



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***J. E. M. Ag  
Supply, Inc.  
v.  
Pioneer Hi-Bred  
Int'l, Inc.***

No. 99-1996,  
U.S. Supreme  
Court  
Dec. 10, 2001

***"[U]tility patents  
may be issued  
for plants."***

On December 10, 2001, the U.S. Supreme Court upheld the Federal Circuit's affirmance of the district court's summary judgment in favor of Pioneer, which had sued J.E.M. for infringement of seventeen U.S. patents relating to inbred and hybrid corn seed products. The district court held that the subject matter covered by 35 U.S.C. § 101 clearly includes plant life, and that in enacting the Plant Protection Act (PPA) and the Plant Variety Protection Act (PVPA), Congress neither expressly nor implicitly removed plants from § 101 subject matter. The Supreme Court noted:

[P]etitioners argue that the PPA and the PVPA provide the exclusive means of protecting new varieties of plants, and so awarding utility patents for plants upsets the scheme contemplated by Congress. We disagree. Considering the two plant specific statutes in turn, we find that neither forecloses utility patent coverage for plants. . . .

The 1930 PPA conferred patent protection to asexually reproduced plants. Significantly, nothing within either the original 1930 text of the statute or its recodified version in 1952 indicates that the PPA protection for asexually reproduced plants was intended to be exclusive. . . .

Whatever Congress may have believed about the state of patent law and the science of plant breeding in 1930, plants have always had the potential to fall within the general subject matter of § 101, which is a dynamic provision designed to encompass new and unforeseen inventions. "A rule that unanticipated inventions are without protection would conflict with the core concept of the patent law that anticipation undermines patentability." . . .

By passing the PVPA in 1970, Congress specifically authorized limited patent-like protection for certain sexually reproduced plants. Petitioners therefore argue that this legislation evidences Congress' intent to deny broader § 101 utility patent protection for such plants. Petitioners' argument, however, is unavailing for two reasons. First, nowhere does the PVPA purport to provide the exclusive statutory means of protecting sexually reproduced plants. Second, the PVPA and § 101 can easily be reconciled. Because it is harder to qualify for a utility patent than for a Plant Variety Protection (PVP) certificate, it only makes sense that utility patents would confer a greater scope of protection. . . .

Thus, while the PVPA creates a statutory scheme that is comprehensive with respect to its particular protections and subject matter, giving limited protection to plant varieties that are new, distinct, uniform, and stable, nowhere does it restrict the scope of patentable subject matter under § 101. . . . The PVPA itself . . . contains no statement that plant variety certificates were to be the exclusive means of protecting sexually reproducing plants. The relevant statements in the legislative history reveal nothing more than the limited view of plant breeding taken by some Members of Congress who believed that patent protection was unavailable for sexually reproduced plants. This view stems from a lack of awareness concerning scientific possibilities.