

## Patenting and Trademarking—Do's and Don'ts

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Patents and trademarks belong to a very important group of rights referred to as Intellectual Property Rights. Like more tangible forms of property, such as real estate or a piece of machinery, they can be bought and sold. And like real estate and machinery, they are crucial elements in commerce today.

Let's turn our attention first to the concept of patents.

The importance of innovation and investment in research and development was recognized by the framers of the U.S. Constitution back in 1789. In Article 1, Section 8, the Constitution states that: The Congress shall have power . . . to promote the progress of science and the useful arts, by securing for limited periods of time to authors and inventors the exclusive right to their respective writings and discoveries.

In 1793 Congress formalized this sentiment by adopting a patent act, authored by our third President, Thomas Jefferson.

A fundamental rationale for granting a monopoly to an inventor was the recognition that society was benefiting by getting something that never existed before. Thus, the patent grant is a reward for making something new available to the general public. The grant takes nothing away from the public which the public already possesses.

In the United States, patent protection of virtually all types lasts for a period of 17 years. During this 17-year period, the patent holder is granted a monopoly that conveys the right to exclude others from making, using, or selling his invention. After that 17-year period the invention falls into the public domain.

As the industrial revolution of the 19th Century gave way to a revolution in plant breeding and genetics in the early part of the 20th Century, Congress became interested in extending a similar type of protection to plants that was already afforded to industry. Individuals such as Luther Burbank and Thomas Edison actively promoted the concept of plant patenting, and finally, in 1930, the U.S. Plant Patent Act was enacted.

The scope of patentable subject matter under the Plant Patent Act is defined as: 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 plant found in an uncultivated state, may obtain a patent therefore . . .

Key words in this section of the code are "asexually reproduces," "distinct and new", and "variety."

The requirement that the plant be asexually reproduced automatically disqualifies all seed-produced crops, whether horticultural or agricultural. This stipulation ensures that all the individual plants propagated from the original new plant are genetically the same; that they are, in other words, clones of the original "variety."

The requirement that the subject of a plant patent be "distinct and new" is at the center of any type of patent anywhere in the world. The inventor, or breeder, is only going to be granted a patent if he can show that his new creation is novel and distinct from anything that has come before.

Finally, the above section of the Code strictly prohibits the granting of a plant patent on any plant found in an "uncultivated state." This means, quite simply, that any new and distinct plant found in a natural state, such as the woods, cannot be patented.

If a breeder or discoverer of a new variety of plant can demonstrate to the U.S. Patent and Trademark Office that his new variety meets all the above criteria, a plant patent will be granted. The basic right a plant patent conveys the patent holder is the "right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced." This right, as mentioned earlier, lasts for 17 years from the date of the grant.

Since the Plant Patent Act was enacted almost 65 years ago, over 8500 plant patents have been granted. Current rates of applications for new plant patents are between 300 and 400 per year.

When one applies for a plant patent on a new variety there are a few legal requirements that are important for one to satisfy. First, a plant patent must be applied for within 1 year from the date of the first offer of sale for that variety. There is nothing to say that one can't apply for a plant patent long before one places the variety on the market. However, the Plant Patent Act specifically requires that one wait no longer than 12 months from the first offer of sale for applying for patent protection. The primary reason for this is to guarantee that the public is indeed getting something that is truly new. If a variety has been on the market for several years it by definition cannot be completely new.

Only the breeder or the discoverer of the new variety can apply for a plant patent on that variety. The applicant does not necessarily have to employ the services of a patent attorney, but most commercial breeders do employ such a service. Patent attorneys can effectively respond to the increasing amount of questions that patent examiners are asking and can much more efficiently prosecute the application throughout the examination process. A good rule of thumb is that a patent attorney's fees will be about \$1000 to \$1500 for a single plant patent. In addition to these fees are government fees, which change from time to time, but which are currently a total of \$1700. For companies with less than 500 employees this figure is reduced by 50%.

The patent and trademark office requires that the new variety be designated by a name. This name can never become the trademark. It is the variety name for that specific variety and will remain so forever.

In the patent application the breeder must satisfactorily describe the new variety, how it came into being, and how it differs from other closely related, previously existing varieties. Additionally, the breeder or discoverer must indicate that the variety has been successfully asexually propagated and that the essential characteristics of the variety are maintained through asexual propagation.

These are the fundamental aspects of applying for United States Plant Patent. The application process is fairly straight forward and not extremely expensive and can be undertaken by any individual of any country in the world; U.S. citizenship is not a requirement.

The subject of trademarking—especially as used in horticulture—is as complicated as plant patenting is simple. And the fact that there are both federal and state trademark laws adds to the confusion. For purposes of this talk, I will discuss only federal trademarks.



Current trademark law follows the Trademark Act of 1946, as amended, which is commonly known as the Lanham Act. The Lanham Act defines a trademark as “a word, name, symbol, or device ... used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.” The primary function of a trademark is, therefore, to indicate origin.

A related function of a trademark is to indicate a certain consistent level of quality for the goods bearing a specific mark, and through advertising to create and maintain a demand for the product.

As an illustration of this point, when you buy a Big Mac<sup>®</sup> hamburger at McDonald's it is going to be pretty much the same whether you buy this hamburger in Philadelphia, Pennsylvania or in Pocatello, Idaho. You have a level of confidence that the quality and other attributes of the product are going to be consistent wherever the product is found.

Because McDonald's has spent a considerable amount of time assuring consistent quality, and a considerable amount of money promoting the product, it would be unfair for any other restaurant to use the words “Big Mac.” Doing so would clearly undermine the creativity and the investment of McDonald's and would constitute unfair competition. It is largely for these reasons the government will grant the right to private ownership of a word or phrase in association with a *certain type of goods*.

McDonald's, however, cannot claim universal ownership of the words “Big Mac” for any type of product. One could conceivably use the words “Big Mac” as a trademark for a daylily. In fact, I know of a lot of daylilies with names that are ever more ridiculous than “Big Mac.” It is clear that such a use would not constitute infringement of McDonald's trademark, as there would be little chance for confusion among the public with the Big Mac<sup>®</sup> Hamburger.

There are currently 42 international classes of goods and services under which trademarks can be registered. The class covering agricultural, horticultural, and forestry products is International Class 31.

Although it is preferable for many reasons, a trademark does not have to be registered with U.S. Patent and Trademark Office to be a valid trademark. Trademarks derive their status solely through their use in interstate commerce. Simply the proper and consistent use of the word or words that one applies to ones goods gives one a *de facto* common law trademark.

In many incidents one sees the letters “TM” following a word or phrase. This notation puts the public on notice that the user considers the word or phrase to be his trademark, but that he is not yet registered that mark with the Patent and Trademark Office. Only those marks which have been officially granted registration status can be followed by the ® symbol, which is the legal symbol for a registered trademark.

A trademark is, in its most basic form, a brand name. Well known examples include Kleenex<sup>®</sup> facial tissues, Tylenol<sup>®</sup> pain reliever, or Dorritos<sup>®</sup> corn chips. The best way to think of a trademark, or brand name, is that it is always an adjective and never a noun. Therefore, to properly use the trademark one should always say: I would like to buy some Kleenex<sup>®</sup> tissues, “not” I would like to buy some Kleenex<sup>®</sup>.

It is this distinction between adjective and noun that lies at the center of the loss of several important trademarks over the past decades. Perhaps the best known

example of this loss of trademark status is the word "aspirin," which was originally a brand name for acetylsalicylic acid owned by The Bayer Company. Because the Bayer Company over time let the word aspirin become a noun, and therefore become generic, they lost their right to ownership of the word. That is, because of the way the company promoted its products to the public, the word aspirin ceased to be a brand, and rather became a generic word for a type of pain reliever. People were referring to the product in terms of "I'm going to buy some aspirin," and not "I'm going to buy some aspirin pain reliever."

All this is fairly technical, and this is the easy part. Trademarking products is extremely tricky, but in the world of commerce it has become more and more important.

In our own world of horticulture, the use of trademarks takes two general forms—one controversial and one not. Taking the easy one first, the non-controversial form of trademark usage involves house brands. Examples of these family brands would be Burpee® Seeds, Optimara® African Violets, and Star® Roses. In these examples, the registered trademark covers a range of products and denotes their origin.

Where the debate gets louder is when trademarks are used at the variety level. Here it is important to remember what was mentioned earlier—a trademark can never be the **name** of a plant, because the name is by definition generic. Rather, a trademark is the brand of that specific plant.

Let's take a hypothetical example of a horizontal juniper named Tapestry. From the standpoint of proper nomenclature, this plant would be referred to as *Juniperus horizontalis* 'Tapestry'. Tapestry is the name of this specific variety and as such can never be used as a trademark.

If one wanted to apply the word Tapestry as a trademark, one would be obliged to give a variety name to the variety completely distinct and separate from the trademark, Tapestry. For example, one could call the variety Hartap, resulting in the full designation, *Juniperus horizontalis* 'Hartap'. In applying the trademark Tapestry, the appellation could be written *Juniperus horizontalis* TAPESTRY® (variety: Hartap) or *Juniperus horizontalis* TAPESTRY® / 'Hartap.'

Proper trademark usage would require one to refer to the plant as TAPESTRY® juniper, or better yet, TAPESTRY® brand juniper. One should never call the plant *Juniperus* 'Tapestry.'

What this example says, and what every example of proper trademark usage on any type of product says, is that the public must always have a way to refer to a specific item which is in the public domain. In the above example of Tapestry, the public would have the word Hartap by which to refer to the variety. Tapestry becomes the trademark, or brand name, of that type of juniper.

In the case of trademarks applied to plants, it is essential to realize that a trademark gives its owner absolutely no control over the propagation and subsequent sale of the plant. It only gives the owner the right to exclude others from using his trademark in association with the plant.

Therefore, in the above example, if one wanted to propagate and sell plants of *Juniperus horizontalis* 'Hartap' one would be free to do so under that name so long as one didn't apply the trademark Tapestry to that variety. In fact, one could conceivably propagate and grow Juniper 'Hartap' under a completely different trademark if one wanted.



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In terms of the grant, the essential difference between a patent and a trademark is very clear. Patents cover an invention for a 17-year period of time, during which a patent holder can prevent others making, using, or selling his invention. A patent cannot be renewed.

A trademark, however, does not grant any sort of proprietary rights to a product or an invention itself. It is merely a fancy name applied to a product which denotes a specific source of origin and connotes a certain level of quality. A trademark is valid for a 10-year period and is renewable for successive 10-year periods, so long as the mark continues to be used in interstate commerce. Should the mark fall into disuse for a sufficient amount of time, it will be assumed to be abandoned by the Patent and Trademark Office, and could conceivably be picked up and used by another individual or firm.