

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.

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.)

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

Rule 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 [R-45]

An application for a plant patent consists of the same parts as other applications and must be filed in duplicate (rule 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, rule 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 plant patents 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 [R-25]

Rule 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 rules 42, 43, and 47). The oath or declaration required of the applicant, in addition to the averments required by rule 65, must state that he 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 et al. Board of Appeals decision in Plant Patent File 707.

1605 Specification and Claim [R-19]

35 U.S.C. 162. Description, claim. No plant patent shall be declared invalid for noncompliance with sec-

drawing (if in color) are forwarded to the Agricultural Research Service, Horticultural Crops Research Branch, Department of Agriculture. It is the practice to forward the duplicate file and duplicate drawing of the application with a letter of transmittal (Form POL-86) including such data as the examiner has developed that will enable the Agricultural Research Service to render a report on the application as to whether the variety of plant disclosed in the application is distinct over known varieties of plant.

The initial step in taking the application up for action is for the examiner to brief the application on the search brief cards (there being a printed form for each of the plant subclasses in class 47). The sufficiency of the specification and drawings are determined as to their completeness and compliance with the rules, and the applicant is advised of any deficiencies in the disclosure. Transmittal of the duplicate file to the Department of Agriculture may be deferred until such time as the applicant submits by appropriate amendment, in duplicate, the necessary additional matter and/or corrections. [R-23]

1609 Report of Agricultural Research Service [R-31]

The report of the Agricultural Research Service (A.R.S.) 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 [R-31]

The action on the application by the examiner will include all matters as provided for in other types of patent applications. See rule 161.

The action may include so much of the report of the A.R.S. 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 A.R.S. 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 rule 167.

The report of the A.R.S. is not in the nature of a publication and matters raised therein within the personal knowledge of the specialists of the A.R.S. 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. (rule 107.) See *Ex parte Rosenberg* 46 USPQ 393. Board of Appeals decision in Plant Patent File 412.

1611 Issue [R-23]

The preparation of a plant patent application for issue involves the same procedure as for other applications (rule 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.