

# 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; 521 O.G. 272.)

*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

An application for a plant patent consists of the same parts as other applications and must be filed in duplicate (to provide an original and duplicate file) but only one need be signed and executed; the second copy may be a legible carbon copy of the original. 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 Office at all times.

## 1604 Applicant, Oath

*Rule 162. Applicant, oath.* 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 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 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

*Rule 163. Specification.* 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.

Two copies of the specification (including the claim) must be submitted, but only one need be signed and executed; the second copy may be a legible carbon copy of the original.

*Rule 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 text books 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 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.

A plant patent is granted 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

*Rule 165. Drawings.* Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure 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.

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 must be submitted. Color drawings may be made either in permanent water color or oil, or in lieu thereof may be photographs made by color photography or properly colored on sensitized paper. The paper in any case must correspond in size, weight and quality to the paper required for other drawings.

With reference to photographic drawings, the mounting of the same on a backing of bristol board or paper of comparable weight is not acceptable.

## 1607 Specimens

*Rule 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

*Rule 167. Examination.* Applications may be submitted by the Patent Office to the Department of Agriculture for study and report.

Affidavits 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 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) [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 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.

With the application judged complete and acceptable for submission to the Department of Agriculture, the duplicate file and duplicate

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.

### 1609 Report of Agricultural Research Service

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

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 ----- 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 Office require the applicant to submit affidavits from recognized experts as to the newness of the variety. See Rule 167. The need for such affidavits when so indicated is incorporated in the Office action by quoting directly from the report; the Examiner making certain that the action makes it quite clear that such affidavits are required by the A.R.S. This is necessary to avoid any embarrassment to the Office; as the need of such affidavits, if made without reference to the A.R.S.'s requirement, could be considered as the calling in by the Office of unauthorized outside help in determining the patentability of the plant in question.

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 special-

ists 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 U.S.P.Q. 393. Board of Appeals decision in Plant Patent File 412.

### 1611 Issue

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 division until after the application has been patented. At certain periods thereafter such duplicate files are collected and sent to the abandoned files for storage.