Chapter 1600 Plant Patents

1601 Introduction: The Act, Scope, Type of Plants Covered [R-11.2013]

The right to a plant patent stems from:

35 U.S.C. 161 Patents for plants.

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, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

Asexually propagated plants are those that are reproduced by means other than from seeds, such as by the rooting of cuttings, by layering, budding, grafting, inarching, etc. Plants capable of sexual reproduction are not excluded from consideration if they have also been asexually reproduced.

With reference to tuber propagated plants, for which a plant patent cannot be obtained, the term "tuber" is used in its narrow horticultural sense as meaning a short, thickened portion of an underground branch. Such plants covered by the term "tuber propagated" are the Irish potato and the Jerusalem artichoke. This exception is made because this group alone, among asexually reproduced plants, is propagated by the same part of the plant that is sold as food.

The term "plant" has been interpreted to mean "plant" in the ordinary and accepted sense and not in the strict scientific sense and thus excludes bacteria. *In re Arzberger,* 112 F. 2d 834, 46 USPQ 32 (CCPA 1940). The term "plant" thus does not include asexual propagating material, *per se. Ex parte Hibberd,* 227 USPQ 443, 447 (Bd. Pat. App. & Int. 1985).

35 U.S.C. 161 originated as an amendment to the pre-existing patent statute with the Plant Patent Act of 1930. As enacted, the "invents or discovers" requirement limited patent protection to plants "that were created as a result of plant breeding or other agricultural and horticultural efforts and that were created by the inventor." *In re Beineke,* 690 F.3d 1344, 1352, 103 USPQ2d 1872, 1877 (Fed. Cir. 2012). The plant patent provisions were separated from the utility patent provisions in the Patent Act of 1952 to create **35 U.S.C. 161**. *Id.* at 1348 n.2, 103 USPQ2d 1875 n.2. **35 U.S.C. 161** was amended in 1954 to extend protection to "newly found seedlings," provided they were found in a cultivated state, but did not otherwise alter the scope of plant patent protection. *Id.* at 1352-53, 103 USPQ2d at 1878-79. In *Beineke,* the Federal Circuit held that two century-old oak trees found on the lawn of a home were ineligible for patent protection under **35 U.S.C. 161** because they were not created from inception by human activity and created by the inventor (i.e., the patent applicant) as required by the 1930 Act, nor were they "newly found seedlings" under the 1954 amendment. *Id.* at 1348, 1352, 103 USPQ2d at 1875, 1879.

In reviewing the history of the Plant Patent Act, the Supreme Court explained:

> Prior to 1930, two factors were thought to remove plants from patent protection. The first was the belief that plants, even those artificially bred, were products of nature for purposes of the patent law…. The second obstacle to patent protection for plants was the fact that plants were thought not amenable to the "written description" requirement of the patent law. See U.S.C. § 112.
>
> *****
>
> In enacting the Plant Patent Act, Congress addressed both of these concerns. It explained at length its belief that the work of the plant

breeder "in aid of nature" was patentable invention. S. Rep. No. 315, 71st Cong., 2d Sess., 6-8 (1930); H.R. Rep. No. 1129, 71st Cong., 2d Sess., 7-9 (1930). And it relaxed the written description requirement in favor of "a description … as complete as is reasonably possible." 35 U.S.C. § 162.

Diamond v. Chakrabarty, 447 U.S. 303, 311-312 (1980).

An asexually reproduced plant may alternatively be protected under **35 U.S.C. 101**, provided the written description requirement can be satisfied. See **35 U.S.C. 112**. In *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int' l, Inc.*, the Supreme Court held that patentable subject matter under **35 U.S.C. 101** includes newly developed plants, even though plant protection is also available under the Plant Patent Act (**35 U.S.C. 161**-**164**) and the Plant Variety Protection Act (7 U.S.C. 2321 et. seq.). *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int' l, Inc.*, 534 U.S. 124, 143-46, 122 S.Ct. 593, 605-06, 60 USPQ2d 1865, 1874 (2001) (The scope of coverage of **35 U.S.C. 101** is not limited by the Plant Patent Act or the Plant Variety Protection Act; each statute has different requirements and protections). An application filed under **35 U.S.C. 101** may claim the same asexually reproduced plant that is claimed under **35 U.S.C. 161**, as well as plant materials and processes involving plant materials. See **MPEP § 2105**.

The filing of a terminal disclaimer may be used in appropriate situations to overcome an obviousness-type double patenting rejection based on claims to the asexually reproduced plant and/or fruit and propagating material thereof in an application under **35 U.S.C. 101** and the claim to the same asexually reproduced plant in an application under **35 U.S.C. 161.**

35 U.S.C. 163 Grant.

In the case of a plant patent, the grant shall include 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, or from importing the plant so reproduced, or any parts thereof, into the United States.

As provided in **35 U.S.C. 161**, the rights associated with a plant patent include the rights associated with a utility patent, and the "right to exclude" has additional terms provided in **35 U.S.C. 163**. A plant patent issuing from an application filed after June 7, 1995 has a term which expires 20 years after the filing date of the application, or any earlier filing date claimed under **35 U.S.C. 120**, **121 or 365(c)**. See **MPEP § 2701**. Plant patent applications will be published pursuant to **35 U.S.C. 122(b)**.

1602 Rules Applicable [R-08.2012]

37 CFR 1.161 Rules applicable.

The rules relating to applications for patent for other inventions or discoveries are also applicable to applications for patents for plants except as otherwise provided.

1603 Elements of a Plant Application [R-11.2013]

37 CFR 1.163 Specification and arrangement of application elements in a plant application.

*****

(b) The elements of the plant application, if applicable, should appear in the following order:

(1) Plant application transmittal form.
(2) Fee transmittal form.
(3) Application data sheet (see § **1.76**).
(4) Specification.
(5) Drawings (in duplicate).
(6) The inventor's oath or declaration (§ **1.162**).

*****

An application for a plant patent consists of the same parts as other applications. For information pertaining to the inventor's oath or declaration, specification and claim, or drawings, see **MPEP § 1604**, **1605**, or **1606**, respectively.

1604 Applicant, Oath or Declaration [R-11.2013]

37 CFR 1.162 Applicant, oath or declaration.

[Editor Note: Applicable only to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012.]

The inventor named for a plant patent application must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought. The inventor's oath or declaration, in addition to the averments required by **§ 1.63** or **§ 1.64**, must state that the inventor has asexually reproduced the plant. Where the plant is a newly found plant, the inventor's oath or declaration must also state that it was found in a cultivated area.

37 CFR 1.162 (pre-AIA). Applicant, oath or declaration.

*[Editor Note: **Not applicable** to patent applications filed under 35 U.S.C. 111(a) or 363 on or after September 16, 2012.]*

The applicant for a plant patent must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought (or as provided in §§ 1.42, 1.43 and 1.47). The oath or declaration required of the applicant, in addition to the averments required by § 1.63, must state that he or she has asexually reproduced the plant. Where the plant is a newly found plant, the oath or declaration must also state that it was found in a cultivated area.

The inventor's oath or declaration, in addition to the averments required by **37 CFR 1.63** or **37 CFR 1.64**, (or, for applications filed before September 16, 2012, **pre-AIA 37 CFR 1.63**) must state that the inventor has asexually reproduced the plant. Where the plant is a newly found plant, the inventor's oath or declaration must also state that it was found in a cultivated area.

A Plant Patent Application (**35 U.S.C. 161**) Declaration, Form PTO/AIA/09, may be used to submit a declaration in a plant application filed on or after September 16, 2012.

In an application for a plant patent, there can be joint inventors. See *Ex parte Kluis*, 70 USPQ 165 (Bd. App. 1945).

Doc Code: Oath
Document Description: Oath or declaration filed

PTO/AIA/09 (06-12)
Approved for use through 01/31/2014. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PLANT PATENT APPLICATION (35 U.S.C. 161) DECLARATION (37 CFR 1.162)

☐ Declaration Submitted with Initial Filing **OR** ☐ Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16(e)) required)

Attorney Docket Number	
First Named Inventor	
COMPLETE IF KNOWN	
Application Number	
Filing Date	
Art Unit	
Examiner Name	

The new and distinct variety of:

plant named:

As a below named inventor, I hereby declare that:

This declaration is directed to:

☐ The attached application

OR

☐ United States Application Number _____ filed on (MM/DD/YYYY) _____ .

I have asexually reproduced the plant to which this application applies.

☐ Said plant was found in cultivated area (*check this box for newly found plant only*)

The above-identified application was made or authorized to be made by me.

I believe I am the original inventor or an original joint inventor of a claimed invention in the application.

I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

[Page 1 of 2]

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/AIA/09 (06-12)
Approved for use through 01/31/2014. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

DECLARATION - Plant Patent Application

Direct all correspondence to: ☐ The address associated with Customer Number:		
OR ☐ Correspondence address below		
Name		
Address		
City	State	Zip
Country	Telephone	Email

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

LEGAL NAME OF SOLE OR FIRST INVENTOR:			
(*E.g.*, Given Name (first and middle (if any) and Family Name or Surname)			
Inventor's Signature			Date (Optional)
Residence: City	State	Country	
Mailing Address			
City	State	Zip	Country

☐ Additional inventors are being named on the_____ supplemental sheet(s) PTO/AIA/10 attached hereto

[Page 2 of 2]

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

1605 Specification and Claim [R-11.2013]

35 U.S.C. 162 Description, claim.

No plant patent shall be declared invalid for noncompliance with **section 112** if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

37 CFR 1.163 Specification and arrangement of application elements in a plant application.

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

(b) The elements of the plant application, if applicable, should appear in the following order:

(1) Plant application transmittal form.
(2) Fee transmittal form.
(3) Application data sheet (see § 1.76).
(4) Specification.
(5) Drawings (in duplicate).
(6) The inventor's oath or declaration (§ 1.162).

(c) The specification should include the following sections in order:

(1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.
(2) Cross-reference to related applications (unless included in the application data sheet).
(3) Statement regarding federally sponsored research or development.
(4) Latin name of the genus and species of the plant claimed.
(5) Variety denomination.
(6) Background of the invention.
(7) Brief summary of the invention.
(8) Brief description of the drawing.
(9) Detailed botanical description.
(10) A single claim.
(11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

37 CFR 1.164 Claim.

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The specification should include a complete detailed description of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, expressed in botanical terms in the general form followed in standard botanical textbooks or publications dealing with the varieties of the kind of plant involved (evergreen tree, dahlia plant, rose plant, apple tree, etc.), rather than a mere broad nonbotanical characterization such as commonly found in nursery or seed catalogs. The specification should also include the origin or parentage and the genus and species designation of the plant variety sought to be patented. The Latin name of the genus and species of the plant claimed should be stated and preceded by the heading set forth in **37 CFR 1.163(c)(4)**. The specification must particularly point out where, e.g., location or place of business, and in what manner the variety of plant has been asexually reproduced.

Form Paragraphs 16.01, 16.09, and 16.10 may be used to object to the disclosure under **37 CFR 1.163(a)**.

¶ *16.01 Specification, Manner of Asexually Reproducing*

The application is objected to under **37 CFR 1.163(a)** because the specification does not "particularly point out where and in what manner the variety of plant has been asexually reproduced." Correction is required.

¶ *16.09 Specification, Less Than Complete Description*

The disclosure is objected to under **37 CFR 1.163(a)** because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties. More specifically: **[1]**.

¶ *16.10 Specification, Location of Plant Not Disclosed*

The disclosure is objected to under **37 CFR 1.163(a)** because the specification does not particularly point out the location and character of the area where the plant was discovered.

Where color is a distinctive feature of the plant, the color should be positively identified in the specification by reference to a designated color as given by a recognized color dictionary or color chart.

Form Paragraphs 16.02 and 16.03 may be used to object to the disclosure or reject the claim, respectively, because of a lack of a clear and complete disclosure with regard to colors.

¶ *16.02 Colors Specified Do Not Correspond With Those Shown*

The disclosure is objected to under **35 U.S.C. 112(a)** or **pre-AIA 35 U.S.C. 112**, first paragraph, because the **[1]** colors specified fail to correspond with those shown.

¶ *16.03 Rejection, 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, 1st Paragraph, Non-Support for Colors*

The claim is rejected under **35 U.S.C. 112(a)** or **pre-AIA 35 U.S.C. 112**, first paragraph, as being unsupported by a clear and complete disclosure with regard to **[1]** colors, for the following reasons: **[2]**.

If the written description of a plant is deficient in certain respects (see, e.g., *In re Greer*, 484 F.2d 488, 179 USPQ 301 (CCPA 1973)), a clarification or additional description of the plant, or even a wholesale substitution of the original description so long as not totally inconsistent and unrelated to the original description and photograph of the plant may be submitted in reply to an Office action. Such submission will not constitute new matter under **35 U.S.C. 132**. *Jessel v. Newland*, 195 USPQ 678, 684 (Dep. Comm'r Pat. 1977).

The rules on Deposit of Biological Materials, **37 CFR 1.801**-1.809, do not apply to plant patent applications in view of the reduced disclosure requirements of **35 U.S.C. 162**, even where a deposit of a plant has been made in conjunction with a utility application (**35 U.S.C. 101**).

A plant patent is granted only on the entire plant. Only one claim is necessary and only one is permitted. A method claim in a plant patent application is improper. An example of a proper claim would be "A new and distinct variety of hybrid tea rose plant, substantially as illustrated and described herein."

1606 Drawings [R-11.2013]

37 CFR 1.165 Plant drawings.

(a) Plant patent drawings should be artistically and competently executed and must comply with the requirements of **§ 1.84**. View numbers and reference characters need not be employed unless required by the examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation.

(b) The drawings may be in color. The drawing must be in color if color is a distinguishing characteristic of the new variety. Two copies of color drawings or photographs must be submitted.

If the drawings or photographs are in color, two color copies of each drawing or photograph are required. If the required copies of the drawings are not included, the application will be accorded a filing date, but correction will be required before the application is forwarded for examination.

37 CFR 1.84 Standards for drawings.

*****

(c) *Identification of drawings.* Identifying indicia should be provided, and if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet within the top margin. Each drawing sheet submitted after the filing date of an application must be identified as either "Replacement Sheet" or "New Sheet" pursuant to § **1.121(d)**. If a marked-up copy of any amended drawing figure including annotations indicating the changes made is filed, such marked-up copy must be clearly labeled as "Annotated Sheet" pursuant to § **1.121(d)(1)**.

*****

(e) *Type of paper.* Drawings submitted to the Office must be made on paper which is flexible, strong, white, smooth, non-shiny, and durable. All sheets must be reasonably free from cracks, creases, and folds. Only one side of the sheet may be used for the drawing. Each sheet must be reasonably free from erasures and must be free from alterations, overwritings, and interlineations. Photographs must be developed on paper meeting the sheet-size requirements of paragraph (f) of this section and the margin requirements of paragraph (g) of this section. See paragraph (b) of this section for other requirements for photographs.

(f) *Size of paper.* All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

(1) 21.0 cm. by 29.7 cm. (DIN size A4), or
(2) 21.6 cm. by 27.9 cm. (8 1/2 by 11 inches).

(g) *Margins.* The sheets must not contain frames around the sight (*i.e.*, the usable surface), but should have scan target points (*i.e.*, cross-hairs) printed on two cater-corner margin corners. Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9 5/8 inches) on 21.6 cm. by 27.9 cm. (8 1/2 by 11 inch) drawing sheets.

*****

(i) *Arrangement of views.* One view must not be placed upon another or within the outline of another. All views on the same sheet should stand in the same direction and, if possible, stand so that they can be read with the sheet held in an upright position. If views wider than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the top of the sheet, with the appropriate top margin to be used as the heading space, is on the right-hand side. Words must appear in a horizontal, left-to-right fashion when the page is either upright or turned so that the top becomes the right side, except for graphs utilizing standard scientific convention to denote the axis of abscissas (of X) and the axis of ordinates (of Y).

*****

(t) *Numbering of sheets of drawings.* The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number and the second being the total number of sheets of drawings, with no other marking.

(u) *Numbering of views.*

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or

inverted commas. The view numbers must be larger than the numbers used for reference characters.

*****

(x) *Holes.* No holes should be made by applicant in the drawing sheets.

Form Paragraphs 16.06, 16.07, and 16.11 may be used to object to the drawing disclosure.

¶ *16.06 Color Drawings Must Be in Duplicate*

The disclosure is objected to under **37 CFR 1.165(b)** because applicant has not provided copies of the color drawing in duplicate. Correction is required.

¶ *16.07 Drawing Figures Not Competently Executed*

The disclosure is objected to under **37 CFR 1.165(a)** because Fig. **[1]** not artistically and/or competently executed.

¶ *16.11 Drawings in Improper Scale*

The disclosure is objected to under **37 CFR 1.165(a)** because the drawings are of an inadequate scale to show the distinguishing features of the plant.

1607 Specimens [R-08.2012]

37 CFR 1.166 Specimens.

The applicant may be required to furnish specimens of the plant, or its flower or fruit, in a quantity and at a time in its stage of growth as may be designated, for study and inspection. Such specimens, properly packed, must be forwarded in conformity with instructions furnished to the applicant. When it is not possible to forward such specimens, plants must be made available for official inspection where grown.

Specimens of the plant variety, its flower or fruit, should not be submitted unless specifically called for by the examiner.

Form Paragraph 16.13 may be used to require specimens.

¶ *16.13 Specimens Are Required*

Applicant **[1]** required to submit **[2]** in accordance with **37 CFR 1.166**.

1608 Examination [R-11.2013]

Plant applications are subject to the same examination process as any other national application. As such, the statutory provisions with regard to patentable subject matter, utility, novelty, obviousness, disclosure, and claim specificity requirements apply (**35 U.S.C. 101**, **102**, **103**, and **112**). The sole exception in terms of applicability of these statutory provisions is set forth in **35 U.S.C. 162**.

The prior art considered by the examiner is developed by a search of appropriate subclasses of the United States patent classification system as well as patent and nonpatent literature data bases. Where appropriate, a report may be obtained from the Agricultural Research Service, Horticultural Research Branch, Department of Agriculture. See **MPEP § 1609**.

1609 Report of Agricultural Research Service [R-11.2013]

35 U.S.C. 164 Assistance of Department of Agriculture.

The President may by Executive order direct the Secretary of Agriculture, in accordance with the requests of the Director, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Director officers and employees of the Department.

37 CFR 1.167 Examination.

Applications may be submitted by the Patent and Trademark Office to the Department of Agriculture for study and report.

The authority for submitting plant applications to the Department of Agriculture for report is given in:

> *Executive Order No. 5464, October 17, 1930. Facilitating the consideration of applications for plant patents.*
> I, Herbert Hoover, President of the United States of America, under the authority conferred upon me by act of May 23, 1930 (Public No. 245) [now **35 U.S.C. 164**], entitled "An act to provide for plant patents," and by virtue of all other powers vested in me relating thereto, do hereby direct the Secretary of Agriculture: (1) to furnish the Commissioner of Patents such available information of the Department of Agriculture, or (2) to conduct through the appropriate bureau or division of the department such research upon special problems, or (3) to detail to the Commissioner of Patents such officers and employees of the department, as the Commissioner may request for the purpose of carrying said act into effect.

Where the examiner considers it necessary to the examination of the plant patent application, a copy of the file and drawing of the application are

forwarded to the National Program Leader for Horticultural Crops, Agricultural Research Service (ARS), U.S. Department of Agriculture, along with a request for a report as to whether the plant variety disclosed is new and distinct over known plant varieties. As the report is merely advisory to the Office, it is placed in the file but is not given a paper number. The copy of the report is customarily utilized by the examiner in the preparation of his or her action on the application.

The report may embody criticisms and objections to the disclosure, may offer suggestions for correction of such, or the report may merely state that:

> "Examination of the specification submitted indicates that the variety described is not identical with others with which our specialists are familiar."

1610 The Action [R-08.2012]

The action on the application by the examiner will include all matters as provided for in other types of patent applications. See **37 CFR 1.161**.

With reference to the examination of the claim, the language must be such that it is directed to the "new and distinct variety of plant." This is important as under no circumstance should the claim be directed to a new variety of flower or fruit in contradistinction to the plant bearing the flower or the tree bearing the fruit. This is in spite of the fact that it is accepted and general botanical parlance to say "A variety of apple or a variety of blackberry" to mean a variety of apple tree or a variety of blackberry plant.

Where the application is otherwise allowable, a claim which recites, for example "A new variety of apple characterized by," may be amended by the insertion of - tree - after "apple" by an examiner's amendment.

By the same token, the title of the invention must relate to the entire plant and not to its flower or fruit, thus: Apple Tree, Rose Plant.

Care should also be exercised that the specification does not contain unwarranted advertising, for example, "the disclosed plant being grown in the XYZ Nurseries of Topeka, Kansas." It follows, also, that in the drawings any showing in the background of a plant, as a sign carrying the name of an individual, nursery, etc., is objectionable and deletion thereof is required. Nor should the specification include laudatory expressions, such as, "The rose is prettier than any other rose." Such expressions are wholly irrelevant. Where the fruit is described, statements in the specification as to the character and quality of products made from the fruit are not necessary and should be deleted.

The Office action may include so much of any report of the ARS as the examiner deems necessary, or may embody no part of it. In the event of an interview, the examiner, in his or her discretion, may show the entire report to the inventor or attorney.

Form Paragraph 16.12 may be used to reference portions of the ARS report.

¶ *16.12 Report From U.S. Dept. of Agriculture*

This application has been submitted to the U.S. Department of Agriculture for a report. Pertinent portions follow: **[1]**

The report of the ARS is not in the nature of a publication and matters raised therein within the personal knowledge of the specialists of the ARS are not sufficient basis for a rejection unless it is first ascertained by the examiner that the same can be supported by affidavits by said specialists (**37 CFR 1.104(d)(2)**). See *Ex parte Rosenberg*, 46 USPQ 393 (Bd. App. 1939).

Form Paragraphs 16.04 and 16.08, as appropriate, may be used to reject the claim.

¶ *16.04 Rejection, 35 U.S.C. 102*

The claim is rejected under **35 U.S.C. 102** as failing to patentably distinguish over **[1]**.

¶ *16.08 Rejection, 35 U.S.C. 112*

The claim is rejected under **35 U.S.C. 112[1]** because **[2]**.

1611 Issue [R-11.2013]

The preparation of a plant patent application for issue involves the same procedure as for other applications (**37 CFR 1.161**), with the exception that where there

are color drawings, the better one of the two judged, for example, by its sharpness or cleanliness is selected to be printed in the patent.

The International Patent Classification symbols, most recent edition, should be placed on the Issue Classification form of all plant patent applications being sent to issue.

All plant patent applications should contain an abstract when allowed.

1612 UPOV Convention [R-11.2013]

The International Convention for the Protection of New Varieties of Plants (generally known by its French acronym as "UPOV Convention") was adopted on December 2, 1961, by a Diplomatic Conference held in Paris.

The UPOV Convention has been revised on November 10, 1972, on October 23, 1978, and on March 19, 1991, in order to reflect technological developments in plant breeding and experience acquired with the application of the UPOV Convention. As of December 5, 2012, 71 states and organizations were party to the UPOV Convention.

MEMBERS OF THE INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS
International Convention for the Protection of New Varieties of Plants*
UPOV Convention (1961), as revised at Geneva (1972, 1978 and 1991)

Status on December 5, 2012 State/Organization	Latest Act[1] of the Convention to which State/Organization is party		**Status on December 5, 2012** State/Organization	Latest Act[1] of the Convention to which State/Organization is party
Albania	1991 Act		Lithuania	1991 Act
Argentina	1978 Act		Mexico	1978 Act
Australia	1991 Act		Morocco	1991 Act
Austria	1991 Act		Netherlands	1991 Act [5]
Azerbaijan	1991 Act		New Zealand	1978 Act
Belarus	1991 Act		Nicaragua	1978 Act
Belgium [2]	1961/1972 Act		Norway	1978 Act
Bolivia (Plurinational State of)	1978 Act		Oman	1991 Act
Brazil	1978 Act		Panama	1991 Act
Bulgaria	1991 Act		Paraguay	1978 Act
Canada	1978 Act		Peru	1991 Act
Chile	1978 Act		Poland	1991 Act
China	1978 Act [3]		Portugal	1978 Act
Colombia	1978 Act		Republic of Korea	1991 Act
Costa Rica	1991 Act		Republic of Moldova	1991 Act
Croatia	1991 Act		Romania	1991 Act
Czech Republic	1991 Act		Russian Federation	1991 Act
Denmark [4]	1991 Act		Serbia	1991 Act
Dominican Republic	1991 Act		Singapore	1991 Act
Ecuador	1978 Act		Slovakia	1991 Act
Estonia	1991 Act		Slovenia	1991 Act
European Union	1991 Act		South Africa	1978 Act
Finland	1991 Act		Spain	1991 Act
France	1991 Act		Sweden	1991 Act
Georgia	1991 Act		Switzerland	1991 Act
Germany	1991 Act		The former Yugoslav Republic of Macedonia	1991 Act
Hungary	1991 Act		Trinidad and Tobago	1978 Act
Iceland	1991 Act		Tunisia	1991 Act
Ireland	1991 Act		Turkey	1991 Act
Israel	1991 Act		Ukraine	1991 Act
Italy	1978 Act		United Kingdom	1991 Act
Japan	1991 Act		United States of America [6]	1991 Act
Jordan	1991 Act		Uruguay	1978 Act
Kenya	1978 Act		Uzbekistan	1991 Act
Kyrgyzstan	1991 Act		Viet Nam	1991 Act
Latvia	1991 Act			

* The International Union for the Protection of New Varieties of Plants (UPOV), established by the International Convention for the Protection of New Varieties of Plants, is an independent intergovernmental organization having legal personality. Pursuant to an agreement concluded between the World Intellectual Property Organization (WIPO) and UPOV, the Director General of WIPO is the Secretary-General of UPOV and WIPO provides administrative services to UPOV.

1 “1961/1972 Act” means the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as amended by the Additional Act of November 10, 1972; “1978 Act” means the Act of October 23, 1978, of the Convention; “1991 Act” means the Act of March 19, 1991, of the Convention.
2 With a notification under Article 34(2) of the 1978 Act.
3 With a declaration that the 1978 Act is not applicable to Hong Kong, China.
4 With a declaration that the Convention of 1961, the Additional Act of 1972, the 1978 Act and the 1991 Act are not applicable to Greenland and the Faroe Islands.
5 Ratification for the Kingdom in Europe.
6 With a reservation pursuant to Article 35(2) of the 1991 Act.

Most states adhere to either the 1978 text or the 1991 text. The United States adheres to the 1991 text, and has a reservation under Article 35(2) of the text (which allows plant patents rather than breeder's rights certificates to be granted).

The 1961, 1978, and 1991 texts guarantee to plant breeders in each member state both national treatment and the right of priority in all other member states. In many states, new plant varieties are protected by breeders' rights laws rather than patent laws. Accordingly, the Paris (Industrial Property) Convention cannot always be relied on to provide these and other rights.

Insofar as the patenting of asexually reproduced plants in the United States is concerned, both national treatment and the right of priority have been accorded to foreign plant breeders since enactment of the plant patent law in 1930 (now **35 U.S.C. 161**-**164**). See **MPEP § 1613** for the right of priority based upon an application for plant breeder's rights.

Application of the UPOV Convention in the United States does not affect the examination of plant patent applications, except in one instance. It is now necessary as a condition for receiving a plant patent to register a variety denomination for that plant. Inclusion of the variety denomination in the patent comprises its registration. The registration process in general terms consists of inclusion of a proposed variety denomination in the plant patent application. The examiner must evaluate the proposed denomination in light of UPOV Convention, Article 13. Basically, this Article requires that the proposed variety denomination not be identical with or confusingly similar to other names utilized in the United States or other UPOV member countries for the same or a closely related species. In addition, the proposed denomination must not mislead the average consumer as to the characteristics, value, or identity of the patented plant. Ordinarily, the denomination proposed for registration in the United States must be the same as the denomination registered in another member state of UPOV.

Pursuant to **37 CFR 1.76(b)(3)**, the Latin name and the variety denomination for the plant claimed may be included in an application data sheet (ADS). The Office, pursuant to the UPOV Convention, has been asked to compile a database of the plants patented and the database must include the Latin name and the variety denomination of each patented plant. Having this information in an ADS will make the process of compiling this database more efficient.

Form Paragraph 16.05 may be used to object to the disclosure as lacking a common or market name or "denomination" of the plant.

¶ *16.05 Name or Denomination for Plant Missing*

The disclosure is objected to under **37 CFR 1.121(e)** because no "variety denomination" of the instant plant has been set forth in the disclosure. **37 CFR 1.163(c)(4)**. Correction by adding such a name is required.

¶ *16.05.01 Latin Name of Genus and Species of the Plant Claimed Missing*

The disclosure is objected to under **37 CFR 1.121(e)** because the Latin name of the genus and species of the instant plant has not been set forth in the disclosure. **37 CFR 1.163(c)(4)**. Correction by adding such a name is required.

1613 Right of Priority Based upon Application for Plant Breeder's Rights [R-08.2012]

Pursuant to **35 U.S.C. 119(f)**, an application for a plant patent may rely upon an application for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) for priority under **35 U.S.C. 119(a)** through (c).