



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER F. BEINEKE

Appeal 2007-4215
Application 10/919,902
Technology Center 1600

Decided: July 31, 2008

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, and
RICHARD E. SCHAFER, ERIC GRIMES, RICHARD M. LEBOVITZ, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* GRIMES.

Opinion Dissenting filed by *Administrative Patent Judge* LEBOVITZ, with
whom *Chief Administrative Patent Judge* FLEMING joins.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving a plant patent application.¹ The Examiner has rejected the claim under 35 U.S.C. § 161 on the basis that the claimed oak tree was found in an uncultivated state. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

The Specification² describes a “new variety of white oak tree (*Quercus alba* L.) [that] was discovered by the applicant near Vallonia, Jackson County, Indiana in a front yard of a home” (Spec. 1).

The claim reads as follows:

A new and distinct variety of white oak tree named ‘AFTO-2’ substantially as illustrated and described, which has excellent timber quality, extremely rapid growth rate, and fairly strong central stem tendency, and produces annual acorn crops.

The Examiner has rejected the claim on the basis that AFTO-2 was found in an uncultivated state, and therefore is not eligible for a plant patent (Answer 4).

Appellant contends that the “claimed tree was **found in a cultivated** state, in the yard of a home, on land that had been cultivated for 35 years more than the age of the tree, and was cultivated at discovery” (Appeal Br. 4).

¹ This appeal was heard at the same time as Appeal 2007-3882 (application 10/919,574). The applications have the same inventor and assignee, and they present the same issue. We have considered them together.

² “Specification” refers to the substitute specification filed Sept. 6, 2005.

In view of these conflicting positions, the issue in this appeal is: Was the claimed oak tree AFTO-2 found in an uncultivated state and therefore ineligible for patenting under 35 U.S.C. § 161?

Findings of Fact

FF1. The instant application was filed August 17, 2004.

FF2. The Specification states that Appellant discovered AFTO-2 “in a front yard of a home” (Spec. 1, ¶ 1).

FF3. The Specification states that “[b]efore the house was constructed in the 1930’s, the area was a wooded pasture with many white oak and hickory trees present” (Spec. 1, ¶ 2).

FF4. The Specification states that the “U.S. government first sold the land to a Peters family in the 1850’s” (Spec. 1, ¶ 2).

FF5. The Specification states that “at age 10, ‘AFTO-2’ seedlings averaged 27.0 ft. tall at the first planting” (Spec. 2, ¶ 3).

FF6. The Specification states that AFTO-2 was “approximately 118 years old when described at a location near Vallonia, Indiana in a cultivated state” (Spec. 2, ¶ 4).

FF7. The Specification states that “[r]eal estate records show that the land was settled and farmed for at least 35 years before the tree was started” (Spec. 2, ¶ 4).

FF8. The Specification does not describe any specific efforts made by anyone to cultivate AFTO-2 (e.g., watering, staking, fertilizing, or pruning).

FF9. Figure 1 is said to show “the timber form of ‘AFTO-2’” (Spec. 3, ¶ 9).

FF10. Figure 3 is said to show “the bole of ‘AFTO-2’” (Spec. 3, ¶ 11).

FF11. Figures 1 and 3 are photographs showing a tree growing next to a small bush in an area of low-growing vegetation in a bend of what looks like an asphalt driveway (Figs. 1 and 3).

FF12. Figures 1 and 3 bear an apparent date stamp reading “3 2 ‘04” (Figs. 1 and 3).

FF13. Appellant has submitted a copy of a document titled “Partition of the Real Estate among the heirs of Christian Peters Deceased” and dated February 1875 (part of Exhibit 3 in the Evidence Appendix attached to the Appeal Brief).

FF14. The “Partition” document describes a certain tract of land (“Lot No. 5”) as being “assign[ed] and deliver[ed] unto Mary Peter [sic]” (Evidence Appendix, Exhibit 3, third page, first full paragraph).

FF15. Appellant has submitted a copy of a handwritten document titled “Past Ownership of the Neal Stuckwish Property/Section 4, T4, R4 Jackson Co. IN/56.87 acres/The location of AFT-O2 and AFT-O3” (part of Exhibit 3 in the Evidence Appendix attached to the Appeal Brief).

FF16. The “Past Ownership” document states: “~1850 land originally purchased from the U.S. government by Christian Peters” (Evidence Appendix, Exhibit 3).

FF17. The “Past Ownership” document states: “Mary Peters – Feb 3, 1875 – 91.5 acres/In 1886 and 1899 when the trees first started growth, Mary Peters owned the land” (Evidence Appendix, Exhibit 3).

Discussion

We conclude that the evidence of record supports the Examiner's position that the claimed plant does not fall within the scope of 35 U.S.C. § 161. Section 161 reads as follows:

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.

35 U.S.C. § 161.

Thus, "a plant found in an uncultivated state" is expressly excluded from the scope of § 161. The question that is central to this appeal is whether AFTO-2 was found in an uncultivated state.

The burden is generally on the Examiner to show that a claimed invention is unpatentable. *See Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) ("In the prosecution of a patent, the initial burden falls on the PTO to set forth the basis of any rejection, i.e., a prima facie case."). We note that § 161 is unusual in expressly excluding certain subject matter, but we will assume for present purposes that the Examiner bears the initial burden of showing that AFTO-2 is outside the scope of § 161.

The Examiner points to the Specification's statements that AFTO-2 was 118 years old when it was found, and that "before the house was constructed the area was a wooded pasture" (Answer 4). The Examiner concludes that "based upon consideration of all the evidence of record it is more likely than not that the claimed plant was found in an uncultivated state" (*id.*).

We conclude that the Examiner has made out a prima facie case of unpatentability. The Specification contains data on the size of 10-year-old AFTO-2 seedlings (FF5). The instant application was filed August 17, 2004 (FF1). In order for seedlings to have been grown for 10 years by the filing date of the instant application, they must have been planted no later than August 1994; thus, AFTO-2 must have been found by August 1994.

The Specification states that AFTO-2 was about 118 years old when it was found (FF6). A tree that was 118 years old in 1994 would have started growing in 1876.³ The Specification states that the land on which AFTO-2 was found was a wooded pasture until the 1930's, when a house was built nearby (FF3). The Specification's description thus means that AFTO-2 was 54-63 years old at the time of the first disclosed human activity that might have affected it. The Specification does not describe any deliberate cultivation of AFTO-2 such as watering, fertilizing, staking, or pruning (FF8).

We agree with the Examiner that the above evidence, provided by the Specification, supports a prima facie conclusion that AFTO-2 was found in an uncultivated state.

Appellant argues that the “claimed tree was **found** in a **cultivated** state, in the yard of a home” (App. Br. 4). Appellant reasons that “[a]s FIG. 1 of the specification illustrates, when discovered by the inventor it was in a yard with grass clearly maintained ‘by labor and attention,’ . . . labor and

³ This is earlier than the 1886 date stated in Appellant's “Past Ownership” document (FF17) but still after the land was acquired by Mary Peter(s), according to Appellant's “Partition” document (FF13, FF14).

attention that would also benefit ‘AFTO-2’” (*id.* at 6). That is, “[b]ecause the tree is surrounded by the other plants and the roots of the tree extend under the lawn, which the examiner admits is ‘cultivated,’ cultivation of the lawn must necessarily reach the tree” (Reply Br. 2).

This argument does not rebut the Examiner’s *prima facie* case. The Specification indeed states that AFTO-2 was found “in a front yard of a home” (FF2).⁴ But, as discussed above, the Specification itself provides evidence that AFTO-2 was found no later than August 1994. The only evidence of record that shows the actual state of AFTO-2 is provided by Figures 1 and 3, which are date-stamped “3 2 ‘04” (FF12), which we understand to mean March 2, 2004, nearly ten years after the latest date that AFTO-2 could have been found according to the data in the Specification. No evidence, provided by way of declaration or otherwise, relates the state of the tree shown in Figures 1 and 3 to the state of the tree when it was found in 1994 or earlier.

⁴ The Specification also states that AFTO-2 was found “in a cultivated state” (FF6). However, we disagree with Appellant’s position that his statement to this effect is conclusive of the legal issue on appeal (Reply Br. 2). We also note that the official file contains two signed Declarations under 37 C.F.R. § 1.63, only one of which has a check in the box that states “Said plant was found in cultivated area (check this box for newly found plant only)” (Declarations filed March 16, 2005 and Sept. 21, 2005). The later-filed Declaration (with the box checked) is undated, and Appellant has not explained the basis for the conflicting statements. According to the cover letter filed Sept. 21, 2005, the later-filed Declaration was submitted to “reflect[] the new title of the [application] as amended from AFT-02 to AFTO-2.”

Appellant also argues that AFTO-2 was found “on land that had been cultivated for 35 years more than the age of the tree” (App. Br. 4) and that “the land on which ‘AFTO-2’ developed was always owned and used as a farm” (*id.* at 6).

This argument is unpersuasive because it is unsupported by evidence. Appellant has provided evidence that the land on which AFTO-2 was later found was privately owned as early as the 1850’s, and was owned by a Mary Peters (or Peter) in 1876 when AFTO-2 apparently began growing. Private ownership, however, is not cultivation. The evidence of record does not show that the land was cultivated at any date prior to 2004, when the photographs of Figures 1 and 3 were apparently taken.

And even if the evidence showed that AFTO-2 was found in a mowed lawn, that showing would not necessarily establish that it was covered by § 161. That statute does not refer to plants “found in an uncultivated *area*,” but to plants “found in an uncultivated *state*.” The “state” of a thing refers to its “mode or condition of being”⁵ not its physical surroundings. Thus, the condition of the environment surrounding AFTO-2 does not conclusively determine the “cultivated” or “uncultivated” state of AFTO-2 itself. In our view, compliance with the “cultivated” requirement of § 161 is determined by whether the existence or condition of the found plant itself has been affected by human activity (i.e., cultivation).

The legislative history of § 161 supports this position. Section 161 derives from the 1930 Plant Patent Act, which amended R.S. 4886 (now 35

⁵ Webster’s Ninth New Collegiate Dictionary 1151 (Merriam-Webster Inc., 1990).

U.S.C. § 101) to read as follows: “Any person who has invented or discovered any new and useful art, machine . . . *or who has invented or discovered and asexually reproduced any distinct and new variety of plant other than a tuber-propagated plant*, . . . may . . . obtain a patent therefor” *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1563 (Fed. Cir. 1995)(quoting R.S. 4886, alterations by the *Imazio Nursery* court).

“Prior to 1930, two factors were thought to remove plants from patent protection. The first was the belief that plants, even those artificially bred, were products of nature for purposes of the patent law.” *Diamond v. Chakrabarty*, 447 U.S. 303, 311 (1980). Congress addressed this concern by “explain[ing] at length its belief that the work of the plant breeder ‘in aid of nature’ was patentable invention.” *Id.* at 312.

The *Chakrabarty* Court cited the 1930 House and Senate Committee Reports, which noted the distinction between the discovery of a new mineral and the discovery of a new variety of plant. The Reports pointed out that unlike formation of a mineral, “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 313. The Court concluded that “Congress thus recognized that the relevant distinction was not between living and inanimate things, but between *products of nature*, whether living or not, and *human made inventions*.” *Id.* (emphases added).

The Committee Reports accompanying the 1930 Plant Patent Act show that Congress did not intend that law to cover plants that arise without any human involvement. The bill that resulted in the 1930 Act originally covered two classes of plants: “(1) any distinct and new variety of plant or

(2) any distinct and newly found variety of plant.” *Ex parte Foster*, 90 USPQ 16, 17 (Pat. Off. Bd. App. 1951), quoting Senate Bill 4015. The Senate Committee on Patents amended the bill by “striking out from the bill the words ‘or (2) any distinct and newly found variety of plant,’ thus eliminating newly found plants from the scope of the bill.” *Id.*

The Report accompanying S. 4015 (attached to the Appeal Brief as Exhibit 5) confirms that

the committee has, by its amendment in striking out the patenting of “newly found” varieties of plants, eliminated from the scope of the bill 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.

S. Rep. No. 71-315, at 7 (1930). The House Committee Report (attached to the Appeal Brief as Exhibit 6) also notes that the “exclusion of a wild variety, the chance find of the plant explorer, is in no sense a limitation on the usefulness of the bill to those who follow agriculture or horticulture as a livelihood and who are permitted under the bill to patent their discoveries.” H.R. Rep. No. 71-1129, at 4 (1930).⁶ The legislative history of the Plant Patent Act thus shows that it was deliberately drafted to exclude from coverage “chance find[s]”; i.e., plants that were not subject to “plant cultivation or care.”

“In 1952, Congress revised the patent statute and placed the plant patents into a separate chapter 15 of Title 35. . . . This was merely a housekeeping measure that did nothing to change the substantive rights or

⁶ The Senate Report likely contains the same sentence, but the copy of record is missing page 4, where the sentence would be.

requirements for a plant patent.” *J.E.M. Ag Supply Inc. v. Pioneer Hi-Bred Int’l*, 534 U.S. 124, 133 (2001).

Section 161 was amended in 1954 to its current form. The Senate Committee Report accompanying the bill states that the amendment was intended to “remove any doubt that the legislative intent of the Congress clearly means that sports, mutants, hybrids, and seedlings, discovered by persons engaged in agriculture or horticulture, should be patentable.” S. Rep. No. 83-1937 (1954), as reprinted in 1954 U.S.C.C.A.N. 3981, 3981. The Senate Report also includes a copy of a memorandum from the Patent Office to the Secretary of Commerce, indicating that the Patent Office had doubts about the constitutionality of allowing “the grant of a patent to one who has merely found a plant not previously known and has contributed nothing to producing it, provided it is found in a cultivated state.” *Id.* at 3983.⁷

The Senate Report responded that, in the Committee’s opinion, the legislation was constitutional. *Id.* at 3981-82. The Report concludes that “[i]t 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

⁷ The Patent Office memorandum also notes that “the language of the bill would give rise to difficult questions of interpretation. It is not certain whether the new plant itself must be the subject of cultivation, or must merely be found in a cultivated area. Apparently the question of patentability might sometimes be reduced to one as to which side of a fence the plant was found on.” *Id.* at 3984. Obviously, Congress did not resolve this ambiguity, or we wouldn’t be addressing it today.

he had deliberately planned the result achieved.” *Id.* at 3982 (emphasis added).

In our view, the legislative history shows that Congress did not intend the Plant Patent Act, as amended in 1954, to encompass plants created and growing without being the subject of human effort. Found plants were not encompassed by the 1930 Act, whether cultivated or not. The 1954 amendment broadened the Act but expressly excluded plants found in an uncultivated state.

The 1954 Committee Report states that the purpose of the amendment was to “strengthen the original purpose for the . . . Plant Patent Act [by] enhancing the incentive for achievement in plant breeding, gardening, and horticulture.” *Id.* at 3981. The Committee could have added that another purpose was to provide an incentive for nurserymen to search out new varieties of plants, even those that did not owe their existence or condition to human activity, and asexually reproduce them to preserve the new variety. But it didn’t.

Instead, it indicated that the amendment was intended to cover a new plant developed by a plant grower “through no particular efforts of his own other than perhaps by accident, . . . [but] which is, nevertheless, due to his activity.” *Id.* at 3982.

In our view, the legislative history of the 1954 amendment shows that Congress’ intent, in excluding plants found in an uncultivated state, was to limit the scope of the Act to plants whose existence or condition is, even if indirectly or unintentionally, the result of human effort in fields such as plant breeding, gardening, and horticulture.

The legislative history does not indicate that Congress intended the Plant Patent Act 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. Surrounding a tree with a lawn does not change the state of the tree itself. In order for a tree to be within the scope of 35 U.S.C. § 161, the tree itself must be cultivated; otherwise, it falls within the excluded category of a “plant found in an uncultivated state.”

Appellant has pointed to no evidence in the record to show that AFTO-2 was cultivated at the time it was found. Therefore, a preponderance of the evidence of record supports the Examiner’s position that AFTO-2 was found in an uncultivated state. We affirm the rejection under 35 U.S.C. § 161.

Our dissenting colleagues disagree with our interpretation of § 161. They argue that it “would be inconsistent with the plain language of the statute to require the plant to have been cultivated prior to its discovery . . . since ‘newly found’ implies that its existence was not known up until its actual discovery” (*post* at 21).

That position misapprehends what it means to “discover” a new plant variety. *See Ex parte Moore*, 115 USPQ 145 (Pat. Off. Bd. App. 1957). The issue in *Moore* was who was the true inventor of a new variety of peach tree: The owner, who found it growing in his yard and “protected the tree from injury and watered and fertilized it” but who “had no idea that the peach tree in his yard was a new variety” (*id.* at 146), or his orchardist friend, who “saw the peach tree in [the owner’s] yard and recognized that it was a new

variety” (*id.*). The Board concluded that “although one may find a plant, he has not discovered a new variety if he has no appreciation that the plant is a distinct and new variety” (*id.* at 147).

Thus, discovering a new variety of plant does not require the inventor to be the first human to lay eyes on the plant, it only requires the inventor to be the first to recognize the plant as a new variety. Our interpretation of § 161 to require that the claimed plant itself must be cultivated is not inconsistent with the language of the statute.

The dissent also attaches significance to the statement in the House report accompanying the 1954 amendment to § 161 that its purpose was to overrule *Ex parte Foster* or a similar opinion (*post* at 19-20). That purpose, however, is not relevant to the issue here, since the plant claimed in *Foster* was found in a garden (*see Foster*, 90 USPQ at 17) and therefore reasonably appears to have been in a cultivated state when discovered to be a new variety.

Finally, the dissent concludes that the Examiner has not provided a sufficient basis for challenging the Specification’s assertions that AFTO-2 was found on cultivated land (*post* at 23-24) and disagrees with our conclusion that the evidence of record does not show that AFTO-2 was in a cultivated state when it was discovered (*id.* at 25-26).

We disagree with both of these positions. In our view, the Examiner provided an adequate basis for shifting the burden to Appellant to provide evidence of the cultivated state of AFTO-2 by pointing to the lack of “evidence of record describing cultivation of the claimed tree, e.g., planting of the tree, or maintenance, labor or attention given the claimed tree” (Office

action mailed Jan. 27, 2006, p. 5). In response, Appellant could have provided, for example, declaratory evidence describing how the tree had been cultivated.

An Examiner, by contrast, has no reasonable way to provide evidence showing that a given plant had *not* been cultivated. In similar circumstances, where the Examiner provides a reasonable basis on which to conclude that a claimed product is unpatentable, the burden of proof is properly shifted to the applicant. *Cf. In re Best*, 562 F.2d 1252, 1255 (CCPA 1977)(“Where . . . the claimed and prior art products are identical or substantially identical . . . the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. . . . [The] fairness [of the burden-shifting] is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.”). Here, as in *Best*, Appellant is in the best position to provide evidence regarding cultivation and the USPTO lacks the ability to obtain such evidence.

We also disagree with the dissent’s conclusion that the record provides sufficient evidence of cultivation. Our dissenting colleagues assume that the area in which AFTO-2 grew was subject to “occasional mowing as would be the case for a wooded pasture or a yard” (*post* at 25), but cite to no evidence in the record of any mowing or other cultivation activities.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

LEBOVITZ, *Administrative Patent Judge*, with whom *Chief Administrative Patent Judge* FLEMING joins, dissenting.

STATEMENT OF CASE

This appeal involves the patentability of an asexually reproduced plant under 35 U.S.C. § 161, also known as the Plant Patent Act (PPA). Under 35 U.S.C. § 161, a patent may be obtained for an asexually reproduced

distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than . . . a plant found in an uncultivated state.

The plant for which a patent is sought in this case is a white oak tree discovered by Appellant in the front yard of a home when it was 118 years old (FF2, 6) and subsequently asexually reproduced and named “AFTO-2.” Claim 1 in this appeal is drawn to AFTO-2.

The Examiner’s position is that AFTO-2 is not eligible for a patent because it had not been “subject to cultivation prior to its discovery” and therefore it is expressly excluded from the scope of 35 U.S.C. § 161 as “a plant found in an uncultivated state” (Ans. 8-9).

Appellant contends that the Examiner erred in requiring “that the plant was under cultivation *prior* to its discovery” by its property owner (Reply Br. 3). Appellant states that a plant discovered on cultivated land, as was AFTO-2, can be patented under 35 U.S.C. § 161 (App. Br. 6-7). He argues that the “statute does **not** require that the instant cultivar had to be cultivated at the time of planting, only at the time of discovery, which is the case for” AFTO-2 (App. Br. 8).

THE MAJORITY OPINION

The majority affirms the Examiner's rejection. Stating that the phrase "found in an uncultivated state" as it appears in 35 U.S.C. § 161 refers to the state of the plant and not its physical surroundings, the majority concludes that compliance with the statute is determined by whether "the found plant itself has been affected by human activity (i.e., cultivation)" (Maj'y Opn.⁸ 8). The majority's opinion is based largely on the legislative history of the 1930 Plant Patent Act and the 1954 amendment to it which our colleagues contend expressed a clear intent to exclude plants which had been created and grown without human effort (Maj'y Opn. 11-12). Reading the statute in this light, the majority concludes, as did the Examiner, that Appellant did not provide adequate evidence to establish that AFTO-2 had been "affected by human activity" prior to its discovery and thus the plant is expressly excluded from the scope of 35 U.S.C. § 161 (Maj'y Opn. 8).

DISCUSSION

We dissent from the majority's interpretation of 35 U.S.C. § 161 and their conclusion that a plant found in "settled and farmed" land (FF7), and subsequently asexually reproduced, is ineligible under the statute for a patent.

The Plant Patent Act of 1930 – the progenitor of 35 U.S.C. § 161 – extended patent protection to asexually reproduced plants (Fowler,⁹ at 621). According to its legislative history, the drafters intended to exclude

⁸ "Maj'y Opn." refers to the majority opinion in this Decision affirming the Examiner's rejection.

⁹ Cary Fowler, *The Plant Act of 1930: A Sociological History of its Creation*, 82 J. PAT. & TRADEMARK OFF. SOC'Y 621 (2000).

“a wild variety, the chance find of the plant explorer” (S. Rep. No. 71-315, at 3 (1930)) “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, the PPA was amended to include “cultivated sports, mutants, hybrids, and newly found seedlings, . . . other than . . . a plant found in an uncultivated state”, i.e.,

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.

The amendment was apparently in part a response to a ruling in which the Patent Office had found a “chance seedling” to be excluded from the PPA.¹⁰ The case was not specifically identified by name, but the facts appear to be similar to those in *Ex parte Foster*, 90 USPQ 16 (Pat. Off. Bd. App. 1951), published several years prior to the 1954 amendment. In *Foster*, the applicant had discovered two small plants growing in a garden in Colombia, South America. *Id.* at 17. The owner of the garden gave the plants to the applicant who returned to Florida where he resided. *Id.* The applicant subsequently determined the plant was a new plant variety, reproduced the plant asexually, and sought a patent for the asexually reproduced plant under the PPA. *Id.* The Examiner rejected the claim on the grounds that “the plant claimed is a variety of plant found in nature and

¹⁰ H.R. Rep. No. 83-1455, at 2 (Mar. 31, 1954); Donald G. Daus, *Plant patents: A potentially extinct variety*, 21 ECONOMIC BIOLOGY 388 (1967).

hence excluded from the scope of” the PPA. *Foster*, 90 USPQ at 16. In affirming the Examiner’s rejection, an expanded panel of the Board of Appeals asked:

What is meant by “invented or discovered” and by “new variety of plant” in the statute? Do these words mean that the plant must be new in fact in the sense that the plant did not exist before, or do they include what is old and has existed before but which has been merely newly found?

Id. at 17.

Reviewing the legislative history of the Plant Patent Act of 1930, the Board concluded that Congress specifically intended to exclude newly found plants as was the plant claimed by *Foster*. *Id.* at 18.

The 1954 amendment to the Plant Patent Act was apparently intended to address *Foster* or a case like it. A House Report accompanying the bill states:

This bill is made necessary because of a change in the ruling of the Patent Office on the so-called chance seedlings. For many years, the Patent Office considered these chance seedlings to be patentable but about 4 years ago that Office reversed its position and ruled that Congress did not intend that these plants be embraced within the plant patent amendments. Thus, the enactment of this bill will indicate clearly that plant seedlings discovered, propagated asexually, and proved to have new characteristics distinct from other known plants are patentable under the patent laws of the United States.

H.R. Rep. No. 83-1455, at 2 (Mar. 31, 1954).

The Senate Report similarly states: “The purpose of the proposed legislation is to amend section 161 . . . to indicate clearly that plant seedlings . . . are patentable under the patent laws of the United States.”

S. Rep. No. 83-1937, at 1 (Jul. 19, 1954).

A “newly found” plant seedling would not have been the recipient of human effort since it would have been conceived under the watch of nature until “newly found” by the discoverer. It would be inconsistent with the plain language of the statute to require the plant to have been cultivated prior to its discovery, as concluded by our colleagues, since “newly found” implies that its existence was not known up until its actual discovery and therefore would not necessarily have been the direct beneficiary of human labor or care. Similarly, “sports” and “mutants”, which are eligible subject matter, would each arise spontaneously without human effort. *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1565 (Fed. Cir. 1995).

The 1954 amendment excluded “newly found” seedling from § 161 if “found in an uncultivated state.” The most logical explanation for the exclusionary amendment was to simply make explicit that which was already implicit from the legislative history of the 1930 Act, i.e., that a plant variety found in the “wild” by a “plant explorer” was non-statutory subject matter. Thus, “an uncultivated state” was intended to refer to the region or area (the “wild”) in which the plant was discovered, rather than the condition of the plant, itself, as opined by the majority. The statutory language that a “newly found” seedling was patentable, unless discovered in the wild, clarified that a plant discovered in a garden, as in *Foster*, falls within the scope of the PPA.

Therefore, in our view, a plant discovered on land which had been

improved by human labor or care (i.e., cultivated)¹¹ is within the scope of the amended Plant Patent Act, regardless of whether it had been the recipient of human labor prior to its discovery. This reading is consistent with the amendment being necessary to correct *Foster* (or a *Foster* type decision) which had found a plant in a garden to be excluded from the PPA because it was “a thing already existing” and “newly found.” *Foster*, 90 USPQ at 17-18. In sum, we fundamentally disagree with the majority’s reading of 35 U.S.C. § 161 to exclude “the chance find” of a plant on cultivated land.

The majority relies on the legislative history for reaching its conclusion “that Congress’ intent, in excluding plants found in an uncultivated state, was to limit the scope of the Act to plants whose existence or condition is . . . the result of human effort” (Maj’y Opn. 12). However, in the same legislative history, the Department of Agriculture recommended “that there be inserted after the words, ‘uncultivated state,’ some such phrase as ‘or in a location where no effort has been made to promote the growth of the plant.’” S. Rep. No. 83-1937, at 2 (Jul. 19, 1954). Apparently, this recommendation was rejected as the proposed language was not incorporated into the amended statute. For this additional reason, we do not agree that Congress expressed a clear and unambiguous intent to exclude from the scope of § 161 plants which originated without direct human effort.

Nonetheless, we cannot ignore the statutory language of § 161 that a patent may be obtained for the invention or discovery of “*cultivated* sports,

¹¹ Unlike our colleagues (Maj’y Opn. 14), we do not draw a distinction between a “garden”, a “wooded pasture”, or any other piece of improved land as each are a cultivated state and therefore outside the statutory exception of an “uncultivated state” as a source of a “newly found” plant.

mutants, hybrids, and newly found seedlings” (emphasis added). However, because “sports”, “mutants”, and “newly found seedlings” would each arise without human intervention, it is incompatible with the statute to read “cultivated” as a requirement that the “new variety of plant”, itself, have been accorded human care at its inception. As stated in its legislative history:

Under the present Plant Patent Act [of 1930], seedling plants developed by chance, with no attention or effort by the owner, are not subject to a patent. The enactment of this legislation will remove any doubt that the legislative intent of the Congress clearly means that sports, mutants, hybrids, and seedlings, discovered by persons engaged in agriculture or horticulture, should be patentable.

S. Rep. No. 83-1937, at 1 (Jul. 19, 1954). Evidently, it was Congress’ intent that human “attention” or “effort” would not be necessary to obtain a patent on “seedling plants developed by chance.” *Id.* In this light, we would understand “cultivated” to be a requirement that the plant be the recipient of human labor only after its discovery.

In sum, a newly found seedling that came into existence and which was subsequently discovered on cultivated land is eligible for a patent under 35 U.S.C. § 161. The issue in this case, which we now turn to, is whether the white oak tree from which AFTO-2 is derived, came into existence and was discovered on cultivated land.

The burden of establishing a *prima facie* case of unpatentability rests with the Examiner. The Examiner contends that there is no evidence “that the property owner had cultivated the tree itself” and that the “[d]iscovery of a tree on land that was once a ‘wooded pasture’ is not sufficient to support a conclusion that the tree was under cultivation” (Ans. 5).

The Examiner has not met the burden of establishing unpatentability. Under 35 U.S.C. § 161, a plant eligible for a patent must have arisen and been discovered on cultivated land. Thus, we first look to the issue of whether the AFTO-2's progenitor came into being on land that was improved by human labor or care.

With respect to the state of the land, we take note of the following findings of fact (Maj'y Opn. 3):

FF2. The Specification states that Appellant discovered AFTO-2 "in a front yard of a home" (Spec. 1, ¶ 1).

FF3. The Specification states that "[b]efore the house was constructed in the 1930's, the area was a wooded pasture with many white oak and hickory trees present." (Spec. 1, ¶ 2.)

FF7. The Specification states that "[r]eal estate records show that the land was settled and farmed for at least 35 years before the tree was started" (Spec. 2, ¶ 4).

The Examiner does not appear to have challenged these facts, but instead argues that discovering a plant on a "wooded pasture" does not make an asexually reproduced plant eligible for a patent because it does not establish that the tree "was under cultivation" (Ans. 5). As explained above, the Examiner improperly read the statute to require that the new variety of plant, itself, was the subject of human cultivation, which is wholly inconsistent with it being "newly found." Instead, the question is whether a plant "started" on land "settled and farmed for at least 35 years" (FF7) and then found "in a front yard of a home" (FF2) is excluded from 35 U.S.C. § 161 as being found in an "uncultivated state."

In affirming the Examiner, the majority states that the “evidence of record does not show that the land was cultivated at any date prior to 2004, when the photographs of Figures 1 and 3 were apparently taken” (Maj’y Opn. 8). We do not agree. The Specification states that the land was “settled and farmed . . . before the tree was started” (FF7), had been in a wooded pasture (FF3), and that the tree was discovered in a “front yard” of a house subsequently built on the pasture (FF2). Thus, there are statements by the inventor that the land upon which the tree initiated and continued its growth was under human care. The amount of human effort necessary to establish an area as “cultivated” would be understood to mean the ordinary care and labor commensurate with the purpose for which the land is held, e.g., occasional mowing as would be the case for a wooded pasture or a yard.

The majority finds the evidence that Appellant discovered AFTO-2 “in a front yard of a home” (Spec. 1, ¶ 1; FF2) insufficient because the accompanying photographs that show the state of the tree were taken “nearly ten years after the latest date that AFTO-2 could have been found according to the data in the Specification” (Maj’y Opn. 7). They conclude: “No evidence, provided by way of declaration or otherwise, relates the state of the tree shown in Figures 1 and 3 to the state of the tree when it was found in 1994 or earlier” (*id.*). The problem with this conclusion is that it is the PTO’s burden to show unpatentability which, in this case, means to show that the oak tree was found in an “uncultivated state,” an express exclusion to eligibility under 35 U.S.C. § 161.

When Appellant has made clear statements in the Specification that the tree came into existence on settled and farmed land (FF7), was once in a wooded pasture (FF3), and was discovered in a front yard of a house (FF2), in our opinion, the PTO must have a clear reason to doubt these assertions¹² that together establish the land as cultivated and outside the statutory exclusion. Our colleagues have identified nothing on the face of these statements, nor have they found an inconsistency in the record, which would have led persons of ordinary skill in the art to doubt their veracity.

In sum, on this record, we would conclude that Examiner has not met the burden of showing that the subject matter of claim 1 is ineligible for a patent under 35 U.S.C. § 161.

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¹² It is well-established that assertions made in a specification disclosure are presumptively correct. *In re Brana*, 51 F.3d 1560, 1566 (Fed. Cir. 1995). The majority's reference to *In re Best*, 562 F.2d 1252 (CCPA 1977) as a rationale for requiring Appellant to prove that the claimed plant was found in a "cultivated state" (Maj'y Opn. 15) is beside the point since evidentiary statements were made in the Specification and no basis was provided to doubt these presumptively correct assertions.