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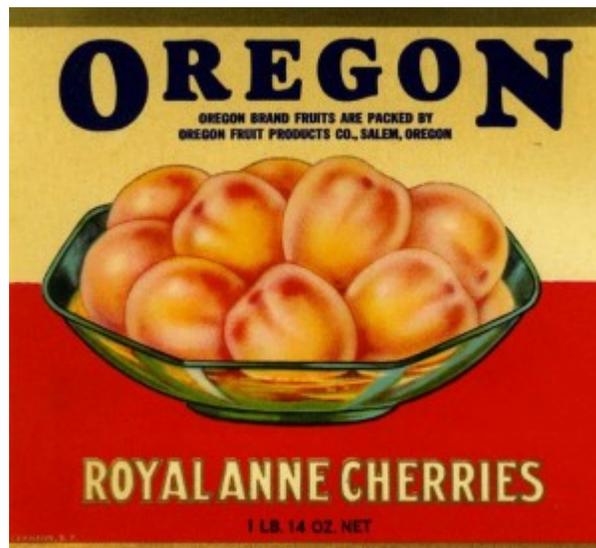
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The Growing Allure of Plant Patenting for Brand Differentiation

"Earth & Table" Law Reporter



Plant patents occupy a seldom studied corner of potential patent protection. But plant patenting is taking on new importance as growers and producers of fruits and vegetables—once branded only as commodities—take advantage of

the premium price points more specific patent and trademark rights can yield. Commodities appeal to the undifferentiated masses; but marketing targeted to individual taste preferences is now the order of the day.

What are Plant Patents?

Established through the Plant Patent Act of 1930 (the PPA), this intellectual property right is granted to any person who "invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings . . ." 35 U.S.C. 161.[\[1\]](#)

The Act's [legislative history](#) describes this provision in layperson terms: "[T]he bill provides that any person who invents or discovers a new and distinct variety of plant shall be given by patent an exclusive right to propagate that plant by asexual reproduction; that is by grafting, budding, cuttings, layering, division, and the like, but not by seeds."

The PPA does not provide patent protection for varieties of plants found growing in an uncultivated or wild state. So, sorry to all you plant foragers! Tuber propagated plants (e.g., potatoes) are also excluded from plant patent protection.

Before the PPA was enacted in 1930, patent laws seemed to favor industrialists over farmers. This rankled the most famous American plant breeder of the time, Luther Burbank. He bemoaned the fact that:

I have been for years in correspondence with leading breeders, nurserymen, and Federal officials and I despair of anything being done at present to secure to the plant breeder any adequate returns for his enormous outlays of energy and money. A man can patent a mousetrap or copyright a nasty song, but if he gives to the world a new fruit that will add millions to the value of earth's annual harvests, he will be fortunate if he is rewarded by so much as having his name connected with the result.^[2]

In the 21st century, the goals of the PPA may be coming closer to fulfilling Luther Burbank's plant breeder aspirations. Take cherries, for example, which are now coming into season in droves. While Bing cherries—Royal Annes in an earlier era of canned cherries—still dominate the U.S. market for fresh cherries, it is becoming more highly differentiated with new market entries.^[3] Aficionados can distinguish among and may prefer a Rainer, a Chelan, a Lapin or a Summit cherry, instead of that good ol' Bing cherry.

Yet, the durability of the Bing cherry is a testament to its extraordinary qualities. Its longevity (circa 1876) underscores why trademark protection—which can last indefinitely if maintained properly—is a vital legal avenue for protecting the brand value of perennially popular fruit or vegetable varieties. The patent term, in contrast, lasts only 20 years. Trademarking plants has its own potential pitfalls; they are discussed in more detail at the close of this article.

Of Sports, Hybrids and Teenage Mutant Ninja Turtles

The PPA terminology of the new and distinct varieties is foreign to most people. Mutants sound like alien beings, calling to mind "teenage mutant ninja turtles," a pop culture hit of the late 1980s and early 1990s. The legislative history describes the three classes of varieties protectable under the PPA—sports, mutants, and hybrids—as follows:

In the first class of cases, *the sports*, the new and distinct variety results from bud variation, and not seed variation. A plant or portion of a plant may suddenly assume an appearance or character distinct from that which normally characterizes the variety or species.

In the second class of cases, *the mutants*, the new and distinct variety results from seedling variation by self-pollination of species.

In the third class of cases, *the hybrids*, the new and distinct variety results from seedlings of cross-pollination of two species, two varieties, or of a species and a variety. In this case, the word "hybrid" is used in its broadest sense.

All such plants must be asexually reproduced in order to have their identity preserved. This is necessary since seedlings either of chance or self-pollination from any of these would not preserve the character of the individual.^[4]

What is a Distinct Variety?

The PPA only authorizes the granting of patent rights if the new variety is *distinct*. It can be new and distinct variety of an existing species of plant, or an entirely new plant species. In the view of the USPTO, whether the characteristics of the new variety are inferior or superior to existing varieties is immaterial.

Characteristics that distinguish one variety from another can come in many forms: "immunity from disease; resistance to cold, drought, heat, wind, or soil conditions; color of flower, leaf, fruit, or stems; flavor; productivity, included ever-bearing qualities in the cases of fruits; storage qualities; perfume; form; and ease of asexual reproduction."^[5]

Nature of the Plant Patent Grant

The unique specification and claim language of plant patents set them apart from both design and utility patents. For specification purposes, the botanical description of the plant must be as full and complete as possible in order for the USPTO to determine whether plant characteristics are distinguishable over other related plant varieties. The specification must particularly point out where and in what manner the variety of plant has been asexually reproduced. Because of the difficulties in enabling a plant patent invention or discovery through a mere textual description, "[n]o plant patent shall be declared invalid with [35 U.S.C. 112] if the description is as complete as reasonably possible." 35 U.S.C. 162.

Because a plant patent is granted only on an entire plant, only one patent claim is allowed, whereas utility patents can and usually do include multiple claims. A proper plant patent claim, for example, would read as follows, "A new and distinct variety of a hybrid tea rose plant, substantially as illustrated and described herein."^[6]

Enforcing the Plant Patent Against Infringers

A plant patent is only enabled by duplication of the patented plant. For "the purposes of plant patent infringement, the patentee must prove that the alleged infringing plant is an asexual reproduction, that is, the progeny of the patent plant."^[7] Therefore, to prove that a plant patent has been infringed, the patentee must demonstrate unlawful propagation of the patented plant.

Unlike utility or design patents, the doctrine of equivalents does not apply to plant patent infringement analysis. Close does not count. That means "chain-of-custody" type evidence is the necessary for proving that the infringing plant is the product of unlawful grafting and propagation. It is not enough merely to show "asexual reproduction of a plant having the same essential characteristics as the patented plant."^[8]

While proof of infringement is more exacting in plant patent infringement cases, the PPA was amended in 1998 to make it clear that infringing conduct applies to "any parts" of a patented plant. This protects the

patentee from those who may attempt to use, sell or import plant parts, e.g., the fruit produced by the patented tree.

Practice Pointer: Variety Names and Trademark Genericide



A prospective patentee is required to provide a proposed variety denomination in his or her patent application. The proposed name cannot be identical with or confusingly similar to other names utilized for same of closely related plant species.

This assemblage of new variety names for plant patents raises a pointed trademark genericide issue. The variety name given to a plant patent automatically becomes its generic name and it

therefore cannot function as a trademark. If the creators of the more memorable patent variety names thought they could serve double-duty as viable trademarks, they are sorely mistaken. That is why patentees often give their plant patents an entirely forgettable alpha-numeric designation, and then adopt a different name with more panache for use as the plant's trademark.

The *Trademark Manual of Examining Procedure*, 1202.12 (8th ed. 2011), instructs the applicant and trademark examiner as follows:

Varietal or cultivar names are designations given to cultivated varieties or subspecies of live plants or agricultural seeds. They amount to the generic name of the plant or seed by which such variety is known to the public. * * * *

A varietal or cultivar name is used in a plant patent to identify the variety. Thus even if the name was originally arbitrary, it 'describes to the public a [plant] of a particular sort, not a [plant] from a particular [source] It is against public policy for any one supplier to retain exclusivity in a

patented variety of plant, or the name of a variety, once its patent expires.' [Citing case.]

If the [USPTO] examining attorney determines that wording sought to be registered as a mark for live plants, agricultural seeds, fresh fruits, or fresh vegetables comprises a varietal or cultivar name, then the examining attorney must refuse registration, or require a disclaimer, on the ground that the matter is a varietal name of the goods and does not function as a trademark

Once a patentee coins a trademark name for a patented plant, he or she also needs to be careful in not allowing the trademark name to become a surrogate variety designation over time. Lax commercial conduct can lead to trademark genericide, as the trademark owner discovered in a leading case of *Van Well Nursery, Inc. v. MONY Life Ins. Co.*, 421 F.Supp.2d 1321 (W.D. Wash. 2006)(the author represented the prevailing defendant in this case). The court determined that the once trademarked "Scarlet Spur" and "Smoothie" names for apples now function as their varietal names—not as trademarks. Among other things, the "plaintiffs themselves use the terms as the name of the patented variety when discussing their product. Van Well's online catalog lists 'Scarlet Spur' as one of the 'World's Best Apple Varieties' because Scarlet Spur 'is America's earliest coloring, solid blush Red Delicious.'" *Id.*, at 1330. The trademarked names had become synonymous with the apple varieties, and had ceased operating as their source-identifiers.

Conclusion

In lending his support to the passage of the Plant Patent Act of 1930, Thomas Edison opined that "[n]othing that Congress could do to help farming would be of greater value and permanence than to give to the plant breeder the same status as the mechanical and chemical inventors through the patent law. There are but few plant breeders. The [PPA] will, I feel sure, give us many Burbanks."^[9] With the number of issued U.S. plant patents now reaching close to 23,000 as of June 2012, Edison's prediction is bearing fruit, along with many other new and distinct varieties of plants.

[1] Plant patenting is not the exclusive way to protect plant inventions or discoveries. Pursuant to 35 U.S.C. 101, utility patents can be employed to cover plant patent inventions in some instances. Also, the Plant Variety Protection Act, 7 U.S.C. 2321 *et seq.*, provides patent-like plant variety protection for sexually reproduced or tuber propagated plant varieties. The Supreme Court has held that these various forms of plant variety rights are not necessarily mutually exclusive. See *J.E.M. AG Supply, Inc. v. Pioneer Hi-Bred International, Inc.*, 534 U.S. 124 (2001).

[2] See "Plant Patents," House Report No. 1129, 71st Congress, Second Sess., at 11 (4/11/1930).

[3] The development of the Bing cherry is an amazing story of immigrant America and manifest destiny in the 19th century. Henderson Lewelling is a pioneer who traveled from Iowa to Oregon by wagon train in 1847 with his family, taking with them 700 hundred tiny fruit trees in earth filled boxes. They established a land claim near Milwaukie, Oregon, and Henderson's brother Seth would soon join them. The Bing cherry is the product of crossbreeding performed by Seth. It was first exhibited at the 1876 Centennial exhibition in Philadelphia. Fairgoers initially thought they were crabapples because of their extraordinary size. It is named "Bing" after the Lewelling's longstanding foreman, Ah Bing, who immigrated to the U.S. from Manchuria in 1855.

[4] See fn. 2, at 13 (emphasis added).

[5] *Id.*, at 14.

[6] See Manual of Patent Examining Procedure, 1605 (8th ed. 2008), at 1600-6.

[7] *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560, 1569 (Fed.Cir. 1995).

[8] *Id.*, at 1570.

[9] See fn. 2, at 12.

