

# Protections for your selections

Breeders and growers looking to protect their work have several available options

**T**HERE ARE A multitude of options for intellectual property (IP) protection for plants and plant-based inventions in the United States. A well-honed IP strategy can result in innovation and growth for just about any nursery stock producer, retailer, landscaper and related companies serving the nursery and greenhouse industry.

The primary sources of IP protection for crop plants in the U.S. are as follows.

## Utility patents

One source of protection for plants in the United States is the utility patent. It can protect plants, plant parts (seeds, pollen, fruit, and flowers), physical traits, new inbreds, first-generation hybrids, proteins, genes (with certain exceptions), microorganisms, transformed cells, chemicals, and methods of developing any of the above.<sup>1</sup>

The requirements for a utility patent include novelty, utility and non-obviousness. In order to be novel, the invention must not have already been patented, nor should it be described in any printed publication, in public use, on sale or otherwise available to the public before the effective filing date of the invention, although there is a one year grace period for the inventor's own disclosures and disclosures of information by others that was obtained directly from the inventor (and without a non-disclosure agreement in place).<sup>2</sup>

An issued patent grants the inventor or their assignee the exclusive right to make or use the invention for 20 years following the effective filing date of the patent application. The patent holder can exclude others from making, using, selling or commercializing the plant in the United States for that 20 year period.

In other words, no one can use the patented plant in any crosses or for any experimentation without first obtaining

a license from the patent owner without risking a claim of infringement.

In the case of patents for plant cultivars, the application process normally includes the collection of data on the new plant, comparing that data to closest known varieties, preparing and filing the application with the U.S. Patent and Trademark Office (USPTO), and in many cases making a seed deposit), and making any required assignments and disclosure of known prior art to the USPTO.

## Plant patents

Plant patents are unique to the United States and are designed to encourage research and investment in new, asexually produced varieties. A U.S. plant patent grants protection to “whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and new found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state.”<sup>3</sup>

The requirements for a plant patent are similar to those for a utility patent (novelty, utility and non-obviousness) and the term is the same — it's good for 20 years following the application filing date. The plant patent is available for asexually reproduced plants only, some examples of which are strawberry, blueberry, raspberry, other fruits, grapevines, grasses, potted plants and cut-flower plants.<sup>4</sup>

## Knowing the difference

What is the difference between plant patents and utility patents? Plant patents



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apply to asexually reproduced plants except for edible tubers (i.e., buds and cuttings), whereas utility plants apply to sexually reproducing plants (flowers and seeds) and genetically engineered plants.

Plant patents have only one claim, whereas utility patents have multiple claims, averaging 10-60. Therefore, plant patents are significantly less expensive due to their relative simplicity compared to utility patents, and typically require fewer responses to “office actions” from the USPTO prior to issuance.

However, utility patents offer much broader protection than plant patents since they can cover, among other things, trait claims, breeding methods, and food product claims.<sup>5</sup>

Furthermore, and importantly, there is no research exception for utility patented varieties, unlike for plant patents, and a utility patent holder can prevent other breeders from using a patented variety in breeding during the term of the patent.<sup>6</sup>



## Plant variety protection

The U.S. Plant Variety Protection Act is another source of intellectual



property protection for plants. However, unlike utility and plant patents, which are granted by the USPTO, the plant variety program is administered by the U.S. Department of Agriculture (USDA).

Similarly to patents, the requirements for plant variety protection include novelty, but they also require uniformity, stability, and distinctiveness.<sup>7</sup> Similar to patents, the plant variety certificate has a term of 20 years from issuance in most cases<sup>8</sup>. The U.S. PVP certificate certifies “that the breeder has the right, during the term of the PVP, to exclude others from selling the variety, or offering it for sale, or reproducing it, or importing it, or exporting it, or using it in producing a hybrid or different variety therefrom, to the extent provided by this Act.”

However, unlike utility patents, the U.S. PVR has a research exemption that allows for bona fide research without risk of infringement, as well as a saved seed exemption that allows farmers to save seed from protected varieties and to use them in the production of a crop without infringement.<sup>9</sup>

### What about trademarks?

Trademarks are another source of intellectual property protection for plants. Trademarks represent a connection in the minds of consumers between the source of a good or service (plants) and its producer (nursery, farm, etc.).

Unlike a varietal name that identifies the specific plant for all plants of a specific variety, trademarks act as brand names and can be used for numerous plants to indicate the source of an entire series of plants.<sup>10</sup> Examples include Endless Summer<sup>®</sup> (for hydrangeas), Bushel and Berry<sup>®</sup> (formerly Brazelberries<sup>®</sup>, for berry shrubs), and Knock Out<sup>®</sup> (for roses).

Unlike patents and PVPs, trademarks can be protected indefinitely, so long as they are exclusively and continuously used by their owner in connection with the sale of goods and services.

One benefit of obtaining a federal trademark registration rather than simply relying on common law rights developed

in certain regions of the country, is that the federal registration provides nationwide rights to exclude others from using the same or similar mark in the same or a related class of goods and services. In order to have the best chance of obtaining a federal registration, the trademark – whether it be for a word, phrase, slogan or logo – should be unusual and distinctive, not merely descriptive or generic.

An application for a plant variety name as a trademark will result in a rejection of the application because the varietal name is descriptive or generic as it identifies a specific plant cultivar. Likewise, use of geographic regions in connection with other common terms (i.e., Valencia oranges or Northwest marionberries) is likely to be rejected by the trademark examiner as geographically descriptive.

### Trade secrets

Trade secrets protection is also available in the United States for plants, both at the state and federal levels.

Trade secrets are broadly defined at the federal level as “all forms and types of financial, business, scientific, technical, economic, or engineering information, including patterns, plans, compilations, program devices, formulas, designs, prototypes, methods, techniques, processes, procedures, programs, or codes, whether tangible or intangible, and whether or how stored, compiled, or memorialized physically, electronically, graphically, photographically, or in writing.”<sup>11</sup>

There is no registration or certification process available, as with patents, PVRs and trademarks. Rather, trade secret protection is only available under state and federal law when the owner has taken reasonable measures to keep such information secret and the information derives independent economic value, actual or potential, from not being generally known to or readily ascertainable by another person who can obtain economic value from the disclosure or use of the information.<sup>12</sup>

### Copyrights

Copyrights protect artistic or creative

works, such as books, movies, pictures, sculptures, music, and computer programs. More applicable to nursery stock producers and associated businesses, copyright protection applies to instructional materials, designs, online writing such as blogs and articles, as well as maps and graphics. Whoever owns the copyright to a work is allowed to distribute, display, reproduce, perform, or use the work to create derivative works.

Copyright arises upon creation, i.e., once the idea of the creative work has been reduced to tangible form. Under current law, copyrights last for the life of the author plus 70 years for individual works and for 95 years from first publication for corporate works (i.e., works “made for hire”).

Like a trademark, there is no requirement that you register a copyright with the federal government in order to enjoy the legal right to its protection. However, without registering, you do not have the right to sue another for infringing on your copyright, nor do you have the right to recover statutory damages or attorneys’ fees from those that infringe prior to your registration date. Instead, only an award of actual damages (which are hard to prove) and profits earned by the infringer are available to you as the copyright owner.

### Contracts

Finally, intellectual property and contracts go hand in hand. Licenses, assignments, co-existence agreements, consent agreements, sale agreements, non-compete and non-solicitation agreements and employee/contractor intellectual property agreements are some of the most common forms of contracts that apply to intellectual property in agriculture, as in other industries. Confidentiality, non-disclosure and non-use agreements are also important, particularly in the realm of patent and trade secret law.

### Conclusion

There are multiple ways to the protect intellectual property associated with crop plants in the U.S., and intellectual property is an important asset for most busi-

nesses. At Jordan Ramis we will assist you with the registration of your trademarks and copyrights and with the protection of your trade secrets. We will also help you enforce your rights in your patents, trademarks, copyrights and trade secrets through cease and desist letters, licensing and joint development agreements, and, when necessary, litigation.<sup>13</sup> ©

*The information contained in this article is for the general interest of our readers and should not be regarded as legal advice.*

*If you have questions, or to obtain more information on this topic, please contact Susan Ford.*

Endnotes

- 1 See Current Legal Issues in Intellectual Property Rights and Protection for Crop Plants, Crop Science ([www.crops.org](http://www.crops.org)), Vol. 55, November-December 2015, at 2497, citing J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred International, 534 U.S. 124, 143-146, 122 S.Ct. 593, 605-606, 60 USPQ2d 1865, 1874.
- 2 Current Legal Issues in Intellectual Property Rights and Protection for Crop Plants, Crop Science ([www.crops.org](http://www.crops.org)), Vol. 55, November-December 2015, at 2497.
- 3 U.S. Plant Variety Protection Act of 1970 (PVPA), 7 U.S.C. §§ 2321-2582; see also *In re Beineke* 690 F.3d 1344, 1352, 103 USPQ2d 1872, 1877 (2012).
- 4 Current Legal Issues in Intellectual Property Rights and Protection for Crop Plants, Crop Science ([www.crops.org](http://www.crops.org)), Vol. 55, November-December 2015, at 2498.
- 5 Trait claims cover those varieties developed and disclosed in the patent application without the need for a seed deposit and can cover those varieties independently developed later that fall within the claim. See <http://perennialpatents.com/plantpatent-v-utility-patents/#> (last visited August 22, 2019).
- 6 Id.
- 7 Current Legal Issues in Intellectual Property Rights and Protection for Crop Plants, Crop Science ([www.crops.org](http://www.crops.org)), Vol. 55, November-December 2015, at 2499.
- 8 Plant Variety Protection is offered for 25 years for vines and trees. See <https://www.ams.usda.gov/services/plant-variety-protection> (last visited Aug. 28, 2019).
- 9 U.S. Plant Variety Protection Act of 1970 (PVPA), 7 U.S.C. §§ 2321-2582.
- 10 See <http://www.iphandbook.org/handbook/ch11/p06/> at p. 3 (last visited August. 26, 2019).
- 11 The Defend Trade Secrets Act, 18 U.S.C. § 1836, et. Seq.
- 12 Id., see also ORS 646.461(4).
- 13 Additionally, we can refer you to and collaborate with registered patent agents and attorneys for the filing and prosecution of your patent applications and plant variety certificates.



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