

**UNITED STATES DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
Address: Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

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Patent Under Examination: PP05751  
Examiner: Locker, H  
Art Unit: 1661  
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**NOTICE OF INTENT TO ISSUE REEXAMINATION CERTIFICATE**

**[ \* \* \* ]**

**STATEMENT OF REASONS FOR PATENTABILITY  
AND/OR CONFIRMATION**

**The following is an examiner's statement of reasons for patentability and/or confirmation of the claim found patentable in this reexamination proceeding:**

Upon careful consideration, the "Da Vine" patent claim (to the plant as described and illustrated) is patentable over the plants of Exhibits 1 and 2, as neither of same, when taken alone or in any combination, render prima facie obvious or anticipate the claim to the plant as described and illustrated in United State Plant Patent Number 5,307 [sic] to Miller (hereafter 'Da Vine').

Evaluation of Martin & Plowman 1805 was performed by the examiner based upon the plant as described and illustrated in requester's Exhibit 1, Exhibit 2, the Gates Monograph, and the life size Kittredge photocopy, with evaluation of 'Da Vine' being based upon the entirety of the disclosure of United States Plant Patent Number 5,571 and the dried specimen of 'Da Vine' sent to the examiner from Karen Shigamatsu at the Lyon Arboretum, University of Hawaii.

Based on this side-by-side evaluation, several distinctions between the respective plants became apparent. For example, there are characteristic distinctions in

leaf side and shape between the respective plants, with the foliage of ‘Da Vine’ having a comparably greater length to width ratio, while being slimmer and smaller in overall size, and the adult foliage having a more acuminate tip than Martin & Plowman 1805.

Patent Owner’s continuing arguments relative to distinctiveness in flower color remain unpersuasive in and of themselves, but for the record, it is acknowledged that the specific color designations referenced in United States Plant Patent 5,751 to ‘Da Vine’ are not set forth or otherwise specifically disclosed anywhere as being characteristic for Martin & Plowman 1805 or any other *Banisteriopsis caapi* plant per se.

‘Da Vine’ was discovered by the patent Owner growing in a cultivated area (i.e. a domestic garden, column 1, lines 16-17 of United States Plant Patent Number 5,751), and as such is statutorily eligible for protection under the United States Plant Patent Act (Ex Parte Moore 115 USPQ 145). There are two steps of inventorship in a Plant Patent, the breeding or discovery of the plant (such discovery must be in a cultivated area and includes the recognition and appreciation of the distinctive and novel characteristics of the plant (Nicholson v. Bailey 125 USPQ 157), and successful asexual reproduction (In re Kluis 70 USPQ 165). The patent file clearly indicates that both of these requisite steps have been accomplished by the patent owner. The record in the patent file does not support requesters’ allegation that ‘Da Vine’ is a “wild plant” and thus statutorily ineligible for Plant Patent Protection under 35 U.S.C. 161. Indeed, the record supports just the opposite.

35 U.S.C. 161 states:

**“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 therefore, subject to the conditions and requirements of this title.**

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

35 U.S.C. 163 states:

**“In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.”**

The statement in the ‘Da Vine’ patent that “this plant was discovered growing in a domestic garden in the Amazon rain-forest of South America,” and the requisite

declaration by the inventor, Loren Miller as set forth in United States Plant Patent application Serial Number 06/669745, dated May 12, 1981 are clear and unambiguous, and satisfy all statutory requirements including those relative to origin of the plant, stability of the plant, and asexual reproduction of the same.

Per 35 U.S.C. 163, the granting of United States Plant Patent Number 5,751 gives the inventor the right to exclude others from asexually reproducing the *Banisteriopsis caapi* cultivar named 'Da Vine,' or selling or using the plant so reproduced. The scope of the protection granted is limited to this single cultivar (the original plant and its asexually reproduced progeny) from within the many cultivars making up *Banisteriopsis caapi*, and does not extend to other cultivars within the species whether found in the wild or in a cultivated state, or even to use of 'Da Vine' itself as a parent in a controlled traditional breeding or induced mutation breeding program.

Given that the statutory requirements were met relative to origin of the plant having been in a cultivated area, the granting of United States Plant Patent Number 5,751 to 'Da Vine' was based upon the written description of the plant and the submitted photographic illustrations of the plant. That is, each and every botanical characteristic of the plant specifically described in the written description and/or illustrated in the submitted photographic illustrations was in combination considered in the ultimate determination of patentability of the plant. The claim in a United States Plant Patent is among the very narrowest in scope granted by the United States Patent and Trademark Office, as it is specific to a single plant and its identical asexually reproduced progeny. If the plant cannot be reliably produced by asexual means, it fails under the requirement for stability under 35 U.S.C. 161.

So long as there is at least one botanical characteristic of the plant which is distinguishing, or if the combination of characteristics are per se distinguishing, and so long as the plant is stable relative to expression of this and all other characteristics described and illustrated through asexual reproduction, the grant of Plant Patent protection under 35 U.S.C. 161 is proper.

Considerations such as therapeutic and/or medicinal properties of the plant were properly present as part of the original written description of the plant (37 CFR 1.163(a)) as providing as complete a disclosure as possible of the plant, but were given limited weight in the determination of the patentability of the plant as such were largely prospective in nature as evidenced in column 1 of the 'Da Vine' Patent, and did not define over the species per se in any event. Whether such were specifically referenced or not would be of little moment as regards the scope of protection offered by the granting of the 'Da Vine' patent as 'Da Vine' is 'Da Vine,' it is not more and it is not less that the originally found plant and its genotypically identical asexually reproduced progeny.

Relative to Exhibits 1 and 2 (and supporting Exhibit 18), the requester has alleged that such show that 'Da Vine' was known and used by others prior to Miller's invention. The leap from the fact that plants within the species were known to exist in the United States prior to the filing date of the 'Da Vine' patent to such demonstrating that 'Da Vine' was known or used by others in this country long before Miller's "invention of the purported new cultivar" (requester at page 5) has been found to lack foundation as Plowman & Martin 1805 is not the same plant as 'Da Vine'. The sole botanical feature specifically referenced in Exhibits 1 and 2 is flower coloration which is alleged by requester to be "similar or identical" to that of 'Da Vine'. There is no evidence to indicate, let alone prove that Exhibits 1 and 2 are directed to the *Banisteriopsis caapi* plant named 'Da Vine,' or even that the flower coloration (the single morphological characteristic referenced) under consideration is identical. Indeed, the Gates Monograph, as referenced previously, provides evidence to the contrary. No factual supporting data, such as a comparison of the plants when grown in a side-by-side or equivalent relationship has been made brought forth [sic] by the requester to substantiate this allegation.

From the botanical characteristics which can be observed from the black and white photocopies of which Exhibits 1 and 2 consist, there would appear to be characteristic differences in leaf size and shape (for example, the foliage of 'Da Vine' looks to have a greater length to width ratio, being slimmer and overall smaller, and a more acuminate tip than the foliage illustrated in Exhibits 1 and 2). Exhibit 18 provides specific evidence that plants of *Banisteriopsis caapi* are grown in a cultivated state in South America, rather than just being found naturally in the wild (see item 6 on page 2 thereof).

That specimens within the species *Banisteriopsis caapi* were per se known in the United States prior to the effective filing date of 'Da Vine' is acknowledged for the record, but is of little moment relative to the ultimate patentability of 'Da Vine' as it has not been established on the record that the plant(s) of Exhibits 1 and 2 are anything but generally similar to 'Da Vine'. Such similarity would be reasonably expected given the identical taxonomic classification of these plants and in fact is borne out by some of requesters' other Exhibits of record which discuss the botanical characteristics of the species (for example, Exhibits 17 and 20). Exhibits 1 – 2 do not anticipate, render obvious, or otherwise adversely impact the patentability of 'Da Vine' as they show, at best, that the species was per se known in this country prior to effective filing date of 'Da Vine' (this was a consideration not explicitly addressed or considered per the written record in the 'Da Vine' Plant Patent file).

The scope of protection awarded in a United States Plant Patent in general (and to 'Da Vine' in particular) is to the single germplasm (that is, the single and particular

plant within the species) as therein described and illustrated (Jessel, Duffet & Mix v. Newland, Jessel and Duffet 193 USPQ 678, and Yoder Brothers Inc. v. California – Florida Plant Corp 193 USPQ 264) and its asexually reproduced progeny. Stability by asexual propagation is a prerequisite to the plant being statutorily eligible for protection under 35 U.S.C. 161 (Yoder Brothers 193 USPQ 293).

The scope of protection per United States Plant Patent 5,751 does not extend to encompass or cover a range of plants having similar characteristics such as deep pink blooms which fade to white with age as seemingly thought/alleged by requester, and indeed is specific only to the single germplasm as described and illustrated (Imazio Nursery Inc. v. Dania Greenhouses 69F.3d 1567, 36 USPQ 2.d 1673, 1678). That is, patent owner does not control the rights over an entire species, but only a singly, specific and unique plant within same.

The plants disclosed and discussed in Exhibits 1 and 2 cannot be factually shown to be directed to the same plant as ‘Da Vine.’ Indeed, flower color is not alleged by requester to be identical (attempts are made, for example in Exhibit 17, to explain away the noted color difference, and no other morphological characteristics are meaningfully compared or brought forth at all).

**Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: “Comments on Statement of Reasons for Patentability and/or Confirmation” and will be placed in the reexamination file.**

Any inquiry concerning this communication from the examiner should be directed to Howard J. Locker whose telephone number is (703) 308-2924. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Mr. Bruce Campbell, can be reached at (703) 308-4205.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Howard J. Locker/hjl

January 25, 2001

[signatures]