A GROWERS' APPROACH TO PLANT PATENTS AND TRADEMARKS

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DEFINITIONS

Plant Patent: A plant patent is granted to provide the patent owner control over the propagation, use, and sale of a plant during the 17 year life of the patent. A patent is intended to cover a specific plant to protect the rights of the inventor to the plant patented and provides a specific basis for preventing the propagation, growing, and distribution of said plant.

Trademark: A federal trademark is "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by other." A trademark identifies the source or origin of a product. It lasts for 20 years and may be renewed without limit. A trademark is established to cover a class or broad selection of items or plants and to disclose the origin or source. Economic rewards to owner is a basic reason.

WHO CAN PATENT A PLANT?

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, can patent a plant. They must comply with conditions and requirements of the patent law.

WHO CAN OBTAIN A TRADEMARK?

Anyone who selects a name, device, or symbol *not already registered* to identify a broad class of his goods and their source, and said trademark had been used in commerce.

PLANT PATENTS

Points to be considered. New plants must be sufficiently different from existing cultivars and specifically any other patented plant to merit introduction to commerce and a plant patent.

A. Growth habit
   1) Branching habit
   2) Growth rate (vigor)
   3) Ultimate size and form
B. Trunks and stems
   1) Color
   2) Texture
C. Leaves
   1) Size
   2) Shape
   3) Color (summer to fall)
   4) Luster
   5) Persistence
D. Flowers
   1) Size
   2) Shape
   3) Color
   4) Quantity
   5) Substance
   6) Fragrance
   7) Season of bloom
E. Fruit
   1) Size
   2) Shape
   3) Color
   4) Quality
   5) Edibility
   6) Persistence
   7) Value for wildlife
F. Insect and disease resistance
G. Adaptability to specific areas and sites

Requirements for obtaining a patent.

1) Must submit a written document comprising a petition; specification and claims describing and defining the new plant; an oath or declaration; a drawing, if possible, or a photograph; and payment of the filing fee. Application must be made only in the name of the actual inventor, but may be assigned.
2) When color is a distinguishing factor, the drawing or photograph must be in color and the color described by reference to an accepted color fan or dictionary.
3) The description of the plant should be very complete and detailed, expressed in botanical terms.
4) The origin (location geographically) must be described in detail to establish that it was not found in an uncultivated state.
5) The method of asexual propagation used must be specified.
6) The fact must be established that the invention has not previously been described in any publication in the United States or foreign country.
7) Patience. A properly filed petition usually takes two years to receive approval or disapproval.
8) Costs. All costs vary widely, depending on time involved by professionals to prepare, submit, and support the petition. I suggest a figure for consideration of $3,000 to $5,000 per patent, depending upon complexity of petition.

Conclusions regarding a plant patent. The only way to protect your right to propagate and sell a newly discovered plant is to patent it. You can protect your patent rights through the courts. If you have a patentable plant, it is best not to sell it or distribute plants before the patent is received, unless you have signed agreements acknowledging your ownership.

When attempting to patent a plant the services of a professional horticulturist and a plant patent attorney are invaluable, not legally required but well worth the cost, and increases your chances immeasurably. Sometimes the services of a professional photographer and/or artist are also necessary.

TRADEMARKS

A name registered as a cultivar name should not be confused with a trademark. A trademarked plant must also have a generic name by which it is commonly known. In past years trademarks in the nursery trade have been improperly used very widely. The proper trademark use is properly illustrated by:

- Siebenthaler's trademark, 'Moraine', Moraine locust, Moraine ash, Moraine ginkgo.
- Stark Bros. trademark 'Starkspur' used on a number of fruit tree cultivars.
- Conard-Pyle's blue hollies: 'Blue Princess'; 'Blue Maid'. Clonal trademarks in the trade today probably could not be successfully defended in court. There are several types of trademarks, but for any multistate protection the Federal Trademark Registration is the one we are talking about.

A trademark registration is good for 20 years and can be renewed unlimited times. A plant patent is for 17 years and generally cannot be renewed. Usually several years of the 17 are used up in establishing the worth of the new cultivar, hence the desirability of having both a patent and a trademark becomes evident.

Since a trademark cannot be issued for a generic or cultivar name but identifies the source of a class or group of plants, it is advisable to expand its use to more than one cultivar. Thus, the courts may protect a trademark owner's position and may enforce the owner's right to exclusive use of the trademark. Although the trademark protection afforded the owner is completely different from the plant patent protection, the ultimate value to the inventor is greatly increased by having the dual protection afforded by both the plant patent and the trademark registration.

Requirements to obtain a trademark registration

1) The requested trademark registration should apply to a group or class of plants and identify their source or origin.
2) The trademark must be used in commerce.

3) It is deemed in use in commerce when placed in any manner on the goods, containers, tags or labels, or invoices, affixed thereto and the goods are sold or transported.
4) It is advisable, though not legally required, to have the services of experienced counsel not only to file the application but to determine if the requested trademark is already in use. The patent and trademark office will not assist in this. They maintain a digest of all registered trademarks in their library, but a search is necessary before filing to expedite the application.
5) The time frame involved in a ruling on a trademark is roughly the same as a patent application.
6) The cost involved is appreciably less—maybe $1,000 to 2,000.

Conclusions regarding plant trademarks. Trademark rights enhance the value of plant material. They do not prohibit others from propagating and selling the material under its generic or some other name. Hence, anytime a trademark name or brand is used in marketing plants its generic cultivar name should also appear on labelling or catalog listing.

Due to the wide misuse of trademark names in horticultural commerce, it is important to educate the nursery trade to their proper use. Trademark registration does prevent the use by others of the trademark unless licensed by the trademark owner.

Use of a registered trademark gives some protection to the inventor/owner beyond the 17 years of the patent.

SUMMATION

1) A patent on a new plant cultivar is the best protection obtainable. While the patent is in force (17 years) nobody can legally reproduce the plant under its patent name, another name, or under no name at all.
2) A trademark offers less protection as it protects only the name. Anyone can grow the trademarked plant under another name but, if properly used, a trademark can offer some protection beyond the 17-year life of the patent.
3) Violation of plant patent rights are often very difficult to enforce by the courts. Plant fingerprinting and chromosome studies offer some hope in this area. Violations of trademark rights are much easier to prosecute. However, enforcement is time-consuming, expensive, and may not be worth the effort.
4) In the pursuit of plant patents and trademarks, professional help is generally necessary though not legally required.

5) The proper use of plant patents and trademarks together gives the inventor/owner the maximum protection available under current law. It offers the opportunity of economic gain to inventor/owners and should serve to encourage the development and introduction of improved cultivars, thus helping to upgrade our horticultural industry.

REFERENCES

Individuals, organizations, and government offices

1) American Association of Nurserymen
1250 I Street
Washington, D C. 20005

2) American Bar Association
Section of Patent, Trademark and Copyright Law
750 North Lake Shore Drive
Chicago, IL 60611

3) American Intellectual Property Law Association
2001 Jefferson Davis Highway
Arlington, VA 22202

4) Galle, Fred
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5) National Association Plants Patents Owners
Clay Logan, President
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6) Patent and Trademark Office
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Washington, D. C 20231

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8) John Sataga
Legislative Consultant to AAN
Article "Plant Patents and Trademarks What's the difference?"
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Publications

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