TIMELY SUBMISSION OF U.S. PLANT PATENT APPLICATIONS CONTINUES TO BE OF PRIME IMPORTANCE

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Interest in this topic has revived following recent changes in the U.S. Patent law (America Invents Act) that will become effective on March 16, 2013.[1]

We are reminded that standard UPOV novelty provisions **have never been** a part of the U.S. Plant Patent Law (35 U.S.C. §161 to 164). Such typical UPOV provisions provide that a plant (a) must not have been offered for sale or marketed with the agreement of the breeder longer than one (1) year in the country where rights are being sought, or (b) in any other country longer than six (6) years for a tree or vine, or longer than four (4) years for any other plant.

Presented hereafter is our understanding of the current U.S. law and what is believed at this time to be a reasonable application of the new law that is scheduled to become effective on March 16, 2013.

Currently, any of the following events are capable of creating a novelty bar to patentability in the United States under 35 U.S.C. §102(b):

(1) Described in a **printed publication anywhere** more than one year prior to submitting the Application in the U.S. Generally stated, this must be an "enabling" publication that could place the plant in the hands of the reader combined with his or her knowledge of plant science.

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[1] The America Invents Act has different effective dates for different provisions. This paper focuses on provisions with a March 16, 2013 effective date.

(2) **Use** of the plant **in the U.S.** more than one year prior to the U.S. Application. Generally stated, testing/experimental use by the Applicant is not a bar to patentability.

(3) **On sale to the public in the U.S.** more than one (1) year prior to the U.S. Application. "On sale" includes offers for sale as well as actual sales.

In recent years, U.S. Plant Patent Examiners, to the dismay of many, on their own initiative, have taken the view that for a plant invention, a **special application** of Title 35 U.S.C. §102(b) should be used. This view appears to be contrary to the express language of 35 U.S.C. §161, which states that the "provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided." Accordingly, it currently is being reasoned with few exceptions and contrary to decades of practice to the contrary, that novelty can be defeated for plant inventions if there is a **"non-enabling" publication** anywhere which identifies the plant more than one year prior to the U.S. Application, **combined with** plant **availability to the public** outside the U.S. more than one year prior to the submission of the Application in the U.S. Plant availability, in a foreign country, currently is being reasoned by U.S. Examiners to "enable" an otherwise "non-enabled" publication. Two events which each fail to defeat novelty pursuant to the language of the law **in combination** are being currently viewed by Examiners to have a novelty-defeating impact. This issue presently is removed in the eyes of U.S. Examiners by filing a U.S. Plant Patent Application on an effective date that is before **both** of the above-identified events have taken place.

When a U.S. Plant Patent Application is submitted **within one year** of the filing of a Plant Breeders Rights Application in a WTO member country (or a foreign UPOV

Contracting Party), the U.S. Applicant has the option to claim priority for the earlier PBR filing under 35 U.S.C. §119(f). Under such circumstance, the earlier PBR filing date is considered to create a same **"effective filing date"** in the U.S., and any potential novelty-defeating dates are compared to this date.

We turn now to the **new U.S. legislation** that will become effective on March 16, 2013. **In this new legislation, the novelty-defeating bars to patentability are expressed somewhat differently, but the net impact need not be more severe than the recent application of 35 U.S.C. §102(b).**

For a U.S. Plant Patent Application having an **effective filing date of March 16, 2013 or later**, any of the following events are understood to create a bar to patentability **subject to an important exception identified later**:

1. Plant is described in a **printed publication prior to the effective filing date** anywhere in the world.
2. Plant is in **public use (non-experimental use) prior to the effective filing date** anywhere in the world.
3. Plant is **on sale prior to the effective filing date** anywhere in the world.
4. Plant is **otherwise available to the public prior to the effective filing date** anywhere in the world.

However, if any of 1, 2, 3 or 4 **occur less than one year** prior to the effective filing date and are attributed to the **conduct of the breeder/inventor or by another who obtained the plant directly or indirectly from the breeder/inventor, such conduct does not count to create a bar to patentability.** Needless to say, this is good news.

It further is important to note the lack of a **geographic limitation** in any of 1, 2, 3 or 4. This is a substantive change from the current law.

The genetics of plant breeding is sufficiently complex that the same new plant is **not** created by different breeders operating independently. Until plant science reaches this point, it is extremely unlikely that the conduct **of others** can be found to constitute a bar to the patentability of a proposed new variety.

Accordingly, **a one-year grace period can be found to persist for practical purposes**. It is anticipated that plant breeders/inventors operating outside the U.S. will continue to seek PBR within one year of commercialization in a country abroad, and to thereafter seek U.S. Plant Patent protection **within one year of the filing** of such PBR Application. It will be important at the time of submission of the U.S. Application to indicate a **priority claim** for the earlier PBR filing under 35 U.S.C. §119(f). This claim is further perfected by the timely submission to U.S. authorities of a certified copy of the earlier PBR papers. Such certified copy is prepared by the governmental authority where the PBR application was initially filed. Under such circumstance, the effective filing date of the U.S. Plant Patent Application will be considered to be **that of the earlier PBR Application**. Any potential bar to patentability created by the conduct of the breeder/inventor within one year of the initial PBR filing should be obviated in view of the sufficiently early effective filing date that is accorded the U.S. Plant Patent Application.

So long as the PBR Application was filed **within one year** of commercialization abroad, it should be possible to submit a Plant Patent Application in the U.S. **more than one year after the commercialization date** so long as the Application is filed in the

U.S. **within one year** of the initial PBR filing. Example: Breeder/inventor commercializes in France on April 1, 2013 (with or without a printed publication), files a PBR Application in France on March 1, 2014, and files a U.S. Plant Patent Application on February 1, 2015 while claiming priority for March 1, 2014 PBR filing.

The net result is that foreign plant breeders/inventors continue to be provided some additional time to submit a U.S. Plant Patent Application provided a claim is timely perfected for taking advantage of an earlier PBR filing date.

Comments and inquiries are welcome.