Chapter 1600 Plant Patents

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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 sexual 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*, 112 F. 2d 834, 46 USPQ 32 (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 alternatively 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 include the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

As provided in 35 U.S.C. 161, the rights associated with a plant patent include the rights associated with a utility patent, and the "right to exclude" has additional terms provided in 35 U.S.C. 163. A plant patent issuing from an application filed after June 7, 1995 has a term which expires 20 years after the filing date of the application, or any earlier filing date claimed under 35 U.S.C. 120, 121 or 365(c). See MPEP § 2701. Plant patent applications will be published pursuant to 35 U.S.C. 122(b).

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

37 CFR 1.163. Specification and arrangement of application elements in a plant application.

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(b) The elements of the plant application, if applicable, should appear in the following order:

(1) Plant application transmittal form.
(2) Fee transmittal form.
(3) Application data sheet (see § 1.76).
(4) Specification.
(5) Drawings (in duplicate).
(6) Executed oath or declaration (§ 1.162).

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An application for a plant patent consists of the same parts as other applications. For information pertaining to the oath or declaration, specification and claim, or drawings, see MPEP § 1604, § 1605, or § 1606, respectively.

1604 Applicant, Oath or Declaration

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.

A Plant Patent Application (35 U.S.C. 161) Declaration, Form PTO/SB/03, may be used to submit a declaration. Form PTO/SB/81 may be used to appoint an attorney or agent. See MPEP § 402.

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

Type a plus sign (+) inside this box → ☐

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PLANT PATENT APPLICATION (35 U.S.C. 161) DECLARATION (37 CFR 1.63)

☐ Declaration Submitted with Initial Filing *OR* ☐ Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)

Attorney Docket Number	
First Named Inventor	
COMPLETE IF KNOWN	
Application Number	/
Filing Date	
Group Art Unit	
Examiner Name	

As a below named Inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the new and distinct variety of:

plant named:

which is claimed and for which a plant patent is sought, the specification of which

☐ is attached hereto *OR* ☐ was filed on (MM/DD/YYYY) as United States

Application Number and was amended on (MM/DD/YYYY) (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claim, as amended by any amendment specifically referred to above.
I have asexually reproduced the plant to which this application applies.

☐ Said plant was found in a cultivated area *(check this box for newly found plant only)*

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the National or PCT International filing date of the continuation-in-part.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Check Only If Priority Not Claimed	Certified Copy Attached? YES	NO
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

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Burden Hour Statement: This form is estimated to take 21 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Type a plus sign (+) inside this box → ☐

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DECLARATION – Plant Patent Application

I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY	☐ Additional provisional application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

Direct all correspondence to: ☐ Customer Number or Bar Code Label [ ] *OR* ☐ Correspondence address below

Name

Address

Address

City	State	ZIP

Country	Telephone	Fax

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SOLE OR FIRST INVENTOR: ☐ A petition has been filed for this unsigned inventor

Given Name	Family Name or Surname

Inventor's Signature	Date

Residence: City	State	Country	Citizenship

Mailing Address

Mailing Address

City	State	Zip	Country

NAME OF SECOND INVENTOR: ☐ A petition has been filed for this unsigned inventor

Given Name	Family Name or Surname

Inventor's Signature	Date

Residence: City	State	Country	Citizenship

Mailing Address

Mailing Address

City	State	Zip	Country

☐ Additional inventors are being named on the ___supplemental Additional Inventor(s) sheet(s) PTO/SB/02A attached hereto.

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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 and arrangement of application elements in a plant application.

(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. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

(b) The elements of the plant application, if applicable, should appear in the following order:

(1) Plant application transmittal form.

(2) Fee transmittal form.

(3) Application data sheet (see § 1.76).

(4) Specification.

(5) Drawings (in duplicate).

(6) Executed oath or declaration (§ 1.162).

(c) The specification should include the following sections in order:

(1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.

(2) Cross-reference to related applications (unless included in the application data sheet).

(3) Statement regarding federally sponsored research or development.

(4) Latin name of the genus and species of the plant claimed.

(5) Variety denomination.

(6) Background of the invention.

(7) Brief summary of the invention.

(8) Brief description of the drawing.

(9) Detailed botanical description.

(10) A single claim.

(11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

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 and the genus and species designation of the plant variety sought to be patented. The Latin name of the genus and species of the plant claimed should be stated and preceded by the heading set forth in 37 CFR 1.163(c)(4). The specification must particularly point out where, e.g., location or place of business, and in what manner the variety of plant has been asexually reproduced.

Form Paragraphs 16.01, 16.09, and 16.10 may be used to object to the disclosure under 37 CFR 1.163(a).

¶ *16.01 Specification, Manner of Asexually Reproducing*

The application is objected to under 37 CFR 1.163(a) because the specification does not "particularly point out where and in what manner the variety of plant has been asexually reproduced". Correction is required.

¶ *16.09 Specification, Less Than Complete Description*

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties. More specifically: **[1]**.

¶ *16.10 Specification, Location of Plant Not Disclosed*

The disclosure is objected to under 37 CFR 1.163(a) because the specification does not particularly point out the location and character of the area where the plant was discovered.

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.

Form Paragraphs 16.02 and 16.03 may be used to object to the disclosure or reject the claim, respectively, because of a lack of a clear and complete disclosure with regard to colors.

¶ *16.02 Colors Specified Do Not Correspond With Those Shown*

The disclosure is objected to under 35 U.S.C. 112, first paragraph, because the **[1]** colors specified fail to correspond with those shown.

¶ *16.03 Rejection, 35 U.S.C. 112, 1st Paragraph, Non-Support for Colors*

The claim is rejected under 35 U.S.C. 112, first paragraph, as being unsupported by a clear and complete disclosure with regard to **[1]** colors, for the following reasons: **[2]**.

If the written description of a plant is deficient in certain respects (see, e.g., In re Greer, 484 F.2d 488, 179 USPQ 301 (CCPA 1973)), 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 may be submitted in reply to an Office action. Such submission will not constitute new matter under 35 U.S.C. 132. Jessel 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. An example of a proper claim would be "A new and distinct variety of hybrid tea rose plant, substantially as illustrated and described herein."

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 drawings may be in color. The drawing must be in color if color is a distinguishing characteristic of the new variety. Two copies of color drawings or photographs and a black and white photocopy that accurately depicts, to the extent possible, the subject matter shown in the color drawing or photograph must be submitted.

If the drawings or photographs are in color, two color copies of each drawing or photograph are required. If the required copies of the drawings are not included, the application will be accorded a filing date, but correction will be required before the application is forwarded for examination. The requirement under 37 CFR 1.165(b) for a black and white photocopy of any color drawing or photograph has been waived. See 1246 O.G. 106 (May 22, 2001).

37 CFR 1.84. Standards for drawings.

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(c) *Identification of drawings.* Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

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(e) *Type of paper*. Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. See paragraph (b) of this section for other requirements for photographs.

(f) *Size of paper*. All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

(1) 21.0 cm. by 29.7 cm. (DIN size A4), or

(2) 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches).

(g) *Margins.* The sheets must not contain frames around the sight (*i.e.*, the usable surface), but should have scan target points (*i.e.*, cross-hairs) printed on two cater-corner margin corners. Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8 1/2 by 11 inch) drawing sheets.

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(i) *Arrangement of views***.** One view must not be placed upon another or within the outline of another. All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right-hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote the axis of abscissas (of X) and the axis of ordinates (of Y).

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(t) *Numbering of sheets of drawings*. The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

(u) *Numbering of views.*

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

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(x) *Holes*. No holes should be made by applicant in the drawing sheets.

Form Paragraphs 16.06, 16.06.01, 16.07, and 16.11 may be used to object to the drawing disclosure.

¶ *16.06 Drawings Must Be in Duplicate*

The disclosure is objected to under 37 CFR 1.165(b) because applicant has not provided copies of the drawing in duplicate. Correction is required.

¶ *16.07 Drawing Figures Not Competently Executed*

The disclosure is objected to under 37 CFR 1.165(a) because Fig. **[1]** not artistically and/or competently executed.

¶ *16.11 Drawings in Improper Scale*

The disclosure is objected to under 37 CFR 1.165(a) because the drawings are of an inadequate scale to show the distinguishing features of the plant.

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.

Form Paragraph 16.13 may be used to require specimens.

¶ *16.13 Specimens Are Required*

Applicant **[1]** required to submit **[2]** in accordance with 37 CFR 1.166.

1608 Examination

37 CFR 1.167. Examination.

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

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 requests of the Director, 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 Director 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 copy of the 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. As the report is merely advisory to the Office, it is placed in the file but is not given a paper number. The copy of the report is customarily utilized by the examiner in the preparation of his or her action on the application.

The report may embody criticisms and objections to the disclosure, may offer suggestions for correction of such, 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.

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 is otherwise allowable, 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 may include so much of any 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 or her discretion, may show the entire report to the inventor or attorney.

Form Paragraph 16.12 may be used to reference portions of the ARS report.

¶ *16.12 Report From U.S. Dept. of Agriculture*

This application has been submitted to the U.S. Department of Agriculture for a report. Pertinent portions follow: **[1]**

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 1.104(d)(2)). See *Ex parte Rosenberg*, 46 USPQ 393 (Bd. App. 1939).

Form Paragraphs 16.04 and 16.08, as appropriate, may be used to reject the claim.

¶ *16.04 Rejection, 35 U.S.C. 102*

The claim is rejected under 35 U.S.C. 102 as failing to patentably distinguish over **[1]**.

¶ *16.08 Rejection, 35 U.S.C. 112*

The claim is rejected under 35 U.S.C. 112 **[1]** because **[2]**.

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 color drawings, the better one of the two judged, for example, by its sharpness or cleanliness is selected to be printed in the patent.

The International Patent Classification symbols, most recent edition, should be placed in the issuing classification boxes on the file wrapper or 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 Office of Patent Publication.

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 that had not been party to the 1961 text, Ireland and New Zealand. As of September 24, 2000, 46 states were party to the UPOV Convention: Argentina, Australia, Austria, Belgium, Bolivia, Brazil, Bulgaria, Canada, Chile, China, Colombia, Czech Republic, Denmark, Ecuador, Estonia, Finland, France, Germany, Hungary, Ireland, Israel, Italy, Japan, Kenya, Kyrgyzstan, Mexico, Netherlands, New Zealand, Norway, Panama, Paraguay, Poland, Portugal, Republic of Moldova, Russian Federation, Slovakia, Slovenia, South Africa, Spain, Sweden, Switzerland, Trinidad and Tobago, Ukraine, United Kingdom, United States of America, and Uruguay. Most states adhere to the 1978 text. The United States adheres to the 1991 text, and has a reservation under Article 35(2) of the text (which allows plant patents rather than breeder's rights certificates to be granted).

The 1961, 1978, and 1991 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). See MPEP § 1613 for the right of priority based upon an application for plant breeder's rights.

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 denomination for that plant. Inclusion of the variety denomination in the patent comprises its registration.

The registration process in general terms consists of inclusion of a proposed variety denomination in the plant patent application. The examiner must evaluate the proposed denomination in light of UPOV Convention, Article 13. Basically, this Article requires that the proposed variety denomination 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 denomination must not mislead the average consumer as to the characteristics, value, or identity of the patented plant. Ordinarily, the denomination proposed for registration in the United States

must be the same as the denomination registered in another member state of UPOV.

Form Paragraph 16.05 may be used to object to the disclosure as lacking a common or market name or “denomination” of the plant.

¶ *16.05 Name or Denomination for Plant Missing*

The disclosure is objected to under 37 CFR 1.121(e) because no “variety denomination” of the instant plant has been set forth in the disclosure. 37 CFR 1.163(c)(4). Correction by adding such a name is required.

¶ *16.05.01 Latin Name of Genus and Species of the Plant Claimed Missing*

The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the instant plant has not been set forth in the disclosure. 37 CFR 1.163(c)(4). Correction by adding such a name is required.

1613 Right of Priority Based upon Application for Plant Breeder’s Rights

Pursuant to 35 U.S.C. 119(f), an application for a plant patent may rely upon an application for plant breeder’s rights filed in a WTO member country (or in a foreign UPOV Contracting Party) for priority under 35 U.S.C. 119(a) through (c).

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