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**ADMINISTRATIVE AND LEGAL COMMITTEE**

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**RECENT CHANGES IN THE PRACTICE OF THE  
U.S. PATENT AND TRADEMARK OFFICE RELEVANT TO PLANT VARIETIES**

*Document prepared by the Office of the Union*

1. Towards the end of October 2000, the Office of the Union was informed by private circles that the United States Patent and Trademark Office (USPTO) had recently changed their interpretation and application of the United States Patent Law with regard to plant patents.
2. At a request, made by the Office of the Union, the USPTO provided the following information:

**“ADVICE TO BREEDERS SEEKING A US PLANT PATENT**

“In the USA, plant variety protection for vegetatively-propagated varieties is provided through the plant patent system operated by the US Patent & Trademark Office (USPTO). The USPTO has recently interpreted and applied US patent law in a manner different from that done until now. The USPTO is now regarding a prior foreign grant of plant variety protection to be equivalent to a grant of a patent for purposes of determining whether a plant variety, for which a plant patent has been applied, meets the statutory novelty requirements. Specifically, US patent law provides in Section 102(d) of title 35, United States Code, that a person shall be entitled to a patent unless –

“the invention was first patented or caused to be patented ... by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent ... filed

more than twelve months before the filing of the application in the United States ...”

“The recent change in interpretation of the patent laws by the USPTO will be tested by appeal in the near future. However, until the correctness of this interpretation is finally established, it would seem prudent to guard against rejection of a US application on a plant variety, regardless whether it is for a plant patent or a utility patent, by filing the US application no later than 12 months after the filing of the application for a plant variety right.”

3. The change in practice of the USPTO caused considerable problems for those applicants who were holders of a plant variety protection title granted by the authorities of Contracting Parties to the International Convention for the Protection of New Varieties (UPOV) other than the United States of America and who had, until now, based themselves on the (wrong) assumption that the United States of America being party to the Convention was bound by Article 6(1) of the 1991 Act of the UPOV Convention, which states:

“The variety shall be deemed to be new if, at the date of filing of the application for a breeder’s right propagating or harvested material of the variety has not been sold or otherwise disposed of to others by or with the consent of the breeder for purposes of exploitation of the variety

“(i) in the territory of the Contracting Party in which the application has been filed earlier than one year before that date and

“(ii) in a territory other than that of the Contracting Party in which the application has been filed earlier than four years or, in the case of trees or of vines, earlier than six years before the said date.”

4. It has to be kept in mind, however, that Article 35(2) states as follows:

“(a) Notwithstanding the provisions of Article 3(1), any State which, at the time of becoming party to this Convention, is a party to the Act of 1978 and which, as far as varieties reproduced asexually are concerned, provides for protection by an industrial property title other than a breeder’s right shall have the right to continue to do so without applying this Convention to those varieties.

“(b) Any State making use of the said right shall, at the time of depositing its instrument of ratification, acceptance, approval or accession, as the case may be, notify the Secretary-General accordingly. The same State may, at any time, withdraw the said notification.”

5. The President of the United States of America has notified the Union of the respective reservation in its instrument of ratification on November 20, 1998, by stating: “Protection for Asexually Reproduced Varieties--Pursuant to Article 35(2), the United States of America will continue to provide protection for asexually reproduced varieties by an industrial property title other than a breeder’s right and will not therefore apply the terms of this Convention to those varieties.”

6. Regardless of the fact that a period of grace for novelty as provided for by Article 6(1) of the 1991 Act of the UPOV Convention is not applicable for plant patent applications under the U.S. Patent Law, there are two major problems:

(a) The sudden change to a long-standing practice of the U.S. Patent and Trademark Office causes uncertainty among those applicants being holders of a breeder's right granted by another Contracting Party and wishing to make use of a period of grace after having experienced some market success of their variety before applying for a plant patent for the same variety in the United States of America.

(b) A continuation of the recently introduced practice of the USPTO might lead to the presence of a large number of unprotected varieties on the U.S. market for asexually reproduced varieties. Experience from comparable situations (appearance of unprotected varieties on a market where protected varieties used to play a dominant role) shows that this might cause substantial distortions.

7. More recent information received indicates, however, that the USPTO has reversed the position taken in October 2000 with regard to Section 102(d) of the U.S. Patent Law. The following information was issued by the USPTO on January 22, 2001:

**“Inapplicability of 35 U.S.C. § 102(d) to Plant Breeder’s Rights Certificates**

[...]

“After review of the legislative history of 35 U.S.C. § 119(f) as amended by the American Inventor’s Protection Act of 1999 (AIPA) (Title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948) as introduced in the 106<sup>th</sup> Congress on November 17, 1999), the USPTO has determined that a rejection under 35 U.S.C. § 102(d) based on a PBR certificate is not appropriate. While section 4802 of the AIPA added plant breeder’s rights as a basis for a foreign priority claim under 35 U.S.C. § 119(f), there was no corresponding change to 35 U.S.C. § 102(d). The legislative history accompanying the AIPA makes it clear that “Section 4802 also adds subsection (f) to section 119 of the Patent Act to provide for the right of priority in the United States on the basis of an application for a plant breeder’s right first filed in a WTO member country or in a UPOV Contracting Party.... Because section 119 presently addresses only patents and inventors’ certificates, applicants from these countries are technically unable to base a priority claim on a foreign application for a plant breeder’s right when seeking plant patent or utility patent protection for a plant variety in this country.” (*Congressional Record*, S. 14723 (Nov. 17, 1999)). This legislative history supports the position that absent a clear statutory basis, rejections under 35 U.S.C. § 102(d) based on PBR certificates are not appropriate. Moreover, unlike the changes made in Public Law 92-358 (July 28, 1972) which added inventor’s certificates to both 35 U.S.C. § 119(d) and 35 U.S.C. § 102(d), the AIPA did not include a corresponding change to 35 U.S.C. § 102(d). Therefore, to maintain consistency in statutory interpretation the USPTO will not make rejections under 35 U.S.C. § 102(d) based on a PBR certificate. Any such rejections that have been made under 35 U.S.C. § 102(d) will be withdrawn.”

“After consulting with interested circles in industry and the bar, the USPTO may consider seeking legislation that would further clarify the status of certificates of plant variety protection as prior art.”

[...]”

8. *The Committee is invited to take note of the information given above.*

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