

Plant Variety Protection

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There are three available forms of plant variety protection in the United States; plant patents, utility patents, and certificates of protection. Each form of protection grants different rights to its owner. This paper describes the procedures for obtaining plant patents, utility patents and PVPA Certificates of Protection in the United States for new plant varieties and the rights obtained by these protection grants. Applications for plant and utility patents are similar but there are different requirements for applications for Certificates of Protection. In all applications for protection, it is important to describe the new variety as completely as possible. Plant patents protect varieties that are asexually reproducible and Certificates of Protection apply to sexually reproducible varieties. Utility patents may be obtained for both asexually and sexually reproducible plant varieties. The cost of obtaining protection is also different. Government fees are lower for plant patents (filing fee \$480, issue fee \$590, both reducible by 50% for "small entities"), and highest for Certificates of Protection (total fees are about \$2600, no reduction for "small entities"). Utility patents are in between (filing fee \$710, issue fee \$1170, both reducible by 50% for "small entities"), but maintenance fees are required for utility patents before the end of the fourth, eighth, and twelfth years of the utility patent term in order to maintain the patent in effect. No maintenance fees are required for plant patents.

INTRODUCTION

Plant variety protection became available in the United States in 1930 when Congress extended the definition of patentable subject matter to include asexually reproducible plant varieties. There are now three ways of protecting new plant varieties in this country. Two forms of protection are under the U.S. Patent Law administered by the U.S. Patent and Trademark Office ("PTO") and a third form of protection is available under the Plant Variety Protection Act ("PVPA") administered by the Plant Variety Protection Office in the Department of Agriculture.

Plant patents are granted only for plant varieties which have been "asexually reproduced", e.g. by grafting, rooting of cuttings, micropropagation, etc.

A Certificate of Protection is granted by the PVPA for new sexually reproducible plant varieties. A Certificate of Protection applies to the propagating material and not to the finished product, i.e. the plant.

The third form of protection is a utility patent under 35 U.S.C. 101 of the general patent law. Utility patents may be granted for plants that are reproducible sexually and/or asexually.

PROTECTION OF PLANTS UNDER THE PLANT PATENT LAW (35 U.S.C. 161)

Plant patents are obtained by filing an application with the PTO. The required parts of a plant patent application are: (1) a specification; (2) "drawings"; (3) an oath

or declaration; (4) a single claim; and (5) the filing fee. The new variety, must be identified in the application by its “varietal denomination.” Usually, this denomination appears in the title of the application.

The specification of the application comprises the description of the new variety and should be as full and complete as is possible. The characteristics of the new variety which distinguish it from its antecedents and from the closest other known variety should also be described and the specification should indicate how and where the new variety has been asexually reproduced. In the case of mutations or “sports,” the specification should describe and specify the location and environment of the cultivated area where the mutation was discovered and distinguishing characteristics of the new variety should be described and compared with the parent(s). In general, the characteristics of the plant and its flowers and/or fruit should be disclosed in as much detail as possible, with particular attention to their distinguishing characteristics.

The “drawings” which accompany the specification as part of the application for a plant patent are intended to illustrate the new variety in detail and, in particular, its distinguishing features and qualities. Most commonly, the “drawing” is a color *photo illustration which shows as much detail of the new variety as possible*, but the specific content of the illustration depends upon the type of plant to be protected. If, for example, the new variety is a flowering ornamental, then the illustration should describe the characteristics and color of the flower in different stages of development. A suitable recognized horticultural color chart, such as the Royal Horticultural Society Colour Chart, should be used to describe the color values.

The plant patent application must conclude with a single claim which specifically forms the basis of protection conferred by the plant patent. The plant patent claim is usually in an abbreviated format that refers to the new variety “substantially as shown and described” in the application.

The plant patent application must be accompanied by an oath or declaration in the form prescribed by the law and the PTO rules. It is very important that the proper “inventor” (breeder) be identified in the oath or declaration otherwise the validity of the patent may be affected.

The application for a plant patent must be accompanied by the appropriate filing fee when filing the application. Currently the regular filing fee is \$480 but “small entities” may take advantage of a provision which permits them to pay 50% of the regular government fees. The applicant for a patent is considered a small entity if the applicant or the assignee (the owner) of the application has fewer than 500 employees.

After the patent examiner to whom the application is assigned determines that it is allowable, the applicant is notified that the patent will issue upon payment of the issue fee, currently \$590 but also subject to a 50% reduction for small entities. The 17-year period of protection granted by the patent begins at the date the patent issues (not the date of application filing as is the case in some other countries). Unlike utility patents, no maintenance fees are required to maintain the plant patent in full force and effect; therefore, once the plant patent is granted it is not necessary to pay any additional fees during the 17-year term of the patent.

The owner of a plant patent has the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced. The patent is

infringed by any one of these three acts. Since those selling or using plants which have been unlawfully asexually reproduced are also liable for plant patent infringement, infringement damages may be significantly greater for those improperly using infringing plants to produce commercial products or crops. Sexual reproduction of the patented variety would not constitute infringement of the plant patent since the plant patent rights are limited to the exclusion of others from asexual reproduction of the plant and not from sexual reproduction.

PROTECTION OF PLANTS UNDER THE GENERAL PATENT LAW (35 U.S.C. 101)

All the requirements for patentability under the general patent law also extend to applications for utility patents directed to new varieties of plants. Thus, the requirements of novelty and utility applicable to new varieties under the Plant Patent Act, are the same for utility patents. Both of these requirements can be met by virtually any new variety of plant which is the product of a breeding program or which is a mutation of a preexisting hybrid variety.

An application for a utility patent to a new variety of plant under the general patent law must include the same full and complete description of the new variety as is required under the plant patent statutes and as has been described previously. A major difference however, is that a utility patent may include more than one claim and, thus, the scope of protection available to the patent owner may be increased. For example, a utility patent may include separate claims to the fruit and flowers produced by the plant. This increased protection can be extremely important from a commercial standpoint.

One problem peculiar to applications for utility patents for new varieties of plants is that the disclosure in a utility patent application must be sufficient to enable the public to practice the patented invention upon expiration of the patent. The requirement raises certain problems that make patenting asexually reproducible varieties more difficult than sexually reproducible varieties which can satisfy this requirement by making a deposit of seed. Nonetheless, in important commercial situations, it may be desirable to make the effort to secure a utility patent so as to take advantage of the potentially wider scope of protection. As the law is written, it is possible for the breeder of a new plant variety to make application for both a plant patent and a utility patent or for both a Certificate of Protection under the PVPA and a utility patent.

PROTECTION OF NEW VARIETIES UNDER THE PLANT VARIETY PROTECTION ACT (PVPA)

The PVPA extends protection to new plant varieties reproduced sexually, i.e., by seed, and is similar in some respects to the patent law but there are notable exceptions and differences. The PVPA is administered by the U.S. Department of Agriculture through the Plant Variety Protection Office in Beltsville, Maryland, which grants "Certificates of Protection" following receipt and examination of complete applications. The PVPA applies to almost all sexually reproducible plants.

A requirement for protection under the PVPA is that the new variety must be novel and this requirement is satisfied if there is "distinctiveness, uniformity, and stability" as defined by 7 U.S.C. 2401(a). However, like patents, a variety which has

been a “public variety” as defined by the law, i.e., sold or in public use for more than one year, cannot be protected. The new variety must also have been sexually reproduced and the application must also contain a complete description of the new variety in the form prescribed by the statute for that particular variety. The procedure used in breeding the new variety and its genealogy should also be included in the application. Total U.S. government fees are much higher than for patents, currently about \$2,600, and there is no reduction for “small entities.”

In addition to the foregoing, the PVPA requires that the applicant submit a seed deposit with the application to the Plant Variety Protection Office.

Infringement of a Certificate of Protection is described rather explicitly in 7 U.S.C. 2541. Among the described acts of infringement are the selling, offering for sale, transfer, importation or exportation of the protected variety. However, using the variety for purposes other than propagation is not an infringement of the Certificate of Protection. For example, grinding seeds to produce flour would not infringe the certificate. One important exception to infringement in the PVPA is the so-called “farmers exemption” which is the right to save seed produced from plants of lawfully obtained protected seed for the purpose of growing crops or for limited sale to other farmers for the same purpose.

Unlike patents, applications for a Certificate of Protection may be filed in the name of the owner of the variety, e.g., the company owning the variety, and need not be filed in the name of the breeder of the new variety. The scope of the Certificate of Protection is limited to the propagating material, i.e., seeds, of the new variety. Thus, the only way to expressly protect the individual plant parts such as the flowers or fruit of sexually reproducible varieties is through utility patents. The term of the Certificate of Protection is 18 years from the date the certificate issues, which contrasts with the 17-year term of U.S. patents.

Copies of the sections of law referred to in this paper and other additional information on the subject of plant variety protection may be obtained from the author upon request.