IP Alert: Supreme Court Decides Bowman v. Monsanto

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Supreme Court Decides *Bowman v. Monsanto*

By Sarah A. Kagan

The Supreme Court handed down a unanimous decision today in *Bowman v. Monsanto*, holding the doctrine of patent exhaustion does not permit a farmer to reproduce patented seeds by replanting seeds after growing a first crop.

Supported by anti-GMO (genetically modified organism) non-profit organizations such as the Center for Food Safety and Save Our Seeds, Hugh Bowman took his case all the way to the Supreme Court. The Court roundly rejected Bowman's theories as to why his replanting of commodity seeds and saving selected Round-Up Ready™ seeds for further plantings did not constitute infringement of Monsanto's patents on the genetically modified seeds.

Bowman's case rested on the doctrine of patent exhaustion, whereby once a patentee sells his product, he cannot control further use of that product. Bowman had bought the beans from a commodity grain elevator, which had purchased the crop from a farmer who bought from an authorized Monsanto agent. Bowman argued that the original sale of the parental seed to the farmer exhausted Monsanto's right to control use of the subsequent generations of soybeans. Bowman's theories have some initial appeal, because certainly the *raison d'etre* of a seed is to plant it. As the Court noted, however, planting a seed to make more seeds for planting future generations is not the only use of a seed. Soybean seeds can be used as a direct food source for human and animal consumption. Soybean seeds can also be processed into other products, such as oil, milk, tofu, and nutritional supplements. Thus Monsanto's prevention of the use of the soybeans as parents of further generations did not prevent the purchaser from enjoying all uses of the soybeans.

But more fundamental to the Court's decision was its characterization of replanting seed for future generations as an impermissible reconstruction or copying of the invention, which the doctrine of patent exhaustion does not permit. The Court pointed out that the first sale exhausts the rights only in the actual product sold, *i.e.,* the seeds actually purchased. Those seeds could be used for any commodity purpose, *i.e.,* for consumption or processing and consumption. But replanting the seeds inevitably created a second generation of plants, and that second generation constituted a copy of the original invention.

While Bowman tried to avoid his role in the infringing process by urging that the seeds just germinated on their own, the Court rejected that position as a "blame-the-bean defense." It found the eight repeated cycles of planting, treating with Round-Up™ , harvesting, saving and planting did not just happen without Bowman's active labor.

Although the Court indicated that it had taken the case in order "to consider the important question of patent law raised in this case," it is not clear that the decision breaks any new ground. The Court relied on long-standing precedent and cited no case law that would make this a close question. Its decision does not appear to deviate from the reasoning in the lower courts. Once one sorts out the generations of seeds, the case falls squarely within prevailing legal principles. The Court in *Bowman v. Monsanto* had the potential to reach other self-replicating inventions, such as cell lines and microorganisms. However, the Court explicitly limited its holding to the specific facts of this case, declining to extend its holding to all self-replicating inventions.

The Court may have taken the case as part of its recent interest in reviewing the fundamentals of patent protection. The Court has shown particular interest in the patent eligibility of inventions in the biological sciences, such as clinical tests, therapeutic regimens, and genes. Bowman may be part of the Court's reassessment of the role of patents related to living things.

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