

How to graft trees legally

The patents of some popular apple varieties have expired, but trademarks last forever.

BY GERALDINE WARNER

Growers who graft over or propagate trees using bud wood from patented trees in their own orchards need to obtain a propagation license from a nursery that holds the license for the variety, says Rex Stratton, attorney and partner with the Nursery Licensing Association (NLA).

Stratton said the nursery will probably charge the royalty, which goes to the patent owner, and a propagation fee because the nursery has lost the ability to sell the grower new trees. How much the fees will be is a matter that the grower and the nursery need to work out. Certain varieties will have more value than others.

"It's a willing buyer and willing seller market," he said.

The only time the NLA becomes involved is if there has been past infringement, Stratton said. The NLA simply enforces plant patent rights, but is not involved in negotiating licenses for future business.

"If they don't have a license and they infringed, it will become NLA business. If they're proactive and license their trees in the beginning, then the NLA is not involved."

Call the nursery

Jack Snyder at C&O Nursery, Wenatchee, said if a grower wants to propagate a variety, he or she can call any nursery that features the variety in their catalog. In some cases, nurseries are the patent owners, but in others, they are just licensees.

C&O typically charges the patent fee, which is passed on to the patent holder, plus an enabling fee of a similar amount that is designed to compensate the nursery for the loss of the sale.

For example, if a grower wants to graft trees to September Wonder, an early Fuji variety owned by Broetje Orchards, the grower typically would have to pay a royalty of \$1, which goes to Broetje, and another \$1 to C&O, which holds the propagation license. The fee might vary with the number of trees to be propagated, Snyder said, and it all has to be agreed between the parties involved.

Snyder said some growers have been contacting nurseries before grafting or budding trees. In some cases, nurseries have supplied them with certified virus-free bud wood. Growers can use bud wood from their own orchards, but they still need permission from the nursery and must pay the royalty and enabling fee.

In the past, growers have been more likely to contact the nursery when grafting trees to a new variety than when budding trees, he said. Grafting is done in the late dormant

period, when nurseries are the best source of bud wood. Budding is done in the summer, when bud wood is widely available.

Snyder said it is to everyone's benefit when growers communicate with the nurseries and let them know what their plans are. He said nurseries want to do what's right for their customers.

Growers don't need to pay fees when grafting or propagating unpatented varieties. Patent rights expire 20 years after the application date.

Some of the older Red Delicious strains, such as Top Red, Red Spur, New Red Spur, Top Spur, Red Chief, and Scarlet Spur Red Delicious are no longer patented. The patent has also expired on the Royal Gala (Tenroy cultivar).

Trademarks

However, trademarks do not expire. An orchardist can grow those varieties but would be infringing the trademark by referring to the trees or selling the fruit by those names.

Similarly, Improved Golden Delicious (Gibson cultivar) is no longer patented, but the Smoothee name is trademarked, so the fruit should be referred to as Improved Golden Delicious.

The original B.C. and Nagafu strains of Fuji are not patented and are therefore not subject to royalties. They have been largely replaced by newer, patented, high-coloring strains, but would still work well in areas with good coloring conditions, Snyder said.

There are unpatented strains of Bosc pears, though the more desirable russeted strains are patented, and many unpatented strains of peaches are available.

Nursery catalogs usually indicate if varieties are patented. For more information on specific plant patents, check the U.S. Patent and Trademark Office's searchable Web site at www.uspto.gov/main/patents.htm.