Chapter 1600 Plant Patents

1601 Introduction: The Act, Scope, Type of Plants Covered

The right to a plant patent stems from:

35 U.S.C. 161 Patents for plants.

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 provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

Asexually propagated plants are those that are reproduced by means other than from seeds, such as by the rooting of cuttings, by layering, budding, grafting, inarching, etc. Plants capable of stable reproduction are not excluded from consideration if they have also been asexually reproduced.

With reference to tuber propagated plants, for which a plant patent cannot be obtained, the term "tuber" is used in its narrow horticultural sense as meaning a short, thickened portion of an underground branch. Such plants covered by the term "tuber propagated" are the Irish potato and the Jerusalem artichoke. This exception is made because this group alone, among asexually reproduced plants, is propagated by the same part of the plant that is sold as food.

The term "plant" has been interpreted to mean "plant" in the ordinary and accepted sense and not in the strict scientific sense and thus excludes bacteria: *In re Arzberger*, 1940 C.D. 653, 46 USPQ 32, 27 CCPA 1315 (CCPA 1940). The term "plant" thus does not include asexual propagating material, per se, *Ex parte Hibberd*, 227 USPQ 443,447 (Bd. Pat. App. & Int. 1985).

An asexually reproduced plant may also be protected under 35 U.S.C. 101, as the Plant Patent Act (35 U.S.C. 161) is not an exclusive form of protection which conflicts with the granting of utility patents to plants, *Ex parte Hibberd*, 227 USPQ 443 (Bd. Pat. App. & Int. 1985). Inventions claimed under 35 U.S.C. 101 may include the same asexually reproduced plant which is claimed under 35 U.S.C. 161, as well as plant materials and processes involving plant materials. The filing of a terminal disclaimer may be used in appropriate situations to overcome an obviousness–type double patenting rejection based on claims to the asexually reproduced plant and/or fruit and propagating material thereof in an application under 35 U.S.C. 101 and the claim to the same asexually reproduced plant in an application under 35 U.S.C. 161.

35 U.S.C. 163. Grant.

In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

1602 Rules Applicable

37 CFR 1.161. Rules applicable.

The rules relating to applications for patent for other inventions or discoveries are also applicable to applications for patents for plants except as otherwise provided.

1603 Elements of a Plant Application

An application for a plant patent consists of the same parts as other applications and must be filed in duplicate (37 CFR 1.163(b)), but only one need be signed and executed; the second copy may be a legible carbon copy of the original. Two copies of color drawings must be submitted, 37 CFR 1.165(b). The reason for thus providing an original and duplicate file is that the duplicate file is utilized for submission to the Department of Agriculture for a report on the plant variety, the original file being retained in the Patent and Trademark Office at all times.

Applications for a plant patent which fail to include two copies of the specification and two copies of the drawing when in color will be accepted for filing only. The Application Division will notify the applicant immediately of this deficiency and require the same to be rectified within one month. Failure to do so will result in loss of the filing date.

1604 Applicant, Oath

37 CFR 1.162. Applicant, oath or declaration.

The applicant for a plant patent must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought (or as provided in §§ 1.42, 1.43 and 1.47). The oath or declaration required of the applicant, in addition to the averments required by § 1.63, must state that he or she has

asexually reproduced the plant. Where the plant is a newly found plant, the oath or declaration must also state that it was found in a cultivated area.

In an application for a plant patent, there can be joint inventors. See *Ex parte Kluis*, 70 USPQ 165 (Bd. App. 1945).

1605 Specification and Claim

35 U.S.C. 162. Description, claim.

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

37 CFR 1.163. Specification.

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

(b) Two copies of the specification (including the claim) must be submitted, but only one signed oath or declaration is required. The second copy of the specification may be a legible carbon copy of the original.

37 CFR 1.164. Claim.

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The specification should include a complete detailed description of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, expressed in botanical terms in the general form followed in standard botanical textbooks or publications dealing with the varieties of the kind of plant involved (evergreen tree, dahlia plant, rose plant, apple tree, etc.), rather than a mere broad nonbotanical characterization such as commonly found in nursery or seed catalogs. The specification should also include the origin or parentage of the plant variety sought to be patented and must particularly point out where; e.g., location or place of business, and in what manner the variety of plant has been asexually reproduced. Where color is a distinctive feature of the plant, the color should be positively identified in the specification by reference to a designated color as given by a recognized color dictionary or color chart.

If the written description of a plant is deficient in certain respects, a clarification or additional description of the plant, or even a wholesale substitution of the original description so long as not totally inconsistent and unrelated to the original description and photograph of the plant, will not constitute new matter under 35 U.S.C. 132. (*Jessell* v. *Newland*, 195 USPQ 678, 684 (Dep. Comm'r Pat. 1977).

The rules on Deposit of Biological Materials, 37 CFR 1.801–1.809, do not apply to plant patent applications in view of the reduced disclosure requirements of 35 U.S.C. 162, even where a deposit of a plant has been made in conjunction with a utility application (35 U.S.C. 101).

A plant patent is granted only on the entire plant. It, therefore, follows that only one claim is necessary and only one is permitted. A method claim in a plant patent application is improper.

1606 Drawings

37 CFR 1.165.Plant drawings.

(a) Plant patent drawings should be artistically and competently executed and must comply with the requirements of § 1.84. View numbers and reference characters need not be employed unless required by the examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation.

(b) The drawing may be in color and when color is a distinguishing characteristic of the new variety, the drawing must be in color. Two copies of color drawings or color photographs must be submitted.

All color drawings should be so mounted as to provide a 2–inch margin at the top for office markings when the patent is printed.

1607 Specimens

37 CFR 1.166 . Specimens.

The applicant may be required to furnish specimens of the plant, or its flower or fruit, in a quantity and at a time in its stage of growth as may be designated, for study and inspection. Such specimens, properly packed, must be forwarded in conformity with instructions furnished to the applicant. When it is not possible to forward such specimens, plants must be made available for official inspection where grown.

Specimens of the plant variety, its flower or fruit, should not be submitted unless specifically called for by the examiner.

1608 Examination

37 CFR 1.167. Examination.

(a) Applications may be submitted by the Patent and Trademark Office to the Department of Agriculture for study and report.

(b) Affidavits or declarations from qualified agricultural or horticultural experts regarding the novelty and distinctiveness of the variety of plant may be received when the need of such affidavits or declarations is indicated.

The authority for submitting plant applications to the Department of Agriculture for report is given in:

Executive Order No. 5464, October 17, 1930. Facilitating the consideration of applications for plant patents.

I, Herbert Hoover, President of the United States of America, under the authority conferred upon me by act of May 23, 1930 (Public No. 245) [now 35 U.S.C. 164], entitled "An act to provide for plant patents," and by virtue of all other powers vested in me relating thereto, do hereby direct the Secretary of Agriculture: (1) to furnish the Commissioner of Patents such available information of the Department of Agriculture, or (2) to conduct through the appropriate bureau or division of the department such research upon special problems, or (3) to detail to the Commissioner of Patents such officers and employees of the department, as the Commissioner may request for the purpose of carrying said act into effect.

35 U.S.C. 164. Assistance of Department of Agriculture.

The President may by Executive order direct the Secretary of Agriculture, in accordance with the request of the Commissioner, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

Plant applications are subject to the same examination process as any other national application. As such, the statutory provisions with regard to patentable subject matter, utility, novelty, obviousness, disclosure, and claim specificity requirements apply (35 U.S.C. 101, 102, 103, and 112). The sole exception in terms of applicability of these statutory provisions is set forth in 35 U.S.C. 162.

The prior art considered by the examiner is developed by a search of appropriate subclasses of the United States patent classification system as well as patent and nonpatent literature data bases. Where appropriate, a report may be obtained from the Agricultural Research Service, Horticultural Research Branch, Department of Agriculture.

1609 Report of Agricultural Research Service

Where the examiner considers it necessary to the examination of the plant patent application, a duplicate file and drawing of the application are forwarded to the National Program Leader for Horticultural Crops, Agricultural Research Service (ARS), U.S. Department of Agriculture, along with a request for a report as to whether the plant variety disclosed is new and distinct over known plant varieties.

The report of the ARS is usually accompanied by the duplicate file and drawing. The report is in duplicate, the original being signed by the Chief of the Branch. The original copy of the report is retained in the duplicate file. As the report is merely advisory to the Office, it is not a part of the official record of the application and is, therefore, not given a paper number and is not placed in the original file. The carbon copy of the report is customarily utilized by the examiner in the preparation of his action on the case and is also retained in the duplicate file.

The report may embody criticisms and objections to the disclosure, may offer suggestions for correction of such, may require specimens of the plant, flower, or fruit thereof, may require affidavits of recognized authorities to corroborate the allegations of the applicant as to certain or all of the distinguishing features of the variety of plant sought to be patented, may state that the plant will be inspected by a field representative of the Department of Agriculture, etc., or the report may merely state that:

"Examination of the specification submitted indicates that the variety described is not identical with others with which our specialists are familiar."

1610 The Action

The action on the application by the examiner will include all matters as provided for in other types of patent applications. See 37 CFR 1.161.

The action may include so much of the report of the ARS as the examiner deems necessary, or may embody no part of it. In the event of an interview, the examiner, in his discretion, may show the entire report to the inventor or attorney.

With reference to the examination of the claim, the language must be such that it is directed to the "new and distinct variety of plant." This is important as under no circumstance should the claim be directed to a new variety of flower or fruit in contradistinction to the plant bearing the flower or the tree bearing the fruit. This is in spite of the fact that it is accepted and general botanical parlance to say — A variety of apple or a variety of blackberry — to mean a variety of apple tree or a variety of blackberry plant.

Where the application may be allowed a claim which recites, for example — A new variety of apple characterized by — may be amended by the insertion of — tree — after "apple" by an examiner's amendment.

By the same token, the title of the invention must relate to the entire plant and not to its flower or fruit, thus: Apple Tree, Rose Plant.

Care should also be exercised that the specification does not contain unwarranted advertising, for example, "the disclosed plant being grown in the XYZ Nurseries of Topeka, Kansas." It follows, also, that in the drawings any showing in the background of a plant, as a sign carrying the name of an individual, nursery, etc., is objectionable and deletion thereof is required. Nor should the specification include laudatory expressions, such as, "The rose is prettier than any other rose." Such expressions are wholly irrelevant. Where the fruit is described, statements in the specification as to the character and quality of products made from the fruit are not necessary and should be deleted.

The Office action is typed with an additional copy which is placed in the duplicate file. The papers in the duplicate file are not noted on the index at the back of the duplicate file wrapper.

When it appears that the application must be resubmitted to the A.R.S., as when the report indicates that the duplicate file and drawing are retained, applicant is notified that response papers must be in duplicate.

Frequently, the ARS in its report states that in view of its lack of sufficient information, data, specimens, etc., its specialists are unable to determine whether the variety of plant under consideration is new and distinct and suggests that the Patent and Trademark Office require the applicant to submit affidavits or declarations from recognized experts as to the newness of the variety. See 37 CFR 1.167(b).

The report of the ARS is not in the nature of a publication and matters raised therein within the personal knowledge of the specialists of the ARS are not sufficient basis for a rejection unless it is first ascertained by the examiner that the same can be supported by affidavits by said specialists (37 CFR 1.107(b)). See *Ex parte Rosenberg*, 46 USPQ 393 (Bd. App. 1939).

1611 Issue

The preparation of a plant patent application for issue involves the same procedure as for other applications (37 CFR 1.161), with the exception that where there are colored drawings, the better one of the two judged, for example, by its sharpness or cleanliness is selected, and to this one the issue slip is affixed. The duplicate file is retained in the examining group until after the application has been patented. At certain periods thereafter, such duplicate files are collected and sent to the abandoned files for storage.

The International Patent Classification symbols, most recent edition, should be placed on the Issue Classification slip of all plant patent applications being sent to issue.

All plant patent applications should contain an abstract when forwarded to the Patent Issue Division.

1612 UPOV Convention

On November 8, 1981, the 1978 text of the "International Convention for the Protection of New Varieties of Plants" (generally known by its French acronym as the UPOV Convention) took effect in the United States and two other states, Ireland and New Zealand. As of March 1, 1990, 19 states were party to the UPOV Convention: They are Australia, Belgium, Denmark, Federal Republic of Germany, France, Hungary, Israel, Italy, Japan, Netherlands, New Zealand, Poland, South Africa, Spain, Sweden, Switzerland, United Kingdom, and United States of America. Over time, most states are expected to adhere to the 1978 text.

Both the 1961 and 1978 texts guarantee to plant breeders in each member state both national treatment and the right of priority in all other member states. In many states, new plant varieties are protected by breeders' rights laws rather than patent laws. Accordingly, the Paris (Industrial Property) Convention cannot always be relied on to provide these and other rights.

Insofar as the patenting of asexually reproduced plants in the United States is concerned, both national treatment and the right of priority have been accorded to foreign plant breeders since enactment of the plant patent law in 1930 (now 35 U.S.C. 161–164). The UPOV Convention does not yet apply to the protection of sexually reproduced plants under the Plant Variety Protection Act, 7 U.S.C. 232 et seq., administered by the Department of Agriculture.

Application of the UPOV Convention in the United States does not affect the examination of plant patent applications, except in one instance. It is now necessary as a condition for receiving a plant patent to register a variety name for that plant.

The registration process in general terms consists of inclusion of a proposed variety name in the plant patent application. The examiner must evaluate the proposed name in light of UPOV Convention, Article 13. Basically, this Article requires that the proposed variety name not be identical with or confusingly similar to other names utilized in the United States or other UPOV member countries for the same or a closely related species. In addition, the proposed name must not mislead the average consumer as to the characteristics, value, or identity of the patented plant. Ordinarily, the name proposed for registration in the United States must be the same as the name registered in another member state of UPOV. Inclusion of the variety name in the patent comprises its registration. Rules of Practice are now being developed for administering this variety naming requirement.