One vine day

THE CASE:
James M Green, et al v Monrovia Nursery Company
US Court of Appeals for the Ninth Circuit
6 January 2021

David A Dillard and **Drew Wilson** discuss the difficulties involved in proving the heritage of, and rights to, commercial plant mutations

Plant patents allow someone who has isolated and asexually propagated a unique cultivar of a plant to exclude others from propagating that same plant. This encourages farmers, nurseries and those interested in agriculture to invest the significant amount of time and effort that it takes to isolate desired traits. These cultivars are often given botanical names to identify their lineage and fanciful trade names for use in marketing and advertisements.

The case of *Green, et al v Monrovia Nursery Company,* involved litigation over contract and patent rights to a cultivar of a mandevilla, a genus of flowering vines belonging to the family Apocynaceae. Mandevilla flowers typically have single flowers consisting of a ring of five large petals. At their nursery, plaintiffs James M Green, Cecil M Green and Rita M Green discovered a branch mutation on an existing mandevilla cultivar called Alice Du Pont. The branch mutation was characterised by the presence of red-purple double flowers consisting of an outer ring of five large petals and an inner ring of five petaloids. The Greens named the cultivar Rita Marie Green (RMG).

In 1998, the Greens entered into a licence agreement with Monrovia Nursery Company who agreed to pay royalties on the sales of the RMG cultivar[1] and any new cultivars derived from the RMG. The agreement included a clause granting all patent rights in the RMG to Monrovia Nursery Company (Monrovia), except that the rights would revert to the Greens in the event of a breach of the agreement. The RMG became the third mandevilla cultivar in Monrovia's product line. Monrovia also sold the Alice du Pont cultivar with its single pink flowers and another double flowering cultivar, also derived from the Alice du Pont, called Monite[2] characterised by pale pink double flowers.

In 2000, Monrovia discovered new double flowers on a branch of a Monite plant. The flowers had twice the number of petals as the RMG and Monite flowers and had a unique pink ruffled look. This new cultivar was named Monrey.[3] The Greens believed that the Monrey was derived from an RMG plant and that, by not paying royalties for sales of the Monrey, Monrovia had breached the parties' agreement. The Greens filed suit in federal court asserting a number of causes of action, among them breach of contract, patent infringement, misappropriation of trade secrets and product disparagement/trade libel.

In order to prove their suspicions, the Greens hired a well-regarded expert in plant genetics, Detlef Weigel, to genetically test and compare the RMG and Monrey cultivars to determine if they were related or identical. Weigel informed the Greens that because the RMG and Monrey were derived from the same common ancestor, ie the Alice Du Pont cultivar, a DNA test would not be meaningful since the plants were already known to be virtually genetically identical. As an alternative, Weigel considered the likelihood of the independent occurrence of the double flower in the Alice du Pont cultivar. Borrowing known mutation rates from other plants of the same plant family, Weigel opined that there was an astronomically low probability that a double-flowering trait could randomly occur at any given time.

Weigel did not appear to consider the direct evidence presented by Monrovia. This included eyewitness declarations and photographs taken on the day of the discovery of the original branch mutation on a Monite plant showing the new double flowers.

Monrovia moved for summary judgment on the Greens' claims, and the court granted the motion. As for the genetic parentage of the Monrey, the issue was whether the Monrey was derived from an RMG plant or a Monite plant. The court agreed with Monrovia that Weigel's report did not answer this question. The court noted that "however unlikely the double flowering trait is, plaintiffs' expert report does not establish that the Rita Marie Green is any more likely than the Monite to be the Monrey's parent." The court suggested that, had the Monrey been alleged to be another branch mutation of the Alice du Ponte, Weigel's report would likely have created a genuine issue of material fact. But as to whether the RMG or the Monite was the parent of the Monrey, Weigel's report was irrelevant.

An interesting practice pointer here is that statistical reports as to the likelihood of the expression of a trait by a cultivar might be used to create a triable issue of fact sufficient to defeat summary judgment. Even if the mutation rates for the cultivar are not known, mutation rates for similar plants expressing the trait might be considered and used as proxies.

Footnotes

1. Monrovia Nursery sells the RMG cultivar under the commercial name PINK PARFAIT.
2. Monrovia Nursery sells the Monite cultivar under the commercial name MOONLIGHT PARFAIT.
3. Monrovia Nursery sells the Monrey cultivar under the commercial name TANGO TWIRL.

Authors

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