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UPOV

CAJ/XII/ 3 Add.
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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Twelfth Session
Geneva, November 7 and 8, 1983

LEGAL ASPECTS OF THE
PROBLEM OF MINIMUM DISTANCES BETWEEN VARIETIES

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OFFER FOR SALE AND MARKETING
IN RELATION WITH THE NOVELTY CONCEPT

Document prepared by the Office of the Union

The annex hereto contains the replies from the delegation of the United States of America to the questions asked by the Office of the Union for the purpose of preparing a study of the concept of offering for sale and marketing and of the interpretation of that concept in the various member States for the purposes of novelty within the meaning of Article 6(1)(b) of the Convention. (The questions are reproduced in paragraph 2 of document CAJ/XII/3.)

[Annexe follows]

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

AUG 9 1983

Dr. Heribert Mast
Vice Secretary General
International Union for the
Protection of New Varieties of Plants
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Dear Heribert:

This responds to UPOV Circular No. 811-08.4, asking about the concepts of offering for sale and marketing under the national laws of each member state.

Replying to the first question, the plant patent law (sections 161-164 of the general patent law) provides for the patenting of new (novel) varieties of asexually reproduced plants. The novelty provisions of the general patent law (section 102) provide the legal standards for determining if a plant variety is novel. According to subsection 102(b), an invention is not novel if it has been in public use or on sale in this country for more than one year prior to the date a United States patent is applied for.

The term "on sale" includes both actual sale (marketing) and offering for sale. If either occurs more than one year prior to applying for a United States patent, a patent will be denied for lack of novelty. Similarly, a court will invalidate a patent for the same reason.

An invention publicly used more than one year before a patent application is filed cannot be patented. The concept of public use, however, is broader than its literal meaning. Secret use of an invention for commercial purposes is considered under our jurisprudence to be a public use.

A process carried out in secret to produce a commercial product is regarded as a public use of that process. It makes no difference that the product cannot be reverse engineered to ascertain the process used in manufacturing or the product's ingredients. Similarly, secret use of a device or machine for commercial purposes is considered a public use.

Sections 41 and 42 of the Plant Variety Protection Act define the concept of novelty in regard to the protection of sexually reproduced plants. Subsection 42(a)(1) precludes protection for any variety deemed to be a public variety in this country. The term "public variety" is in turn defined in subsection 41(i), insofar as the Circular is concerned, as one sold or used in the United States for more than one year before the filing of an application for protection. A Department of Agriculture regulation, to take effect on August 5, 1983, purports to preclude protection for any variety offered for sale or marketed in a foreign country for longer than four years (six years for some varieties) prior to filing an application for protection in the United States.

Our reply to question 2 must be understood as only our view as to how the Plant Variety Protection Act might be judicially interpreted. This Act is similar to the patent law, however, and both are based on the same public purposes. Accordingly, we expect a court deciding this question to apply the concepts and precedents of the patent law.

Merely transferring seed to a contract multiplier, without any transfer of ownership of the seed, should not be regarded as offering the seed for sale or marketing it. Rather, the contract multiplier is only the seed owner's agent for carrying out the multiplication.

If hybrid seed produced by the multiplier is offered for sale or marketed, however, the "public use" doctrine of the patent law would seem to apply. The parental lines would be regarded as publicly used, along with the method of crossing these parental lines to produce the hybrid. If hybrid seed has been offered for sale or marketed for more than one year, no protection would be available for the parental lines or for the breeding process.

I trust this answers your questions. I have enclosed copies of each of the cited references.

Sincerely,

Michael K. Kirk
Assistant Commissioner for
External Affairs

Enclosures

EXTRACTS FROM LEGAL TEXTS CITED IN SUPPORT OF THE REPLIES

1. Patent Laws

Section 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless--

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, 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 or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other (Amended July 28, 1972, Public Law 92-358, sec. 2, 86 Stat. 501; November 14, 1975, Public Law 94-131, sec. 5, 89 Stat. 691).

Section 161. Patents for Plants

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 therefor, subject to the conditions and requirements of title. (Amended September 3, 1954, 68 Stat. 1190).

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

Section 162. Description, claim

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

Section 163. Grant

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.

Section 164. Assistance of Department of Agriculture

The President may by Executive Order direct the Secretary of Agriculture, in accordance with the requests of the Commissioner, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Commissioner, officers and employees of the Department.

2. Plant Variety Protection Act

Section 41. Definitions and rules of construction

The definitions and rules of construction set forth in this section apply for the purpose of this Act.

...

(i) The term "public variety" means a variety sold or used in this country, or existing in and publicly known in this country; but use for the purpose of testing, or sale or use as individual plants not known to be sexually reproducible, shall not make the variety a public variety.

Section 42. Right to plant variety protection; plant varieties protectable

(a) The breeder of any novel variety of sexually reproduced plant (other than fungi, bacteria, or first generation hybrids) who has so reproduced the variety, or his successor in interest, shall be entitled to plant variety protection therefor, subject to the conditions and requirements of this title unless one of the following bars exists:

(1) Before the date of determination thereof by the breeder, or more than one year before the effective filing date of the application therefor, the variety was (A) a public variety in this country, or (B) effectively available to workers in this country and adequately described by a publication reasonably deemed a part of the public technical knowledge in this country which description must include a disclosure of the principal characteristics by which the variety is distinguished.

(2) An application for protection of the variety based on the same breeder's acts, was filed in a foreign country by the owner or his privies more than one year before the effective filing date of the application filed in the United States.

(3) Another is entitled to an earlier date of determination for the same variety and such other (A) has a certificate of plant variety protection hereunder, or (B) has been engaged in a continuing program of development and testing to commercialization, or (C) has within six months after such earlier date of determination adequately described the variety by a publication reasonably deemed a part of the public technical knowledge in this country which description must include a disclosure of the principal characteristics by which the variety is distinguished.

(b) The Secretary may, by regulation, extend for a reasonable period of time the one year time period provided in subsection (a) of this section for filing applications, and may in that event provide for at least commensurate reduction of the term of protection.

[End of document]