

## An Update on Trademarks and Cultivar Names

**Richard H. Munson**

The Botanic Garden of Smith College, Northampton, Massachusetts 01063

When I last spoke to this group in December 1988 my purpose was to bring to your attention a situation which was just beginning to become a problem (Munson, 1989). I wish that I was able to report to you that the problem had been solved or even lessened. However, the opposite appears to be the case. My goal in presenting this paper is to update you on the continuing problem and to inform you of some communication from the Office of Patents and Trademarks regarding the trademark issue and what it may mean to our industry.

The issuance of plant patents to clones with trademarked fancy names and nonsensical cultivar names continues without apparent abatement. During the past three years I have encountered numerous examples of this practice in our trade publications, nursery catalogs, and popular horticultural magazines. It is important to understand the basic rationale for assigning a nonsensical cultivar name to a patented clone while at the same time obtaining a "fancy" trademarked name. The underlying fact is that clones are sold on the basis of a single name with which the horticultural public has become accustomed. If somehow that one well-known name can be monopolized the name owner can effectively control the sales of that particular clone. As you know, plant patents are in force for 17 years, the same as for any patent. Since breeder's rights or patent owner's rights are protected during the period the patent is in force, the situation really becomes a problem at or near the time the patent expires. Let me give you an example of a common scenario. The plant illustrated is intended to be fictitious. An apple tree clone has been patented with the cultivar name Cinnamon Spice listed as the name of the clone on the patent. Nearly seventeen years later, the original patent owner, realizing that he is about to lose his exclusive production of the highly successful cultivar Cinnamon Spice, applies for a trademark for the name 'Cinnamon Spice', and gives, as the cultivar name for the clone, the unpleasant name 'Bulhaw' (a code name combining the originator's initials with those of his partner). Upon expiration of the patent, other nurseries are able to propagate and sell the clone without paying royalties. However, they are unable to sell the plant by its widely known fancy name Cinnamon Spice, which is now the sole property of the trademark owner. They are quite unlikely to be able to sell the clone under its "new" cultivar name, 'Bulhaw', either. At this point the only real option left is to give another name to this clone, whether trademarked or not, and hope that a demand can be created for this "new" cultivar. The end result is not desirable.

Another variation on this theme is that a licensed grower of a patented clone obtains a trademark on the cultivar name and gives a new cultivar name for the clone on the trademark application. This is sometimes done without the knowledge or permission of the patent owner. Instead of the clone with a well-known name passing to the public domain, it is now essentially the private property of the trademark owner. How can this happen? What has happened to the system of cultivar registration? Can anything be done to stop these practices?

As Chairman of the Plant Nomenclature and Registration Committee of the American Association of Botanical Gardens and Arboreta it fell to me to attempt to

obtain some clarification of the practices of the Patent and Trademark Office of the U.S. Department of Commerce with regard to trademarks for plant names. Past attempts by myself and others had not been successful. This time, however, I was successful in receiving a reply which shed some light, and some ambiguity, on the practices of the Patent and Trademark Office (PTO).

My original letter gave several examples of the problem of which my committee was aware. The letter also explained the system of cultivar registration set forth by the International Code of Nomenclature for Cultivated Plants. Although the Cultivated Code was effective in the proper naming of cultivars in the past, it is now essentially passe since it has no force of law. Indeed, one of the main problems with our system of naming cultivars is that registering a name with a National or International Registration Authority is totally voluntary. Many nurseries simply ignore or bypass the registration process in favor of trademarking.

What follows is a summary and paraphrasing of the reply as they relate to specific questions. *What about the confusion of consumers who may not be aware that the same plant may exist in the trade under two or more names as a result of the trademarking of a well-known cultivar name and the subsequent re-naming of the clone by other growers?* The laws pertaining to registration and protection of trademarks are not intended to allow deliberate confusion for consumers. However, the PTO is not charged with the responsibility to seek out and eradicate trade practices that might result in consumers making purchasing decisions without the full understanding of what is available to them in the marketplace. Only if a new proposed trademark is too similar to an existing mark would it likely be denied. "It is neither the right nor the responsibility of the PTO to educate consumers that identical plants may be available under two different trademarks. Similarly, in the situation where the new producer of a formerly-patented plant utilizes the cultivar name for that plant, it is neither the right nor the responsibility of the PTO to educate consumers that a plant designated by a relatively unknown cultivar name is identical to a plant sold under a well-known trademark." In both cases, although consumers may not be buying formerly-patented plants with the full knowledge of the situation they are not being "confused" in any way which the PTO has the power to prevent (Samuels, 1990)

*What about the "extension" of patent monopolies by the use of trademarks?* "It has long been a theoretical underpinning of trademark law, and a judicially recognized principle, that the trademark laws should not be used to extend the limited monopolies granted by the patent laws." However definitive this statement sounds, the situation is tempered, and perhaps confused, by the question of whether or not "a formerly patented product has become generic, as used by the public.....", and, if so, "then the trademark laws will not preclude generic use or fair use of the designation" (Samuels, 1990). Aspirin is used as an example of a formerly trademarked pain reliever with a little used chemical name. Since the public never became familiar with the chemical name the trademarked name became, by common usage, generic. The same phenomenon may occur in the cultivar plant trade which *may* allow new propagators of a formerly patented plant the right to use a name originally adopted as a trademark. However, one must weigh the cost of likely court challenges compared to the cost of a normal licensing agreement with the trademark holder. "You may consider this scenario to constitute extension of the patent holder's monopoly, but it cannot be viewed as a government authorized

extension or even one that the government ought to prevent. The mechanisms of the marketplace determine whether a term continues to function as a mark or whether it has become generic (Samuels, 1990).” The burden of showing that a mark has become generic falls to the prospective new user, which also implies financial risk.

*Why not require patent applicants to use cultivar names which meet the requirements of the Cultivated Code?* (This would at least prevent the use of a “fancy” trademark and a nonsensical cultivar name.) This recommended amelioration of the problem may not be possible, not only because the Cultivated Code has no force of law, but also because, according to the PTO, “commercial consequences caused by the use or lack of use of a variety denomination in the market place cannot, and should not, be addressed by the patent system (Samuels, 1990).” In addition, Article 13 of the International Convention for the Protection of New Varieties of Plants (UPOV) does not require that cultivar names be in a modern language, but only that the designations not mislead or cause confusion concerning characteristics. The Cultivated Code approach seems to be possible if, and only if, there is complete voluntary adherence by all involved. This scenario is unlikely to be even a remote possibility.

*Can anything be done to prevent the trademarking of cultivar names which have long-standing use in the trade?* According to the PTO, whenever anyone makes application for a trademark designation for a plant the current policies of the Trademark Examining Operation (TMEO) require the examining attorney to consult with the USDA to determine if the designation sought has been registered or used as a cultivar before. If it is found to be so used, then registration of the mark will be refused. Likewise, the USDA may check with the PTO to determine if a proposed cultivar name has been previously registered as a trademark. This cross-cooperation has resulted in the denial of trademark applications when it was shown that the name already existed as a cultivar name. It is obvious, however, that this system can work only if the USDA has access to complete and up-to-date records. Unfortunately, these do not exist. It would take the establishment of a national database to enable this system to work effectively. One of the barriers to effective control of registration of improper trademarks is the limited means available to both the PTO and the USDA to monitor all trademark applications.

*Can blanket trademarks be prevented?* The PTO cannot arbitrarily decide to deny trademark applications that meet all legal requirements even if the mark is likely to be used as a “blanket” trademark, i.e., a single name that applies to plants in various genera. They do, however, promise to continue to strictly apply trademarking rules in accordance with existing regulations.

**Conclusion.** It appears that the trademarking of “fancy” names will continue. However, the trademarking of cultivar names of formerly patented clones may be prevented by proving that the cultivar names have become generic as a result of usage. This does, nevertheless, imply certain financial and legal risk which may cost more than normal licensing agreements. The only other “solution” may be legislative.

## LITERATURE CITED

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