPA. There is no requirement that you deposit seeds in a publicly accessible depository. You do have to make a deposit, but it does not have to be publicly accessible. There are very different protectability requirements, lower quality-level protectability requirements, than would be required under the utility patent regime. In exchange, applicants get a relatively low level of protection.

This is where the research exemption in the PVPA becomes important. Why do I say “a low level of protection” under the PVPA? There are many different provisions that bear on this. I will not go into all of them, but just to give you an idea, the protection provided under the PVPA is just for a *variety*, the lowest plant grouping in taxonomy. If this were copyright, we would be talking about the low level of abstraction. It is a lot like copyright protection. The legislative history of the PVPA reflects this, saying, “we expect that infringement is only going to occur by unauthorized reproduction, just short of flat out copying or multiplying of protected varieties.” This is a narrow conception of what infringement would be.

If you examine the infringement provisions in the PVPA, you will see more of this. For example, it is infringement to use a protected variety to *produce* another variety. This sounds similar to the utility patent language; however, it is not infringement to use a protected variety to *develop* another variety. The legislative history attempts to make this distinction but inevitably that is something that will certainly be left for litigation.

There are many other limitations. Private, non-commercial acts are expressly exempted as not constituting infringement. The Saved Seed Exception, which was the subject of litigation in the Supreme Court a few years ago, allows farmers to save seeds and plant them on their own farms. Such use does not constitute infringement. Additionally, there is a compulsory license provision for emergencies relating to the food supply. Finally there is the generic research exemption that I told you about.

My point in giving you this context is to reinforce the proposition that you cannot simply look to the PVPA as an analog and simply transplant the research exemption from that statute into the utility patent regime and expect that it is going to work out. This would be unraveling a statutory bargain that was set up.

Why would you think of doing this? Why would it be an issue? Why would anybody think of possibly transferring this exemption from one regime to another? This takes me back to the example I was referring to a moment ago: the KM5 inbred corn line. It is protected under a PVPA certificate and also by a utility patent.

The U.S. utility patent has a whole variety of claims in it and that raises interesting issues. There are two questions. First, if you have a utility patent on a plant, or one that includes claims directed to a plant, and you have PVPA protection as well, is this double protection? Some would argue that it is. I suggest that it certainly is not; that the two regimes are very much different. This is not a hypothetical debate. There is a case in front

of the U.S. Supreme Court right now, *J.E.M. v. Pioneer Hybrid*,<sup>2</sup> where this is the very issue presented. Should the eligibility provision in the United States Utility Patent Statute Section 101 be construed to include plants? Or should it not, on the basis that doing otherwise would give double protection to those seeking both utility patent protection and PVPA protection? This is a very real debate. It has been briefed and will be decided in the next few months by the Supreme Court.

The second question that arises: what does this mean for the research exemption? In the PVPA there is a generic research exemption and many other limitations, whereas in the utility patent regime there is a truly narrow research exemption. Judge Rader has discussed how truly narrow he would construe it – I was surprised by how narrow his construction was. What if you had behavior that would be exempted under the PVPA provision, but would not be exempted under a narrow construction of the research exemption under the utility patent regime? What do you do as a Judge in that situation? That case might come up. It depends on how the Supreme Court rules on the issue of double protection. Such a case would be an opportunity for the court to speak to the content of the research exemption under the utility patent regime. I have a variety of ideas about how that might come out and what might happen, but I will save those for later discussion.

Thank you.

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<sup>2</sup> *J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred Intern., Inc.*, 122 S.Ct. 593 (U.S. 2001).