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Why a Rose by Another Name Smells Sweeter

The Often Overlooked Intersection between Plant Patent and Trademark

William Shakespeare's Juliet famously bemoaned, "What's in a name? That which we call a rose by any other name would smell as sweet…" Little did Shakespeare know that his words would carry an important reminder about the intersection of United States Patent and Trademark law.

It is vitally important that the owner of a patent for a plant variety select and use a name in her patent application that is different from the brand name under which she intends to market and sell the plant in question. Doing so ensures that she can continue to profit from her invention long after the patent expires.

> The scientific name of plant variety must be different from the trademark under which it is sold…

A patent protects machines or processes that are novel, non-obvious, and useful. One who obtains a patent has the exclusive right to make, use, or sell the machine or process in question for a period of 20 years. After the 20-year period expires, the invention goes into the public domain and can be made, used, or sold by anyone. Important here, new varieties of plant are eligible for patent protection.

Trademark, on the other hand, protects distinctive marks that are used to identify goods or services. The most common examples of trademark are business names and logos. The owner of a trademark has the exclusive right to use the mark in her trade. Different from patent, trademark protection can last forever, if properly preserved. Trademark protection, however, is subject to forfeiture if the mark becomes generic. Important here, trademark may be used to protect the name under which a plant variety is sold.

When completing a plant patent application, the owner will be called upon to give a name to her plant variety. Suppose that a hypothetical patent owner has discovered a new variety of roses. It is tempting to list the same name on the patent application under which she intends to market the rose variety.

However, a careful look at the function of patents reveals problems with this approach. Plant patent will protect a variety of roses that did not exist before. As a result, the name given to the variety on the patent application will forever be its scientific or generic name.

Once the plant patent is issued, the owner will have 20 years in which she is the only person who can make, use, or sell the rose variety. This provides her with monopoly rights over the rose variety. But, after those 20 years have expired, anyone can make, use, or sell her rose variety because it enters the public domain.

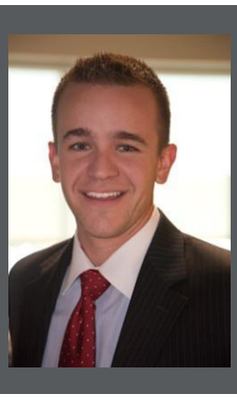
A wise patent owner will acquire a federally registered trademark for the distinctive name under which she sells her rose variety. By doing so she will build a valuable brand associated with her rose variety. Consumers will associate the sought-after rose variety with the trademark. Further, the owner will be able to exclude competitors from selling roses under the same or a confusingly similar mark.

Recall, though, that once the 20-year term of the patent has expired, the rose variety goes into the public domain. If the owner uses the same name on her patent application as is used to sell her roses (*i.e.*, her trademark), then the trademark instantly becomes generic upon the expiration of the patent because it is the scientific or generic name for the rose variety. Thereafter, the owner has neither the patent nor the trademark rights associated with her rose variety.

However, if the owner was savvy enough to use one name on her patent application and a different name to sell her roses, then she will maintain her trademark rights even after the patent has expired. Accordingly, she will be able to continue on having the exclusive right to sell roses under the mark that consumers have come to associate with the rose variety. She will remain the name brand seller of the rose variety long after her patent expires.

Intellectual property has the function of preserving reasons for consumers to choose one seller over another, thereby preserving financial benefit to the owner. Careful selection of one scientific name for the plant variety on a patent application and a different name for the trademark under which the rose variety will be sold will infinitely extend that financial benefit.

To answer Shakespeare's Juliet: it's *all* in the name. The scientific name of a plant patent must be different from the trademark under which it is sold if the owner desires to have continued protection in the plant variety after the patent expires.



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