

Plant Patents and Trademarks: Frequently Asked Questions

Important Note: *PlantHaven is pleased to provide these notes in good faith, in the belief that they represent industry best practice. However, readers are advised that PlantHaven is not qualified or permitted to give any legal advice or to practice at the US Patent and Trademark Office. Therefore, these notes are provided on the express condition that they are intended for general guidance only and may not be relied upon as definitive of any particular situation. Accordingly, PlantHaven advises readers that they should obtain legal advice from a qualified attorney if they have any questions about plant patents and trademarks.*

PATENTS

What is a Plant Patent?

A Plant Patent is a right granted by the US Patent and Trademark Office (USPTO) which allows the patent owner to exclude others from propagating the patented variety, or from selling or using it, or any of its parts throughout the United States.

The patent owner may also prohibit others from importing the plant or any of its parts into the United States.

Almost 1,000 plant patents have been granted by USPTO during 2009.

Who is entitled to file and own a Plant Patent?

The named individual who bred or discovered the new variety is known as the Inventor and all patent applications require the inventor to sign a Declaration as such. It is permitted for there to be more than one named inventor. Unless the inventor(s) formally assigns their patent rights to another person or entity, the patent rights always belong to the inventor, or the inventor's successors, and are regarded as personal property.

What other forms of plant protection are available?

New plants or series of plants may be eligible for Utility Patent protection either instead of, or in addition to a Plant Patent. Utility Patents are generally more appropriate for protecting the results of advanced technical plant breeding where novel common characteristics have been developed and which form an entirely new class of material.

Outside the US, new plant varieties are protected by Plant Breeders Rights (see below).

Trademarks (also see below) are not intended to be used for prohibiting the propagation of a plant variety.

What steps are involved in patenting a plant?

A plant patent is obtained by filing at the U.S. Patent and Trademark Office a comprehensive specification for the variety which must include an explanation of its origin, a thorough botanical description and a set of photographs which present the variety's essential characteristics. The filing papers will include a declaration by the inventor that the variety is new and distinct and that it was either bred, or discovered in a cultivated state (as opposed to having been found in the wild.)

After the filing has been accepted at USPTO, the case will be assigned to a patent examiner who will usually get to the application in 9 – 15 months time, depending on case load. The examiner may have supplementary questions and may request additional information.

Once the examiner is satisfied with the contents of the application, a Notice of Allowance is mailed together with a requirement to pay the issue fee. The patent itself, with its Patent Number is mailed by USPTO approximately three months after payment of the issue fee.

Must the breeder be represented by a Patent Attorney?

USPTO recommends that all patent applicants be represented by a registered Patent Attorney or Patent Agent. However, USPTO is required to allow and assist independent inventors (breeders or discoverers) to prosecute their own ("pro se") application if sufficient competency is demonstrated.

If the inventor transfers his or her entire rights in the patent or patent application (an assignment) then that assignee may proceed to engage a patent practitioner or to prosecute the application *pro se*.

When must a patent be filed?

In general, a plant patent application must be filed within one year of the first date on which the variety was made available to the public (which includes the trade) anywhere in the world.

PlantHaven advises that if the new variety is described in any publication, including the internet, then it is prudent to assume that the one year grace period has been started.

How much does a patent cost?

As of November 2009, the USPTO application fee for a plant patent is \$720, and the issue fee is \$1,190. These fees exclude the service fees charged by practitioners. A prudent estimate of total cost is in the range \$2,750 - \$4,000.

Unlike patents for other inventions, no annual fees are due to USPTO for maintaining a Plant Patent.

How long does a patent last?

Plant patents are granted for a term of 20 years from the date of filing of the application.

I am a wholesale grower: how can I grow a patented plant?

The owner of the patent has the exclusive right to permit or prohibit propagation or distribution of a patented plant, and may choose to exercise that right in order to be the sole producer and distributor of the variety.

Alternatively, the patent owner may be interested in permitting others to grow the variety under license in return for a payment of royalties. Either the patent owner or his/her agent will decide whether to grant third party propagation rights, on what terms and to whom.

I am a grower or a retailer or a landscaper: why should I carry or use patented plants which will eat into my profit margin?

Patented plants should be superior plants with significant and valuable commercial and performance benefits which more than outweigh the included royalty cost for the consumer.

I am a breeder: how can I tell if a plant is worth patenting?

The market will support the introduction of a patented variety, including its royalty level, if the variety carries benefits which justify the premium cost of the royalty and the new product development and marketing processes.

It is best practice always to determine in advance, through market research and secure trials, that a variety will be taken up enthusiastically by the industry and be profitable for all parties.

If a plant is worth patenting, and is properly managed, then it should be capable of delivering a sustained royalty stream for many years, or even for the entire life of the patent.

How can I check if a plant is patented?

All patented plants should display a tag and be listed in trade catalogues with a clear statement of the plant patent number. Granted plant patents can be looked up and researched on the website of USPTO: www.uspto.gov, using Search...Patents...Issued Patents.

What is PPAF?

PPAF is a term used by our industry to put others on notice that a variety is "Plant Patent Applied For." It is equivalent to the term "Patent Pending".

The purpose of giving notice in this way is to forewarn others that a patent application is in process and, upon issuance, the plant concerned becomes instantly subject to the patent holder's right to exclude all non-permitted activity. Thus, growers and propagators will often accept a license in order to be "grandfathered in" to the expected issue of the plant patent.

It is a Federal offence knowingly and erroneously to hold out a plant variety as Pending or PPAF.

How can I check if a patent has been filed?

All patent applications are maintained in secrecy until 18 months after their date of filing. At that point, applications may be searched on the website of USPTO: www.uspto.gov, using Search...Patents...Published Applications.

However, USPTO regulations permit most plant applicants to request non-publication at 18 months, in which case the particulars are not publicly available until the patent is granted and issued.

Is it legal to breed from a plant protected by a Plant Patent?

It appears that this question has not been definitively resolved in law. Some practitioners maintain that the original patent holder has the right to exclude others from using parts (including seed, pollen) of a patented variety in a deliberate breeding program. However, other practitioners have held that no such right or control exists after the patented plant has been purchased in open sale and the royalty has been paid. In effect, the original breeder's rights have been exhausted, thereby rendering the variety free and clear.

PLANT BREEDERS RIGHTS

What is involved in protecting a plant overseas?

The Plant Patent system is unique to the U.S. Other countries, including Canada, offer Plant Breeders Rights (PBR) protection for breeders.

The overall PBR procedure is similar in all cases: the breeder or his representative files an application, which is then examined, and a grant of rights may follow in due course. However, compared with a patent application, there are some important differences, chiefly:

- The breeder may have a longer "grace" period in which to file. Typically, a PBR application must be filed within one year of first date of sale within the application territory, or within 4 years of first date of sale outside the application territory. In the case of trees or vines, the 4 year term may extend to 6 years.
- The examination process requires test plants to be submitted to official comparative trials against the nearest known cultivar. The candidate variety will be assessed for its distinctness and stability, and may fail on either count.

What are the costs and the duration of Plant Breeders Rights?

The costs of obtaining a grant of PBR vary widely from territory to territory, being most expensive in Europe where the total cost (excluding any agents' fees) is in the range €2,500 - €3,750 (approximately \$3,750 - \$5,625 in November 2009).

PBR applications cannot be processed by a non-resident of the application territory. It is required to engage a domestic representative who may also act as the breeder's agent.

In view of the potential for costs to accumulate from each territory of interest, it is important to make an early start on plant trials, and to utilize the permitted grace period to the full, in order to make reliable royalty revenue projections prior to incurring the costs of protection.

Grants of PBR generally have longer terms than Plant Patents. A grant of PBR in Europe lasts for 25 years in general; 30 years for trees and vines.

Grants of PBR require payment of an annual maintenance fee in the region of \$200 - \$400.

TRADEMARKS

What is the difference between a trademark and a patent?

Whereas (USPTO) "Patents protect inventions... Trademarks include any word, name, symbol, or device... used in commerce to identify and distinguish the goods of one manufacturer or seller from goods manufactured or sold by others and to indicate the source of the goods".

Only a patent has the ability to control (permit or exclude) propagation of a plant variety. A trademark does not provide this protection.

What does TM mean, and what is meant by registration of a trademark?

It is common to find the TM designation applied to goods or services, including plant names. This designation is used to put others on notice that trademark rights are being claimed in those goods or services. The TM designation does not carry the endorsement of having secured federal registration, which is denoted by use of the symbol ®.

Federal registration of a claimed trademark follows after scrutiny by an examining attorney at USPTO and after a period of public notice and opportunity to oppose registration. Trademarks which are federally registered have a presumption of validity. In addition, the trademark owner enjoys the benefit that others may readily consult and verify the registered mark and its ownership on www.uspto.gov.

PlantHaven believes that any person or company who aspires to build a reputation for their goods or services should consider obtaining federal registration of trademark or trademarks which denote and unite those goods or services with their origin.

Trademarks are good value: for a modest outlay, and with consistent and proper promotion and marketing, the owner will find that the trademark acquires over time significant value or brand equity which will be increasingly effective in maintaining differentiation in the marketplace.

In PlantHaven's experience, plant breeding programs and branded plant or nursery marketing programs are ideal subjects for trademark protection.

How do I obtain Federal Registration of a proposed Trademark?

The USPTO website is an excellent resource for learning the basic principles and procedures for applying for Federal registration. If an applicant feels fully conversant with the required procedures and formalities, and has conducted a prior search of registerability, then the applicant may elect to file electronically, without the use of a trademark attorney.

The initial filing fee for federal registration of a trademark is \$325 and a further fee of \$100 will be due upon allowance – unless the trademark was filed on the basis of actual prior use in commerce.

However, with such a modest fee, PlantHaven feels that it is prudent and worthwhile to consult in advance with an attorney with trademark expertise, who will generally indicate the advisability and methods of conducting a thorough search of registerability before proceeding.

What about trademarks on plant variety names?

USPTO maintains a clear position that varietal or cultivar names cannot be registered as trademarks. Further, trademark examiners are required to inquire of "plant" applicants whether their proposed trademark has any significance as a varietal name.

USPTO, being concerned about possible confusion of the public in the marketing of plants, is opposed to the registration of any trademarks which are used to describe to the public a particular sort of plant, as opposed to a plant from a particular source.

In principle, USPTO holds that it is common sense to provide the prospective purchaser with some common descriptive varietal name: a name which cannot then function as a trademark.

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P.O. Box 3056 • Santa Barbara, CA 93130-3056

Phone 805.569.9179

Fax 805.569.6549

Web <http://www.planthaven.com>

Email new.plants@planthaven.com