

Section 18. PLANT PATENTS

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18-1. Introduction: Scope, Type of Plants Covered

The authority for the grant of a plant patent lies in R.S. 4886 which provides in addition to the five classes of invention for which a person may obtain a utility patent under stated conditions, an additional class of inventions as to which, a person "who has invented or discovered and asexually reproduced any distinct and new variety of plant other than a tuber-propagated plant" may obtain a patent therefor.

It is thus quite clear that the grant of a plant patent is predicated on the fact that: (1) the new variety of plant must be distinct and (2) that it shall have been asexually reproduced prior to the application for a patent. This does not mean that it must be a variety of a new species. The variety of plant to be patentable may be a new and distinct variety either of an existing or of a new species, or it may be an entirely new species of plant. The features that render a variety distinct are, for example, growth characteristics, color, odor of flower, flavor of fruit, productivity, form, or ease of asexual reproduction.

The new and distinct variety of plant referred to in the statute may be a sport, mutant or hybrid.

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.)

In addition to the requirement that the new variety sought to be patented must be distinct, it is also mandatory that the same be asexually reproduced prior to the application for patent. Thus it must be conclusively demonstrated that the variety is capable of asexual reproduction as by grafting, layering, or division.

With reference to tuber-propagated plants for which a plant patent cannot be had, 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 Application

Rule 21.1 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.

The form of plant patent claim and the limitation of number of claims to one are specified in Rule 21.4. A plant patent is granted on the entire plant. It therefore follows that only one claim is necessary and only one is permitted. See ex parte Van Over, Dec. 10, 1941, 24 J.P. O.S. 293. Method claims in a plant patent application are improper as the statute says nothing about methods or arts in connection with a plant patent. See ex parte Van Over, supra.

Practice and Examination

The Executive Order by President Herbert Hoover, dated October 17, 1930, under Authority of the Plant Patent Act, directs the Secretary of Agriculture to:

- (1) furnish the Commissioner of Patents such available information of the Department of Agriculture, or
- (2) conduct through the appropriate bureau or division of the department such research upon special problems, or
- (3) 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.

In pursuance of the intent of the Executive Order, the then Secretary of Agriculture designated and authorized the Chief of the Bureau of Plant Industry to represent the Agriculture Department in all dealings with the Commissioner of Patents in furnishing the Commissioner such pertinent information as is available to the Department and in arranging for special researches to provide the information desired.

The stamp "PLANT PATENT" is placed over the words - Patent No. - on the face of both the original and duplicate files when received in the division.

The duplicate files of the applications and which had been marked "Duplicate" by the Application Branch, are maintained separate from the original files. It is the original file and the contents thereof which constitute the official record of the application.

The plant patent application is accorded the same examination for form and substance and search of the prior art as is accorded other applications for patent. The prior art in the division, in addition to the large number of plant patents, includes numerous publications, texts on horticulture, botany, pomology, etc., and color dictionaries.

It is the practice to forward the duplicate file and duplicate drawing of the application when acted on by the Examiner to the Bureau of Plant Industry in the Department of Agriculture with a letter of transmittal (Form PO 86) including such data as the Examiner has developed that will enable the Bureau 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. (Rule 21.7). Prior plant patents which the Examiner considers pertinent are noted by name and number in the letter of transmittal and request is made of the Bureau to indicate how the variety of plant disclosed is distinct over said patents.

As the specialists of the Bureau of Plant Industry take anywhere from one to six months for their report and return of the papers therewith to the division, a plant patent application is taken up, in the discretion of the Examiner, shortly after it is filed or some months before it would normally be reached for action on the Examiner's docket, for study and search and preparation of the letter of transmittal. The concluding paragraph in the letter of transmittal notifies the Bureau that the application will be reached for action in the division by a designated date and request is made that the report be forwarded to the division before said date. This is done, to insure as far as possible, that a plant patent application awaiting a report from the Bureau of Plant Industry will not carry the division date.

The report of the Bureau of Plant Industry is usually accompanied by the duplicate file and drawing. The report is in duplicate, the original being signed by the Chief of the Bureau. 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.

Where both the duplicate file and drawing are returned with the report, the charge card is destroyed. Occasionally a report is received without return of the duplicate file and drawing. In such instance the date of the report is noted on the charge card which is retained in the charge box.

It frequently happens that an amendment is filed before the duplicate file and drawing are returned with the report. At the discretion of the Examiner, this is forwarded to the Bureau. All amendments and responses filed by the applicant must be in duplicate. Where it is necessary to forward same to the Bureau of Plant Industry, an additional charge card identifying the application is made out, marked "Supplemental Papers" and sent along with the amendment and transmittal memorandum.

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."

18-4.

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 21.1.

The action may include so much of the report of the Bureau of Plant Industry as the Examiner deems necessary, or may embody no part of it. In the event of an interview, there is no objection to showing the whole of the 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 contradiction to the plant bearing the flower or the tree bearing the fruit. This 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 in view of a favorable report by the Bureau of Plant Industry, 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.

Care should also be exercised that the specification does not contain unwarranted advertising, for example, the enclosed 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 a 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.

The Office action is typed with two carbons. The second carbon 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 duplicate application must be resubmitted to the Bureau, applicant is notified that response papers must be in duplicate.

18-5. Specimens

When the report of the Bureau of Plant Industry requests the submission of specimens, see Rule 21.6, the Examiner will note such request in his action indicating in full the Bureau's requirement as to quantity and stage of growth of the plant, flower or fruit. The Examiner will further indicate that such specimens be sent directly to the Bureau of Plant Industry, Beltsville, Maryland, with such directions for identification and packaging as necessary. These specimens should not be sent to the Patent Office.

However, corrections to the drawings may require the submission of specimens when deemed necessary by the Chief Draftsman. In such instances the Examiner will supply instructions in his action for transmittal of the same directly to the Patent Office.

18-6. Affidavits

Frequently the Bureau of Plant Industry in its report states that in view of its lack of sufficient information, data, specimens, etc., its specialists are unable to determine that 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 21.7. 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 Bureau of Plant Industry. This is necessary to avoid any embarrassment to the Office; as the need of such affidavits, if made without reference to the Bureau'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.

18-7.

Issue

The preparation of a plant patent application for issue involves the same procedure as for other applications (Rule 21.1), 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.