

United States Plant Patents and legal issues

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In the United States, plant patents are the major way intellectual property rights are protected for plants. In this article, Anne Whealy, who owns and operates a company dedicated to writing and enforcing plant patents, describes the system.

Intellectual property in the form of new cultivars of plants, plant phenotypes and plant propagation methods can be protected in the United States by one or more of the following:

- US Plant Patents for new cultivars of asexually reproduced plants (by cuttings, tissue culture, grafting, divisions, etc.);
- US Utility Patents for new cultivars of asexually or sexually reproduced plants (by seed), phenotypes or propagation processes;
- US Plant Variety Protection for new cultivars of sexually reproduced plants; and
- Trade Secrets for new cultivars or propagation processes.

The most popular type of protection for asexually reproduced plants in the United States is the US Plant Patent, established in 1930 for the purpose of providing American agriculture with the same type of protection that the industry sector enjoyed with the patent system. The goal was to stimulate plant breeding by affording breeders the same type of protection as mechanical and chemical inventors.

The vast majority of all new asexually reproduced cultivars of flowering plants, annuals, perennials and foliage plants grown and sold in the United States are protected by US Plant Patents. US Plant Patent applications are applied for in the name of an individual or individuals. The applicant is referred to as an inventor. For new plant cultivars, the inventor may be a plant breeder or a discoverer of a newly found seedling, sport or induced mutation. The inventor (s) may hold the rights to the patent in his, her or their name(s) or the inventor(s) may transfer, or assign, a portion of or the entire rights of the patent to another individual(s), entity, or a company which is then referred to as the assignee. The rights can be further transferred or assigned provided that the original assignee agrees to the reassignment.

A US Plant Patent application is essentially a "legal case" that is brought before the US Patent Office and prosecuted on its merits during the examination. To receive a granted plant patent, the inventor(s) must demonstrate that the new cultivar is new and distinctly different from its antecedents and known related cultivars in at least one distinguishing characteristic. A distinguishing characteristic might be plant size, flower color, flower form or leaf color, for example. The inventor(s) must declare that they are the original and sole inventor(s) of the new

cultivar. In addition, the inventor(s) must declare that the new cultivar has been discovered in a cultivated area, such as a greenhouse or nursery. The requirement of discovery of the new cultivar in a cultivated area excludes the possibility of patenting the discovery of a wild species, that is, it is not possible to patent plants that freely occur "in nature." Further, the inventor(s) must declare that the new cultivar has been reproduced asexually, and that the unique characteristics of the new cultivar are uniform and stable over successive generations of asexual reproduction.

In addition to the aforementioned declarations, a US Plant Patent application must also include a visual detailed botanical description of the new cultivar which clearly describes the new cultivar and differentiates it from its antecedents and known related cultivars; the location and method by which the new cultivar has been asexually reproduced; and colored photographs or drawings of the new cultivar that accurately depict the unique characteristics of the new cultivar. "Genetic fingerprinting" techniques may also be used to further describe the plant cultivar's unique characteristics, however, these techniques are usually more useful in the event of infringement and are typically not included in the application.

A US Plant Patent application may be denied if the new cultivar has been "offered for sale" for more than one year in the United States prior to filing the application. At present, legislation is being drafted to define the term of availability outside the United States regarding patentability.

The term of the patent is 17 or 20 years. After the patent has expired, the subject matter of the patent becomes public domain, meaning that the plant becomes a "free variety" and can be asexually reproduced, used and/or sold without permission from the Inventor(s) and/or assignee.

Inventor(s) typically obtain the assistance of a federally registered Patent Agent or Attorney to assist them with the preparation of their applications.

The granting of a US Plant Patent provides the inventor(s) and/or assignee with " . . . 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 of America or from importing the asexually reproduced plant, or any parts thereof, into the United States of America" without the inventor(s) and/or assignee's permission. Inventor(s) and/or assignees grant permission to others to propagate, use, offer for sale and/or sell the new plant via licensing agreements. License agreements are legal contracts and are governed under standard contract law. Professional growers may enter into licensing agreements directly with the inventor(s), with the assignee, and/or with the inventor (s) and/or assignee's agent or legal representative. License agreements allow the licensee "usage" of the new cultivars and therefore, license agreements can be viewed as rental agreements. License agreements permit the licensee to rent the rights to propagate, use and/or sell the new cultivar during the term and under the conditions of the agreement; and the "rent" paid by the licensee is the royalty.

The terms and conditions of the License Agreement vary with the actual cultivar(s), inventor(s) and/or assignee, types of propagation methods and other considerations. All license agreements should also specify the location where the cultivar(s) can be reproduced, used and sold; the types and forms of the products to be produced; the term of the contract; the royalty rate; provisions for royalty enforcement, administration and collection; labeling requirements; and conditions under which the contract can be terminated.

Plant breeding requires a long investment of time to produce the product, new cultivars. For breeding of ornamental crops it may take three to 10 years from the initial crossing of the parent cultivars to commercialization of a new cultivar. During this time, the plant breeder is not being compensated for his expenses and efforts. When the new cultivar is eventually introduced and commercialized, plant breeders finally begin to get paid for their years of work in the form of royalties. Compared to other types of businesses, plant breeding is considered a high risk because of the long time required to produce new cultivars and their potentially short life as a competing plant breeder's new

cultivar has the potential to make the plant breeder's brand new cultivar "yesterday's news."

It is unlikely that plant breeders would risk this investment of resources and time if there were no royalties. Royalties are essential for the continuation of successful plant breeding programs, the impetus for developing new plant breeding programs, and therefore are considered to be the lifeblood of our industry.

Commercially viable spontaneous or induced mutations of patented plant cultivars may occur. Ownership of such mutations, or sports, is usually considered in license agreements. Licensees who discover such sports should promptly contact the owner of the parent cultivar.

It is important for the patent owner, the inventor(s) and/or assignee, to physically identify, and provide proper marking, of the new plant with its cultivar name and patent number. The cultivar name and patent number should be clearly displayed on all tags and/or containers, catalogs, invoices and other literature pertaining to the new cultivar. Even though there is no penalty for the patent owner by not providing or requiring proper identification, it could adversely affect the right to damages. If plants are not adequately marked, how can a third party know a plant patent protects the plant? In the case of prosecuting patent infringement, proper identification of the new plant with the cultivar name and patent number presumes such knowledge.

Propagation of a patented plant for any purpose without permission from the patent owner is illegal and an infringement of the plant patent owner's rights. In addition, offering for sale, selling and/or using plants derived from illegal propagation are also considered infringement. Proving infringement is presently the plant patent owner's burden, however it is the professional grower's obligation to respect a plant patent owner's property. Nonpayment or underpayment of royalties by the licensees is also illegal and is theft.

Professional growers should be familiar with what may constitute infringement. Infringement in the United States may be defined as:

Asexual reproduction of the new cultivar;

- 1) Selling, offering for sale, exposing for sale, delivering, shipping, consigning, exchanging, soliciting an offer to buy, or any other transfer of title or possession of plants of the new cultivar;
- 2) Importation or exportation of the new cultivar into or from the United States;
- 3) Dispensing the new cultivar to another, in a form which can be asexually reproduced, without notice as to being a protected cultivar; or
- 4) Performing, instigating or actively inducing performance of any of the aforementioned acts.

US Plant Patents that have been granted are listed on the US Patent & Trademark Office's website: www.uspto.gov. Information regarding pending US Plant Patent applications is not publicly available. Therefore to avoid the potential of infringing, contact plant breeding companies, marketing companies, sales agents, brokers and/or patent owner's agents and representatives directly to determine if the new cultivars you are producing or marketing in the United States are in the process of being protected and if License Agreements are available before propagating, using or selling the new cultivars.

--[Dr. C. Anne Whealy](#) owns *Proprietary Rights International*, Roanoke, Texas, United States.