



# PLANT VARIETY PROTECTION GAZETTE AND NEWSLETTER

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## NEW MEMBERS OF UPOV

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### SERBIA<sup>1</sup>

On December 5, 2012, the Government of Serbia deposited its instrument of accession to the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as revised at Geneva on November 10, 1972, on October 23, 1978, and on March 19, 1991, with the Secretary-General of UPOV.

The Convention entered into force for Serbia one month after the deposit of its instrument of accession, i.e. on January 5, 2013.

On that date, Serbia became the seventy-first member of the Union.

According to the notification deposited with the Secretary-General together with the instrument of accession, protection is available to all plant genera and species.

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<sup>1</sup> Pursuant to Article 34 (3) of the 1991 Act of the UPOV Convention, any State which is not a member of the Union and any intergovernmental organization shall, before depositing its instrument of accession, ask the Council of UPOV to advise it in respect of the conformity of its laws with the provisions of the UPOV Convention. If the decision embodying the advice is positive, the instrument of accession may be deposited. The positive advice of the Council of UPOV concerning the legislation of Serbia is contained in paragraph 8 of document C(Extr.)/28/3 ([http://www.upov.int/edocs/mdocs/upov/en/c\\_extr/28/c\\_extr\\_28\\_03.pdf](http://www.upov.int/edocs/mdocs/upov/en/c_extr/28/c_extr_28_03.pdf)).

## **ACCESSION TO THE 1991 ACT OF THE UPOV CONVENTION**

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### **PANAMA**

On October 22, 2012, the Government of Panama deposited its instrument of accession to the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as revised at Geneva on November 10, 1972, on October 23, 1978, and on March 19, 1991.

Panama has been a member of UPOV since May 23, 1999.

The 1991 Act entered into force for Panama on November 22, 2012, one month after the deposit of its instrument of accession.

According to the notification deposited with the Secretary-General together with the instrument of accession, the legislation governing breeders' rights of Panama applies to all genera and species.

## NOTIFICATIONS CONCERNING GENERA AND SPECIES

### AZERBAIJAN

On November 30, 2012, the Office of the Union received a notification that the legislation governing breeders' rights of Azerbaijan applies to the following list of genera and species:

UPOV Code	Botanical Names	English
<a href="#">CAPSI ANN</a>	Capsicum annuum L.; Capsicum annuum L. var. annuum; Capsicum annuum subsp annuum var pomiferum; Capsicum annuum var. fasciculatum (Sturtev.) Irish; Capsicum annuum var. grossum (L.) Sendtn.; Capsicum annuum var. longum Sendtn.	Capsicum; Chili; Green capsicum; Hot pepper; Paprika; Sweet Pepper
<a href="#">CUCUM SAT</a>	Cucumis sativus L.	Cucumber; Gherkin
<a href="#">GOSSY HIR</a>	Gossypium hirsutum L.	Cotton
<a href="#">HORDE VUL</a>	Hordeum vulgare L.; Hordeum distichum jessen; Hordeum vulgare L. convar distichon L.; Hordeum vulgare L. ssp polystichum Hall Schinz et Kell	Barley
<a href="#">MALUS DOM</a>	Malus domestica Borkh.; Malus pumila Mill var. domestica; Pyrus malus L.	Apple
<a href="#">MEDIC SAT</a>	Medicago sativa L.	Alfalfa; Lucerne
	Onobrychis vicifolia scop	Sainfoin
	Dactylis gromelata L	Orchard grass
	Kochia prostrate Schard	Summercypress
<a href="#">MORUS ALB</a>	Morus alba L.	Silkworm Mulberry; White Mulberry
<a href="#">NICOT TAB</a>	Nicotiana tabacum L.	Tobacco (common)
<a href="#">PHASE VUL</a>	Phaseolus vulgaris L.	French Bean
<a href="#">PUNIC GRA</a>	Punica granatum L.	Pomegranate
<a href="#">SOLAN LYC</a>	Solanum lycopersicum L.; Lycopersicon esculentum Mill.	Tomato; tomato
	Allium L	Onion
	Allium sativum	Garlic
<a href="#">SOLAN MEL</a>	Solanum melongena L.	Aubergine, Eggplant
<a href="#">SOLAN TUB</a>	Solanum tuberosum L.	Potato
<a href="#">TRITI AES</a>	Triticum aestivum L.; Triticum aestivum L. emend. Fiori et Paol.	Wheat
<a href="#">TRITI TUR DUR</a>	Triticum durum Desf.; Triticum turgidum L. subsp. durum (Desf.) Husn.; Triticum turgidum ssp turgidum conv durum	Durum Wheat; Hard Wheat; Macaroni Wheat
<a href="#">TRITL</a>	×Triticosecale Wittm. ex A. Camus; ×Triticale; ×Triticosecale Wittmack	Triticale
<a href="#">ZEAAA MAY</a>	Zea mays L.	Corn; Maize
	Lens esculenta Moench	Lentil
	Cucer arietinum	Chickpea
	Pisum sativum L.	Vegetable pea
	Anethum graveolens	Dill
	Faeniculum vulqare	Anise
	Cucurbita Citrullus L.	Watermelon
	Ziziphus jujube Mill	Unabi
	Cornus Mas mas L.	Dogwood
	Feijoa Seloviana Berg	Feijoa
	Olea europela L.	Olive
	Hippophae rhamnides L.	Sea buckthorn
	Vitus vanifera L.	Grape

## BELARUS

In accordance with Law No. 115-3 of Accession of the Republic of Belarus to the International Convention for the Protection of New Varieties of Plants of June 26, 2002, Order No. 5 of January 4, 2013, provides notification that the legislation governing breeders' rights of Belarus applies to all genera and species since January 5, 2013.

## CHINA

On August 29, 2013, the Office of the Union received a notification that the legislation governing breeders' rights of China applies to the following additional genera and species from April 1, 2013:

Botanical Name
Abelia R. Br.
Abies Mill.
Acanthopanax (Decne. et Planch.) Miq.
Acidosasa C. D. Chu et C. S. Chao
Aesculus L.
Akebia Decne.
Albizia Durazz.
Alnus Mill.
Ammopiptanthus Cheng f.
Amorpha L.
Aucuba Thunb.
Berberis L.
Bombax L.
Bougainvillea Comm. ex Juss.
Broussonetia L'Hér. ex Vent.
Buddleja L.
Callicarpa L.
Calligonum mongolicum Turcz.
Campsis Lour.
Camptotheca acuminata Decne.
Caragana Fabr.
Carpinus L.
Carya Nutt.
Cassia L.
Castanea Mill.
Casuarina L.
Cedrus Trew
Celtis L.
Cephalotaxus Sieb. et Zucc.
Cercis L.
Chimonobambusa Makino
Chionanthus L.
Choerospondias axillaris (Roxb.) B. L. Burtt et A. W. Hill
Clematis L.
Clerodendrum L.
Cornus L.
Cotoneaster Medik.
Crataegus L.
Cryptomeria D. Don
Daphne L.
Davidia Baill.
Dendrocalamus Nees
Elaeagnus L.
Elaeocarpus L.
Ephedra L.

Botanical Name
Eucommia ulmoides Oliv.
Fargesia Franch.
Gleditsia L.
Haloxylon Bunge
Hamamelis L.
Hibiscus L.
Hippophae L.
Hopea Roxb.
Hydrangea L.
Hypericum L.
Idesia Maxim.
Ilex L.
Illicium L.
Indosasa McClure
Jacaranda Juss.
Jasminum L.
Jatropha curcas L.
Juniperus L.
Keteleeria Carrière
Lagerstroemia L.
Larix Mill.
Lespedeza Michx.
Ligustrum L.
Lindera Thunb.
Liquidambar L.
Litsea Lam.
Luculia Sweet
Malus Mill. (except fruits)
Melastoma L.
Melia L.
Metasequoia Miki ex Hu et W. C. Cheng
Myrica rubra Sieb. et Zucc.
Nitraria L.
Ormosia Jackson
Osmanthus Lour.
Phellodendron amurense Rupr.
Phoebe Nees
Photinia Lindl.
Pistacia L.
Platycarya Sieb. et Zucc.
Platyclusus Spach
Pleioblastus Nakai
Potentilla fruticosa L.
Prunus L. (except fruits)
Pterocarya Kunth

Botanical Name
Pteroceltis Maxim.
Quercus L.
Rubus L.
Sambucus L.
Sapindus L.
Sapium Jacq.
Sassafras tzumu (Hemsl.) Hemsl.
Schima Reinw. ex Blume
Sinojackia Hu
Sorbaria (DC) A. Braun
Sorbus L.
Spathodea P. Beauv.
Spiraea L.
Symplocos Jacq.
Taiwania Hayata

Botanical Name
Tamarix L.
Tectona grandis L. f.
Telosma Cov.
Ternstroemia Mutis ex Linn. f.
Tetradium Lour.
Tilia L.
Toona M. Roemer
Torreya Arn.
Vaccinium L.
Viburnum L.
Vitex L.
Weigela Thunb.
Wisteria Nutt.
Xanthoceras sorbifolium Bunge
Ziziphus Mill.

## JORDAN

On December 4, 2012, the Office of the Union received a notification that the legislation governing breeders' rights of Jordan applies to the following consolidated list of genera and species:

UPOV Code	Botanical Names	English
<a href="#">ABELM_ESC</a>	Abelmoschus esculentus (L.) Moench; Hibiscus esculentus L.	Gombo
<a href="#">ALLIU_CEP_CEP</a>	Allium cepa L. var. cepa; Allium cepa (Cepa Group); Allium cepa L. var. cepa Helm	bulb onion; echalion; Onion; Spanish onion
<a href="#">CAPSI_FRU</a>	Capsicum frutescens L.	
<a href="#">CICER_ARI</a>	Cicer arietinum L.	Chick-pea; Chickpea
<a href="#">CUCUM_SAT</a>	Cucumis sativus L.	Cucumber; Gherkin
<a href="#">CUCUR_PEP</a>	Cucurbita pepo L.; Cucurbita pepo L. subsp. ovifera (L.) D. S. Decker var. ovifera (L.) Harz; Cucurbita pepo L. subsp. pepo var. pepo; Cucurbita pepo L. var. montia Duch; Cucurbita pepo L. var. patisson Duch; Cucurbita pepo var. giraumontia Filov; Cucurbita pepo var. melopepo (L.) Harz; Cucurbita pepo var. styriaca Greb.	Courgette; Marrow; Pumpkin; Summer squash; Table queen squash; Vegetable Marrow; Zucchini
<a href="#">FRAGA</a>	Fragaria L.	Strawberry
<a href="#">HORDE_VUL</a>	Hordeum vulgare L.; Hordeum distichum Jessen; Hordeum vulgare L. convar distichon L.; Hordeum vulgare L. ssp polystichum Hall Schinz et Kell	Barley
<a href="#">LENSS_CUL</a>	Lens culinaris Medik.	Lentil
<a href="#">MALUS_DOM</a>	Malus domestica Borkh.; Malus pumila Mill var. domestica; Pyrus malus L.	Apple
<a href="#">OLEEA_EUR</a>	Olea europaea L.	Olive
<a href="#">PHOEN_DAC</a>	Phoenix dactylifera L.	Date; Date Palm
<a href="#">PRUNU_PER</a>	Prunus persica (L.) Batsch; Persica vulgaris Mill.; Prunus L. subg. Persica	Peach
<a href="#">PRUNU_SAL</a>	Prunus salicina Lindl.	Japanese Plum; Plum
<a href="#">SOLAN_LYC</a>	Solanum lycopersicum L.; Lycopersicon esculentum Mill.	cherry tomato; tomato; Tomato; tomato

UPOV Code	Botanical Names	English
<a href="#">SOLAN_LYC_LYC</a>	<i>Solanum lycopersicum</i> L. var. <i>lycopersicum</i> ; <i>Lycopersicon esculentum</i> Mill. var. <i>esculentum</i> , <i>Lycopersicon esculentum</i> P. Mill. nom. cons. var. <i>esculentum</i> ; <i>Lycopersicon lycopersicum</i> (L.) H. Karst.; <i>Lycopersicon lycopersicum</i> (L.) Karst. ex Farwell; <i>Solanum lycopersicum</i> L.	Tomato
<a href="#">SOLAN_MEL</a>	<i>Solanum melongena</i> L.	Aubergine, Eggplant
<a href="#">TRCOS_CUC_ANG</a>	<i>Trichosanthes cucumerina</i> L. var. <i>anguina</i> (L.) Haines; <i>Trichosanthes anguina</i> L.	Club Gourd; Serpent Gourd; Serpent-cucumber; Snake Gourd; Viper's Gourd
<a href="#">TRITI_AES</a>	<i>Triticum aestivum</i> L.; <i>Triticum aestivum</i> L. emend. Fiori et Paol.	Wheat
<a href="#">TRITI_TUR_DUR</a>	<i>Triticum durum</i> Desf.; <i>Triticum turgidum</i> L. subsp. <i>durum</i> (Desf.) Husn.; <i>Triticum turgidum</i> ssp. <i>turgidum</i> conv. <i>durum</i>	Durum Wheat; Hard Wheat; Macaroni Wheat
<a href="#">VICIA_ERV</a>	<i>Vicia ervilia</i> (L.) Willd.	
<a href="#">VICIA_FAB</a>	<i>Vicia faba</i> L.; <i>Faba vulgaris</i> Moench ssp. <i>vulgaris</i>	Broad Bean; Field Bean; Horse Bean; Tick Bean

## SINGAPORE

On December 14, 2013, the Office of the Union received a notification that the legislation governing breeders' rights of Singapore applies to the following list of genera and species from December 9, 2013:

UPOV Code	Botanical Names	English
<a href="#">ANUBI</a>	Anubias, Schott	Anubias
<a href="#">ARAND</a>	xAranda Hort. (Arachnis x Vanda) <ul style="list-style-type: none"> <li>• Aranda x Arachnis</li> <li>• Aranda x Vanda</li> <li>• Selfing or sibling of Aranda</li> </ul>	Aranda
<a href="#">ARANT</a>	xAranthera, Hort. (Arachnis x Renanthera) <ul style="list-style-type: none"> <li>• Aranthera x Arachnis</li> <li>• Aranthera x Renanthera</li> <li>• Selfing or sibling of Aranthera</li> </ul>	Aranthera
<a href="#">BRASS_RAP_CHI</a>	<i>Brassica rapa</i> L. (syn. <i>Brassica campestris</i> L.), <i>Brassica rapa</i> subsp. <i>chinensis</i> , (L.) Hanelt <i>Brassica rapa</i> subsp. <i>parachinensis</i> , (L.) Hanelt	Bai Cai, Xiao Bai Cai Cai Xin
<a href="#">CRPTC</a>	<i>Cryptocoryne</i> , Fischer	Water Trumpet
<a href="#">DNDRB</a>	<i>Dendrobium</i> , Swartz	Dendrobium
<a href="#">ECHND</a>	<i>Echinodorus</i> , Rich ex Engelm.	Amazon Sword Plant
<a href="#">HLCON</a>	<i>Heliconia</i> , Linnaeus	Crab Claw Plant
<a href="#">JATRO_CUR</a>	<i>Jatropha curcas</i> L.	Physic Nut
<a href="#">LIMNO</a>	<i>Limnophila</i> , R. Br.	Asian Marsh Weed
<a href="#">MOKAR</a>	xMokara, Hort. (Arachnis x Ascocentrum x Vanda) <ul style="list-style-type: none"> <li>• Ascocenda (Ascocentrum x Vanda) x Arachnis</li> <li>• Aranda (Arachnis x Vanda) x Ascocentrum</li> <li>• Ascorachnis (Ascocentrum x Arachnis) x Vanda</li> <li>• Ascocenda x Aranda</li> <li>• Ascocenda x Ascorachnis</li> <li>• Aranda x Ascorachnis</li> <li>• Mokara x Arachnis</li> <li>• Mokara x Ascocentrum</li> <li>• Mokara x Vanda</li> <li>• Mokara x Ascocenda</li> <li>• Mokara x Aranda</li> <li>• Mokara x Ascorachnis</li> <li>• Selfing or sibling of Mokara</li> </ul>	Mokara
<a href="#">ONCID</a>	<i>Oncidium</i> , Swartz	Dancing Lady Orchid
<a href="#">PHALE</a>	<i>Phalaenopsis</i> , Blume	Moth Orchid



UPOV Code	Botanical Names	English
<a href="#">RENTD</a>	xRenantanda, Hort. (Renanthera x Vanda) <ul style="list-style-type: none"> <li>• Renantanda x Renanthera</li> <li>• Renantanda x Vanda</li> <li>• Selfing or sibling of Renantanda</li> </ul>	Renantanda
<a href="#">VANDA</a>	Vanda, Jones	Vanda

## SOUTH AFRICA

On August 27, 2013, the Office of the Union received a notification that the Regulations relating to breeders' rights of South Africa have been amended in order that protection is extended to the following genera and species:

1		2	3	4
Kind of plant Soort Plant		Category Kategorie	Period of Plant Breeder's Right (Years) Termyn van Planttelersreg (Jare)	Period of sole Right (Years) Termyn van Alleenreg (Jare)
Botanical Name Botaniese Naam	Common Name Gewone Naam			
<i>Agave</i> L. (All spp. except <i>A. sisalana</i> Perrine)	Agave	A	20	5
<i>Allium</i> L. (All spp.)	Onion genus	A	20	5
<i>Amaranthus</i> L. (All spp.)	Amaranth	A	20	5
<i>Cajanus</i> L. (All spp.)	Cajanus	A	20	5
<i>Chondropetalum</i> Rottb. (All spp.)	Chondropetalum	A	20	5
<i>Cleome</i> L. (All spp.)	Cleome	A	20	5
<i>Colocasia</i> Schott. (All spp.)	Elephant ear	A	20	5
<i>Corchorus</i> L. (All spp.)	Mallow	A	20	5
<i>Coriandrum</i> L. (All spp.)	Coriandrum	A	20	5
<i>Echinocloa</i> P. Beauv. (All spp.)	Echinocloa	A	20	5
<i>Euphorbia X martini</i>	Red spurge	A	20	5
<i>Foeniculum</i> Mill. (All spp.)	Fennel	A	20	5
<i>Moringa</i> Adans (All spp.)	Moringa	B	25	8
<i>Panicum</i> L. (All spp.)	Panicum	A	20	5
<i>Paspalum</i> L. (All spp.)	Paspalum	A	20	5
<i>Pericallis</i> D. Don (All spp.)	Ragwort	A	20	5
<i>Physocarpus</i> (Cambess) Raf. (All spp.)	Ninebark	B	25	8
<i>Solanum retroflexum</i> Dunal	Wonderberry	A	20	5
<i>Spiraea</i> L. (All spp.)	Spiraea	B	25	8
<i>Xanthosoma</i> Schott. (All spp.)	Malanga	A	20	5

## SOUTH Africa (continued)

With the incorporation of the genera and species notified on August 27, 2013, the legislation governing breeders' rights of South Africa applies to the following consolidated list of genera and species:

UPOV Code	Botanical Names	English	Notes
<a href="#">ABELI</a>	Abelia R. Br.	Abelia	
<a href="#">ABELM</a>	Abelmoschus		
<a href="#">ABUTI</a>	Abutilon Mill.	Abutilon	
<a href="#">ACACI_POD</a>	Acacia podalyriifolia A. Cunn. ex G. Don; Acacia podalyriifolia A. Cunn.	Pearl Acacia; Queensland Silverwattle	
<a href="#">ACMAD</a>	Acmadenia		
<a href="#">ACORU</a>	Acorus		
<a href="#">ACTIN</a>	Actinidia Lindl.	Actinidia	
<a href="#">ADENA</a>	Adenanthos		
<a href="#">AGAPA</a>	Agapanthus L'Hér.	African Lily; Agapanthus; Blue Lily	
<a href="#">AGATO</a>	Agathosma Willd.		

<b>UPOV Code</b>	<b>Botanical Names</b>	<b>English</b>	<b>Notes</b>
<a href="#">AGAVE</a>	Agave		Agave L.: except for Agave sisalana
<a href="#">AGERT</a>	Ageratina		
<a href="#">AGLAO</a>	Aglaonema Schott.; Aglaonema spp.	Chinese Evergreen	
<a href="#">AGROT</a>	×Agrotriticum; Agropyron × Triticum	Agrotriticum	
<a href="#">AJUGA</a>	Ajuga L.		
<a href="#">ALLIU</a>	Allium L.	Ornamental Allium	
<a href="#">ALOEE</a>	Aloe L.	Aloe	
<a href="#">ALSTR</a>	Alstroemeria L.	Alstroemeria; Herb Lily	
<a href="#">ALYOG HUE</a>	Alyogyne huegelii (Endl.) Fryxell		
<a href="#">AMARA</a>	Amaranthus L.	Amaranth	
<a href="#">ANANA_COM</a>	Ananas comosus (L.) Merr.	Pineapple	
<a href="#">ANGLN</a>	Angelonia Bonpl.; Angelonia Humb. et Bonpl.		
<a href="#">ANISO</a>	Anisodonteia K.B. Presl; Anisodonteia K.B.	George Mallow; Hairy Mallow	
<a href="#">ANTHP_PUB</a>	Antheophora pubescens Nees	Bottle Brush Grass	
<a href="#">ANTHU</a>	Anthurium Schott	Anthurium; Tail Flower	
<a href="#">ANTIR</a>	Antirrhinum L.; Antirrhinum Tourn.	Snapdragon	
<a href="#">ARACH</a>	Arachis	Peanut	
<a href="#">ARCTI</a>	Arctotis L.	Arctotis	
<a href="#">ARGYR</a>	Argyranthemum Webb ex Schultz Bip.; Argyranthemum Webb	Daisy Bush	
<a href="#">ARTEM</a>	Artemisia L.	Mugwort	
<a href="#">ASPAR_DEN</a>	Asparagus densiflorus (Kunth) Jessop; Asparagus sprengeri Regel	Asparagus-fern	
<a href="#">ASPAR_OFF</a>	Asparagus officinalis L.	Asparagus	
<a href="#">ASTER</a>	Aster L.	Aster; Michaelmas Daisy	
<a href="#">AULAX</a>	Aulax Berg	Aulax	
<a href="#">AVENA</a>	Avena L.	Oats	
<a href="#">BARLE</a>	Barleria L.	Barleria	
<a href="#">BAUHI</a>	Bauhinia L.		Excluding B. purpurea and B. variegata
<a href="#">BEGON</a>	Begonia L.; Begonia-Hybridae	Begonia	
<a href="#">BERGE</a>	Bergenia Moench	Megasea	
<a href="#">BETAA_VUL</a>	Beta vulgaris L.		
<a href="#">BOUGA</a>	Bougainvillea Comm. ex Juss.; Bougainvillea Comm.	Bougainvillea	
<a href="#">BOUVA</a>	Bouvardia Salisb.	Bouvardia	
<a href="#">BRASS_JUN</a>	Brassica juncea (L.) Czern.; Brassica juncea (L.) Czern. et Coss. in Czern.	Brown mustard; India mustard; Indian mustard; Oriental mustard	
<a href="#">BRASS_NAP</a>	Brassica napus L.		
<a href="#">BRASS_OLE</a>	Brassica oleracea L.		
<a href="#">BRASS_RAP</a>	Brassica rapa L.		
<a href="#">BRCHY</a>	Brachyscome Cass.; Brachycome	Swan River Daisy	

<b>UPOV Code</b>	<b>Botanical Names</b>	<b>English</b>	<b>Notes</b>
<a href="#">BROMU_CAT</a>	Bromus catharticus Vahl; Bromus unioloides H.B.K.; Bromus unioloides Kunth; Bromus willdenowii Kunth	Rescue Grass	
<a href="#">BRUNF_LAT</a>	Brunfelsia latifolia (Pohl) Benth.		
<a href="#">BRUNI</a>	Brunia Lam.; Brunia L.	Brunia	
<a href="#">BUDDL</a>	Buddleja L.	Buddleia; Butterfly-bush	
<a href="#">BULBI</a>	Bulbine Wolf		
<a href="#">CAJAN</a>	Cajanus Adans.		
<a href="#">CALIB</a>	Calibrachoa Llave & Lex.		
<a href="#">CALSM</a>	Callistemon R. Br.	Bottle-brush	
<a href="#">CANNA</a>	Canna L.	Canna	
<a href="#">CAPSI</a>	Capsicum L.	Sweet Pepper	
<a href="#">CAREX_BRU</a>	Carex brunnea Thunb.		
<a href="#">CARIC_PAP</a>	Carica papaya L.	Papaw; Papaya	
<a href="#">CARYA_ILL</a>	Carya illinoensis (Wangenh.) C. Koch	Pecan Nut	
<a href="#">CEANO_DEN</a>	Ceanothus dentatus Torr. & A. Gray	Cropleaf ceanothus	
<a href="#">CENCH_CIL</a>	Cenchrus ciliaris L.; Pennisetum ciliare (L.) Link	Blue Buffalo Grass	
<a href="#">CHEIR</a>	Cheiranthus L.	Wallflower	
<a href="#">CHIRO</a>	Chironia L.	Christmas Berry; Wild Gentian	
<a href="#">CHLRP</a>	Chlorophytum Ker Gawl.		
<a href="#">CHMLC</a>	Chamelaucium Desf.	Chamelaucium; Geraldton Wax	
<a href="#">CHOIS_DEW</a>	Choisya x dewitteana Geerinck		
<a href="#">CHRYS</a>	Chrysanthemum L.; Chrysanthemum dendranthema; Dendranthema (DC.) Desmoul.	Chrysanthemum; Daisies	
<a href="#">CICHO_INT</a>	Cichorium intybus L.	Chicory	
<a href="#">CITHR</a>	Citharexylum Mill.	Fiddlewood	
<a href="#">CITRU</a>	Citrus L.	Citrus	
<a href="#">CLEMA</a>	Clematis L.	Clematis	
<a href="#">CLEOM</a>	Cleome L.	Spider Flower	
<a href="#">CLIVI</a>	Clivia Lindl.	Clivia; Kaffir-lily	
<a href="#">CMLIA</a>	Camellia L.	Camellia	
<a href="#">CMLIA_SIN</a>	Camellia sinensis (L.) Kuntze; Thea sinensis L.	Tea	
<a href="#">COFFE_ARA</a>	Coffea arabica L.	Coffee	
<a href="#">COLEO</a>	Coleostephus		
<a href="#">COLOC</a>	Colocasia Schott	Taro	
<a href="#">COPRO</a>	Coprosma J.R. et G. Forst.	Coprosma; Mirror Plant	
<a href="#">CORCH</a>	Corchorus		
<a href="#">CORDY</a>	Cordyline Comm. ex Juss.; Cordyline Comm. ex R. Br.	Cordyline	
<a href="#">COREO_LAN</a>	Coreopsis lanceolata L.	perennial coreopsis	
<a href="#">COREO_PUB</a>	Coreopsis pubescens Elliott		
<a href="#">COREO_ROS</a>	Coreopsis rosea Nutt.	Pink tickseed	
<a href="#">CORIA</a>	Coriandrum L.		
<a href="#">COSMO_ATR</a>	Cosmos atrosanguineus (Hook.) Voss	Black cosmos; Chocolate cosmos	

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<a href="#">COTYL</a>	Cotyledon L.		
<a href="#">CRAMB_ABY</a>	Crambe abyssinica Hochst. ex R. E. Fr.; Crambe abessinica Hochst. ex Fries		
<a href="#">CRASS</a>	Crassula L.	Pigmyweed	
<a href="#">CRINU</a>	Crinum L.	Cape lily	
<a href="#">CROCO</a>	Crocoshia Planch.	Crocoshia	
<a href="#">CRYLS</a>	Corylus L.	Filbert; Hazelnut	
<a href="#">CUCUM</a>	Cucumis L.	Cucumber; Sweet Melon	
<a href="#">CUCUR</a>	Cucurbita L.	Pumpkin; Squash	
<a href="#">CUPHE_HYS</a>	Cuphea hyssopifolia Kunth	Mexican-heather	
<a href="#">CUPRC</a>	×Cupressocyparis Dallim.		
<a href="#">CUPRE</a>	Cupressus L.	Cypress	
<a href="#">CYCLP</a>	Cyclopia Vent.	Honeybush Tea	
<a href="#">CYDON</a>	Cydonia Mill.; Cydonia	Flowering Quince; Quince	
<a href="#">CYNOD</a>	Cynodon		
<a href="#">CYPER</a>	Cyperus		
<a href="#">CYRTA</a>	Cyrtanthus Aiton; Cyrtanthus L. f.	Fire Lily; Ifafa Lily	
<a href="#">CYTHE</a>	Cyathea Sm.	Tree Fern	
<a href="#">DAHLI</a>	Dahlia Cav.	Dahlia	
<a href="#">DAPHN_TRA</a>	Daphne xtransatlantica C. D. Brickell & A. R. White; Daphne collina × Daphne caucasica		
<a href="#">DAUCU_CAR</a>	Daucus carota L.; Daucus carota L. ssp. sativus (Hoffm.) Schübl. et G. Martens; Daucus carota L. subsp. sativus (Hoffm.) Arcang. var. sativus Hoffm.	Carrot	
<a href="#">DCTLS_GLO</a>	Dactylis glomerata L.	Cocksfoot; Orchard Grass	
<a href="#">DELOS</a>	Delosperma N. E. Br.		
<a href="#">DESMD</a>	Desmodium		
<a href="#">DGTRA_ERI</a>	Digitaria eriantha Steud.; Digitaria decumbens Stent; Digitaria eriantha Steud. ssp. eriantha; Digitaria smutsii Stent	Common Finger Grass; Digit Grass; Pangola Grass; Smuts Digitaria; Woolly Finger Grass	
<a href="#">DIANE</a>	Dianella		
<a href="#">DIANT_ALL</a>	Dianthus xallwoodii hort.		
<a href="#">DIANT_CAR</a>	Dianthus caryophyllus L.; Dianthus-Caryophyllus-Hybridae	Carnation	
<a href="#">DIASC</a>	Diascia Link & Otto	Twinspur	
<a href="#">DIEFF</a>	Dieffenbachia Schott	Dieffenbachia; Dumb Bane; Tuft Root	
<a href="#">DIERA</a>	Dierama K. Koch	wandflower	
<a href="#">DIETE</a>	Dietes Salisb. ex Klatt		
<a href="#">DIMOR</a>	Dimorphotheca Vaill. ex Moench; Dimorphotheca Moench	Bitou; Cape Marigold	
<a href="#">DRACA</a>	Dracaena Vand. ex L.	Dracena; Dragon Tree	
<a href="#">DURAN</a>	Duranta L.	Forget-me-not Tree	

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<a href="#">ERAGR_CUR</a>	Eragrostis curvula (Schrad.) Nees; Eragrostis robusta Stent	Boer love grass; Weeping love grass; Weeping Lovegrass	
<a href="#">ERAGR_TEF</a>	Eragrostis tef (Zuccagni) Trotter; Eragrostis tef (Zucc.) Trotter	Teff	
<a href="#">ERICA</a>	Erica L.	Heath	
<a href="#">ERICE</a>	Eriocephalus L.		
<a href="#">ERYNG</a>	Eryngium L.; Eryngium hybrida	Eryngo	
<a href="#">EUCAL</a>	Eucalyptus L'Hér.	Eucalyptus	
<a href="#">EUCOM</a>	Eucomis L'Her.		
<a href="#">EUONY</a>	Euonymus L.	Spindle Tree	
<a href="#">EUPAT</a>	Eupatorium L.	Boneset; Thorough-wort	
<a href="#">EUPHO_HYP</a>	Euphorbia hypericifolia L.; Chamaesyce hypericifolia (L.) Millsp.		
<a href="#">EUPHO_MRT</a>	Euphorbia martinii; Euphorbia x martinii		
<a href="#">EUPHO_PUL</a>	Euphorbia pulcherrima Willd. ex Klotzsch	Poinsettia	
<a href="#">EURYO</a>	Euryops (Cass.) Cass.; Euryops Cass.	Resin Bush	
<a href="#">FELIC</a>	Felicia Cass.	Felicia	
<a href="#">FERRA</a>	Ferraria Burm. ex Mill.		
<a href="#">FESTL</a>	xFestulolium Aschers. et Graebn.; xFestulolium; Festulolium	Festulolium	
<a href="#">FICUS</a>	Ficus L.	Fig Tree	
<a href="#">FOENI</a>	Foeniculum Mill.		
<a href="#">FORTU</a>	Fortunella Swingle	Kumquat	
<a href="#">FRAGA_ANA</a>	Fragaria xananassa Duch.; Fragaria grandiflora Ehrh. non (L.) Crantz	Strawberry	
<a href="#">FREES</a>	Freesia Eckl. ex Klatt; Freesia x hybrida hort.; Freesia-Hybridae	Freesia	
<a href="#">FUCHS</a>	Fuchsia L.; Fuchsia x hybrida	Fuchsia; Ladies' Eardrops	
<a href="#">GAILL_GRA</a>	Gaillardia xgrandiflora hort. ex Van Houtte; Gaillardia x grandiflora		
<a href="#">GARDE</a>	Gardenia Ellis	Gardenia	
<a href="#">GAURA</a>	Gaura L.	Gaura	
<a href="#">GAZAN</a>	Gazania Gaertn.	Gazania; Treasure Flower	
<a href="#">GELSE_SEM</a>	Gelsemium sempervirens (L.) J.St.-Hil	Carolina Jasmine; Evening Trumpet-flower; Gelsemium; Woodbine; Yellow-jessamine	
<a href="#">GERBE</a>	Gerbera L.	Gerbera	
<a href="#">GLADI</a>	Gladiolus L.; Gladanthera; Gladiolus xhybrid	Gladiolus	
<a href="#">GLAND</a>	Glandularia		
<a href="#">GLYCI_MAX</a>	Glycine max (L.) Merr.; Soja hispida Moench	Soya Bean; Soybean	
<a href="#">GONIO</a>	Goniolimon		
<a href="#">GOSSY_HIR</a>	Gossypium hirsutum L.	Cotton	

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<a href="#">GREVI</a>	Grevillea R. Br. corr. R. Br.; Grevillea hybrid; Grevillea R. Br	Grevillea	
<a href="#">GSTRA</a>	Gasteria Duval		
<a href="#">GYPSO</a>	Gypsophila L.	Baby's Breath; Gyp; Gypsophila	
<a href="#">HAEMN</a>	Haemanthus L.	Blood Lily	
<a href="#">HARDE</a>	Hardenbergia Benth.	Australian Lilac; Sarsaparilla	
<a href="#">HEBEE</a>	Hebe Comm. ex Juss.;; Hebe; Hebe hybrid; Hebe veronica	Shrubby Speedwell	
<a href="#">HEDER</a>	Hedera L.	Ivy	
<a href="#">HEMER</a>	Hemerocallis L.	Day-lily	
<a href="#">HERMA</a>	Hermannia L.		
<a href="#">HEUCH</a>	Heuchera L.	Coral Flower	
<a href="#">HIBIS</a>	Hibiscus L.	Rose-mallow	
<a href="#">HIPPE</a>	Hippeastrum Herb.;; Hippeastrum x hybridum hort.;; Hippeastrum Hybrids; Hippeastrum x hortorum Maatsch; Hippeastrum-Hybridae	Amaryllis	
<a href="#">HLNTS_ANN</a>	Helianthus annuus L.	Common Sunflower	
<a href="#">HLNTS_TUB</a>	Helianthus tuberosus L.	Jerusalem Artichoke	
<a href="#">HLOPS_HEL</a>	Heliopsis helianthoides (L.) Sweet		
<a href="#">HORDE</a>	Hordeum L.	Barley	
<a href="#">HOSTA</a>	Hosta Tratt.	Funkia; Hosta; Plantain Lily	
<a href="#">HTRNT</a>	Heteranthemis		
<a href="#">HUMUL_LUP</a>	Humulus lupulus L.	Hop	
<a href="#">HYDRN</a>	Hydrangea L.	Hydrangea	
<a href="#">HYPER</a>	Hypericum L.	Rose of Sharon; Saint John's Wort	
<a href="#">HYPOE</a>	Hypoestes Soland. ex R. Br.;; Hypoestes Sol. ex R. Br.	Ribbon Bush	
<a href="#">HYPOX</a>	Hypoxis L.		
<a href="#">IBERI</a>	Iberis L.	Candytuft	
<a href="#">ILEXX_CRE</a>	Ilex crenata Thunb.	Box-leaf holly; Japanese holly	
<a href="#">ILEXX_DIM</a>	Ilex dimorphophylla Koidz.		
<a href="#">IMPAT</a>	Impatiens L.	Balsam; Busy Lizzie; Touch-me-not	
<a href="#">IPOMO_BAT</a>	Ipomoea batatas (L.) Lam.;; Ipomoea batatas (L.) Poir.	Sweet Potato	
<a href="#">IRISS</a>	Iris L.	Iris	
<a href="#">ISOPO</a>	Isopogon R. Br.		
<a href="#">JAMES</a>	Jamesbrittenia O. Kuntze		
<a href="#">JUGLA</a>	Juglans L.	Walnut	
<a href="#">JUNIP</a>	Juniperus L.;; Sabina Mill.	Juniper	
<a href="#">KALAN</a>	Kalanchoë Adans.;; Kalanchoë x hybrida hort.	Kalanchoë	
<a href="#">KNIPH</a>	Kniphofia Moench	Torch-lily	

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<a href="#">KOELE</a>	Koeleria Pers.	Hairgrass	
<a href="#">KUNZE</a>	Kunzea Reichb.		
<a href="#">LACHE</a>	Lachenalia Jacq. f. ex Murr.; Lachenalia spp.	Cape Cowslip; Lachenalia	
<a href="#">LACTU_SAT</a>	Lactuca sativa L.	Lettuce	
<a href="#">LAGER_IND</a>	Lagerstroemia indica L.; Lagerstroemia indica prostrata	Crape Myrtle	
<a href="#">LAMIU_MAC</a>	Lamium maculatum L.	Spotted Deadnettle	
<a href="#">LAMPR</a>	Lampranthus N. E. Br.		
<a href="#">LANTA_MON</a>	Lantana montevidensis (Spreng.) Briq.; Lantana sellowiana Link & Otto	Creeping Lantana; Purple Lantana; Small Lantana; Trailing Lantana; Weeping Lantana	
<a href="#">LATHY_TIN</a>	Lathyrus tingitanus L.	Gypsy Sweet Pea; Tangier Scarlet Pea; Tangier Sweet Pea	
<a href="#">LAVAN</a>	Lavandula L.	Lavender	
<a href="#">LEDEB</a>	Ledebouria Roth; Drimiopsis Lindl. & Paxton; Resnova Van der Merwe		
<a href="#">LESPE_CUN</a>	Lespedeza cuneata (Dum. Cours.) G. Don	Chinese bush-clover; Chinese lespedeza; Perennial lespedeza; Sericea le; Silky bush-clover	
<a href="#">LESPE_STR</a>	Lespedeza striata (Thunb.) Hook. & Arn.; Kummerowia striata (Thunb.) Schindl.		
<a href="#">LEUCA</a>	Leucanthemum; Leucanthemum Mill.		
<a href="#">LEUCD</a>	Leucadendron R. Br.	Conebush; Protea; Yellowbush	
<a href="#">LEUCS</a>	Leucospermum R. Br.	Pincushion; Protea	
<a href="#">LIBER_IXI</a>	Libertia ixioides (G. Forst.) Spreng.		
<a href="#">LILIU</a>	Lilium L.	Lily	
<a href="#">LIMON</a>	Limonium Mill.	Sea Lavender; Statice	
<a href="#">LIRIP_MUS</a>	Liriope muscari (Decne.) L. H. Bailey; Liriope platyphylla F. T. Wang & T. Tang; Liriope platyphylla Wang et Tang		
<a href="#">LITCH_CHI</a>	Litchi chinensis Sonn.	Litchi	
<a href="#">LOBEL_ERI</a>	Lobelia erinus L.	edging lobelia, garden lobelia, trailing lobelia; lobelia	
<a href="#">LOLIU</a>	Lolium L.	Ryegrass	
<a href="#">LOMAN</a>	Lomandra Labill		
<a href="#">LONIC</a>	Lonicera L.	Honeysuckle; Lonicera	
<a href="#">LOTUS_COR</a>	Lotus corniculatus L.	Bird's Foot Trefoil	
<a href="#">LPTOS</a>	Leptospermum J.R. et G. Forst.	Tea Tree	
<a href="#">LUPIN</a>	Lupinus L.	Lupin	
<a href="#">LYCIA_RAN</a>	Lycianthes rantonnei (Carrière) Bitter; Solanum rantonnetii Carr ex. Lescuy	Blue Potato Bush	
<a href="#">LYCIU</a>	Lycium		
<a href="#">LYSIM</a>	Lysimachia L.	Loosestrife; Moneywort	

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<a href="#">MACAD</a>	Macadamia F. Muell.	Macadamia; Queensland Nut	
<a href="#">MALUS</a>	Malus Mill.	Apple	
<a href="#">MALVA</a>	Malva L.	Mallow	
<a href="#">MANDE</a>	Mandevilla Lindl.; Dipladenia A. DC.	Mandevilla	
<a href="#">MANGI_IND</a>	Mangifera indica L.	Mango	
<a href="#">MEDIC</a>	Medicago L.	Alfalfa; Lucerne	
<a href="#">MELIA_AZE</a>	Melia azedarach L.	Bead Tree; Persian Lilac	
<a href="#">MERWI</a>	Merwillia Speta		
<a href="#">MIMET</a>	Mimetes Salisb.	Cape Bottlebrush	
<a href="#">MISCA_GIG</a>	Miscanthus xgiganteus J. M. Greef & Deuter ex Hodk. & Renvoize		
<a href="#">MONAR</a>	Monarda L.	Bee Balm; Bergamot; Horsemint	
<a href="#">MONOP</a>	Monopsis Salisb.	Wild Violet	
<a href="#">MORAE</a>	Moraea Mill.; Homeria Vent.		
<a href="#">MORIN</a>	Moringa		
<a href="#">MURRA_PAN</a>	Murraya paniculata (L.) Jack		
<a href="#">MUSAA_ACU</a>	Musa acuminata Colla; Musa cavendishii Lamb.	Banana; Cavendish banana; Chinese banana; Dwarf banana	
<a href="#">NANDI</a>	Nandina		
<a href="#">NARCI</a>	Narcissus L.	Daffodil; Jonquil; Narcissus	
<a href="#">NEMES</a>	Nemesia Vent.	Nemesia	
<a href="#">NEONO_WIG</a>	Neonotonia wightii (Wight & Arn.) J. A. Lackey; Glycine javanica auct., non L.; Glycine wightii grahan ex a mott ver		
<a href="#">NEPHR</a>	Nephrolepis Schott	Ladder Fern; Sword-fern	
<a href="#">NERIN</a>	Nerine Herb.	Nerine	
<a href="#">NERIU</a>	Nerium L.	Oleander; Rose Bay	
<a href="#">NICOT_TAB</a>	Nicotiana tabacum L.	Tobacco (common)	
<a href="#">OCIMU_BAS</a>	Ocimum basilicum L.	Basil	
<a href="#">OLEAA</a>	Olea; Olea L.	Olive	
<a href="#">OPHIO</a>	Ophiopogon Ker -Gawl.; Ophiopogon Ker Gawl.; Ophiopogon Ker-Gawl.	Lilyturf; Mondo; Snake's Beard	
<a href="#">ORNTG</a>	Ornithogalum L.	Chinkerinchee; Star of Bethlehem	
<a href="#">ORNTP_COM</a>	Ornithopus compressus L.		
<a href="#">ORNTP_SAT</a>	Ornithopus sativus Brot.; Ornithopus intybus L.	Serradella	
<a href="#">OROTH</a>	Orothamnus Papp ex Hook.	Marsh Rose	
<a href="#">ORYZA_SAT</a>	Oryza sativa L.	Rice	
<a href="#">OSTEO</a>	Osteospermum L.	Osteospermum	
<a href="#">PANDO</a>	Pandorea (Endl.) Spach.	Pandorea	



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<a href="#">PANDO_JAS</a>	<i>Pandorea jasminoides</i> (Lindl.) K. Schum.	Bowerplant	
<a href="#">PANIC</a>	<i>Panicum</i> L.	Panicum	
<a href="#">PARAH_CAT</a>	<i>Parahebe catarractae</i> (G. Forst.) W. R. B. Oliv.		
<a href="#">PARAN</a>	<i>Paranomus</i> Salisb.	Paranomus	
<a href="#">PASPA</a>	<i>Paspalum</i>		
<a href="#">PASPA_DIL</a>	<i>Paspalum dilatatum</i> Poir.	Dallisgrass	
<a href="#">PASSI</a>	<i>Passiflora</i> L.		Excluding <i>P. caerulea</i> , <i>P. tripartita</i> var. <i>mollissima</i> , <i>P. suberosa</i> and <i>P. subpeltata</i>
<a href="#">PASTI_SAT</a>	<i>Pastinaca sativa</i> L.	Parsnip	
<a href="#">PELAR</a>	<i>Pelargonium</i> L'Hér. ex Ait.; <i>Pelargonium hederifolium</i> Salisb.; <i>Pelargonium</i> L'Hérit. ex Ait.	Geranium; Pelargonium	
<a href="#">PENNI_CLA</a>	<i>Pennisetum clandestinum</i> Hochst. ex Chiov.		
<a href="#">PENNI_GLA</a>	<i>Pennisetum glaucum</i> (L.) R. Br.; <i>Pennisetum americanum</i> (L.) Leeke; <i>Pennisetum glaucum</i> (L.) R. Br. emend. Stuntz; <i>Pennisetum typhoides</i> (Burm. f.) Stapf & C. E. Hubb.; <i>Pennisetum typhoides</i> (Burm. f.) Stapf et C.E. Hubb.	Pearl Millet	
<a href="#">PENTA</a>	<i>Pentas</i> Benth.	Pentas	
<a href="#">PERIC</a>	<i>Pericallis</i> D. Don		
<a href="#">PERSE_AME</a>	<i>Persea americana</i> Mill.	Avocado	
<a href="#">PETRO_CRI</a>	<i>Petroselinum crispum</i> (Mill.) Nyman ex A. W. Hill; <i>Petroselinum hortense</i> auct.; <i>Petroselinum sativum</i> Hoffm.	Parsley	
<a href="#">PETUN</a>	<i>Petunia</i> Juss.	Petunia	
<a href="#">PHALR_AQU</a>	<i>Phalaris aquatica</i> L.; <i>Phalaris stenoptera</i> Hack.; <i>Phalaris tuberosa</i> L.	Harding's Grass	
<a href="#">PHALR_ARU</a>	<i>Phalaris arundinacea</i> L.	Reed Canary Grass	
<a href="#">PHASE_COC</a>	<i>Phaseolus coccineus</i> L.	Kidney Bean; Runner Bean	
<a href="#">PHASE_VUL</a>	<i>Phaseolus vulgaris</i> L.	French Bean	
<a href="#">PHILO</a>	<i>Philodendron</i> Schott corr. Schott	Philodendron	
<a href="#">PHLOX</a>	<i>Phlox</i> L.	Phlox	
<a href="#">PHOEN_DAC</a>	<i>Phoenix dactylifera</i> L.	Date; Date Palm	
<a href="#">PHORM</a>	<i>Phormium</i> J.R. et G. Forst.; <i>Phormium</i> Forst. et G. Forst.	New Zealand Flax	
<a href="#">PHOTI</a>	<i>Photinia</i> Lindl.	Christmas Berry; Photinia	
<a href="#">PHYSC</a>	<i>Physocarpus</i> (Cambess.) Maxim.		
<a href="#">PHYSS_VIR</a>	<i>Physostegia virginiana</i> (L.) Benth.	Obedient Plant	
<a href="#">PIMEL</a>	<i>Pimelea</i> Banks ex Soland.	Riceflower	
<a href="#">PINUS</a>	<i>Pinus</i> L.	Pine	
<a href="#">PISTA</a>	<i>Pistacia</i> L.	Pistachio	
<a href="#">PISUM</a>	<i>Pisum</i> L.	Pea	
<a href="#">PITTO_TEN</a>	<i>Pittosporum tenuifolium</i> Gaertn.	Kohuhu; Tawhiwhi	

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<a href="#">PLECT</a>	Plectranthus L'Hér.; Coleus Lour.; Plectranthus L'Herit.	Spurflower	
<a href="#">PLUMB</a>	Plumbago L.	Leadwort	
<a href="#">PLYGL</a>	Polygala L.		
<a href="#">POLYP</a>	Polypodium L.	Polypody	
<a href="#">PORTR_AFR</a>	Portulacaria afra (L.) Jacq.	elephant-bush	
<a href="#">POTEN</a>	Potentilla L.	Cinquefoil	
<a href="#">PROTE</a>	Protea L.	Protea; Sugarbush	
<a href="#">PRUNU_ARM</a>	Prunus armeniaca L.; Armeniaca vulgaris Lam.	Apricot	
<a href="#">PRUNU_AVI</a>	Prunus avium (L.) L.; Cerasus avium (L.) Moench	Sweet Cherry	
<a href="#">PRUNU_CSS</a>	Prunus cerasus L.	dwarf cherry; Maraschino cherry; morello cherry; pie cherry; sour cherry; tart cherry	
<a href="#">PRUNU_DOM</a>	Prunus domestica L.; Prunus L. subg. Prunus; Prunus subg. Prunus	Plum	
<a href="#">PRUNU_DUL</a>	Prunus dulcis (Mill.) D. A. Webb; Amygdalus communis L.; Prunus amygdalus Bartock; Prunus communis (L.) Arcang.; Prunus L. subg. Amygdalus	Almond; Sweet Almond	
<a href="#">PRUNU_LAU</a>	Prunus laurocerasus L.; Laurocerasus officinalis M. Roem.	Cherry-laurel	
<a href="#">PRUNU_PER</a>	Prunus persica (L.) Batsch; Persica vulgaris Mill.; Prunus L. subg. Persica	Peach	
<a href="#">PRUNU_SAL</a>	Prunus salicina Lindl.	Japanese Plum; Plum	
<a href="#">PSIDI_GUA</a>	Psidium guajava L.	Guava	
<a href="#">PSYLL</a>	Psylliostachys		
<a href="#">PUNIC_GRA</a>	Punica granatum L.	Pomegranate	
<a href="#">PYRUS</a>	Pyrus L.	Pear	
<a href="#">RAPHA_SAT</a>	Raphanus sativus L.	Daikon; Japanese radish; Radish	
<a href="#">RHODD</a>	Rhododendron L.; Azalea	Azalea; Azaleodendron; Rhododendron	
<a href="#">RHODH</a>	Rhodohypoxis		
<a href="#">RIBES</a>	Ribes L.	Currants; Gooseberry; Ornamental Currant	
<a href="#">RICIN_COM</a>	Ricinus communis L.	Castorbean; Palmi-christi	
<a href="#">ROSAA</a>	Rosa L.	Rose	
<a href="#">ROSMA</a>	Rosmarinus; Rosmarinus L.	Rosemary	
<a href="#">RUBUS</a>	Rubus L.	Blackberry; Bramble; Ornamental Bramble; Raspberry	
<a href="#">RUSCU_ACU</a>	Ruscus aculeatus L.	Box-holly; Butcher's Broom	
<a href="#">SACCH_OFF</a>	Saccharum officinarum L.	Sugar Cane	

<b>UPOV Code</b>	<b>Botanical Names</b>	<b>English</b>	<b>Notes</b>
<a href="#">SAINT_ION</a>	Saintpaulia ionantha H. Wendl.	African Violet	
<a href="#">SALVI</a>	Salvia L.	Sage	
<a href="#">SAMBU</a>	Sambucus L.	Elder	
<a href="#">SARCO</a>	Sarcococca Lindl.		
<a href="#">SCABI</a>	Scabiosa L.	Scabious	
<a href="#">SCADO</a>	Scadoxus Raf.		
<a href="#">SCAEV</a>	Scaevola L.	Scaevola	
<a href="#">SCHLU</a>	Schlumbergera Lem.; Zygocactus K. Schum.	Christmas Cactus; Crab Cactus	
<a href="#">SCHZP</a>	Schizocarphus Van der Merwe		
<a href="#">SCILL</a>	Scilla		
<a href="#">SCLER_BIR_CAF</a>	Sclerocarya birrea (A. Rich.) Hochst. ssp. caffra (Sond.) Kokwaro	Maroola-plum; Marula	
<a href="#">SEARS</a>	Searsia F. A. Barkley		
<a href="#">SECAL_CER</a>	Secale cereale L.	Rye	
<a href="#">SELGO</a>	Selago L.		
<a href="#">SENEC_BRA</a>	Senecio brachypodus DC.		
<a href="#">SERRU</a>	Serruria Salisb.	Blushing Bude; Spider Bush	
<a href="#">SETAR_NIG</a>	Setaria nigrirostris (Nees) Dur. et Schinz	Black-seed Bristle Grass	
<a href="#">SETAR_SPH</a>	Setaria sphacelata (Schumach.) Stapf & C. E. Hubb.; Setaria sphacelata (Schum.) Stapf et C.E. Hubb.	Common Setaria; Congo Grass	
<a href="#">SIDER_INE</a>	Sideroxylon inerme L.		
<a href="#">SINAP_ALB</a>	Sinapis alba L.	White Mustard	
<a href="#">SKIMM</a>	Skimmia Thunb.	Skimmia	
<a href="#">SMPHC_ALB</a>	Symphoricarpos albus (L.) S. F. Blake	common snowberry; snowberry; waxberry	
<a href="#">SOLAN_LYC</a>	Solanum lycopersicum L.; Lycopersicon esculentum Mill.	cherry tomato; tomato; Tomato; tomato	
<a href="#">SOLAN_MEL</a>	Solanum melongena L.	Aubergine, Eggplant	
<a href="#">SOLAN_TUB</a>	Solanum tuberosum L.	Potato	
<a href="#">SPIRA</a>	Spiraea L.	Spirea	
<a href="#">SPORO_FIM</a>	Sporobolus fimbriatus (Trin.) Nees	Rush grass	
<a href="#">SPTHP</a>	Spathiphyllum Schott	Spathe Flower; Spathiphyllum; White Sails	
<a href="#">SRGHM</a>	Sorghum Moench	Sorghum	
<a href="#">STCHT</a>	Stachytarpheta		
<a href="#">STENO_SEC</a>	Stenotaphrum secundatum (Walter) Kuntze	Buffalo Grass; Shore Grass; St. Augustine Grass	
<a href="#">STREL</a>	Strelitzia Ait.	Bird of Paradise Flower	
<a href="#">STYLO_HAM</a>	Stylosanthes hamata (L.) Taub.		
<a href="#">SUTER</a>	Sutera Roth; Sutera L.	Sutera	
<a href="#">SYZYG</a>	Syzygium Gaertn.	Syzygium; Water-wood Tree; Waterwood Tree	
<a href="#">TAGET</a>	Tagetes L.	Marigold	
<a href="#">TANAC</a>	Tanacetum L.		
<a href="#">THUJA_OCC</a>	Thuja occidentalis L.	Thuja; White-cedar	

<b>UPOV Code</b>	<b>Botanical Names</b>	<b>English</b>	<b>Notes</b>
<a href="#">TIBOU</a>	Tibouchina Aubl.	Glory Bush Tree; Tibouchina	
<a href="#">TRFOL</a>	Trifolium L.	Clover	
<a href="#">TRITI</a>	Triticum L.	Wheat	
<a href="#">TRITL</a>	×Triticosecale Wittm. ex A. Camus; ×Triticale; ×Triticosecale Wittmack	Triticale	
<a href="#">TROPA</a>	Tropaeolum L.	Nasturtium	
<a href="#">TULBA</a>	Tulbaghia L.; Tulbaghia L. corr Giseke	Society Garlic; Wild Garlic	
<a href="#">UROCH BRI</a>	Urochloa brizantha (Hochst. ex A. Rich.) R. D. Webster; Brachiaria brizantha (Hochst. ex A. Rich.) Stapf; Panicum brizanthum Hochst. ex A. Rich.	Bread Grass; Palisade grass; Palisade signal grass; Signal grass	
<a href="#">VACCI</a>	Vaccinium L.	Bilberry; Cowberry; Cranberry; Ornamental Vaccinium; Whortleberry	
<a href="#">VELTH</a>	Veltheimia Gled.		
<a href="#">VERBA</a>	Verbascum L.	Mullein	
<a href="#">VERBE</a>	Verbena L.	Vervain	
<a href="#">VERON</a>	Veronica L.	Speedwell	
<a href="#">VICIA FAB MAJ</a>	Vicia faba L. var. major Harz	Broad Bean; Horse Bean	
<a href="#">VICIA SAT</a>	Vicia sativa L.	Common Vetch	
<a href="#">VICIA VIL</a>	Vicia villosa Roth; Vicia dasycarpa; Vicia dasycarpa Ten.	Hairy Vetch	
<a href="#">VIGNA SUB</a>	Vigna subterranea (L.) Verdc.; Voandzeia subterranea (L.) Thouars ex DC.		
<a href="#">VIGNA UNG</a>	Vigna unguiculata (L.) Walp.	Cowpea	
<a href="#">VINCA</a>	Vinca L.	Periwinkle	
<a href="#">VIOLA</a>	Viola L.	Pansy; Violet	
<a href="#">VITIS</a>	Vitis L.	Grapevine	
<a href="#">WATSO</a>	Watsonia		
<a href="#">WEINM</a>	Weinmannia		
<a href="#">XEROC</a>	Xerochrysum Tzvelev; Bracteantha Anderb. & Haegi		
<a href="#">XNTHO</a>	Xanthosoma Schott		
<a href="#">YUCCA FIL</a>	Yucca filamentosa L.	Adam's-needle; bear-grass; needle-palm; silk-grass; spoon-leaf yucca	
<a href="#">ZANTE</a>	Zantedeschia Spreng.	Arum-lily; Calla	
<a href="#">ZEAAA MAY</a>	Zea mays L.	Corn; Maize	
<a href="#">ZIZIP JUJ</a>	Ziziphus jujuba Mill.	Chinese jujube; Chinese-date; Common jujube; Jujube	

## TRINIDAD AND TOBAGO

On November 30, 2012, the Office of the Union received a notification that the legislation governing breeders' rights of Trinidad and Tobago applies to the following consolidated list of genera and species:

- Anthuriums
- Bromeliaceae
- Heliconiaceae
- Orchidaceae
- Sterculiaceae
- *Cajanus cajans*
- *Vigna sp.*
- *Theobroma cacao L.*

## VIET NAM

On August 8, 2013, the Office of the Union received a notification that the Minister for Agriculture and Rural Development has issued Circular No. 11/2013/TT-BNNPTNT providing that the legislation governing breeders' rights of Viet Nam applies to the following additional genera and species since March 22, 2013:

Tên Việt Nam Vietnamese name	Tên khoa học Latin name
1. Bầu	<i>Lagenaria sinceraria</i> (Molina) Stanley
2. Cải thảo	<i>Brassica pekinensis</i> Lour. Rupr.
3. Cần tây	<i>Apium graveolens</i> L.
4. Đậu tằm	<i>Vicia faba</i> L. var. major Harz
5. Dẻ	<i>Castanea sativa</i> Mill.
6. Dứa	<i>Ananas comosus</i> (L.) Merr.
7. Đậu Bắp	<i>Abelmoschus esculentus</i> (L.) Moench.
8. Hồng	<i>Diospyros kaki</i> L.
9. Hướng dương	<i>Helianthus annuus</i> L.
10. Khoai môn	<i>Colocasia esculenta</i> (L.) Schott
11. Lan (Hòa thảo)	<i>Dendrobium</i> Sw.
12. Lan Mokara	<i>Mokara</i> .
13. Lê	<i>Pyrus communis</i> L.
14. Mận	<i>Prunus salicina</i> Lindl.
15. Rau muống	<i>Ipomoea aquatica</i>
16. Sắn	<i>Manihot esculenta</i> Crantz
17. Thuốc lá	<i>Nicotiana tabacum</i> L.
18. Thược dược	<i>Dahlia</i> Cav.
19. Trinh nữ hoàng cung	<i>Cranium latifolium</i> L.
20. Tulíp	<i>Tulipa</i> L.
21. Xương rồng	Nhóm Chumbera, Nopal tunero, Tuna và Nhóm Xocnostles

## LEGISLATION

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### AUSTRALIA



#### **Plant Breeder's Rights Act 1994**

#### **Plant Breeder's Act 1994 as amended in 2012**

#### **Act No. 110 of 1994 as amended**

This compilation was prepared on 24 May 2012  
taking into account amendments up to Act No. 35 of 2012

The text of any of those amendments not in force  
on that date is appended in the Notes section

The operation of amendments that have been incorporated may be  
affected by application provisions that are set out in the Notes section

Prepared by the Office of Legislative Drafting and Publishing,  
Attorney-General's Department, Canberra

### **An Act to provide for the granting of proprietary rights to breeders of certain new varieties of plants and fungi, to repeal the *Plant Variety Rights Act 1987*, and for related purposes**

#### **Part 1—Preliminary**

##### **1 Short title** [see Note 1]

This Act may be cited as the *Plant Breeder's Rights Act 1994*.

##### **2 Commencement** [see Note 1]

- (1) Subject to subsection (2), the provisions of this Act commence on a day to be fixed by Proclamation.
- (2) If a provision of this Act does not commence under subsection (1) within the period of 6 months commencing on the day on which this Act receives the Royal Assent, it commences on the first day after the end of that period.

##### **3 Definitions**

- (1) In this Act, unless the contrary intention appears:

**AAT** means the Administrative Appeals Tribunal.

**AAT Act** means the *Administrative Appeals Tribunal Act 1975*.

**Advisory Committee** means the Plant Breeder's Rights Advisory Committee established by section 63.

**applicant**, in relation to an application, means the person currently shown in the application as the person making the application.

**application** means an application under section 24 for PBR in a plant variety to which this Act extends.

**approved form** means a form approved by the Secretary for the purposes of the provision in which the expression appears.

**breeder**, in relation to a new plant variety, means:

- (a) subject to paragraph (c), if the variety was bred by one person only—the person; or
- (b) subject to paragraph (c), if the variety was bred by 2 or more persons (whether jointly or independently and whether at the same time or different times)—each of those persons; or
- (c) if the variety was bred:
  - (i) by a person in the course of performing duties or functions as a member or employee of a body (whether incorporate or unincorporate); or
  - (ii) by 2 or more persons in the course of performing duties as a member or employee of such a body;

the body of which that person or each of those persons is a member or employee;

and includes any person or body that is the successor in title to the person referred to in paragraph (a), to any of the persons referred to in paragraph (b) or the body referred to in paragraph (c).

**conditioning**, in relation to propagating material of a plant variety, means:

- (a) cleaning, coating, sorting, packaging or grading of the material; or
- (b) any other similar treatment;

undertaken for the purpose of preparing the material for propagation or sale.

**contracting party** means a State, or an intergovernmental organisation, that is a party to the Convention.

**Convention** means the International Convention for the Protection of New Varieties of Plants, a copy of the English text of which is set out in the Schedule.

**Court** means the Federal Court of Australia.

**dependent plant variety**, in relation to another plant variety in which a person holds PBR in Australia, means a plant variety over which PBR in the other plant variety extends under section 13.

**essential characteristics**, in relation to a plant variety, means heritable traits that are determined by the expression of one or more genes, or other heritable determinants, that contribute to the principal features, performance or value of the variety.

**genetic resource centre** means a place that the Secretary declares to be a genetic resource centre under subsection 70(1).

**grantee**:

- (a) in relation to PBR in a plant variety—means the person currently entered on the Register as the holder of that right in that variety; and

- (b) in relation to PBR in a plant variety declared to be an essentially derived variety of another plant variety—includes the person currently entered on the Register as the holder of that right in relation to that other plant variety.

**herbarium** means the organisation that the Secretary declares to be the herbarium under section 71.

**hybrid** means a plant that is a combination of 2 or more genotypes of the same or different taxa but excluding a combination comprising a scion grafted on to a root stock.

**indigenous** means:

- (a) a member of the Aboriginal race of Australia; or  
 (b) a descendant of the indigenous inhabitants of the Torres Strait Islands.

**member** means a member of the Advisory Committee and includes the Registrar.

**PBR**, in a plant variety, means the plant breeder's right specified in section 11.

**PBR**, in respect of a plant variety registered in another contracting party, means a plant breeder's right corresponding to the right specified in section 11 conferred under the law of that contracting party.

**PBR office** means place of work of the Registrar or a person who is engaged under the *Public Service Act 1999* or otherwise for or on behalf of the Commonwealth and whose duties involve providing assistance to the Registrar.

**PBR sub-office** means place of work in a single State of the Registrar or a person who is engaged under the *Public Service Act 1999* or otherwise for or on behalf of the Commonwealth and whose duties involve providing assistance to the Registrar.

**plant** includes all fungi and algae but does not include bacteria, bacteroids, mycoplasmas, viruses, viroids and bacteriophages.

**plant class**, for the purpose of variety denomination, means a class consisting of all plants:

- (a) that belong to a single botanical genus; or  
 (b) that belong to a group of closely related genera;

that is specified from time to time as a plant class in the Registrar's List of Plant Classes maintained under subsection 61(1A).

**plant variety** means a plant grouping (including a hybrid):

- (a) that is contained within a single botanical taxon of the lowest known rank; and  
 (b) that can be defined by the expression of the characteristics resulting from the genotype of each individual within that plant grouping; and  
 (c) that can be distinguished from any other plant grouping by the expression of at least one of those characteristics; and  
 (d) that can be considered as a functional unit because of its suitability for being propagated unchanged.

Note: Plant groupings for the purposes of this definition include genetically modified plant groupings. See section 6.

**process**, in relation to the reproduction of propagating material, of a plant variety does not include:

- (a) the development of a cell or tissue or a plant part into a plant of that variety;  
 or  
 (b) the growth of a plant into a larger plant of that variety.

**propagating material**, in relation to a plant of a particular plant variety, means any part or product from which, whether alone or in combination with other parts or



products of that plant, another plant with the same essential characteristics can be produced.

**propagation**, in relation to a living organism or its components, means the growth, culture or multiplication of that organism or component, whether by sexual or asexual means.

**Register** means the Register of Plant Varieties kept under section 61.

**Registrar** means the Registrar of Plant Breeder's Rights.

**reproduction**, in relation to propagating material of a plant of a particular variety, means any process, whereby the number of units of that propagating material that have the capacity to grow into independent plants is multiplied.

**Secretary** means the Secretary of the Department.

**sell** includes letting on hire and exchanging by way of barter.

**successor** means:

- (a) in relation to a breeder of a plant variety—a person to whom the right of the breeder to make application for PBR in that variety has been assigned, or transmitted by will or by operation of law; and
- (b) in relation to a grantee of PBR—a person to whom that right has been assigned, or transmitted by will or by operation of law.

**synonym**, in relation to the name of a plant variety, means a name that:

- (a) is included in an application in addition to the name of the variety; and
- (b) is a name by which the variety will be known or sold in Australia.

**test growing** includes a comparative test growing.

**Union** means the Union for the Protection of New Varieties of Plants as defined in Article 1 of the Convention.

**will** includes a codicil.

- (2) If a provision of this Act requires or authorises the Secretary or the Registrar to give written notice of any matter to a particular person and does not specify the means of giving that notice, that provision is to be taken, for the purposes of section 29 of the *Acts Interpretation Act 1901* to authorise or require the Secretary or Registrar to serve the notice on the person personally or by post.

#### 4 Definition of essentially derived varieties

A plant variety is taken to be an essentially derived variety of another plant variety if:

- (a) it is predominantly derived from that other plant variety; and
- (b) it retains the essential characteristics that result from the genotype or combination of genotypes of that other variety; and
- (c) it does not exhibit any important (as distinct from cosmetic) features that differentiate it from that other variety.

#### 5 Definition of breeding

- (1) A reference in this Act to breeding, in relation to a new plant variety, includes a reference to the discovery of a plant together with its use in selective propagation so as to enable the development of the new plant variety.

- (2) If a plant is discovered by one person but used in selective propagation by another so as to enable the development of a new plant variety, those persons are together taken to be the joint breeders of the new plant variety.

## 6 Genetic modification

For the purposes of this Act, an organism may be treated as constituting a plant grouping within a single botanical taxon despite the fact that the genome of the plants in that plant grouping has been altered by the introduction of genetic material that is not from plants.

## 8 Approved persons

- (1) In this Act, a reference to an approved person is a reference to a person who, on the basis of the person's qualifications and experience, the Secretary has designated, by instrument in writing, to be such a person in relation to one of more species of plant.
- (2) The Registrar must, from time to time, cause lists of all persons who are approved persons in relation to particular species of plant to be published in the *Plant Varieties Journal*.

## 9 Act to bind Crown

- (1) This Act binds the Crown in right of the Commonwealth, of each of the States, of the Australian Capital Territory and of the Northern Territory.
- (2) Nothing in this Act renders the Crown, in any of its capacities, liable to be prosecuted for an offence.

## 9A Application of the *Criminal Code*

Chapter 2 (other than Part 2.5) of the *Criminal Code* applies to all offences against this Act.

Note: Chapter 2 of the *Criminal Code* sets out the general principles of criminal responsibility.

## 10 Extent of Act

Nothing in this Act requires or permits the granting of PBR in a plant variety unless:

- (a) if Australia is a party to the Convention—the grant is appropriate to give effect to the obligations of Australia under the Convention; or
- (b) the breeding of the plant variety constitutes an invention for the purpose of paragraph 51(xviii) of the Constitution.

## Part 2—Plant breeder's right

### 11 General nature of PBR

Subject to sections 16, 17, 18, 19 and 23, PBR in a plant variety is the exclusive right, subject to this Act, to do, or to license another person to do, the following acts in relation to propagating material of the variety:

- (a) produce or reproduce the material;
- (b) condition the material for the purpose of propagation;
- (c) offer the material for sale;
- (d) sell the material;
- (e) import the material;
- (f) export the material;
- (g) stock the material for the purposes described in paragraph (a), (b), (c), (d), (e) or (f).

Note: In certain circumstances, the right conferred by this section extends to essentially derived varieties (see section 12), certain dependent plant varieties (see section 13), harvested material (see section 14) and products obtained from harvested material (see section 15).

### 12 Extension of PBR to cover essentially derived varieties

Subject to section 23, if:

- (a) PBR is granted to a person in a plant variety (the *initial variety*); and
- (b) PBR is granted to another person in another plant variety; and
- (c) the Secretary makes a declaration, on application by the first-mentioned person, that the other plant variety is an essentially derived variety from the initial variety;

the right granted in the initial variety extends, with effect from the date of the declaration, to that other plant variety.

### 13 Extension of PBR to cover certain dependent plant varieties

Subject to section 23, if PBR is granted in a plant variety (the *initial variety*), the right extends to:

- (a) any other plant variety that:
  - (i) is not clearly distinguishable from the initial variety; and
  - (ii) is clearly distinguishable from any plant variety that was a matter of common knowledge at the time of the grant of PBR in the initial variety; and
- (b) any other plant variety that cannot be reproduced except by the repeated use of the initial variety or of a variety referred to in paragraph (a);

whether or not that other plant variety was in existence at the time PBR was granted in the initial variety.

### 14 Extension of PBR to harvested material in certain circumstances

(1) If:

- (a) propagating material of a plant variety covered by PBR is produced or reproduced without the authorisation of the grantee; and
- (b) the grantee does not have a reasonable opportunity to exercise the grantee's right in relation to the propagating material; and
- (c) material is harvested from the propagating material;

section 11 operates as if the harvested material were propagating material.

- (2) Subsection (1) applies to so much of the material harvested by a farmer from propagating material conditioned and reproduced in the circumstances set out in subsection 17(1) as is not itself required by the farmer, for the farmer's own use, for reproductive purposes.

#### **15 Extension of PBR to products obtained from harvested material in certain circumstances**

If:

- (a) propagating material of a plant variety covered by PBR is produced or reproduced without authorisation of the grantee; and
- (b) the grantee does not have a reasonable opportunity to exercise the grantee's rights in relation to the propagating material; and
- (c) material is harvested from plants grown from the propagating material but the grantee does not have, in the circumstances set out in section 14, a reasonable opportunity of exercising the grantee's rights in the harvested material; and
- (d) products are made from the harvested material;

section 11 operates as if those products were propagating material.

#### **16 Certain acts done for private, experimental or breeding purposes do not infringe PBR**

Any act done in relation to a plant variety covered by PBR that is done:

- (a) privately and for non-commercial purposes; or
- (b) for experimental purposes; or
- (c) for the purpose of breeding other plant varieties;

does not infringe the PBR.

#### **17 Conditioning and use of farm saved seed does not infringe PBR**

(1) If:

- (a) a person engaged in farming activities legitimately obtains propagating material of a plant variety covered by PBR either by purchase or by previous operation of this section, for use in such activities; and
- (b) the plant variety is not included within a taxon declared under subsection (2) to be a taxon to which this subsection does not apply; and
- (c) the person subsequently harvests further propagating material from plants grown from that first-mentioned propagating material;

the PBR is not infringed by:

- (d) the conditioning of so much of that further propagating material as is required for the person's use for reproductive purposes; or
- (e) the reproduction of that further propagating material.

- (2) The regulations may declare a particular taxon to be a taxon to which subsection (1) does not apply.

#### **18 Restriction on grantee's rights in certain circumstances**

(1) If:

- (a) a person is authorised by or under a law of the Commonwealth or of a State or Territory to do an act referred to in a paragraph of section 11 in relation to propagating material of a plant variety; and
- (b) the act is one which (apart from this provision) would require authorisation from the grantee of PBR in the plant variety; and

- (c) before the person does the act, the person either pays equitable remuneration to the grantee in respect of the act or arranges for the payment of such remuneration; and
  - (d) the person does the act;
- then the grantee is not entitled to exercise PBR in the plant variety against the person in respect of that act.
- (2) To avoid doubt, subsection (1) does not limit the operation of section 17 in relation to the conditioning or reproduction of propagating material in the circumstances referred to in that section.
  - (3) In this section:
    - equitable remuneration**, in relation to an act done in relation to propagating material of a plant variety, means an amount:
      - (a) that is agreed between the person proposing to undertake the act and the grantee of PBR in the plant variety; or
      - (b) if agreement cannot be reached under paragraph (a)—determined by a court of competent jurisdiction to constitute equitable remuneration in relation to the act.

### 19 Reasonable public access to plant varieties covered by PBR

- (1) Subject to subsection (11), the grantee of PBR in a plant variety must take all reasonable steps to ensure reasonable public access to that plant variety.
- (2) Reasonable public access to a plant variety covered by PBR is taken to be satisfied if propagating material of reasonable quality is available to the public at reasonable prices, or as gifts to the public, in sufficient quantities to meet demand.
- (3) For the purpose of ensuring reasonable public access to a plant variety covered by PBR, the Secretary may, on behalf of the grantee, in accordance with subsections (4) to (10), license a person whom the Secretary considers appropriate:
  - (a) to sell propagating material of plants of that variety; or
  - (b) to produce propagating material of plants of that variety for sale;during such period as the Secretary considers appropriate and on such terms and conditions (including the provision of reasonable remuneration to the grantee) as the Secretary considers would be granted by the grantee in the normal course of business.
- (4) If, at any time more than 2 years after the grant of PBR in a plant variety, a person considers:
  - (a) that the grantee is failing to comply with subsection (1) in relation to the variety; and
  - (b) that the failure affects the person's interests;the person may make a written request to the Secretary to exercise a power under subsection (3) in relation to the variety.
- (5) A request must:
  - (a) set out the reasons why the person considers that the grantee is failing to comply with subsection (1); and
  - (b) give particulars of the way in which the person considers that the failure affects the person's interests; and
  - (c) give an address of the person for the purposes of notifications under this section.

- (6) The Secretary must give the grantee:
- (a) a copy of the request; and
  - (b) a written invitation to give the Secretary, within 30 days after giving the request, a written statement of the reasons the Secretary should be satisfied that the grantee:
    - (i) is complying with subsection (1) in relation to the variety; or
    - (ii) will so comply within a reasonable time.
- (7) The Secretary must, after considering the request and any statement given by the grantee in response to the invitation under paragraph (6)(b):
- (a) decide whether or not to exercise the power concerned; and
  - (b) within 30 days after so deciding, give written notice of the decision to the grantee and to the person making the request.

Note: A decision under this subsection is reviewable by the AAT under section 77.

- (8) If the Secretary proposes to exercise a power under subsection (3) in relation to a plant variety, the Secretary must give public notice:
- (a) identifying the variety; and
  - (b) setting out particulars of any licence the Secretary proposes to grant; and
  - (c) inviting persons to apply in writing to the Secretary, within 30 days of the publication of the notice, to be granted that licence.
- (9) The Secretary must not grant any such licence unless:
- (a) the Secretary has considered all applications made in response to the invitation; and
  - (b) at least one month before granting any such licence, the Secretary has:
    - (i) given written notice to each such applicant of the name of the proposed licensee; and
    - (ii) given public notice of the name of the proposed licensee.
- (10) If the Secretary:
- (a) has granted a person a licence to produce propagating material of plants of a particular variety; and
  - (b) is satisfied that the person will be unable to obtain such propagating material at a reasonable price or without charge;
- the Secretary may, on behalf of the grantee, make that propagating material available to the person from material stored at a genetic resource centre.

Note: A decision under this subsection to make propagating material available is reviewable by the AAT under section 77.

- (11) This section does not apply in relation to a plant variety in respect of which the Secretary certifies, in writing, at the time of the grant of PBR, that he or she is satisfied that plants of that variety have no direct use as a consumer product.

Note: A decision under this subsection is reviewable by the AAT under section 77.

## 20 PBR is personal property

- (1) PBR is personal property and, subject to any conditions imposed under section 49, is capable of assignment, or of transmission by will or by operation of law.
- (2) An assignment of PBR (otherwise than because of the order of a court) does not have effect unless it is in writing signed by, or on behalf of, the assignor and assignee.
- (3) If a grantee of PBR in a plant variety gives another person a licence in that right, the licence binds every successor in title to the interest of that grantee to the same extent as it was binding on that grantee of the PBR.

Note 1: The *Personal Property Securities Act 2009* applies to PBR, and any licence in PBR, as **intellectual property** (see paragraph (d) of the definition of that phrase in section 10 of that Act). That Act deals with security interests in personal property, including intellectual property and intellectual property licences.

Note 2: Section 106 of the *Personal Property Securities Act 2009* corresponds to subsection 20(3) of this section. Section 106 of that Act provides for security agreements in relation to intellectual property licences (or sub-licences) to be binding on successors in title to the licences (or sub-licences).

## 21 Registrar must be notified of an assignment of PBR

- (1) If a person (the **claimant**) claims that PBR was assigned or transmitted to the claimant, the claimant must inform the Registrar in writing that the claimant has acquired that right, giving particulars of the manner in which that right was acquired, within 30 days after acquiring that right.
- (2) If the Registrar is satisfied that the right has been so assigned or transmitted, the Registrar must amend the Register by entering the name of the claimant as the holder of that right.
- (3) If the Registrar enters the name of the claimant on the Register as the holder of PBR, the Registrar must, within 30 days after entering the name, give written notice to the claimant and to the person who was the holder before the entry was made, stating that the entry has been made.
- (4) If the Registrar is not satisfied that PBR has been assigned or transmitted to the claimant, the Registrar must, as soon as possible:
  - (a) give written notice to the claimant:
    - (i) telling the claimant that the Registrar is not so satisfied; and
    - (ii) setting out the reasons why the Registrar is not so satisfied; and
  - (b) give written notice to the person entered on the Register as the holder of the right:
    - (i) setting out particulars of the information given by the claimant; and
    - (ii) telling the claimant that the Registrar is not so satisfied; and
    - (iii) setting out the reasons why the Registrar is not so satisfied.
- (5) A claimant must include, in the notice to the Registrar informing of the assignment or transmission, an address in Australia for the service of documents in accordance with this Act.

Note: A decision under this section to amend or to refuse to amend the Register is reviewable by the AAT under section 77.

## 22 Duration of PBR

- (1) Subject to subsections (4) and (5), PBR in a plant variety begins on the day that the grant of PBR in the variety is made.
- (2) Subject to subsections (3), (4) and (5), PBR in a plant variety lasts for:
  - (a) in the case of trees and vines—25 years; and
  - (b) for any other variety—20 years.
- (3) The regulations may provide that PBR in a plant variety included within a specified taxon lasts for a longer period than is specified in subsection (2).
- (4) PBR in a plant variety that is a dependent plant variety of another plant variety begins on:
  - (a) the day that the grant of PBR in the other plant variety is made; or
  - (b) the day that dependent variety comes into existence;whichever occurs last, and ends when PBR in the other variety ceases.

- (5) If:
- (a) PBR is held in a plant variety (the **initial variety**); and
  - (b) another plant variety is declared under section 40 to be an essentially derived variety of the initial variety;

PBR in the initial variety extends to the essentially derived variety from the day on which that declaration is made until the day on which PBR in the initial variety ends.

### 23 Exhaustion of PBR

- (1) PBR granted in a plant variety does not extend to any act referred to in section 11:
- (a) in relation to propagating material of the variety; or
  - (b) in relation to propagating material of any essentially derived variety or dependent plant variety;
- that takes place after the propagating material has been sold by the grantee or with the grantee's consent unless that act:
- (c) involves further production or reproduction of the material; or
  - (d) involves the export of the material:
    - (i) to a country that does not provide PBR in relation to the variety; and
    - (ii) for a purpose other than final consumption.
- (2) If:
- (a) a plant variety is declared to be an essentially derived variety of another plant variety (the **initial variety**); and
  - (b) PBR in the essentially derived variety is held both by the grantee of PBR in the essentially derived variety and by the grantee of PBR in the initial variety;
- the reference in subsection (1) to propagating material sold by the grantee or with the grantee's consent is a reference to propagating material sold by, or with the consent of, both of the grantees referred to in paragraph (b).
- (3) If, under subsection 18(1), equitable remuneration is paid, or arranged to be paid, to the grantee of PBR in a plant variety in respect of an act (the **first act**) in relation to propagating material of that variety before the person does the act, PBR in that variety does not extend to any later act (the **later act**) referred to in section 11 in relation to that propagating material unless the later act:
- (a) involves the further production or reproduction of that propagating material; or
  - (b) involves the export of the material:
    - (i) to a country that does not provide PBR in relation to the variety; and
    - (ii) for a purpose other than final consumption.
- (4) To avoid doubt, nothing in subsection (1) or (3) prevents the exercise of the rights of the grantee of PBR in a plant variety in relation to any propagating material of that variety that is obtained by reproduction of the propagating material to which that subsection applies.



## Part 3—Application for plant breeder's right

### Division 1—The making of the application

#### 24 Right to apply for PBR

- (1) A breeder of a plant variety may make application to the Secretary for the grant of a PBR in the variety.
- (2) The breeder can make the application whether or not:
  - (a) the breeder is an Australian citizen; and
  - (b) the breeder is resident in Australia; and
  - (c) the variety was bred in Australia.
- (3) Subject to subsection (4), if 2 or more persons bred a plant variety jointly, those persons or some of them may make a joint application for that right.
- (4) If 2 or more persons bred a plant variety jointly, one of those persons is not entitled to apply for PBR in the variety otherwise than jointly with, or with the consent in writing of, each other of those persons.

#### 25 Right to apply for PBR is personal property

- (1) The right of a breeder of a plant variety to apply for PBR is personal property and is capable of assignment and of transmission by will or by operation of law.
- (2) An assignment of a right to apply for PBR must be in writing signed by or on behalf of the assignor.

Note: The *Personal Property Securities Act 2009* deals with security interests in personal property, including a right to apply for PBR.

#### 26 Form of application for PBR

- (1) An application for PBR in a plant variety must:
  - (a) be in writing; and
  - (b) be in an approved form; and
  - (c) be lodged in a manner set out in the approved form.
- (2) The application must contain:
  - (a) the name and address of the applicant; and
  - (b) if the applicant is using an agent to make the application on the applicant's behalf—the name and address of the agent; and
  - (c) if the applicant is the breeder of the variety—a statement of that effect; and
  - (d) if the applicant is not the breeder of the variety—the name and address of the breeder and particulars of the assignment, or transmission by will or by operation of law, of the right to make the application; and
  - (e) a brief description, or a brief description and photograph, of a plant of the variety sufficient to establish a *prima facie* case that the variety is distinct from other varieties of common knowledge; and
  - (f) the name of the variety, having regard to the requirements of section 27, and any proposed synonym for that name; and
  - (g) the name of the location at which the variety was bred; and
  - (ga) the name of each variety (the **parent variety**) used in the breeding program including, in respect of each parent variety:
    - (i) particulars of the names (including synonyms) by which the parent variety is known or sold in Australia; and

- (ii) particulars of any PBR granted in Australia or in any other contracting party; and
- (gb) a brief description of the manner in which the variety was bred; and
- (h) particulars of any application for, or grant of, rights of any kind in the variety in any other country; and
- (i) the name of an approved person who:
  - (i) will verify the particulars in the application; and
  - (ii) will supervise any test growing or further test growing of the variety required under section 37; and
  - (iii) will verify a detailed description of the variety when such a description is supplied to the Secretary;
- (j) such other particulars (if any) as are required by the approved form.

Note: The information given under paragraph (ga) is not available to the public under section 36.

- (3) If an applicant is resident overseas, the applicant must, unless the applicant has appointed an agent resident in Australia to act on the applicant's behalf in the application, specify, in addition to any address overseas, a postal address in Australia for the service of notices on the applicant.
- (4) An applicant must, before, or at the time of, lodging an application under this section, pay to the Commonwealth such application fee (if any) as is prescribed.

## 27 Names of new plant varieties

- (1) If PBR has not been granted in another contracting party in a plant variety before an application for that right in that variety is made in Australia, the name set out in the application must comply with subsections (4), (5), (6) and (7).
- (2) If, before making an application in Australia for PBR in a plant variety, PBR has been granted in that variety in another contracting party:
  - (a) the name of the variety set out in the Australian application must be the name under which PBR was first granted in another contracting party; but
  - (b) there may, and, if the name referred to in paragraph (a) does not comply with subsections (4), (5), (6) and (7) there must, also be included in the application a synonym, additional to the name of the variety.
- (3) The synonym must be a name determined in accordance with subsections (4), (5), (6) and (7) as if the variety had not been the subject of a grant of PBR in another contracting party.
- (3A) If, before making an application in Australia for PBR in a plant variety, PBR has not been granted in that variety in another contracting party, a synonym may also be included in the application.
- (4) A name (including a synonym), in respect of a plant variety, must be a word or words (whether invented or not) with or without the addition of either or both of the following:
  - (a) a letter or letters that do not constitute a word;
  - (b) a figure or figures.
- (5) A name (including a synonym), in respect of a plant variety must not:
  - (a) be likely to deceive or cause confusion, including confusion with the name of another plant variety of the same plant class; or
  - (b) be contrary to law; or
  - (c) contain scandalous or offensive matter; or
  - (d) be prohibited by regulations in force at the time of the application; or

- (e) be or include a trade mark that is registered, or whose registration is being sought, under the *Trade Marks Act 1995*, in respect of live plants, plant cells and plant tissues.
- (6) A name (including a synonym), in respect of a plant variety must comply with the International Code of Botanical Nomenclature and subsidiary codes.
- (7) A name (including a synonym), in respect of a plant variety must not consist of, or include:
  - (a) the name of a natural person living at the time of the application unless the person has given written consent to the name of the variety; or
  - (b) the name of a natural person who died within the period of 10 years before the application unless the legal personal representative of the person has given written consent to the name of the variety; or
  - (c) the name of a corporation or other organisation, unless the corporation or other organisation has given its written consent to the name of the variety.

## 28 Applications to be given priority dates

- (1) The Secretary must ensure that each application for PBR is given a priority date.
- (2) The priority date is, unless section 29 applies in relation to the application, the date on which the application was lodged with the Secretary or, if another date is determined under the regulations for the application, the date determined.
- (3) If 2 or more applications are made for PBR in the same plant variety, the Secretary must first consider the application having the earlier priority date.

## 29 Priority dates arising from foreign application

- (1) If:
  - (a) a person has lodged an application for PBR in a plant variety in one or more contracting parties other than Australia; and
  - (b) within a period of 12 months after the date that the earliest of those applications (the **foreign application**) was lodged, the person lodges an application in Australia (the **local application**) for PBR in the variety; and
  - (c) the local application is accompanied with a claim to have the date of lodgment of the foreign application treated as the priority date for the purposes of the local application; and
  - (d) the local application is accepted;the person is entitled to have the date of lodgment of the foreign application treated as the priority date for the purposes of the local application, subject to subsections (3) and (4).
- (3) The entitlement of the person to have the date of lodgment of the foreign application treated as the priority date for the purposes of the local application is conditional on the person lodging with the Secretary, within 3 months of making the local application, a copy of the documents that constituted the foreign application, certified by the Authority that received the foreign application to be a true copy of the documents.
- (4) The entitlement of the person to have the date of lodgment of the foreign application treated as the priority date for the purposes of the local application is conditional on the person providing to the Secretary, within a period of 3 years after the making of the foreign application, such further particulars in relation to the plant variety as are required to complete the consideration of the local application.

### 30 Acceptance or rejection of applications

- (1) The Secretary must, as soon as practicable after an application for PBR is lodged in a plant variety, decide whether to accept or reject the application.
- (2) If the Secretary is satisfied that:
  - (a) no other application has, or, if the application were to meet the requirements of paragraphs (b) and (c), would have, an earlier priority date in the variety; and
  - (b) the application complies with the requirements of section 26; and
  - (c) the application establishes a *prima facie* case for treating the plant variety as distinct from other varieties;the Secretary must accept the application.
- (3) If the Secretary is not satisfied of all of the matters referred to in subsection (2), the Secretary must reject the application.
- (4) If the Secretary decides to accept the application, the Secretary must:
  - (a) give written notice to the applicant telling the applicant that the application has been accepted; and
  - (b) as soon as possible after notifying the applicant—give public notice of the acceptance of the application.
- (5) If the Secretary decides to reject an application, the Secretary must:
  - (a) give written notice to the applicant telling the applicant of the rejection and setting out the reasons for the rejection; and
  - (b) as soon as possible after notifying the applicant—give public notice of the rejection of the application.

Note: A decision under this section to accept or reject an application is reviewable by the AAT under section 77.

### 31 Requests for variation of application

- (1) If:
  - (a) after an application for PBR in a plant variety has been accepted; but
  - (b) before concluding the examination of that application (including the subsequent detailed description of that variety) and of any objection to the application;the right of the applicant to apply for PBR in a particular plant variety is assigned to, or has been transmitted by will or operation of law to, another person, that other person may request the Secretary, in writing, to vary the application so that that other person is shown as the applicant.
- (2) If the Secretary is satisfied that the right to apply for PBR in a particular plant variety has been assigned to, or has been transmitted by will or operation of law to, to a particular person, the Secretary must vary the application so that that person is shown as the applicant.
- (3) A request by a person under subsection (1) must give an address in Australia for the service of notices on the person for the purposes of this Act.
- (4) If the Secretary complies with a request under subsection (1) and the address for the service of notices that is given in connection with that request is different from the address contained in the application as the address for service of documents on the applicant, the Secretary must vary the application so that the address so given is shown as the address for service of documents on the applicant.
- (5) If:
  - (a) after an application for PBR in a plant variety has been accepted; but

(b) before concluding the examination of that application (including the subsequent detailed description of that variety) and of any objection to the application;

the applicant requests the Secretary, in writing, to vary the application in any other respect other than that referred to in subsection (1), the Secretary may, in his or her discretion, vary the application in accordance with the request.

- (6) Despite the previous provisions of this section, the Secretary is not obliged or permitted to vary an application in response to a request under this section unless the person making the application for the variation has paid to the Commonwealth the application variation fee that is prescribed for the purposes of this section.

Note: A decision under this section to vary or to refuse to vary an application is reviewable by the AAT under section 77.

### **32 Notification of decisions on requests to vary application**

- (1) If the Secretary varies an application in accordance with a request under subsection 31(1) or (5), the Secretary must, as soon as practicable, give written notice to the person making the request telling the person that the application has been so varied.
- (2) If the Secretary rejects a request under subsection 31(1) or (5), the Secretary must, as soon as practicable, give written notice to the person making the request:
- (a) telling the person that the request has been rejected; and
  - (b) setting out the reasons for the rejection.
- (3) If the Secretary rejects a request under subsection 31(1), the Secretary must, as soon as practicable, also give written notice to the applicant:
- (a) setting out particulars of the request; and
  - (b) telling the applicant that the request has been rejected; and
  - (c) setting out the reasons for the rejection.
- (4) If the Secretary varies an application in accordance with a request under subsection 31(1), the Secretary must, as soon as practicable, also give written notice of particulars of the variation to the person who was the applicant before the variation was made.
- (5) If an application:
- (a) is varied because of a request under subsection 31(1); or
  - (b) is varied because of a request under subsection 31(5) in a significant respect;
- the Secretary must, as soon as practicable, give public notice of particulars of the variation.

### **33 Withdrawal of application**

- (1) An application may be withdrawn by the applicant at any time.
- (2) If an application is withdrawn after public notice of acceptance of the application is given, the Secretary must, as soon as practicable, give public notice of the withdrawal.

## Division 2—Dealing with the application after its acceptance

### 34 Detailed description in support of application to be given to Secretary

- (1) As soon as practicable after, but not later than 12 months after, an application has been accepted, or within such further period as the Secretary allows for the purpose, the applicant must, if the applicant has not already done so, give the Secretary a detailed description of the plant variety to which the application relates.

Note: A decision under this subsection to refuse to extend the 12 months period is reviewable by the AAT under section 77.

- (2) If the applicant fails to give the Secretary the detailed description required under this section within the required period, the application is taken to have been withdrawn.
- (3) The detailed description must:
- (a) be in writing; and
  - (b) be in an approved form; and
  - (c) be lodged with the Secretary in a manner set out in the approved form.
- (4) The detailed description must contain:
- (a) particulars of the characteristics that distinguish the variety from other plant varieties the existence of which is a matter of common knowledge; and
  - (b) particulars of:
    - (i) any test growing carried out, including a test growing carried out as required under section 37, to establish that the variety is distinct, uniform and stable; and
    - (ii) any test growing carried out as required under section 41; and
  - (c) if the variety was bred outside Australia—particulars of any test growing outside Australia that tend to establish that the variety will, if grown in Australia, be distinct, uniform and stable; and
  - (d) such other particulars (if any) as are required by the approved form;
- and must be accompanied by a certificate, in the approved form, verifying the particulars of the detailed description, completed by the approved person nominated in the application as the approved person in relation to that application.
- (5) The Secretary must, as soon as practicable after receiving a detailed description of a plant variety to which an application for PBR relates, give public notice of that description.
- (6) The applicant must:
- (a) unless paragraph (b) applies—within 12 months after the application has been accepted; and
  - (b) if the detailed description has been given to the Secretary before the end of that period—at the time when the description was given;
- pay to the Commonwealth such examination fee as is prescribed.
- (7) Subsection (6) does not apply to an applicant if the plant variety to which the application relates is in quarantine under the *Quarantine Act 1908* when the examination fee becomes payable. Instead, the applicant must pay the prescribed examination fee within 12 months after the plant variety is released from quarantine.

### 35 Objection to application for PBR

- (1) Any person who considers, in relation to an application for PBR in a plant variety that has been accepted:
  - (a) that his or her commercial interests would be affected by the grant of that PBR to the applicant; and
  - (b) that the Secretary cannot be satisfied, in relation to that application, of a matter referred to in a paragraph of subsection 26(2) or in subparagraph 44(1)(b)(i), (ii), (iii), (iv), (v), (vi), (vii) or (viii);may lodge a written objection to the grant of PBR with the Secretary at any time after the giving of that public notice of acceptance of the application and before the end of the period of 6 months starting with the public notice of that detailed description.
- (2) An objection must set out:
  - (a) particulars of the manner in which the person considers his or her commercial interests would be affected; and
  - (b) the reasons why the person considers that the Secretary cannot be satisfied of a matter referred to in paragraph (1)(b).
- (2A) An objection is of no effect unless it is accompanied by the prescribed fee.
- (3) The Registrar must give a copy of the objection to the applicant.

### 36 Inspection of applications and objections

- (1) A person may, at any reasonable time, inspect an application for PBR in a plant variety (including any detailed description of the plant variety given in support of the application) or an objection lodged in respect of that application (including that detailed description).
- (2) A person is entitled, on payment of such fee as is prescribed, to be given a copy of an application for PBR in a plant variety, of an objection to such an application, or of a detailed description of the plant variety.
- (3) However, this section does not entitle a person to inspect the part of the application that contains the information referred to in paragraph 26(2)(ga) or to have a copy of the part of the application containing that information, unless the person is:
  - (a) the applicant; or
  - (b) the applicant's authorised agent; or
  - (c) the Minister; or
  - (d) the Secretary; or
  - (e) a person who is required to inspect the part of the application in the course of performing his or her duties in accordance with this Act; or
  - (f) a person prescribed for the purposes of this subsection.

### 37 Test growing of plant varieties

- (1) If, in dealing with:
  - (a) an application for PBR that has been accepted; or
  - (b) an objection to such an application for PBR; or
  - (c) a request for revocation of PBR;the Secretary decides that there should be a test growing or a further test growing of the variety to which the application, objection or request relates, the Secretary:
  - (d) must give written notice of that decision:
    - (i) to the person who made the application, objection or request; and

- (ii) in the case of an objection to an application for PBR—also to the applicant; and
- (iii) in the case of a request for revocation of PBR—also to the grantee; and
- (e) may also give written notice of that decision to any other person whom the Secretary considers appropriate if the test growing or further test growing is a comparative test growing.

Note: A decision under this subsection to require a test growing is reviewable by the AAT under section 77.

- (2) The notice, in addition to telling the person of the Secretary's decision:
  - (a) must specify the purpose of the test growing; and
  - (b) may require the person:
    - (i) to supply the Secretary with sufficient plants or sufficient propagating material of plants of the variety, and with any necessary information, to enable the Secretary to arrange a test growing; or
    - (ii) to make arrangements for an approved person to supervise the test growing, to supply the approved person with sufficient plants or propagating material to enable the test growing, to give the Secretary a copy of the records of observations made during the test growing and to certify the records of observations so provided;
 whichever the Secretary considers appropriate.

(2A) A person to whom a notice is sent under this section must comply with the requirements of the notice:

- (a) in the case of trees and vines, or propagating materials of trees and vines—within 2 years from the date of service of the notice; and
- (b) in the case of other species of plant or propagating materials of other species of plant—within 12 months from that date.

(2B) If a person, without reasonable excuse, fails to comply with the requirements of a notice issued under this section, the Secretary may:

- (a) if the person is the grantee—revoke PBR, in the plant variety to which the notice relates, under section 50; or
- (b) if the person made an application, objection or request—decide not to further proceed with the application, objection or request for revocation.

Note: A decision not to further proceed with the application, objection or request for revocation is reviewable by the AAT under section 77.

- (3) If a notice under this section contains the requirement referred to in subparagraph (2)(b)(i) and the applicant complies with the request, the Secretary must arrange to have the variety concerned test grown.
- (4) After completion of a test growing arranged by the Secretary, any propagating material of the variety used in, or resulting from, the test growing, that is capable of being transported must be delivered to the person by whom propagating material of that variety was supplied for the purposes of the test growing.
- (5) All of the costs associated with a test growing must be paid:
  - (a) if it is conducted to deal with an application for PBR—by the applicant for PBR; or
  - (b) if it is conducted to deal with an objection to an application for PBR:
    - (i) by the applicant for PBR, where the test growing shows that there are valid reasons for the objection; or
    - (ii) by the objector, in any other case; or
  - (c) if it is conducted to deal with a request for revocation of PBR:
    - (i) by the grantee, where the test growing shows that there are valid reasons for the request; or



- (ii) by the person making the request, in any other case.
- (6) If a contracting party, or a national or an organisation of a contracting party, requests the Secretary to conduct in Australia a test growing of a plant variety, the Secretary may decide to conduct the test growing as so requested.
- (7) If the Secretary decides to conduct a test growing under subsection (6), subsections (1), (2), (3), (4) and (5) apply to such test growing as if:
  - (a) the person or organisation requesting the test growing under subsection (6) was an applicant for PBR; and
  - (b) the test growing had been decided on in relation to that application.

### 38 Characteristics of plant varieties bred or test grown outside Australia

- (1) If:
  - (a) a plant variety (the **subject variety**):
    - (i) was bred outside Australia; or
    - (ii) was bred in Australia but, before an application for PBR was made in Australia, an application for PBR was made in a contracting party other than Australia; and
  - (b) an application under this Act for PBR in the variety has been accepted;the variety is not to be taken to have a particular characteristic unless subsection (2), (3), (4) or (5) applies to the variety.
- (2) This subsection applies to the subject variety if a test growing in Australia has demonstrated that the variety has the particular characteristic.
- (3) This subsection applies to the subject variety if:
  - (a) a test growing of the variety has been carried out outside Australia; and
  - (b) that test growing has demonstrated that the variety has the particular characteristic; and
  - (c) under an agreement between Australia and the country in which the test growing was carried out, Australia is required to accept that the variety has that particular characteristic.
- (4) This subsection applies to the subject variety if the Secretary is satisfied that:
  - (a) a test growing of the variety carried out outside Australia has demonstrated that the variety has the particular characteristic; and
  - (b) that test growing of the variety is equivalent to a test growing of the variety in Australia.
- (5) This subsection applies to the subject variety if the Secretary is satisfied that:
  - (a) a test growing of the variety carried out outside Australia has demonstrated that the variety has the particular characteristic; and
  - (b) any test growing of the variety carried out in Australia would probably demonstrate that the variety has that characteristic; and
  - (c) if a test growing of the variety in Australia sufficient to demonstrate whether the variety has that characteristic were to be carried out, it would take longer than 2 years.

Note: A decision to the effect that the Secretary is, or is not, satisfied of the matters referred to in subsection (4) or (5) is reviewable by the AAT under section 77.

## Division 3—Provisional protection

### 39 Provisional protection

- (1) When an application for PBR in a plant variety is accepted, the applicant is taken to be the grantee of that right for the purposes of Part 5 from the day the application is accepted until:
  - (a) the application is disposed of; or
  - (b) if the Secretary gives the applicant a notice under subsection (2)—the notice is disposed of;whichever occurs first.
- (2) If the Secretary is satisfied in relation to an application for PBR in a plant variety, that:
  - (a) PBR will not be granted or is unlikely to be granted to the applicant; or
  - (aa) a decision has been taken under paragraph 37(2B)(b) not to proceed with the application; or
  - (ab) the application has been withdrawn; or
  - (b) the applicant has given an undertaking to a person (whether or not for consideration) not to commence proceedings for infringement of the right of which the applicant is deemed to be the grantee; or
  - (c) at least 12 months have elapsed since the publication of the detailed description that was given to the Secretary under subsection 34(1);the Secretary may notify the applicant, in writing, that this section will cease to apply to that variety on a day specified in the notice unless, before that time the applicant has made a submission to the Secretary providing reasons why this section should not cease to apply.

Note: A decision under this subsection to notify an applicant is reviewable by the AAT under section 77.

- (3) For the purposes of paragraph (1)(b) a notice referred to in that paragraph is not taken to be disposed of until:
  - (a) the end of the period within which application may be made to the AAT for a review of the giving of the notice; or
  - (b) if such an application is made to the AAT—the application is withdrawn or finally determined, whether by the AAT or a court.
- (4) As soon as practicable after a person ceases to be taken to be the grantee of PBR under this section, the Secretary must give public notice that the person has ceased to be so taken.
- (5) Nothing in this section affects the powers of the Federal Court under subsection 44A(2) of the AAT Act where an appeal is begun in that Court from a decision of the AAT.
- (6) A person who is taken to be the grantee of PBR in a plant variety is not entitled to begin an action or proceeding for an infringement of that right occurring during the period when the person is so taken unless and until that right is finally granted to the person under section 44.

## Division 4—Essential derivation

### 40 Applications for declarations of essential derivation

- (1) If:
  - (a) a person is the grantee of PBR in a particular plant variety—(the *initial variety*); and
  - (b) another person is the grantee of, or has applied for, PBR in another plant variety (the *second variety*); and
  - (c) the grantee of PBR in the initial variety is satisfied that the second variety is, within the meaning of section 4, an essentially derived variety of the initial variety; and
  - (d) the initial variety has not itself been declared to be an essentially derived variety of another variety in which PBR has been granted;the grantee of PBR in the initial variety may make written application to the Secretary for a declaration that the second variety is so derived.
- (2) Nothing in this section implies that a person who is the grantee of PBR in the initial variety may not, in relation to an application by another person for PBR in the second variety that has been accepted but not finally determined:
  - (a) make an objection, under section 35, to the granting of PBR in the second variety; and
  - (b) in the alternative, if PBR is granted to another person in the second variety—apply under subsection (1) for a declaration that the second variety is essentially derived from the initial variety.
- (3) If the second variety:
  - (a) is the subject of an application for PBR; and
  - (b) is also the subject of an application for a declaration of essential derivation;then, unless and until the Secretary decides to grant the application for PBR:
  - (c) the Secretary must not make the declaration of essential derivation; but
  - (d) the Secretary may, in his or her discretion:
    - (i) examine both the application for PBR and the application for a declaration of essential derivation at the same time; and
    - (ii) for the purpose only of examining the application for a declaration of essential derivation—treat the applicant for PBR as the grantee of PBR in the variety.
- (4) An application for a declaration of essential derivation must:
  - (a) be in writing; and
  - (b) be in an approved form; and
  - (c) be lodged with the Secretary in a manner set out in the approved form; and
  - (d) be accompanied by the prescribed fee in respect of the application.
- (5) An application must contain such information relevant to establishing a *prima facie* case that the second variety is an essentially derived variety of the initial variety as is required by the form.
- (6) If the initial variety has itself been declared to be essentially derived from another variety, the Secretary must refuse to declare the second variety essentially derived from:
  - (a) the initial variety; and
  - (b) inform the applicant for the declaration in writing, to that effect, and give the applicant reasons for the decision.

- (7) If the initial variety has not been so declared, the Secretary must determine, on the basis of the application, whether the Secretary is satisfied that there is a *prima facie* case that the second variety is an essentially derived variety of the initial variety.
- (8) If the Secretary is satisfied of that *prima facie* case, the Secretary must:
- (a) inform the applicant and the grantee of PBR in the second variety that the Secretary is so satisfied; and
  - (b) inform the grantee of PBR in the second variety that, unless the grantee establishes, within 30 days after being so informed or such longer period as the Secretary allows, that the second variety is not an essentially derived variety of the initial variety, the Secretary will, at the end of that period, declare the second variety to be such an essentially derived variety.

Note: A decision under this subsection to refuse to extend the period of 30 days is reviewable by the AAT under section 77.

- (9) If the Secretary is not satisfied of that *prima facie* case, the Secretary must inform the applicant, in writing, to that effect, and give the applicant reasons for the decision.
- (10) If, after considering:
- (a) the information presented by the grantee of PBR in the second variety; and
  - (b) any information obtained from a test growing conducted in accordance with section 41; and
  - (c) any other relevant information obtained by the Secretary;
- the Secretary is not satisfied that the grantee of PBR in the second variety has rebutted the *prima facie* case, the Secretary must:
- (d) declare, in writing, that the second variety is an essentially derived variety of the initial variety; and
  - (e) by notice in writing given to the grantee of PBR in the initial variety, tell that grantee of the declaration; and
  - (f) by notice in writing given to the grantee of PBR in the second variety, tell that grantee of the declaration and set out the reasons for not being satisfied that the *prima facie* case has been rebutted.
- (11) If, after considering the information referred to in paragraph (10)(a), (b) or (c), the Secretary is satisfied that the grantee of PBR in the second variety has rebutted the *prima facie* case, the Secretary must:
- (a) by notice in writing given to the grantee of PBR in the initial variety, tell that grantee that he or she is so satisfied and set out the reasons for being so satisfied; and
  - (b) by notice in writing given to the grantee of PBR in the second variety, tell that grantee that he or she is so satisfied.
- (12) While a declaration that the second variety is essentially derived from the initial variety remains in force, section 19 applies in relation to the second variety as if:
- (a) the references in that section to the grantee, in relation to that variety were references both to the person holding PBR in that variety and to the person holding PBR in the initial variety; and
  - (b) the reference in subsection 19(4) to 2 years after the grant of PBR were a reference to 2 years after the grant of PBR in the second variety whether or not the declaration of essential derivation was made at the same time or a later time; and
  - (c) a failure by the other person holding PBR in the initial variety or the person holding PBR in the second variety to co-operate in making the second variety available to the public in accordance with the requirements of subsection 19(1)

was a failure of the grantee to comply with the requirements of that subsection.

Note: A decision under this section to declare, or not to declare, a plant variety essentially derived is reviewable by the AAT under section 77.

#### 41 Test growing associated with applications for declarations of essential derivation

(1) If:

- (a) the grantee of PBR in a plant variety (the *initial variety*) applies for a declaration that another variety (the *second variety*) is an essentially derived variety of the initial variety; and
- (b) in the course of that application the grantee of PBR in the initial variety establishes a *prima facie* case that the second variety is essentially derived; and
- (c) on the basis of information supplied by the grantees of PBR in the initial variety and in the second variety, the Secretary comes to the view that a test growing or further test growing is necessary to determine whether the *prima facie* case has been rebutted;

the Secretary must give notice of that decision both to the grantee of PBR in the initial variety and in the second variety.

Note: A decision under this subsection to require a test growing is reviewable by the AAT under section 77.

(2) The notice must require:

- (a) the grantee of PBR in the initial variety to supply the Secretary with sufficient plants or sufficient propagating material of plants of that variety and with any necessary information; and
- (b) the grantee of PBR in the second variety to supply the Secretary with sufficient plants or sufficient propagating material of plants of that second variety and with any necessary information;

to enable the Secretary to arrange a test growing.

- (3) After completion of the test growing, any propagating material of a variety used in, or resulting from, the test growing that is capable of being transported must be delivered to the person by whom propagating material of that variety was supplied for the purpose of the test growing.
- (4) All costs associated with the test growing must be paid by the person who, without the test growing, failed to rebut the *prima facie* case of essential derivation, whether or not the test growing led to rebuttal of that case.
- (5) If the Secretary requires a test growing or further test growing, subsection 40(8) has effect as if the reference in that subsection to 30 days after being so informed were a reference to 30 days after being informed of the results of the test growing.

## Part 4—The grant and revocation of Plant Breeder’s Right

### Division 1—Grant of Plant Breeder’s Right

#### 42 PBR not to be granted in excluded varieties

- (1) PBR must not be granted in any variety of plant in a taxon that the regulations declare to be a taxon to which this Act does not apply.
- (2) The Governor-General must not make a regulation for the purposes of subsection (1) unless the Governor-General has been informed by the Minister that the Minister has considered advice given by the Advisory Committee in relation to the desirability of making the regulation.
- (3) If:
  - (a) a plant variety is a hybrid; and
  - (b) each of the plant varieties from which it is derived is a plant variety included in a taxon to which this Act does not apply;
 PBR must not be granted in the hybrid.

#### 43 Registrable plant varieties

- (1) For the purposes of this Act, a plant variety in which an application for PBR is made is registrable if:
  - (a) the variety has a breeder; and
  - (b) the variety is distinct; and
  - (c) the variety is uniform; and
  - (d) the variety is stable; and
  - (e) the variety has not been exploited or has been only recently exploited.
- (2) For the purposes of this section, a plant variety is distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge.
- (3) For the purposes of this section, a plant variety is uniform if, subject to the variation that may be expected from the particular features of its propagation, it is uniform in its relevant characteristics on propagation.
- (4) For the purposes of this section, a plant variety is stable if its relevant characteristics remain unchanged after repeated propagation.
- (5) For the purposes of this section, a plant variety is taken not to have been exploited if, at the date of lodging the application for PBR in the variety, plant material of the variety has not been sold to another person by, or with the consent of, the breeder.
- (6) For the purposes of this section, a plant variety is taken to have been only recently exploited if, at the date of lodging the application for PBR in the variety, plant material of the variety has not been sold to another person by, or with the consent of, the breeder, either:
  - (a) in Australia—more than one year before that date; or
  - (b) in the territory of another contracting party:
    - (i) in the case of trees or vines—more than 6 years before that date; or
    - (ii) in any other case—more than 4 years before that date.

Note: For the definition of **sell** see subsection 3(1).

- (7) Subsection (6) does not apply to a sale by the breeder of a plant variety of plant material of the variety to another person if that sale is a part of, or related to,

another transaction under which the right of the breeder to make application for PBR in that plant variety is sold to that other person.

- (7A) Subsection (6) does not apply to a sale of plant material of a plant variety to a person by, or with the consent of, the breeder if:
- (a) the sole purpose of the sale is for the person to multiply plant material of that plant variety on behalf of the breeder; and
  - (b) under the agreement for the sale, immediately after the plant material is multiplied, property in the new plant material vests in the breeder.
- (7B) Subsection (6) does not apply to a sale of plant material of a plant variety to a person by, or with the consent of, the breeder if the sale is part of an agreement under which the person agrees to use plant material of that variety for the sole purpose of evaluating the variety in one or more of the following tests or trials:
- (a) field tests;
  - (b) laboratory trials;
  - (c) small-scale processing trials;
  - (d) tests or trials prescribed for the purposes of this subsection.
- (7C) Subsection (6) does not apply to a sale of plant material of a plant variety to a person by, or with the consent of, the breeder if:
- (a) the sale only involves plant material that is a by-product or surplus product of one or more of the following:
    - (i) the creation of the variety;
    - (ii) a multiplication of the variety;
    - (iii) tests or trials covered by subsection (7B); and
  - (b) the plant material is sold:
    - (i) without identification of the plant variety of the plant material; and
    - (ii) for the sole purpose of final consumption.
- (8) In addition to any other reason for treating a plant variety as a variety of common knowledge, a variety is to be treated as a variety of common knowledge if:
- (a) an application for PBR in the variety has been lodged in a contracting party; and
  - (b) the application is proceeding, or has led, to the grant of PBR.
- (9) A plant variety that is to be treated as a variety of common knowledge under subsection (8) because of an application for PBR in the variety is to be so treated from the time of the application.
- (10) In this section:
- plant material***, in relation to a plant variety, means one or more of the following:
- (a) propagating material of the plant variety;
  - (b) harvested material of the plant variety;
  - (c) products obtained from harvested material of the plant variety.

#### 44 Grant of PBR

- (1) If:
- (a) an application for PBR in a plant variety is accepted; and
  - (b) after examining the application (including the subsequent detailed description) and any objection to the application, the Secretary is, or continues to be, satisfied that:
    - (i) there is such a variety; and
    - (ii) the variety is a registrable plant variety within the meaning of section 43; and

- (iii) the applicant is entitled to make the application; and
- (iv) the grant of that right is not prohibited by this Act; and
- (v) that right has not been granted to another person; and
- (vi) the name of the variety complies with section 27; and
- (vii) propagating material of that variety has been deposited for storage, at the expense of the applicant, in a genetic resource centre approved by the Secretary; and
- (viii) if the Secretary so requires, a satisfactory specimen plant of the variety has been supplied to the herbarium; and
- (ix) all fees payable under this Act in respect of the application, examination and grant have been paid;

the Secretary must grant that right to the applicant.

(2) If:

- (a) an application for PBR in a plant variety is accepted; and
- (b) the plant variety is a variety of a species indigenous to Australia;

the Secretary must require supply of a satisfactory specimen plant of the variety to the herbarium.

(3) If:

- (a) an application for PBR in a plant variety is accepted; and
- (b) the Secretary is not satisfied of all of the matters referred to in paragraph (1)(b);

the Secretary must refuse to grant that right to the applicant.

(4) The Secretary must not grant or refuse to grant PBR in a plant variety until at least 6 months after the giving of public notice of the detailed description of the variety.

(5) If:

- (a) an application for PBR in a plant variety has been varied under section 31; and
- (b) the variation relates to the detailed description of the variety that has been given to the Secretary; and
- (c) the Secretary has given public notice of the variation;

the Secretary must not grant, or refuse to grant, PBR in the variety until 6 months after giving public notice of the variation or of the last such variation.

(6) If an objection to an application for PBR is made under section 35, the Secretary must give the applicant 30 days, starting when a copy of the objection is given to the applicant, or such longer period as the Secretary considers to be reasonable in the circumstances, to provide an answer to the objection.

(7) A quantity of propagating material of a plant variety that is lodged with a genetic resource centre must be sufficient to enable that variety to be kept in existence if there were no other propagating material of plants of that variety.

(8) The delivery and storage of propagating material of a plant variety does not affect the ownership of the material but the material must not be dealt with otherwise than for the purposes of this Act.

(9) The propagating material of a plant stored at a genetic resource centre may be used by the Secretary for the purposes of this Act, including the purposes of section 19.

(10) PBR is granted to a person by the issue to that person by the Secretary of a certificate in an approved form, signed by the Secretary or the Registrar, containing such particulars of the plant variety concerned as the Secretary considers appropriate.



- (11) If the PBR is granted to persons who make a joint application for the right, the right is to be granted to those persons jointly.
- (12) If the Secretary refuses to grant PBR in a plant variety, the Secretary must, within 30 days of so refusing, give written notice to the applicant:
  - (a) telling the applicant of the refusal; and
  - (b) setting out the reasons for the refusal.

Note: A decision under this section to grant, or refuse to grant, PBR in a plant variety is reviewable by the AAT under section 77.

#### 45 Grant of PBR to be exclusive

- (1) Subject to subsections (2) and (3), only one grant of PBR may be made under this Act in relation to a plant variety.
- (2) If 2 breeders lodge a joint application for PBR, the Registrar may grant PBR to them jointly.
- (3) If:
  - (a) a person is the grantee of PBR in a plant variety (the **initial variety**); and
  - (b) another person is the grantee of PBR in another plant variety; and
  - (c) the Secretary declares the other variety to be an essentially derived variety of the initial variety;subsection (1) does not prevent PBR in the initial variety extending to the other variety.

#### 46 Grant of PBR to be entered on Register

- (1) When the Secretary grants PBR in a plant variety, the Registrar must enter in the Register:
  - (a) a description, or description and photograph, of a plant of that variety; and
  - (b) the name of the variety and any proposed synonym; and
  - (c) the name of the grantee; and
  - (d) the name and address of the breeder; and
  - (e) the address for the service of documents on the grantee for the purposes of this Act as shown on the application for the right; and
  - (f) the day on which the right is granted; and
  - (g) such other particulars relating to the granting as the Registrar considers appropriate.
- (2) When the Secretary makes a declaration that a variety (the **derived variety**) is essentially derived from another variety (the **initial variety**), the Registrar must enter in the Register both in respect of the derived variety and the initial variety:
  - (a) the fact that the declaration has been made; and
  - (b) the day on which the declaration was made.

#### 47 Notice of grant of PBR

- (1) The Secretary must, as soon as possible after granting PBR to a person, give public notice of the grant in the *Plant Varieties Journal*.
- (2) The Secretary must, as soon as possible after the making of a declaration that a plant variety is an essentially derived variety of another plant variety, give public notice of the making of the declaration in the *Plant Varieties Journal*.

#### 48 Effect of grant of PBR

- (1) If a person is granted PBR in a plant variety:

- (a) any other person who was entitled to make, but had not made, application for the right in the variety:
    - (i) ceases to be entitled to make such application; and
    - (ii) is not entitled to any interest in the right; and
  - (b) any other person who had made application for the right in the variety:
    - (i) ceases to be entitled to have his or her application considered or further considered; and
    - (ii) is not entitled to any interest in the right.
- (2) Subsection (1) does not prevent a person:
- (a) from applying for a revocation of the rights under section 50; or
  - (b) from instituting proceedings before a court or the AAT in relation to the right; or
  - (c) from requesting the Secretary to make a declaration under section 40 that the plant variety in which the right was granted is essentially derived from another plant variety in which the person holds PBR.
- (3) If:
- (a) PBR in a particular plant variety is granted to a person; and
  - (b) another person (the *eligible person*) was entitled, at law or equity, to an assignment of the right to make an application for the PBR;
- the eligible person is entitled to an assignment of the PBR.

#### **49 PBR may be subject to conditions**

- (1) The Minister may, if the Minister thinks it necessary, in the public interest, refer to the Plant Breeder's Rights Advisory Committee the question whether a grant of PBR, whether proposed or made, should be subject to conditions.
- (2) The Minister may, having regard to the views of the Plant Breeder's Rights Advisory Committee on a matter referred under subsection (1), impose such conditions on PBR that is to be granted or that has been granted as the Minister considers appropriate.
- (3) If the Minister imposes conditions on PBR:
  - (a) the Secretary must give public notice of those conditions and give the grantee a copy of the instrument setting them out; and
  - (b) the Registrar must enter details of those conditions in the Register.

Note: A decision under this section by the Minister to make a grant subject to conditions is reviewable by the AAT under section 77.

## Division 2—Revocation of Plant Breeder's Right or declaration of essential derivation

### 50 Revocation of PBR

- (1) The Secretary must revoke PBR in a plant variety or a declaration that a plant variety is essentially derived from another plant variety if:
  - (a) the Secretary becomes satisfied that facts existed that, if known before the grant of that right or the making of that declaration, would have resulted in the refusal to grant that right or make that declaration; or
  - (b) the grantee has failed to pay a fee payable in respect of that right or of that declaration within 30 days after having been given notice that the fee has become payable.
- (2) The Secretary may revoke PBR in a plant variety if:
  - (a) the Secretary is satisfied that a person to whom that right has been assigned or transmitted has failed to comply with section 21; or
  - (aa) the Secretary is satisfied that the grantee, without reasonable excuse, has failed to comply with the requirements of a notice under section 37; or
  - (b) the Secretary is satisfied that the grantee has failed to comply with a condition imposed under section 49.
- (3) If the Secretary revokes PBR in a plant variety or a declaration that a plant variety is essentially derived from another plant variety, the Secretary must, within 7 days after the decision to revoke was taken, by notice given to the grantee of the right that has been revoked or of the right that is affected by the giving of the declaration of essential derivation, tell that grantee of the decision and set out the reasons for the revocation.
- (4) The Secretary must not revoke PBR under this section unless:
  - (a) the Secretary has given the grantee, or any person to whom the Secretary believes that right has been assigned or transmitted, particulars of the grounds of the proposed revocation; and
  - (b) the grantee or that other person has had 30 days after being given those particulars to make a written statement to the Secretary in relation to the proposed revocation.
- (5) The Secretary must not under this section, revoke a declaration that a plant variety is essentially derived from another plant variety (the **initial variety**) unless:
  - (a) the Secretary has given the grantee of PBR in the initial variety, or any person to whom the Secretary believes that that PBR has been assigned or transmitted, particulars of the grounds of the proposed revocation of that declaration of essential derivation; and
  - (b) the grantee or that other person has had 30 days after being given those particulars to make a written statement to the Secretary in relation to the proposed revocation.
- (6) The revocation of PBR in a plant variety or of a declaration that a plant variety is essentially derived from another plant variety takes effect:
  - (a) if no application for review of the revocation is made to the AAT—at the end of the period within which such an application might be made; or
  - (b) if such an application is made—at the time when the application is withdrawn, or finally determined, whether by the Tribunal or by a court.
- (7) Nothing in this section affects the power of the Court under subsection 44A(2) of the AAT Act.

- (8) A person whose interests are affected by the grant of PBR in a plant variety may apply to the Secretary, in writing, for the revocation of the right.
- (9) A person whose interests are affected by the making of a declaration that a plant variety is essentially derived from another plant variety may apply to the Secretary, in writing, for a revocation of that declaration.
- (9A) An application under subsection (8) or (9) is of no effect unless it is accompanied by the prescribed fee.
- (10) If the Secretary decides not to revoke PBR in a plant variety in accordance with an application under subsection (8) or not to revoke a declaration of essential derivation in accordance with subsection (9), the Secretary must, within 7 days of making that decision, by notice in writing to the person who applied for the revocation, tell the person of the decision and set out the reasons for the decision.

Note: A decision under this section to revoke, or refuse to revoke, PBR or a declaration of essential derivation is reviewable by the AAT under section 77.

### **51 Entry of particulars of revocation**

- (1) If:
  - (a) PBR in a plant variety is revoked in accordance with section 50; or
  - (b) the Secretary is served with a copy of an order of a court given under subsection 54(3) revoking that right;the Secretary must:
  - (c) enter particulars of the revocation in the Register; and
  - (d) give public notice of the revocation.
- (2) If the holder of PBR in a plant variety fails to pay the prescribed annual fee for the renewal of the right by the last day for payment of that fee, the holder is taken to have surrendered the right.
- (3) The Secretary must:
  - (a) enter particulars of the surrender in the Register; and
  - (b) give public notice of the surrender.

### **52 Surrender of PBR**

The holder of PBR in a plant variety may, at any time, by written notice to the Secretary, offer to surrender that right.

## Part 5—Enforcement of Plant Breeder's Right

### 53 Infringement of PBR

- (1) Subject to sections 16, 17, 18, 19 and 23, PBR in a plant variety is infringed by:
  - (a) a person doing, without, or otherwise than in accordance with, authorisation from the grantee of the right, an act referred to in a paragraph of section 11 in respect of the variety or of a dependent variety; or
  - (b) a person claiming, without, or otherwise than in accordance with, authorisation from the grantee of that right, the right to do an act referred to in a paragraph of section 11 in respect of that variety or of a dependent variety; or
  - (c) a person using a name of the variety that is entered in the Register in relation to:
    - (i) any other plant variety of the same plant class; or
    - (ii) a plant of any other variety of the same plant class.
- (1A) To avoid doubt, an infringement of PBR in a plant variety under paragraph (1)(c) can include using a synonym in relation to the name of a plant variety, if that synonym is entered in the Register under paragraph 46(1)(b).
- (2) If a plant variety (the **derived variety**) has been declared to be an essentially derived variety of another plant variety (the **initial variety**), the reference in paragraphs (1)(a) and (b) to authorisation from the grantee of the right means, in relation to the derived variety, authorisation from both the grantee of PBR in the derived variety and from the grantee of PBR in the initial variety.
- (3) In this section, a reference to the grantee of PBR in a plant variety includes a reference to a person who has, by assignment or transmission, become the holder of that right.

### 54 Actions for infringement

- (1) An action for infringement of PBR in a plant variety may be begun in the Court only by the grantee.
- (2) A defendant in an action for infringement of PBR in a plant variety may apply, by way of counterclaim, for revocation of that right on the ground that:
  - (a) the variety was not a new plant variety; or
  - (b) facts exist that would have resulted in the refusal of the grant of that right if they had been known to the Secretary before the grant of that right.
- (3) If, in an action for infringement of PBR in a plant variety:
  - (a) the defendant applies, by way of counterclaim, for the revocation of that right; and
  - (b) the Court is satisfied that a ground for revocation of that right exists;the Court may make an order revoking that right.
- (4) If the Court revoked PBR in a plant variety on the counterclaim of a defendant, the Court may order the defendant to serve on the Registrar a copy of the order revoking that right.

### 55 Declarations as to non-infringement

- (1) A person who proposes to perform an act described in a paragraph of section 11 in relation to the propagating material of a plant variety may, by an action in the

Court against the grantee of PBR in a plant variety, apply for a declaration that the performance of that act would not constitute an infringement of that right.

- (2) A person may apply for a declaration whether or not there has been an assertion of an infringement of PBR by the grantee of that right.
- (3) The Court must not make such a declaration unless:
  - (a) the person proposing to perform the act:
    - (i) has applied in writing to the grantee of the PBR concerned for an admission that the proposed performance of the act would not infringe that right; and
    - (ii) has given the grantee full written particulars of the propagating material concerned; and
    - (iii) has undertaken to repay all expenses reasonably incurred by the grantee in obtaining advice in the declaration; and
  - (b) the grantee has refused or failed to make such an admission.
- (4) The costs of all parties in proceedings for a declaration under this section are to be paid by the person seeking the declaration unless the Court otherwise orders.
- (5) The validity of a grant of PBR in a plant variety is not to be called in question in proceedings for a declaration under this section.
- (6) The making of, or the refusal to make, a declaration under this section does not imply that a grant of PBR in a plant variety is, or is not, valid.

## 56 Jurisdiction of Court

- (1) The Court has jurisdiction with respect to matters in which actions may, under this Part, be begun in the Court.
- (2) That jurisdiction is exclusive of the jurisdiction of all other courts, other than the jurisdiction of the High Court under section 75 of the Constitution.
- (3) The relief that the Court may grant in an action or proceeding for infringement of PBR includes an injunction (subject to such terms, if any, as the Court thinks fit) and, at the option of the plaintiff, either damages or an account of profits.
- (4) The regulations may make provision in relation to the practice and procedure of the Court in actions under this Act, including provision prescribing the time within which any action may be begun, or any other act or thing may be done, and providing for the extension of any such time.
- (5) Subsection (4) does not limit the power of the Judges of the Court or a majority of them to make rules of Court under section 59 of the *Federal Court of Australia Act 1976* that are consistent with the regulations referred to in that subsection.

## 57 Innocent infringement

- (1) The Court may refuse to award damages, or to make an order for an account of profits, against a person in an action for infringement of PBR in a plant variety, if the person satisfies the Court that, at the time of the infringement, the person was not aware of, and had no reasonable grounds for suspecting, the existence of that right.
- (2) If the propagating material of plants of the plant variety, labelled so as to indicate that PBR is held in the variety in Australia, has been sold to a substantial extent before the date of the infringement, the person against whom the action for infringement is brought is taken to have been aware of the existence of PBR in the variety, unless the contrary is established.

## Part 6—Administration

### 58 Registrar of Plant Breeder's Rights

- (1) There is established by this section a Registrar of Plant Breeder's Rights.
- (2) The office of the Registrar of Plant Breeder's Rights is an office in the Department.
- (3) The Registrar has the functions and powers:
  - (a) that are conferred on the Registrar by this Act or by the regulations; or
  - (b) that are delegated to the Registrar by the Secretary under section 59.

### 59 Delegation

#### *Delegation of Minister's statutory powers and functions*

- (1) The Minister may, by signed instrument, delegate to the Registrar, or to an SES employee, or acting SES employee, in the Department, any of the powers or functions of the Minister under this Act or the regulations.

#### *Delegation of Secretary's statutory powers and functions*

- (2) The Secretary may, by signed instrument, delegate to the Registrar, or to an SES employee, or acting SES employee, in the Department, any of the powers or functions of the Secretary under this Act or the regulations.

#### *Delegation of Registrar's statutory powers and functions*

- (3) The Registrar may, by signed instrument, delegate to a prescribed employee, or employees in a prescribed class, any of the powers or functions of the Registrar under this Act or the regulations.

#### *Subdelegation of delegated powers and functions*

- (4) A person to whom a power or function under this Act or the regulations has been delegated by the Minister or the Secretary under subsection (1) or (2) may, by signed instrument, delegate the power or function to a prescribed employee, or employees in a prescribed class.
- (5) A power or function that is exercised or performed by an employee under a delegation under subsection (4) is taken, for the purposes of this Act and the regulations, to have been exercised or performed by the person who originally delegated the corresponding power or function under subsection (1) or (2).

#### *Requirement to act under direction or supervision*

- (6) If required by an instrument under subsection (3) or (4) delegating a power or function to an employee, the employee must exercise the power or perform the function under the direction or supervision of:
  - (a) the person who delegated the power or function to the employee; or
  - (b) another employee specified in the instrument.

This subsection applies whether the instrument identifies the employee specifically or by reference to a class.

#### *Definition*

- (7) In subsections (3), (4), (5) and (6):

**employee** means a person who is engaged under the *Public Service Act 1999* or otherwise for or on behalf of the Commonwealth and whose duties involve providing assistance to the Registrar.

## 60 Certain persons not to acquire PBR

- (1) A person must not apply for, or otherwise acquire, except than by will or by operation of law, PBR in a plant variety or an interest in such right if the person has during the 12 months before the application, held, or performed the duties of:
  - (a) the office of Secretary; or
  - (b) the office of Registrar of Plant Breeder's Rights; or
  - (c) an office in the Department the duties of which involve providing assistance to the Registrar.

Penalty: 60 penalty units.

- (2) A grant of PBR applied for in contravention of subsection (1) or an acquisition of PBR in contravention of that subsection is void.

## 61 Register of Plant Varieties

- (1) The Registrar must keep a register, to be known as the Register of Plant Varieties, at a place approved by the Secretary.
- (1A) The Registrar must maintain, for the purposes of this Act, a list of all plant classes to be known as the Registrar's List of Plant Classes.
- (1B) In maintaining that list the Registrar must, for so long as the Union maintains the document presently known as the List of Classes for Variety Denomination Purposes, have regard to that list and to any variations to that list as so maintained.
- (1C) The list maintained by the Registrar must be kept as a part of the Register.
- (2) In order to foster public access to the information contained in the Register, the Registrar may disseminate that information on the internet or in such other manner as the Registrar considers most likely to enhance its accessibility.

## 62 Inspection of Register

- (1) A person may inspect the Register at any reasonable time.
- (2) A person is entitled, on payment of such fee (if any) as is prescribed, to be given a copy of an entry in the Register.
- (3) For the purposes of subsection (2), a reference to an entry in the Register does not include a reference to the Registrar's List of Plant Classes or to any part of that list.



## Part 7—Plant Breeder’s Rights Advisory Committee

### 63 Establishment of Advisory Committee

- (1) There is established by this section a Committee by the name of the Plant Breeder’s Rights Advisory Committee.
- (2) The functions of the Advisory Committee are:
  - (a) at the request of the Minister, to advise the Minister on the desirability of declaring:
    - (i) in regulations made for the purpose of subsection 17(2)—that subsection 17(1) does not apply to a particular taxon; or
    - (ii) in regulations made for the purpose of subsection 22(3)—that the duration of PBR in a particular taxon will be longer than provided in subsection 22(2); or
    - (iii) in regulations made for the purpose of subsection 42(1)—that a particular taxon is a taxon to which this Act does not apply; and
  - (aa) at the request of the Minister, to advise the Minister on the question of whether an existing, or proposed, grant of PBR should be subject to conditions; and
  - (b) to advise the Registrar on such technical matters arising under this Act, and such other matters relating to the administration of this Act, as the Registrar refers to the Advisory Committee.

### 64 Membership of Advisory Committee

- (1) The Advisory Committee consists of:
  - (a) the Registrar; and
  - (b) 2 members who, in the opinion of the Minister, are appropriate persons to represent breeders, and likely breeders, of new plant varieties; and
  - (c) one member who, in the opinion of the Minister, is an appropriate person to represent users, and likely users, of new plant varieties; and
  - (d) one member who, in the opinion of the Minister, is an appropriate person to represent the interests of consumers, and likely consumers, of new plant varieties or of the products of new plant varieties; and
  - (e) one member who will represent the conservation interests in relation to new plant varieties and the potential impacts of new plant varieties; and
  - (f) one member who will represent indigenous Australian interests in relation to new plant varieties and the source, use and impacts of new plant varieties; and
  - (g) 2 other members who, in the opinion of the Minister, possess qualifications or experience that are appropriate for a member of the Advisory Committee.
- (2) The members, other than the Registrar, must be appointed by the Minister.
- (3) The members, other than the Registrar, hold office as part-time members.
- (4) Each member, other than the Registrar, holds office for the period, not exceeding 3 years, that is specified in the instrument of appointment, but is eligible for re-appointment.
- (5) The Minister may terminate the appointment of a member, other than the Registrar, for misbehaviour or for physical or mental incapacity.
- (6) The Minister must terminate the appointment of a member, other than the Registrar, if the member:

- (a) becomes bankrupt, applies to take the benefit of any law for the relief of bankrupt or insolvent debtors, compounds with his or her creditors or makes an assignment of his or her remuneration for their benefit; or
  - (b) fails, without reasonable excuse, to disclose any interest in a matter required to be disclosed under section 66.
- (7) If a person's appointment as a member is terminated under subsection (6), the Minister must give the person a written notice informing the person of the termination and setting out the reasons for the termination.
- (8) A member, other than the Registrar, may resign his or her office by writing signed by the member and delivered to the Minister.

## 65 Remuneration and allowances

- (1) The members referred to in paragraphs 64(1)(b), (c), (d), (e), (f) and (g) must be paid:
- (a) such remuneration as is determined by the Remuneration Tribunal; and
  - (b) such allowances as are prescribed.
- (2) Subsection (1) has effect subject to the *Remuneration Tribunal Act 1973*.

## 66 Disclosure of interests

- (1) A member who has a direct or indirect pecuniary interest in a matter being considered at a meeting of the Advisory Committee must, as soon as possible after the relevant facts have come to the member's knowledge, disclose the nature of the interest at the meeting.
- (2) A disclosure must:
- (a) be recorded in the minutes of the meeting of the Advisory Committee; and
  - (b) be made known in any advice given by the Committee in relation to that matter.

## 67 Meetings

- (1) The Registrar may convene such meetings of the Advisory Committee as are necessary for the purposes of the performance of the functions of the Advisory Committee.
- (2) At a meeting of the Advisory Committee, 5 members constitute a quorum.
- (3) The Registrar presides at a meeting of the Advisory Committee at which the Registrar is present.
- (4) If the Registrar is not present, the members present must elect one of their number to preside at the meeting.
- (5) Subject to subsection (2), the Advisory Committee may determine the procedure to be followed at a meeting of the Committee.

## Part 8—Miscellaneous

### 68 Public notices

- (1) The Secretary must issue a journal, to be called the *Plant Varieties Journal*, at least 4 times each year.
- (2) Any public notice that the Secretary is required to make under this Act must be published in the Journal.
- (3) Public notice of any matter additional to the matters referred to in subsection (2) that the Secretary considers it necessary or desirable to publicise may also be published in the Journal.
- (4) If the Secretary considers it desirable to give additional public notice of matters by publishing notices of those matters in a periodical other than the Journal, the Secretary may arrange for, or consent to, the giving of additional public notice of those matters in the periodical.

### 69 Notices inviting submissions in respect of certain regulations

- (1) Regulations must not be made for the purposes of subsection 17(2), 22(3) or 42(1) unless, before the making of the regulations and before the Minister seeks any advice from the Advisory Committee concerning those regulations:
  - (a) the Minister has, in accordance with section 68, given public notice of the Minister's intention to make a regulation for the purposes of that subsection in relation to a particular taxon that is specified in the notice; and
  - (b) the notice has given a broad indication of the objectives of the intended regulations and invited persons to make submissions to the Minister concerning it within a period of 30 days after the publication of the notice.
- (2) If the Minister receives, in accordance with an invitation in a public notice under subsection (1), a submission concerning an intended regulation, the Minister must have regard to the submission so made.
- (3) If the Minister seeks advice of the Advisory Committee concerning an intended regulation, the Minister may comply with subsection (2):
  - (a) by providing to the Committee, at the time of requesting the advice of that Committee, a copy of all submissions received; and
  - (b) requesting the Advisory Committee to have regard to those submissions in preparing its advice to the Minister.

### 70 Genetic resource centres

- (1) If, in the opinion of the Secretary, a place is suitable for the storage and maintenance of germplasm material, the Secretary may, by notice in writing, declare that place to be a genetic resource centre for the purposes of this Act.
- (2) The person in charge of a genetic resource centre may do all things necessary to maintain the viability of propagating material stored at that centre.

### 71 The herbarium

If, in the opinion of the Secretary, an organisation has facilities suitable for the storage of plant specimens, the Secretary may, by notice in writing, declare the organisation to be the herbarium for the purposes of this Act.

## 72 Agents may act in matters relating to PBR

Subject to any other law of the Commonwealth, including the High Court Rules and the Federal Court Rules, an application, a written submission or any other document may be prepared or lodged, and any business may be transacted, for the purposes of this Act, by one person on behalf of another person.

## 73 Service of documents

If the Secretary or the Registrar is required by this Act to give a written notice or other document to an applicant for, or a grantee of, PBR, that notice or other document may be given by being posted by pre-paid post as a letter addressed to the applicant or the grantee at the address for service shown on the application or entered in the Register, as the case requires.

## 74 Infringement offences

- (1) A person must not, in relation to propagating material of a plant variety in which PBR has been granted, do any of the acts referred to in a paragraph of section 11 if such an act would, under section 53, infringe the PBR in the variety.

Penalty: 500 penalty units.

- (1A) In subsection (1), strict liability applies to the physical element of circumstance, that the infringement of the PBR would be under section 53.

Note: For strict liability, see section 6.1 of the *Criminal Code*.

- (2) The fact that an action for infringement has been brought against a person under section 54 in respect of a particular act does not prevent a prosecution under this section in respect of the same act.

## 75 Offences other than infringement offences

- (1) A person must not make a false statement in an application or other document given to the Secretary or the Registrar for the purposes of this Act.

Penalty: 6 months imprisonment.

- (2) A person who is not the grantee of PBR in a plant variety must not represent to another person that he or she is the grantee of PBR in that variety.

Penalty: 60 penalty units.

- (3) A person must not represent to another person that PBR granted to that first-mentioned person in a plant variety extends to cover another plant variety that is not:

- (a) a dependent variety of the first-mentioned variety; or  
(b) a variety that has been declared to be an essentially derived variety of the first-mentioned variety.

Penalty: 60 penalty units.

- (4) A person must not represent to another person that a plant of a variety in which PBR has not been granted is a plant of a variety in which PBR has been granted.

Penalty: 60 penalty units.

## 76 Conduct by directors, servants and agents

- (1) If, in proceedings for an offence against section 74 or 75, it is necessary to establish the state of mind of a body corporate in relation to particular conduct, it is sufficient to show:
  - (a) that the conduct was engaged in by a director, servant or agent of the body corporate, within the scope of his or her actual or apparent authority; and
  - (b) that the director, servant or agent had the state of mind.
- (2) Any conduct engaged in on behalf of a body corporate by a director, servant or agent of the body corporate within the scope of his or her actual or apparent authority is to be taken, for the purposes of a prosecution for an offence against section 74 or 75, to have been engaged in also by the body corporate unless the body corporate establishes that the body corporate took reasonable precautions and exercised due diligence to avoid the conduct.
- (3) If, in proceedings for an offence against section 74 or 75, it is necessary to establish the state of mind of a person other than a body corporate in relation to a particular conduct, it is sufficient to show:
  - (a) that the conduct was engaged in by a servant or agent of the person, within the scope of his or her actual or apparent authority; and
  - (b) that the servant or agent had the state of mind.
- (4) Any conduct engaged in on behalf of a person other than a body corporate by a servant or agent of the person within the scope of his or her actual or apparent authority is to be taken, for the purposes of a prosecution for an offence against section 74 or 75, to have been engaged in also by the first-mentioned person unless the first-mentioned person establishes that the first-mentioned person took reasonable precautions and exercised due diligence to avoid the conduct.
- (5) If:
  - (a) a person other than a body corporate is convicted of an offence; and
  - (b) the person would not have been convicted for the offence if subsections (3) and (4) had not been enacted;the person is not liable to be punished by imprisonment for that offence.
- (6) A reference in subsection (1) or (3) to the state of mind of a person includes a reference to:
  - (a) the knowledge, intention, opinion, belief or purpose of the person; and
  - (b) the person's reasons for the intention, opinion, belief or purpose.
- (7) A reference in this section to a director of a body corporate includes a reference to a constituent member of a body corporate incorporated for a public purpose by a law of the Commonwealth, of a State or of a Territory.
- (8) A reference in this section to engaging in conduct includes a reference to failing or refusing to engage in conduct.
- (9) A reference in this section to an offence against section 74 or 75 includes a reference to an offence:
  - (a) against section 6 of the *Crimes Act 1914*; or
  - (b) that is taken to have been committed because of section 11.2 or 11.2A of the *Criminal Code*; or
  - (c) against section 11.1, 11.4 or 11.5 of the *Criminal Code*;that relates to section 74 or 75 of this Act.

## 76A Doing act when PBR office reopens after end of period otherwise provided for doing act

- (1) If the last day of a period provided by this Act (except this section) or the regulations for doing an act is a day when the PBR office or a PBR sub-office is not open for business, the act may be done in prescribed circumstances on the next day when the office or sub-office is open for business.
- (2) For the purposes of this section, the PBR office or a PBR sub-office is taken not to be open for business on a day:
  - (a) declared by regulations to be a day on which the office or sub-office is not open for business; or
  - (b) declared, by a prescribed person in writing published in the prescribed way, to be a day on which the office or sub-office is not open for business.

### *Declarations*

- (3) A declaration mentioned in paragraph (2)(a) or (b) may identify the day by reference to its being declared a public holiday by or under a law of a State or Territory. This does not limit the way the declaration may identify the day.
- (4) A declaration mentioned in paragraph (2)(b):
  - (a) may be made before, on or after the day; and
  - (b) is not a legislative instrument.

### *Relationship with other law*

- (5) This section has effect despite the rest of this Act.
- (6) Subsection 36(2) of the *Acts Interpretation Act 1901* does not apply in relation to the act mentioned in subsection (1) of this section.

### *Exception for prescribed act*

- (7) This section does not apply to a prescribed act.

Note: Subsection 36(2) of the *Acts Interpretation Act 1901* is relevant to a prescribed act.

## 77 Applications for review

- (1) Applications may be made to the AAT for review of:
  - (a) a decision by the Minister under subsection 49(2); or
  - (b) a decision by the Secretary:
    - (i) under subsection 19(7) to exercise a power under subsection 19(3); or
    - (ii) under subsection 19(3) to license, or refuse to license, a person who applied to be so licensed in response to an invitation under paragraph 19(8)(c); or
    - (iii) under subsection 19(10) to make propagating material available; or
    - (iv) under subsection 19(11) to certify, or to refuse to certify, a plant variety; or
    - (v) under section 30 to accept or reject an application; or
    - (vi) under section 31 to vary, or refuse to vary, an application; or
    - (vii) under subsection 34(1) refusing to extend the period for giving a detailed description; or
    - (viii) under section 37 to require a test growing; or
    - (viii a) under paragraph 37(2B)(b) not to proceed further with an application, objection or request for revocation; or
    - (ix) under subsection 38(4) to the effect that the Secretary is satisfied of the matters referred to in that subsection; or

- (x) under subsection 38(5) to the effect that the Secretary is satisfied of the matters referred to in that subsection; or
  - (xi) under subsection 39(2) to issue a notice to an applicant; or
  - (xii) under paragraph 40(8)(b) refusing to extend the period for rebutting the *prima facie* case of essential derivation; or
  - (xiii) under section 40 in respect of an application for a declaration of essential derivation; or
  - (xiv) under section 41 to require a test growing; or
  - (xv) under section 44 to grant, or refuse to grant, PBR in a plant variety; or
  - (xvi) under section 50 to revoke, or not to revoke, PBR in a plant variety or a declaration that a plant variety is essentially derived from another plant variety; or
- (c) a decision of the Registrar under section 21 to amend, or refuse to amend, the Register.
- (2) The AAT does not have power under subsection 29(7) of the AAT Act to extend the time for making an application to that Tribunal for a review of a decision referred to in subsection (1).
- (3) The Secretary must give public notice of:
- (a) any application made under subsection (1); and
  - (b) any decision of the AAT on such an application; and
  - (c) any decision of a court in relation to, or arising out of:
    - (i) such an application; or
    - (ii) a decision of the AAT on such an application.
- (4) In this section:

**decision** has the same meaning as in the AAT Act.

## 78 Repeal

The *Plant Variety Rights Act 1987* is repealed.

## 79 Compensation for acquisition of property

- (1) If, apart from this section, the operation of this Act would result in an acquisition of property from a person otherwise than on just terms, the Commonwealth is to pay the person such reasonable amount of compensation as is agreed on between the person and the Commonwealth, or failing agreement, as is determined by a court of competent jurisdiction.
- (2) Any damages or compensation recovered, or other remedy given, in proceedings that are begun otherwise than under this section must be taken into account in assessing compensation payable in proceedings begun under this section and arising out of the same event or circumstance.
- (3) In this section:

**acquisition of property** has the same meaning as in paragraph 51(xxxi) of the Constitution.

**just terms** has the same meaning as in paragraph 51(xxxi) of the Constitution.

## 80 Regulations

- (1) The Governor-General may make regulations prescribing all matters:
- (a) required or permitted by this Act to be prescribed; or

- (b) necessary or convenient to be prescribed for carrying out or giving effect to this Act.
- (2) Without limiting subsection (1), that subsection includes the power to make regulations:
- (a) prescribing fees including:
    - (i) fees payable in respect of the making of applications for PBR, the examination of those applications and the issue of certificates in respect of the grant of PBR; and
    - (ii) fees payable in respect of the making of applications for declarations of essential derivation, the examination of those applications and the making of those declarations; and
    - (iii) fees payable by grantees of PBR at specified intervals or on specified dates; and
    - (iv) fees payable in respect of costs incurred by the Secretary in respect of the conduct or supervision of the test growing of plants;  
and, if the matter is not dealt with by another provision of this Act, specifying the time at which, or the circumstances in which, such fees are to be paid and the manner of payment of such fees; and
  - (b) making provision in relation to the refund, in specified circumstances, of the whole or part of a fee paid under this Act; and
  - (c) making provision in relation to the remission of, or the exemption of specified classes of persons from the payment of, the whole or a part of a fee; and
  - (d) making provision in relation to the amendment of an entry in the Register to correct a clerical error or an obvious mistake; and
  - (e) making such transitional and saving provisions as are necessary or convenient as a result of the repeal of the *Plant Variety Rights Act 1987* and the enactment of this Act.



## Part 9—Transitional

### 81 Definitions

In this Part:

**commencing day** means the day on which, in accordance with section 2, this Act commences.

**old Act** means the *Plant Variety Rights Act 1987*.

### 82 Plant variety rights under old Act to be treated as PBR under this Act

- (1) If:
  - (a) a person was granted plant variety rights in respect of a plant variety under the old Act; and
  - (b) those rights were still in force immediately before the commencing day;then, subject to the regulations, those rights have effect, despite the repeal of the old Act, on and after that day, as if:
  - (c) this Act had been in force at the time when those rights were granted; and
  - (d) they had been granted at that time as PBR in that variety.
- (2) Despite subsection (1), rights treated as if they had been granted as PBR under this Act continue in force for so long only as they would have continued in force if the old Act had not been repealed.
- (3) Nothing in this section gives the holder of rights treated as PBR in a particular plant variety under this Act the right to claim PBR in respect of plant varieties that would, under this Act, be dependent plant varieties in relation to that particular plant variety.
- (4) Nothing in this section gives the holder of rights treated as PBR in a particular plant variety under this Act the right to seek a declaration that another plant variety is an essentially derived variety of the particular plant variety unless PBR in that other plant variety was given only on or after the commencing day.

### 83 Applications for plant variety rights lodged and criminal proceedings begun before commencing day

- (1) If, before the commencing day:
  - (a) a person has made application for plant variety rights under the old Act; but
  - (b) the application has not been finally disposed of under that Act;the provisions of the old Act are taken to continue in force, for the purpose of dealing with the application, and any objection that has been made before that day, or is made after that day, in relation to the application.
- (2) If before the commencing day, criminal proceedings had been begun under the old Act but those proceedings had not been finally determined before that day, the provisions of the old Act are taken to continue in force, for the purposes of those proceedings.

### 84 Other applications and proceedings under old Act

- (1) Subject to the regulations, this Act applies, on and after the commencing day, to any application, request, action or proceeding made or started under the old Act and not finally dealt with or determined under that Act before that day as if the

application, request, action or proceeding had been made or started under a corresponding provision of this Act.

- (2) Subsection (1) does not apply in relation to an application for plant variety rights, or to criminal proceedings, covered by section 83.

### **85 Transitional arrangements for membership and functions of Advisory Committee**

- (1) The persons who, under the old Act, were members of the Plant Variety Rights Advisory Committee established under section 44 of that Act are to be taken, with effect from the commencing day, to be members of the Plant Breeder's Rights Advisory Committee established by section 63 of this Act.
- (2) Those members who were appointed by the Minister under section 45 of the old Act continue to hold office as if they had been appointed by the Minister under section 64 of the new Act on the same terms and conditions for the balance of the term of their respective appointments.
- (3) Any advice given to the Minister or to the Secretary by the Plant Variety Rights Advisory Committee has effect, on and after the commencing day, as if it had been given by the Plant Breeder's Rights Advisory Committee.

### **86 Register of Plant Varieties**

On and after the commencing day, the Register of Plant Varieties under the old Act is taken to form part of the Register of Plant Varieties under this Act.

**PANAMA<sup>2</sup>****Ley de 2012 que reforma la Ley de 1997 sobre Normas para la Protección de las Obtenciones Vegetales****LEY 63**

De 5 de octubre de 2012

**Que reforma artículos a la Ley 23 de 1997,  
sobre Normas para la Protección de las Obtenciones Vegetales****LA ASAMBLEA NACIONAL  
DECRETA:****Artículo 1.** El artículo 232 de la Ley 23 de 1997 queda así:

**Artículo 232. Definiciones.** Para los fines del presente Título, se adoptan los siguientes términos y definiciones:

**Comité Nacional de Semillas.** Comité Nacional, creado mediante el Decreto 3 de 1978, compuesto por representantes de entidades estatales y del sector privado. Tiene por objetivo el control de calidad de las semillas o material de propagación utilizado en el país, la certificación y el registro de semillas y el cumplimiento de las disposiciones legales vigentes en la materia, entre otros. Está compuesto por una Secretaría Técnica que incluye la Unidad de Reproducción de Semillas, el Laboratorio Oficial de Semillas y la Unidad de Certificación y Registro.

**Consejo para la Protección de las Obtenciones Vegetales.** Cuerpo consultivo, integrado por los distintos medios y gremios interesados en la protección de las obtenciones vegetales y presidido por el ministro de Desarrollo Agropecuario.

**Convenio Internacional para la Protección de las Obtenciones Vegetales (CIPOV),** del 2 de diciembre de 1961, revisado en Ginebra el 10 de noviembre de 1972, el 23 de octubre de 1978 y el 19 de marzo de 1991. Convenio internacional al que pueden adherirse los Estados y ciertas organizaciones intergubernamentales y que tiene por objetivo la protección de las variedades vegetales mediante un derecho de propiedad intelectual. Constituye la base jurídica de la Unión Internacional para la Protección de las Obtenciones Vegetales (UPOV).

**Dirección General del Registro de la Propiedad Industrial del Ministerio de Comercio e Industrias (DIGERPI).** Entidad estatal donde se llevan a cabo los registros de propiedad industrial de la República de Panamá. Para los efectos de este Título, será la encargada de llevar a cabo el registro de las variedades protegidas y de conceder el derecho de obtentor.

**Espécimen de referencia.** La más pequeña entidad utilizada por el obtentor para mantener su variedad, de la cual se toma la muestra representativa para el registro de la variedad.

**Instituto de Investigación Agropecuaria de Panamá (IDIAP).** Entidad estatal, con personalidad jurídica, patrimonio propio y autonomía administrativa, económica y técnica, encargada de normar todas las actividades de investigación, formulación y aplicación de políticas científicas y tecnológicas agropecuarias del sector público. Entidad facultada para efectuar los análisis técnicos para comprobar si una variedad reúne las condiciones establecidas en el presente Título, para poder ser registrada otorgándose derechos de obtentor sobre ella.

**Facultad de Ciencias Agropecuarias de la Universidad de Panamá.** Entidad académica estatal universitaria facultada para realizar análisis técnicos para comprobar si una variedad reúne las condiciones establecidas en el presente Título, para poder ser registrada otorgándose derechos de obtentor sobre ella.

<sup>2</sup> Legislation available in Spanish only.

**Material de reproducción o de multiplicación vegetativa.** Semillas, frutas, plantas, o partes de estas, utilizadas en la reproducción de plantas. Abarca la planta entera.

**Obtendor.** Persona natural o jurídica que haya creado o descubierto y desarrollado una variedad vegetal, la persona que sea el empleador de la persona antes mencionada, cuando el derecho aplicable así lo disponga, o que haya encargado su trabajo, o el causahabiente de las personas mencionadas, según el caso.

**Prioridad reconocida.** Prelación para la obtención de un derecho de obtendor, basada en la presentación, en el extranjero, de una solicitud referida a la misma materia que es objeto de una solicitud posterior presentada en la República de Panamá.

**Registro.** Registro de las variedades protegidas, que se lleva a cabo en la Dirección General del Registro de la Propiedad Industrial del Ministerio de Comercio e Industrias.

**Título.** Con minúscula inicial, término que hace referencia a documento que, de cualquier manera, representa, constituye o concede derechos.

**Unión Internacional para la Protección de las Obtenciones Vegetales (UPOV).** Organización intergubernamental con sede en Ginebra, Suiza, basada en el Convenio Internacional para la Protección de las Obtenciones Vegetales.

**Variedad.** Conjunto de plantas de un solo taxón botánico del rango más bajo conocido que, con independencia de si responde o no, plenamente, a las condiciones para la concesión de un derecho de obtendor, puede:

- a. definirse por la expresión de los caracteres resultantes de un cierto genotipo o de una cierta combinación de genotipos;
- b. distinguirse de cualquier otro conjunto de plantas por la expresión de uno de dichos caracteres, por lo menos;
- c. considerarse como una unidad, por su aptitud a propagarse sin alteración.

**Variedad protegida.** Variedad registrada en el Registro de Variedades Protegidas, de la Dirección General del Registro de la Propiedad Industrial del Ministerio de Comercio e Industrias, y que sea objeto de un derecho de obtendor.

**Artículo 2.** El artículo 233 de la Ley 23 de 1997 queda así:

**Artículo 233. Ámbito de aplicación.** El presente Título se aplicará a todos los géneros y especies vegetales.

**Artículo 3.** El artículo 234 de la Ley 23 de 1997 queda así:

**Artículo 234. Trato nacional y reciprocidad.** Serán beneficiarios de los derechos previstos por el presente Título:

1. Los nacionales de la República de Panamá y todas las personas que tengan su domicilio, residencia o sede en ella.
2. Los nacionales de un miembro de la UPOV, así como las personas naturales que tengan su domicilio en el territorio de un miembro de la UPOV y las personas jurídicas que tengan su sede en dicho territorio. Dichos nacionales, personas naturales y jurídicas del miembro de la UPOV de que se trate deberán cumplir las condiciones y formalidades impuestas a los nacionales de la República de Panamá.
3. A los fines del párrafo (2), se entenderá por “nacionales”, cuando el miembro de la UPOV sea un Estado, los nacionales de dicho Estado y, cuando el miembro de la UPOV sea una organización intergubernamental, los nacionales de cualquiera de sus Estados miembros.
4. Los nacionales de cualquier Estado que, sin ser miembro de la Unión Internacional para la Protección de las Obtenciones Vegetales, concedan una protección eficaz a los nacionales de la República de Panamá. El Órgano Ejecutivo determinará, para los fines de este numeral, si la protección concedida por otro Estado es eficaz y recíproca.

**Artículo 4.** El artículo 236 de la Ley 23 de 1997 queda así:

**Artículo 236. Principios.** Tendrá derecho a solicitar un derecho de obtentor, el obtentor.

En el caso de que varias personas hayan creado y desarrollado en común una variedad, el derecho a la protección les corresponderá en común. Salvo estipulación en contrario entre los coobtentores, las partes de estos serán iguales.

Cuando la persona que haya creado o descubierto y desarrollado una variedad vegetal sea un empleado, el derecho a solicitar un derecho de obtentor se regirá por el contrato de trabajo en cuyo marco se haya creado o descubierto y desarrollado la variedad, de conformidad con el derecho aplicable a dicho contrato.

**Artículo 5.** El artículo 237 de la Ley 23 de 1997 queda así:

**Artículo 237. Características del derecho.** El derecho de obtentor será transferible y heredable. El heredero o causahabiente podrá hacer uso de este derecho, derivar beneficios y disponer de él durante su período de vigencia, de la misma manera y bajo las mismas condiciones que su predecesor. El dueño del derecho podrá conceder licencias de explotación de las variedades protegidas de conformidad con lo dispuesto en los artículos 238 y 239.

Salvo disposición expresa prevista en la presente Ley, no podrá limitarse el libre ejercicio de un derecho de obtentor salvo por razones de interés público. Cuando tal limitación tenga por efecto que el ministro de Comercio e Industrias permita a un tercero realizar cualquiera de los actos para los que se requiere la autorización del obtentor, el obtentor recibirá una remuneración equitativa.

**Artículo 6.** El artículo 238 de la Ley 23 de 1997 queda así:

**Artículo 238. Alcance del derecho de obtentor.**

1. Derecho de obtentor sobre el material de reproducción o de multiplicación:

Salvo lo dispuesto en esta Ley sobre las excepciones y el agotamiento del derecho de obtentor, se requerirá la autorización del obtentor para los siguientes actos en relación con el material de reproducción o de multiplicación de la variedad protegida:

- a. La producción o la reproducción (multiplicación).
- b. La preparación a los fines de la reproducción o de la multiplicación.
- c. La oferta en venta.
- d. La venta o cualquier otra forma de comercialización.
- e. La exportación.
- f. La importación.
- g. La posesión para cualquiera de los fines anteriores.

El obtentor podrá supeditar la autorización que haya concedido, en virtud de los numerales anteriores a ciertas condiciones y limitaciones definidas por él mismo.

2. Derecho de obtentor sobre el producto de la cosecha:

Salvo lo dispuesto en esta Ley sobre las excepciones y el agotamiento del derecho de obtentor, se requerirá autorización del obtentor para los actos mencionados en los puntos a) a la h) del numeral 1 anterior, realizados en relación al producto de la cosecha, incluidas plantas enteras y partes de plantas, obtenido por utilización no autorizada de material de reproducción o de multiplicación de la variedad protegida, a menos que el obtentor haya podido ejercer razonablemente su derecho en relación con dicho material de reproducción o de multiplicación.

**Artículo 7.** El artículo 239 de la Ley 23 de 1997 queda así:

**Artículo 239. Variedades derivadas y algunas otras variedades.** Se aplicará lo dispuesto en el artículo anterior, respecto del material de reproducción o de multiplicación de la variedad protegida o el producto de la cosecha:

1. A las variedades derivadas esencialmente de la variedad protegida, cuando esta no sea a su vez una variedad esencialmente derivada.
2. A las variedades que no se distingan claramente de la variedad protegida de conformidad con lo dispuesto en esta Ley, y
3. A las variedades cuya producción necesite el empleo repetido de la variedad protegida.

Para los efectos de esta Ley, se considerará que una variedad es esencialmente derivada de otra variedad ("la variedad inicial") si:

- a. Se deriva principalmente de la variedad inicial, o de una variedad que a su vez se deriva principalmente de la variedad inicial, conservando al mismo tiempo las expresiones de los caracteres esenciales que resulten del genotipo o de la combinación de genotipos de la variedad inicial,
- b. Se distingue claramente de la variedad inicial, y
- c. Salvo por lo que respecta a las diferencias resultantes de la derivación, es conforme a la variedad inicial en la expresión de los caracteres esenciales que resulten del genotipo o de la combinación de genotipos de la variedad inicial.

Las variedades esencialmente derivadas podrán obtenerse, por ejemplo, por selección de un mutante natural o inducido o de una variante somaclonal, selección de un individuo variante entre las plantas de la variedad inicial, retrocruzamientos o transformaciones por ingeniería genética.

**Artículo 8.** El artículo 241 de la Ley 23 de 1997 queda así:

**Artículo 241. Autorización de venta de semilla.** En materia de requisitos para la venta de semillas, el Comité Nacional de Semillas tomará en consideración lo establecido por el presente Título.

**Artículo 9.** El artículo 243 de la Ley 23 de 1997 queda así:

**Artículo 243. Condiciones de la protección.** Se concederá el derecho de obtentor cuando la variedad: sea nueva, distinta, homogénea, estable y haya recibido una denominación de conformidad con las disposiciones del artículo 265.

La concesión del derecho de obtentor solamente podrá depender de las condiciones antes mencionadas, y se otorgará a reserva de que el obtentor haya satisfecho las formalidades previstas por el presente Título y pagado las tasas adeudadas.

**Artículo 10.** El artículo 244 de la Ley 23 de 1997 queda así:

**Artículo 244. Novedad.** La variedad será considerada nueva si, en la fecha de presentación de la solicitud de derecho de obtentor, o, llegado el caso, en la fecha de prioridad, el material de reproducción o de multiplicación vegetativa o un producto de cosecha de la variedad no ha sido vendido o entregado a terceros de otra manera, por el obtentor o con su consentimiento, a los fines de la explotación de la variedad:

1. En el territorio de la República de Panamá, más de un año antes de esa fecha.
2. En el territorio de cualquier otro Estado, más de cuatro años o, en caso de árboles y vides, más de seis años antes de esa fecha.

**Artículo 11.** El artículo 245 de la Ley 23 de 1997 queda así:

**Artículo 245. Distinción.** La variedad se considerará distinta si se distingue claramente de cualquier otra variedad cuya existencia en la fecha de presentación de la solicitud, sea notoriamente conocida. En particular, la presentación, en cualquier país, de una solicitud de derecho de obtentor o de inscripción en un catálogo de variedades admitidas para la comercialización, se reputará que hace a la variedad, objeto de la solicitud, notoriamente conocida a partir de la fecha de la solicitud, si esta conduce a la concesión del derecho de obtentor o a la inscripción en el catálogo, según el caso.

La notoriedad de la existencia de otra variedad podrá establecerse por diversas referencias, tales como explotación de la variedad ya en curso, inscripción de la variedad en un registro de variedades mantenido por una asociación profesional reconocida, o por presencia de la variedad en una colección de referencia.

**Artículo 12.** El artículo 249 de la Ley 23 de 1997 queda así:

**Artículo 249. Duración del derecho del obtentor.** El derecho otorgado al obtentor será de 20 años, contados a partir de la fecha de concesión del título de protección. Para los árboles y las vides, con inclusión, en cada caso, de sus portainjertos, la protección tendrá una duración de 25 años. El derecho del obtentor se mantendrá vigente solo mientras pague las tasas dimanantes del registro y mantenga su derecho en los términos establecidos por este Título.

Una vez venzan los períodos de protección, se considerará que las variedades pasan al dominio público.

**Artículo 13.** Se adiciona el artículo 250-A a la Ley 23 de 1997, así:

**Artículo 250-A. Excepciones al derecho de obtentor.** El derecho de obtentor no se extenderá:

1. A los actos realizados en un marco privado con fines no comerciales.
2. A los actos realizados a título experimental.
3. A los actos realizados a los fines de la creación de nuevas variedades así como, a menos que las disposiciones del artículo 239 sean aplicables, a los actos mencionados en el artículo 238 realizados con tales variedades.

No obstante lo dispuesto en esta Ley sobre el alcance del derecho de obtentor, se restringe el derecho de obtentor respecto de toda variedad, dentro de los límites razonables y a reserva de la salvaguardia de los intereses legítimos del obtentor que se establecerán por vía reglamentaria, con el fin de permitir a los agricultores utilizar para fines de reproducción o de multiplicación, en su propia explotación, el producto de la cosecha que haya obtenido por el cultivo, en su propia explotación, de la variedad protegida o de una variedad cubierta por el artículo 239 1) y 2).

**Artículo 14.** Se adiciona el artículo 250-B a la Ley 23 de 1997, así:

**Artículo 250-B. Agotamiento del derecho de obtentor.** El derecho de obtentor no se extenderá a los actos relativos al material de su variedad, o de una variedad derivada, que haya sido vendido o comercializado de otra manera en el territorio de Panamá por el obtentor o con su consentimiento, a menos que esos actos:

1. Impliquen una nueva reproducción o multiplicación de la variedad en cuestión.
2. Impliquen una exportación de material de la variedad, que permita reproducirla, a un país que no proteja las variedades del género o de la especie vegetal a que pertenezca la variedad, salvo si el material exportado está destinado al consumo.

Para los efectos del agotamiento del derecho, se entenderá por "material", en relación con una variedad:

1. El material de reproducción o de multiplicación vegetativa, en cualquier forma.
2. El producto de la cosecha, incluidas las plantas enteras y las partes de plantas.

**Artículo 15.** El artículo 252 de la Ley 23 de 1997 queda así:

**Artículo 252. Registro de las obtenciones vegetales.** El registro de las obtenciones vegetales se llevará a cabo en la Dirección General del Registro de la Propiedad Industrial del Ministerio de Comercio e Industrias (DIGERPI).

Todos los trámites administrativos de este Título ante la DIGERPI podrán llevarse a cabo mediante la utilización de medios electrónicos o telemáticos disponibles o por conocer.

Todo lo relacionado a la utilización de medios electrónicos o telemáticos se regirá por la legislación vigente.

Para tales efectos, la DIGERPI determinará las condiciones generales, requisitos y características técnicas necesarias.

Para dicho propósito, la Dirección General del Registro de la Propiedad Industrial mantendrá un registro de obtenciones vegetales, en el que constarán las solicitudes y los derechos otorgados. La Dirección General del Registro de la Propiedad Industrial diferenciará entre registro de solicitudes y registro de derechos otorgados, los que serán públicos.

Toda persona que tenga un interés legítimo podrá:

1. Consultar los documentos relativos a la solicitud.
2. Consultar los documentos relativos a un derecho de obtentor ya concedido.
3. Visitar los ensayos en cultivo y examinar los demás ensayos necesarios, en virtud de examen técnico.

En el caso de variedades cuya producción requiera el empleo repetido de otras variedades (componentes), el solicitante, al presentar la solicitud, podrá pedir que los documentos y los ensayos relativos a los componentes se eximan de las medidas de publicidad.

La Dirección General del Registro de la Propiedad Industrial conservará los elementos de los expedientes, los originales o las reproducciones, durante un plazo de cinco años a partir de la fecha de retiro o del rechazo de la solicitud, o de la fecha de extinción del derecho de obtentor, según sea el caso.

Vencido el plazo anterior, serán enviados a la Dirección Nacional de Archivo Nacional del Registro Público.

A fin de facilitar la custodia, consulta y expedición de reproducciones autenticadas y certificaciones, la DIGERPI establecerá un fondo documental electrónico mediante el cual se almacenarán los documentos que reposan en los expedientes y archivos de papel bajo su custodia.

Los documentos almacenados de esta manera, sus reproducciones debidamente autenticadas y certificaciones tendrán el mismo valor jurídico que los documentos originales, serán admisibles como medio de prueba y tendrán la misma fuerza probatoria otorgada a los documentos en el Libro Segundo, del Procedimiento Civil, del Código Judicial.

**Artículo 16.** El artículo 254 de la Ley 23 de 1997 queda así:

**Artículo 254. Tasas.** La Dirección General del Registro de la Propiedad Industrial percibirá las tasas en concepto de servicios, en relación con la protección de las obtenciones vegetales en los siguientes casos:

a. Por solicitud de derecho obtentor	B/.100.00
b. Por solicitud de antecedentes	B/.25.00
c. Por solicitud de certificación	B/.35.00
d. Por desglose de cada documento	B/.10.00
e. Por solicitud de registro de cambio de nombre del titular, domicilio, cesión, traspaso, licencia contractual u obligatoria y demás cambios administrativos	B/.50.00
f. Por solicitud de copia autenticada de documento	B/.10.00
g. Por cada publicación en el BORPI	B/.10.00
h. Certificado de Obtentor	B/.50.00

El Órgano Ejecutivo queda facultado para fijar, por conducto del ministro de Comercio e Industrias, la sumas que, en concepto de tasas por servicios no incluidos en el artículo anterior, deban pagar los interesados. Esta facultad se extiende a la variación y nuevas fijaciones que, de tiempo en tiempo y con el concepto favorable del director general de la DIGERPI, se estimen necesarias o convenientes.



**Artículo 17.** El artículo 256 de la Ley 23 de 1997 queda así:

**Artículo 256. Forma y contenido de la solicitud.** Cualquier persona que desee obtener la protección de una variedad deberá presentar una solicitud a la Dirección General del Registro de la Propiedad Industrial y pagar la tasa correspondiente.

So pena de nulidad, la solicitud deberá incluir, como mínimo, la siguiente información:

1. El nombre y la dirección de la persona que ha creado y desarrollado la variedad, de no ser el solicitante.
  2. El nombre y la dirección del solicitante y del apoderado legal.
  3. La identificación del taxón botánico (nombre latino o nombre común).
  4. La denominación propuesta para la variedad, o una designación provisional.
  5. Si se reivindica la prioridad de una solicitud anterior, indicar el Estado miembro del Convenio Internacional para la Protección de las Obtenciones Vegetales (CIPOV) que acogió la mencionada solicitud, así como la fecha de presentación.
  6. La descripción técnica de la variedad.
  7. El comprobante del pago de la tasa de solicitud.
- Esta materia será debidamente reglamentada por el Órgano Ejecutivo.

**Artículo 18.** El artículo 257 de la Ley 23 de 1997 queda así:

**Artículo 257. Prioridad.** El solicitante podrá beneficiarse de la prioridad de una solicitud anterior, presentada legalmente para la misma variedad, por él mismo o por su predecesor en el Título, ante la autoridad de un miembro de la Unión Internacional para la Protección de las Obtenciones Vegetales.

Si la solicitud presentada ante la Dirección General del Registro de la Propiedad Industrial ha sido precedida de varias solicitudes, la prioridad solo podrá basarse en la solicitud más antigua.

Se habrá de reivindicar la prioridad, de forma expresa, en la solicitud presentada ante la Dirección General del Registro de la Propiedad Industrial. Solo podrá reivindicarse durante un plazo de 12 meses, contado a partir de la fecha de presentación de la primera solicitud. El día de la presentación no estará comprendido en ese plazo.

Para beneficiarse del derecho de prioridad, el solicitante deberá suministrar a la Dirección General del Registro de la Propiedad Industrial, en un plazo de tres meses, contado a partir de la fecha de presentación, de conformidad con lo establecido en el presente Título, una copia de los documentos que constituyen la primera solicitud, certificada conforme por la autoridad que la haya recibido.

La Dirección General del Registro de la Propiedad Industrial podrá solicitar que se presente, en un plazo de tres meses, contado a partir de la fecha de recepción de la comunicación, una traducción de la primera solicitud o de algunos documentos que constituyan la primera solicitud.

La prioridad tendrá por efecto que la solicitud se considere como presentada en la fecha de presentación de la primera solicitud, con respecto a las condiciones de la protección vinculadas a la variedad.

El obtentor se beneficiará de un plazo de dos años tras la expiración del plazo de prioridad o, cuando la primera solicitud sea rechazada o retirada, de un plazo adecuado a partir del rechazo o de la retirada, para proporcionar cualquier información, documento o material exigidos a los fines del examen previsto en esta Ley.

**Artículo 19.** El artículo 258 de la Ley 23 de 1997 queda así:

**Artículo 258. Examen de forma de la solicitud y fecha de presentación.** La solicitud deberá cumplir los requisitos establecidos en cuanto a fondo y forma.

Si la solicitud está incompleta o no es conforme, la Dirección General del Registro de la Propiedad Industrial pedirá al solicitante que la corrija en un plazo de 30 días calendario, contado a partir de la fecha de recepción de la notificación. Toda

solicitud que no haya sido corregida en el plazo concedido será considerada como inexistente.

Se asignará una fecha de presentación a una solicitud completa y conforme, que será inscrita en el registro. Se considerará fecha de presentación aquella en que la Dirección General del Registro de la Propiedad Industrial haya recibido los elementos de información establecidos en este Título.

**Artículo 20.** El artículo 259 de la Ley 23 de 1997 queda así:

**Artículo 259. Examen de fondo de la solicitud.** La solicitud será examinada en cuanto a su fondo, a fin de comprobar, sobre la base de la información y material suministrado en la solicitud, que la variedad es nueva, distinta, homogénea y estable, que la denominación es conforme a las disposiciones del artículo 265, y que el solicitante está habilitado según las disposiciones establecidas en este Título.

Si el examen revela un obstáculo para la concesión del derecho de obtentor, la solicitud será rechazada.

El examen técnico de la variedad para determinar si la variedad es distinta, homogénea y estable se regirá según lo establecido en el artículo 260.

**Artículo 21.** El artículo 260 de la Ley 23 de 1997 queda así:

**Artículo 260. Examen técnico de la variedad.**

1. La variedad será objeto de un examen técnico cuya finalidad será determinar que la variedad es distinta, homogénea y estable.
2. Cuando se haya comprobado que la variedad cumple las mencionadas condiciones, establecer la descripción oficial de la variedad.
3. La Dirección General del Registro de la Propiedad Industrial podrá organizar el examen de las condiciones de distinción, homogeneidad y estabilidad, según las siguientes modalidades:
  - a. El Instituto de Investigación Agropecuaria de Panamá o la Facultad de Ciencias Agropecuarias de la Universidad de Panamá podrán cultivar la variedad o efectuar otros ensayos necesarios,
  - b. Hacer que se efectúe el cultivo o los otros ensayos necesarios,
  - c. Tener en cuenta los resultados de los ensayos en cultivo o de otros ensayos ya efectuados.

Con vistas a este examen, el obtentor proporcionará toda información, documento o material necesarios especificados en la presente Ley o en su reglamento.

4. El costo del examen técnico será pagado por el solicitante, directamente, a la institución que lo practique. Dicho costo estará determinado por los materiales utilizados y el rendimiento de los servicios. El costo del examen deberá ser razonable. Esta materia será reglamentada por el Órgano Ejecutivo.

**Artículo 22.** El artículo 262 de la Ley 23 de 1997 queda así:

**Artículo 262. Publicidad de la solicitud.** Si la solicitud cumple con los requisitos establecidos en este Título, será publicada en el Boletín Oficial del Registro de la Propiedad Industrial contentivo, por lo menos, de los elementos mencionados en los numerales 1, 2, 3, 4 y 5 del artículo 256.

**Artículo 23.** El artículo 263 de la Ley 23 de 1997 queda así:

**Artículo 263. Impugnación relativa a la concesión del derecho de obtentor.** Una vez publicada la solicitud, cualquiera que estime que no se debería otorgar el certificado de obtentor al solicitante podrá presentar en un plazo de dos meses contado desde la fecha de la publicación en el BORPI, la oposición ante los tribunales competentes para conocer los casos de Propiedad Industrial y de acuerdo con el procedimiento señalado en la Ley 35 de 10 de mayo de 1996.

La oposición únicamente podrá pretender el rechazo de la solicitud porque la variedad no es nueva, distinta, homogénea o estable, o que el solicitante no tiene derecho a la protección.

**Artículo 24.** El artículo 264 de la Ley 23 de 1997 queda así:

**Artículo 264. Concesión del derecho de obtentor y rechazo de la solicitud.** La Dirección General del Registro de la Propiedad Industrial concederá el derecho de obtentor cuando, como resultado del examen técnico de la variedad, efectuado por el Instituto de Investigación Agropecuaria de Panamá o la Facultad de Ciencias Agropecuarias de la Universidad de Panamá o un organismo que se designe, compruebe que la variedad cumple con las condiciones previstas en el artículo 243 y que el solicitante ha satisfecho las demás exigencias del presente Título.

La Dirección General del Registro de la Propiedad Industrial rechazará la solicitud si comprueba lo contrario.

La concesión del derecho de obtentor o el rechazo de la solicitud se inscribirán en el registro de obtenciones vegetales y se publicarán en el Boletín.

El derecho de obtentor se inscribirá, también, en dicho registro. La descripción de la variedad podrá incluirse en el registro por referencia de los expedientes técnicos de la Dirección General del Registro de la Propiedad Industrial y de los exámenes suministrados por el Instituto de Investigación Agropecuaria de Panamá o la Facultad de Ciencias Agropecuarias de la Universidad de Panamá o por un organismo que se designe.

**Artículo 25.** Se adiciona el artículo 264-A a la Ley 23 de 1997, así:

**Artículo 264-A. Protección provisional.** Se establece la protección provisional para salvaguardar los intereses del obtentor durante el período comprendido entre la publicación de la solicitud de concesión de un derecho de obtentor y la concesión del derecho.

El titular de un derecho de obtentor tendrá derecho como mínimo a una remuneración equitativa o, en su caso, a la indemnización por daños y perjuicios, percibida de quien, en el intervalo previsto en el párrafo anterior, haya realizado actos que, después de la concesión del derecho, requieran la autorización del obtentor de conformidad con lo dispuesto en los artículos 238 y 239.

**Artículo 26.** El artículo 265 de la Ley 23 de 1997 queda así:

**Artículo 265. Denominación.**

1. La variedad será designada por una denominación destinada a ser su designación genérica. A reserva de lo dispuesto en el párrafo 4, ningún derecho relativo a la designación registrada como la denominación de la variedad obstaculizará la libre utilización de la denominación en relación con la variedad, incluso después de la expiración del derecho de obtentor.
2. La denominación deberá permitir identificar la variedad. No podrá componerse únicamente de cifras, salvo cuando sea una práctica establecida para designar variedades. No deberá ser susceptible de inducir en error o de prestarse a confusión sobre las características, el valor o la identidad de la variedad o sobre la identidad del obtentor. Concretamente, deberá ser diferente de toda denominación que designe, en el territorio de cualquier miembro de la UPOV, una variedad existente de la misma especie vegetal o de una especie vecina.
3. La denominación de la variedad será propuesta por el obtentor a la Dirección General del Registro de la Propiedad Industrial. Si se comprueba que esa denominación no responde a las exigencias del párrafo 2, la Dirección General del Registro de la Propiedad Industrial denegará el registro y exigirá que el obtentor proponga otra denominación en un plazo prescrito. La denominación será registrada por la Dirección General del Registro de la Propiedad Industrial al mismo tiempo que se conceda el derecho de obtentor.

4. Los derechos anteriores de terceros no serán afectados. Si, en virtud de un derecho anterior, la utilización de la denominación de una variedad está prohibida a una persona que está obligada a utilizarla, de conformidad con lo dispuesto en el párrafo 7, la Dirección General del Registro de la Propiedad Industrial exigirá que el obtentor proponga otra denominación para la variedad.
5. Toda variedad objeto de solicitud de concesión de un derecho de obtentor deberá ser presentada bajo la misma denominación en todos los miembros de la UPOV. La Dirección General del Registro de la Propiedad Industrial deberá registrar la denominación así propuesta, a menos que considere que la denominación es inadecuada. En tal caso, exigirá que el obtentor proponga otra denominación.
6. La Dirección General del Registro de la Propiedad Industrial deberá asegurar la comunicación a las autoridades de los miembros de la UPOV de las informaciones relativas a las denominaciones de variedades, concretamente, de la propuesta, el registro y la cancelación de denominaciones. Toda autoridad podrá transmitir sus observaciones eventuales sobre el registro de una denominación a la DIGERPI.
7. Quien, en el territorio de la República de Panamá, proceda a la puesta en venta o a la comercialización del material de reproducción o de multiplicación vegetativa de una variedad protegida en dicho territorio, estará obligado a utilizar la denominación de esa variedad, incluso después de la expiración del derecho de obtentor relativo a esa variedad, a condición de que, de conformidad con lo dispuesto en el párrafo 4, no se opongan derechos anteriores a esa utilización.
8. Cuando una variedad se ofrezca en venta o se comercialice, estará permitido asociar una marca de fábrica o de comercio, un nombre comercial o una indicación similar, a la denominación de variedad registrada. Si tal indicación se asociase de esta forma, la denominación deberá ser, no obstante, fácilmente reconocible.

**Artículo 27.** El artículo 267 de la Ley 23 de 1997 queda así:

**Artículo 267. Procedimiento de registro.** La denominación propuesta para la variedad cuya protección se solicita será presentada al mismo tiempo que la solicitud.

Con sujeción al pago de una tasa especial y a la indicación de una designación provisional en la solicitud, el solicitante podrá diferir el procedimiento de registro de la denominación. En ese caso, el solicitante deberá presentar la propuesta de denominación en un plazo de 30 días, contado a partir de la fecha de recepción de la solicitud. Si la propuesta no se presentara en el plazo fijado, la solicitud será rechazada.

Para el estudio de la viabilidad de una denominación, la Dirección General del Registro de la Propiedad Industrial someterá su propuesta a la consideración del Instituto de Investigación Agropecuaria de Panamá, que será la autoridad competente para determinar si una denominación puede inscribirse o no. La Dirección General del Registro de la Propiedad Industrial acatará el resultado del informe del Instituto de Investigación Agropecuaria de Panamá.

La denominación se registrará al mismo tiempo que se conceda el derecho de obtentor.

La propuesta de denominación se publicará en el Boletín, salvo si la Dirección General del Registro de la Propiedad Industrial rechace la misma de conformidad con lo establecido en el presente Título.

Una vez publicada la solicitud, cualquiera que estime que no se debería otorgar el registro de la denominación, basada en cualquiera de los motivos de rechazo previstos en el presente Título, podrá presentar en un plazo de dos meses contado desde la fecha de la publicación en el BORPI, la oposición ante los tribunales competentes para conocer los casos de Propiedad Industrial y de acuerdo con el procedimiento señalado en la Ley 35 de 10 de mayo de 1996.

**Artículo 28.** El artículo 268 de la Ley 23 de 1997 queda así:

**Artículo 268. Cancelación de una denominación y registro de una nueva denominación.** La Dirección General del Registro de la Propiedad Industrial cancelará la denominación registrada:

1. Si el titular lo solicita, invocando la existencia de un interés legítimo.
2. Si un tercero presenta una decisión judicial que prohíba la utilización de la denominación en relación con la variedad. Cualquier persona interesada, y previa audiencia del titular, podrá solicitar a los tribunales de justicia competentes para conocer procesos de propiedad industrial, que declare la nulidad de una denominación registrada, si no cumple con los requisitos de este Título.

En atención a lo que se refiere este artículo, el afectado podrá presentar una nueva denominación que se registrará y publicará en cuanto esté aprobada, quedando sujeta al proceso de oposición y nulidad si fuera el caso.

**Artículo 29.** El artículo 270 de la Ley 23 de 1997 queda así:

**Artículo 270. Derechos.** El obtentor deberá pagar durante la vigencia de la protección los derechos que a continuación se detallan:

- a. Doscientos balboas (B/.200.00) de manera previa al otorgamiento del registro, que corresponderá a los primeros cinco años de protección;
- b. Dos mil doscientos balboas (B/.2,200.00) al vencimiento del primer plazo de protección y por los siguientes cinco años;
- c. Dos mil cuatrocientos balboas (B/.2,400.00) al vencimiento del segundo plazo de protección y por los siguientes cinco años;
- d. Tres mil doscientos balboas (B/.3,200.00) al vencimiento del tercer plazo de protección y por el resto de protección.

El pago podrá efectuarse en cualquier momento, antes de la fecha del vencimiento del quinquenio respectivo, salvo el primer pago. Transcurridos seis meses, desde la fecha en que debió efectuarse el pago de algunas de las tasas a que se refiere este artículo, sin haberse hecho efectivo dicho pago, se entenderá que el titular ha abandonado su derecho de obtentor y este caducará de pleno derecho.

**Artículo 30.** El artículo 271 de la Ley 23 de 1997 queda así:

**Artículo 271. Extinción y renuncia al derecho de obtentor.** El derecho de obtentor pasa al dominio público, cuando:

1. Venza su vigencia, al final de los plazos previstos en el artículo 249.
2. El titular renuncie al derecho mediante declaración escrita, dirigida a la Dirección General del Registro de la Propiedad Industrial.

**Artículo 31.** Se adiciona el artículo 271-A a la Ley 23 de 1997, así:

**Artículo 271-A. Caducidad del derecho de obtentor.**

1. Se podrá declarar la caducidad del derecho de obtentor, si se comprueba que ya no se cumplen efectivamente las condiciones de homogeneidad y estabilidad.
2. Además, se podrá declarar la caducidad de un derecho de obtentor si, dentro de un plazo establecido y después de haber sido requerido al efecto:
  - a. El obtentor no presenta las informaciones, documentos o material considerados necesarios para controlar el mantenimiento de la variedad,
  - b. El obtentor no ha pagado las tasas adeudadas, en su caso, para el mantenimiento en vigor de su derecho, o
  - c. El obtentor no propone otra denominación adecuada, en caso de cancelación de la denominación de la variedad después de la concesión del derecho.
3. No podrá declararse la caducidad de un derecho de obtentor por causas distintas de las mencionadas en los párrafos 1 y 2.

**Artículo 32.** El artículo 272 de la Ley 23 de 1997 queda así:

**Artículo 272. Nulidad del derecho de obtentor.** Se declarará nulo el derecho de obtentor, si se comprueba que:

1. La variedad no era nueva o distinta en la fecha de presentación de la solicitud o, llegado el caso, en la fecha de prioridad.
2. Cuando la concesión del derecho de obtentor se basó esencialmente en las informaciones y documentos proporcionados por el solicitante, la variedad no era homogénea o estable en la mencionada fecha.
3. El derecho de obtentor fue concedido a una persona que no tenía derecho a él, y que el derechohabiente no entabló, o renunció a entablar, una demanda de adjudicación judicial, de conformidad con el artículo 242.

Salvo disposición en contrario del presente Título, el derecho de obtentor declarado nulo se considerará como no concedido.

Toda persona que justifique un interés estará legitimado para presentar una demanda de nulidad ante los tribunales competentes para conocer los casos de Propiedad Industrial y de acuerdo con el procedimiento señalado en la Ley 35 de 10 de mayo de 1996.

**Artículo 33.** El artículo 273 de la Ley 23 de 1997 queda así:

**Artículo 273. Recursos civiles.** Toda persona que, sin estar autorizada para ello, realice actos que requieran la autorización del titular, utilice una designación u omita utilizar una denominación de variedad, en violación a las disposiciones de este Título, podrá ser demandada por el obtentor o por el titular de una licencia exclusiva, y le serán aplicables las disposiciones por uso no autorizado de derechos de Propiedad Industrial y el procedimiento establecido en la Ley 35 de 10 de mayo de 1996.

A reserva de lo dispuesto en el presente Título, las disposiciones aplicables al ejercicio de los derechos conferidos en virtud de invenciones y modelos de utilidad, según lo establecen las disposiciones sobre Propiedad Industrial de la República de Panamá, serán aplicables, *mutatis mutandis*, al ejercicio de los derechos en virtud de un derecho de obtentor.

**Artículo 34.** El artículo 275 de la Ley 23 de 1997 queda así:

**Artículo 275. Sanción económica vinculada a la utilización no autorizada de una denominación de variedad vegetal.** Sin perjuicio de indemnizaciones u otras pretensiones del titular del derecho de obtentor o el licenciataria, el juez a petición del demandante podrá aplicar una sanción económica de mil balboas (B/.1,000.00) a diez mil balboas (B/.10,000.00) y, en caso de reincidencia, la sanción será el doble, cuando se demuestre que el demandado con conocimiento de causa utilizó una designación u omitió utilizar una denominación de variedad en violación a las disposiciones del presente Título.

**Artículo 35.** El artículo 279 de la Ley 23 de 1997 queda así:

**Artículo 279. Coordinación.** El Instituto de Investigación Agropecuaria coordinará con la Dirección General del Registro de la Propiedad Industrial todo lo relacionado con el examen de la solicitud en materia de taxones botánicos, los exámenes técnicos, el mantenimiento de la variedad, la viabilidad de las denominaciones, lo referente a las publicaciones en el Boletín Oficial del Registro de la Propiedad Industrial, y cualquier otra actividad necesaria para la adecuada protección y registro de las obtenciones vegetales.

**Artículo 36.** La presente Ley modifica los artículos 232, 233, 234, 236, 237, 238, 239, 241, 243, 244, 245, 249, 252, 254, 256, 257, 258, 259, 260, 262, 263, 264, 265, 267, 268, 270, 271, 272, 273, 275 y 279, adiciona los artículos 250-A, 250-B y 264-A, 271-A, deroga los artículos 240, 266, 274 y 280 de la Ley 23 de 15 de julio de 1997 y todas las disposiciones que les sean contrarias.

**Artículo 37.** Esta Ley comenzará a regir el día de su promulgación.

### **COMUNÍQUESE Y CÚMPLASE.**

Proyecto 512 de 2012 aprobado en tercer debate en el Palacio Justo Arosemena, ciudad de Panamá, a los veintisiete días del mes de septiembre del año dos mil doce.

El Presidente,

Sergio R. Gálvez Evers

El Secretario General,  
Wigberto E. Quintero G.

**ÓRGANO EJECUTIVO NACIONAL. PRESIDENCIA DE LA REPÚBLICA, PANAMÁ,  
REPÚBLICA DE PANAMA, 5 DE OCTUBRE DE 2012.**

RICARDO MARTINELLI BERROCAL  
Presidente de la República

RICARDO QUIJANO J.  
Ministro de Comercio e Industrias

**POLAND**

**Act of 26 June 2003**  
**on the Legal Protection of Plant Varieties**  
**as last amended in 2011**  
(O. J. of 6 August 2003 No 137, item 1300)

as amended by:

1. Act of 9 June 2006 amending the Act on the legal protection of plant varieties and the Seed Act  
O.J. of 14 July 2006 No 126, item 877 – article 1
2. Act of 9 May 2007 amending the Act on copyright and related rights and certain other acts  
O.J. of 5 June 2007 No 99, item 662 – article 5
3. Act of 1 July 2011 amending the Act on the legal protection of plant varieties  
O.J. of 6 September 2011 No 186, item 1099 – article 1

CHAPTER 1  
GENERAL PROVISIONS

Article 1

The issues of the legal protection of plant varieties shall be regulated in this Act, and in particular:

- 1) the mode and way of granting and cancellation of the right to legal protection of the variety bred, or discovered and developed by the breeder, and also making commercial use thereof;
- 2) scope of the protection of that right.

Article 2

1. For the purpose of this Act:

- 1) <sup>(1)</sup> *variety* – shall be taken to mean a grouping of plants within a single botanical taxon of the lowest known rank, which, whether it fully complies or not with the conditions of granting exclusive right:
  - a) *is defined by the expression of the characteristics resulting from a given genotype or combination of genotypes,*
  - b) *is distinguished from any other plant grouping by the expression of at least one of those characteristics,*
  - c) *remains unchanged after propagation;*
- 2) <sup>(2)</sup> *hybrid variety* – shall be taken to mean a variety produced each time by crossing of specified plant groupings, in accordance with the method and sequence given by the breeder of this variety;



- 3) hybrid variety component – shall be taken to mean a variety or a plant line used in the process of production of a hybrid variety;
- 4) protected variety – shall be taken to mean a variety, the breeder has the right of legal protection thereto and making commercial use thereof;
- 5) plant breeding – shall be taken to mean the activity aimed at developing and maintenance of varieties;
- 6) variety maintenance– shall be taken to mean the activity aimed at production of propagating material of this variety, which shall assure preservation of its characteristics, uniformity and stability;
- 7) breeder – shall be taken to mean a person who:
- a) bred, or discovered and developed a variety, or
  - b) <sup>(3)</sup> *is or was employer of the person referred to in (a) or has concluded an agreement under which other party to the agreement has bred or discovered and developed a variety, or*
  - c) is successor in title of persons referred to in intends a and b;
- 8) propagating material – shall be taken to mean plants or their parts intended for sowing, planting, grafting, budding or other method of propagation of plants, including the application of biotechnology;
- 9) harvested material – shall be taken to mean the plants or their parts produced as a result of the cultivation of a specified variety not intended to be used as propagating material;
- 10) <sup>(4)</sup> *variety examination – shall be taken to mean the testing of distinctness, uniformity and stability and assessment of a variety in order to grant its breeder the exclusive right to this variety;*
- 11) associated states – shall be taken to mean the states that are the members of the International Union for the Protection of New Varieties of Plants (UPOV);
- 12) member states – shall be taken to mean the states being the members of the European Union;
- 13) <sup>(5)</sup> *(repealed);*
- 14) <sup>(6)</sup> *conditioning - shall mean cleaning, drying, calibrating, treatment or coating of propagating material or harvested material;*
- 15) <sup>(7)</sup> *processor - shall mean an entrepreneur providing services in the field of conditioning of propagating material or of harvested material to be used as propagating material;*
- 16) <sup>(8)</sup> *exclusive breeder's right - shall be taken to mean the right of the breeder to protect the bred or discovered and developed variety as well as commercialization of such variety.*
2. The provision of paragraph 1 subparagraph 7 intend 'a' shall not be applicable to the persons who bred, or discovered and developed the variety on the basis of an employment contract or other contract, unless otherwise provided for in that contract.
3. <sup>(9)</sup> *Persons who have jointly bred or discovered and developed a variety as well as their successors in title and successors in title of the person referred to in Paragraph 1 (7) (b) shall jointly execute the rights of breeder.*

## Article 3

For the procedures in cases of the issues regulated by this Law, the provisions of the Code of Administrative Procedure are applicable, unless otherwise provided for by this Law.

## CHAPTER 2

## EXCLUSIVE BREEDER'S RIGHT TO THE VARIETY

## Article 4

1. <sup>(10)</sup> *The breeder may apply for the grant of breeder's right to the variety, if the variety is distinct, uniform, stable and new, and its denomination complies with the requirements referred to in Article 9 paragraph 1.*

2. For the grant of the exclusive right may also apply a person who has acquired from the breeder, on the basis of a written contract, the right to the variety bred or discovered and developed by that breeder.

3. The exclusive right shall be granted by the director of the Research Centre for Cultivar Testing.

4. The exclusive right shall apply to the varieties of all plant genera and species.

5. The exclusive right shall be hereditary and may be sold or otherwise disposed of to others by written contract.

6. <sup>(11)</sup> The exclusive right shall not be granted if the variety was applied for the protection or is protected by the Community Plant Variety Office (CPVO).

*Article 4a* <sup>(12)</sup>

*Person who has bred or discovered and developed a variety under the work contract or under any another contract concluded with the breeder shall have the right to remuneration for any commercialization of the variety, unless the contract concluded with the breeder provides otherwise.*

## Article 5

1. A variety shall be deemed to be distinct if, at the date of an application for the grant of an exclusive right, it is clearly distinguishable by at least one characteristic, from any other variety whose existence is a matter of common knowledge.

2. The Research Centre for Cultivar Testing, hereinafter referred to as the "Centre", shall make available to the breeder, upon his request, written information on the characteristics of the variety, which shall be considered on the assessment of its distinctness.

3. A variety shall be deemed to be commonly known, if:

1) an application has been lodged for the grant of an exclusive right or for the entry into a register of varieties in the Republic of Poland, in other member, associated or third state;

2) has been protected or entered into a register of varieties in the Republic of Poland, in other member, associated or third state;

3) its propagating material or harvested material have been placed on the market;

- 4) its description has been published in a publication issued in a member, associated or third state;
- 5) its propagating material is available in commonly accessible variety collections.

#### Article 6

A variety shall be deemed to be uniform if, taking account of the method of the reproduction specific for that variety, it is sufficiently uniform in its relevant characteristics which are taken into account in the examination of distinctness, as well as any other characteristics used for the variety description.

#### Article 7

A variety shall be deemed to be stable if its relevant characteristics which are taken into account in the examination of distinctness, as well as any other characteristics used for the variety description, remain unchanged after its propagation.

#### Article 8

1. A variety shall be deemed new if, at the date of application for the grant of an exclusive right its breeder has not sold or otherwise disposed of to others, for commercial purposes, of its propagating material or harvested material or has not given written consent to it:

- 1) within the territory of the Republic of Poland – earlier than one year before the abovementioned date;
- 2) in other states:
  - a) earlier than six years – in the case of trees or of vines,
  - b) earlier than four years – in the case of other varieties  
- before the date of application for the grant of an exclusive right.

2. A variety shall be also deemed to be new if the breeder at the date of application for the grant of an exclusive right:

- 1) has sold or otherwise disposed of to others:
  - a) variety propagating material to official bodies subordinated to or supervised by the minister competent for agriculture, which in the framework of their statutory activities, perform the variety examinations, or
  - b) parts of plants produced as a result of breeding, propagation, or experimental work, other than propagating material,
  - c) propagating material at an international exhibition organised in accordance with the Convention on International Exhibitions of 22 November 1928 (Journal of Laws of 1961 No 14, item 76 and of 1968 No 42, item 293);
- 2) has disposed of the propagating material to entities for the continuation of breeding or for performing examinations, or for experiments, provided that the propagating material produced from them shall remain the property of this breeder.

3. The components of a hybrid variety shall be deemed to be new if, at the date of application for the grant of an exclusive right, the hybrid propagating material produced thereof have not been sold by the breeder or otherwise disposed of to others for commercial purposes:

- 1) within the territory of the Republic of Poland – earlier than one year;
- 2) in other states – earlier than four years  
- before the date of application for the grant of an exclusive right.

#### Article 9

1. The variety denomination must not:

- 1) be identical as or similar to the denominations of the varieties in the member, associated or third states, which are or were given to the varieties belonging to the same or another species of this genus, as well as the names protected with an exclusive right or entered in an appropriate variety registers, unless the variety is no longer protected or is not present on the market, and its denomination has not been commonly known;
- 2) evoke public objection;
- 3) mislead as to the identity of its breeder, its characteristics or the value for use;
- 4) be identical as or similar to other designations which are commonly used for the marketing of goods;
- 5) violate the rights of third parties to trade-marks;
- 6) contain the words "variety " or "hybrid variety";
- 7) compose exclusively of digits nor start with a digit.

2. In cases where the denomination is inadequate, the Centre shall give the breeder a 14-day period for the submission of a written proposal of another denomination.

3. <sup>(13)</sup> *If the variety is protected by the breeder's right under the specific denomination in another associated state, it shall be protected only under the same denomination in the Republic of Poland.*

4. The duty of using the variety denomination shall apply to any person who performs the assessments, offers for sale, sales, disposes of to others, advertises or gives information on its propagating material or harvested material.

5. The variety denomination shall be protected starting from the date of the grant of an exclusive right, and in the case of removal of its entry in the register of protection of exclusive right – so long as the propagating material remains on the market.

#### Article 10

1. An exclusive right shall be granted at a request of the breeder or its representative.

2. The breeder's representative may be private or legal person, or an organisational unit without legal personality that has its domicile or registered seat in the territory of the Republic of Poland, other member, or associated states.

3. <sup>(14)</sup> *If the breeder has its domicile or registered seat in a state not being the member state or the associated state, the application for the grant of an exclusive right shall be filed by his/her representative.*

#### Article 11

1. The application for the grant of an exclusive right shall be lodged at the Centre.

2. The application for the grant of an exclusive right shall include:

- 1) the name, address and domicile of the breeder or the seat address;
- 2) Polish and Latin name of the plant genus or species;
- 3) designation of the variety on the stage of breeding;
- 4) the proposed denomination of the variety;
- 5) indication of the country of breeding, or the discovery and development of the variety;
- 6) declaration of the breeder that the variety is new in accordance with the requirements referred to in Art. 8;
- 7) declaration of the breeder that the variety has been or has not been genetically modified;
- 8) information on lodging an application for the protection of an exclusive right in other states.

3. The application referred to in paragraph 2 shall be accompanied by:

- 1) in cases where the application is filed by the breeder's representative, the authorisation for the representation of the breeder in all issues relating to the grant of an exclusive right;
- 2) description of the variety or the hybrid variety components (technical questionnaire);
- 3) <sup>(15)</sup> *(repealed)*;
- 4) copy of the receipt for payment of fees for submitting the application for the grant of an exclusive right to the variety;
- 5) <sup>(16)</sup> *declaration of the breeder whether he/she intends to exercise the right of priority referred to in Article 12 (1) in the Republic of Poland.*

4. The minister competent for agriculture shall lay down, by Regulation, a specimen application form for the grant of an exclusive right, specimen technical questionnaire, having regard to the unification of the proceedings related to the grant of an exclusive right.

5. <sup>(17)</sup> The data referred to in paragraph 3 intends 2 and 3, must not be made available without a written consent of the breeder.

6. Where the applications for the grant of an exclusive right for the same variety have the same date of application, the priority has the application which was received by the Centre earlier, which is confirmed by the consecutive receipt number given to each of the applications.

#### Article 12

1. A breeder who lodged an application for the grant of an exclusive right in an associated state may apply, within twelve months of the date of that submission, for the grant in the Republic of Poland of an exclusive right as well as for the admission of his right of priority to the variety, hereinafter referred to as "the right of priority".

2. A breeder who submitted in the Republic of Poland an application for the grant of an exclusive right along with the right of priority shall deliver, without prejudice to paragraph 4, within three months of the date of lodging that application, a copy of the application lodged in the associated state along with the copy of the documents attached to that application.

3. In cases where a breeder has not delivered on time the copy of the application along with the copy of the attached documents lodged in an associated state, the application referred to in paragraph 2 shall not be examined in the framework of the right of priority.

4. In cases where an application for the grant of an exclusive right filed in an associated state has been withdrawn by the breeder, or has not been positively considered by a competent authority, the breeder shall be obliged to notify in writing of this fact to the Centre within three months of the date of the withdrawal of the application or receipt of the decision on the refusal of an exclusive right.

#### Article 13

1. <sup>(18)</sup> *The Centre shall publish every two months in its publication, referred to later as the "Polish Gazette", information on the applications for the grant of an exclusive right and meeting the requirements specified in Article 11, giving the following data:*

- 1) *the name, address and domicile of the breeder or the seat address;*
- 2) *Polish and Latin names of the plant genus or species;*
- 3) *the variety denomination as proposed in the application;*
- 4) *the date of submission of the application;*
- 5) *the consecutive number of the application;*
- 6) *data on:*
  - a) *applications for the grant of an exclusive right withdrawn,*
  - b) *decisions issued in the cases of:*
    - *granting the exclusive right,*
    - *refusal to grant the exclusive right,*
    - *cancellation of the exclusive right,*
    - *nullity of the exclusive right,*
  - c) *changes of breeders and their representatives,*
  - d) *settlement of appeals against decisions of the Director of the Centre.*

2. The Centre shall make available to breeders, with prejudice to Art. 11 paragraph 5, the documents attached to the application for the grant of an exclusive right and the documents relating to the examination for distinctness, uniformity and stability referred to in Art. 15 paragraph 1.

#### Article 14

1. <sup>(19)</sup> *A breeder who lodged an application for the grant of an exclusive right shall enjoy a provisional exclusive right since the date of publication of information on that application in the Polish Gazette.*

2. The provisions relating to an exclusive right shall be applicable accordingly to the provisional exclusive right.

3. The provisional exclusive right shall expire on the date of entry into force of the decision on the grant or on the refusal of the grant of an exclusive right.

#### Article 15

1. Before an exclusive right has been granted, the Centre shall perform the examinations for distinctness, uniformity and stability, hereinafter referred to as the "DUS testing", unless it deems the results of the examinations carried out by the authority performing official examinations in another associated state to be sufficient.

2. The DUS tests shall be carried out in accordance with the examination methodology established for a given species for a period necessary for completing of testing of the variety distinctness, uniformity and stability.

3. Before the beginning of the DUS tests, the Centre shall inform in writing the breeder of the date of starting and the expected time of completion of the examinations.

4. The breeder shall be obliged to deliver to the Centre, free of charge, variety propagating material for the purpose of the DUS testing.

5. The minister competent for agriculture shall lay down in Regulation the quantity of the variety propagating material necessary for carrying out of the DUS tests and the time limits for the delivery of those propagating material to the Centre, taking into account the biological characteristics of the plant species in question.

6. <sup>(20)</sup> *(repealed)*.

#### Article 16

1. During the DUS testing, the breeder shall be obliged to:

1) make possible for the Centre to:

a) control the maintenance of the variety,

b) access to the documents relating to the variety maintenance;

2) provide, upon request of the Centre, written clarifications and information necessary for the performance of the DUS tests.

2. The breeder shall be given the possibility to get acquainted with the course and the results of the DUS tests for his variety, and, after the issue of the decision on the grant of an exclusive right, the breeder shall receive a final report of the DUS tests.

#### Article 17

1. If the Centre does not perform the DUS tests in given species, it may:

1) commission to carry out such tests or their parts to another testing authority, or

2) accept the results of those tests carried out abroad  
-at the breeder's expense, provided that he gives the written consent.

2. The Centre, before commissioning the performance of the DUS tests or before the acceptance of the DUS test results, shall forward to the breeder written information on costs relating to those tests.

3. <sup>(21)</sup> *(repealed)*.

## Article 18

1. Any person may lodge with the director of the Centre a written objection to the grant of an exclusive right, if he/she is in possession of documents or information confirming that:

- 1) the variety does not comply with the conditions referred to in Art. 4 paragraph 1, or
- 2) the breeder is not authorised for submitting an application for the grant of an exclusive right.

2. The Centre, within 14 days of the date of settlement of the objection to an exclusive right, send written information to the objector on the admittance or the refusal of the objection.

3. Written information referred to in paragraph 2 shall contain the justification indicating the reasons for the admittance or the refusal of the objections to an exclusive right.

4. Notwithstanding the admittance of the objections for the reason referred to in paragraph 1 intend 2, and filing an application for the grant of an exclusive right by an authorised breeder, the results of the DUS tests concerning a given variety shall be acknowledged.

## Article 19

1. The Centre shall charge fees for submission an application for the grant of the exclusive right, for the DUS tests as well as for the grant and the maintenance of the exclusive right.

2. The fees for the DUS tests shall not be charged, if the breeder bore the costs referred to in Art. 17 paragraph 1.

3. The minister competent for agriculture, in consultation with the minister competent for public finance, shall lay down in a Regulation the rates of fees referred to in paragraph 1, the way and the time limits of payment thereof, taking into account the costs relating to carrying out of the examinations and to the grant of an exclusive right.

## Article 20

1. After completion of the DUS tests, the director of the Centre shall make a decision concerning the grant of an exclusive right.

2. If two or more persons bred, or discovered and developed the variety jointly, the exclusive right shall be granted jointly to them.

3. <sup>(22)</sup> *The director of the Centre shall refuse, by way of a decision, to grant an exclusive right, if:*

1) *the variety fails to meet the conditions referred to in Article 4 (1), or*

2) *the breeder applying for the exclusive right:*

*a) has failed to submit propagating material to the Centre in order to carry out the DUS tests within the period specified in the provisions issued pursuant to Article 15 (5) or*

*b) fails to pay the fees due for the DUS tests.*

4. An appeal to the minister competent for agriculture shall lie from decisions relating the grant of the exclusive right.



## Article 21

The exclusive right shall include:

- 1) production or reproduction (multiplication);
- 2) conditioning for the purpose of propagation;
- 3) offering for sale;
- 4) selling or other marketing;
- 5) exporting;
- 6) importing;
- 7) stocking  
- of the protected variety propagating material.

## Article 22

1. The exclusive right shall also cover:

1) <sup>(23)</sup> *harvested material or products produced directly from that material, if the breeder had no possibility of exercising of the exclusive right to the protected variety propagating material;*

2) propagating material of ornamental and horticulture plants, if they are reused for commercial purposes as:

- a) reproduction material for the propagation of ornamental plants, or
- b) cut flower, or
- c) propagating material of trees, bushes and perennials;

3) varieties:

a) derived, discovered or produced from a protected initial variety which is not a derived variety,

b) which are not clearly distinct from the protected variety,

c) in those cases where the production of propagating material requires repeated use of a protected variety.

2. A variety shall be regarded as derived from the initial variety, if it is distinct from the initial variety and if:

1) is predominantly derived from initial variety or other derived variety from the same initial variety while retaining the essential characteristics resulting from the genotype or a combination of genotypes of the initial variety;

2) its characteristics are consistent with essential characteristics of the initial variety resulting from its genotype or a combination of genotypes, except for differences resulting from the use of the following breeding techniques:

a) selection of natural or induced mutants,

- b) selection of new forms from initial varieties,
- c) using backcrossings,
- d) genetic engineering.

3. The provisions of paragraph 1 and Art. 21 shall not apply to propagating material and harvested material intended for:

- 1) private, non-commercial purposes;
- 2) experimental purposes;
- 3) breeding of new varieties, excluding the varieties referred to in paragraph 1 intend 3, if these varieties are to be used for commercial purposes.

#### Article 23 <sup>(24)</sup>

1. *A holder of agricultural land may, against remuneration for the breeder, use the harvested material as propagating material of varieties protected by exclusive right, provided that he obtains and uses the material on his farm, notwithstanding Paragraph 3.*

2. *The right to use the harvested material as material referred to in paragraph 1:*

*1) shall apply to variety propagating material of the following plants:*

- a) field bean,*
- b) field pea,*
- c) barley,*
- d) maize,*
- e) linseed,*
- f) lucerne,*
- g) narrow leaved lupin,*
- h) yellow lupin,*
- i) oat,*
- j) durum wheat,*
- k) wheat,*
- l) triticale,*
- m) oilseed rape,*
- n) turnip rape,*
- o) common vetch,*
- p) rye,*
- q) potato;*

*2) shall not apply to hybrid varieties and varieties bred from free crossing of specified lines of allogamous species (synthetic varieties).*

3. *Without the necessity to make the remuneration to the breeder referred to in Paragraph 1, the harvested material of varieties protected by exclusive right can be used as propagating material by holders of agricultural land of:*

- 1) up to 10 ha - in the case of variety protected by exclusive right, being the plant variety referred to in Paragraph 2 Point 1q;*
- 2) up to 25 ha - in the case of variety protected by exclusive right, being the plant variety referred to in Paragraph 2 Point 1a-p.*

4. *The amount of remuneration referred to in Paragraph 1, method and date of payment shall be decided in the agreement concluded between:*
- 1) *a breeder and a holder of agricultural land, or*
  - 2) *a breeder and an organisation representing holders of agricultural land, or*
  - 3) *an organisation of breeders and a holder of agricultural land, or*
  - 4) *an organisation of breeders and an organisation representing holders of agricultural land - and should be lower than the rate of royalty paid for a given category of certified propagating material, set by the breeder of that variety.*
5. *If the agreement referred to in Paragraph 4, has not been reached, the remuneration for the breeder:*
- 1) *amounts to 50% of the royalty for a given category of propagating material, set in a given year by the breeder of the variety;*
  - 2) *should be paid within 30 days from the day of use of the harvested material referred to in Paragraph 2 (1) as propagating material of the variety protected by the exclusive right.*
6. *If the holder of agricultural land fails to pay the remuneration referred to in Paragraph 1, the breeder may request payment of statutory interests for each day of the delay.*
7. *A breeders' organisation may, after concluding an agreement with a breeder who is its member, collect the remuneration referred to in Paragraph 1 for the breeder's benefit.*
8. *The agreement referred to in Paragraph 7 shall contain, in particular:*
- 1) *information about the parties to the agreement;*
  - 2) *duration of the agreement;*
  - 3) *an authorisation to collect remuneration referred to in Paragraph 1 by the breeders' organisation for the breeder's benefit;*
  - 4) *indication of the plant varieties protected by exclusive breeder's right, for which the remuneration referred to in Paragraph 1 is to be collected by the breeders' organisation for the breeder's benefit;*
  - 5) *the method and term of settlement of the remuneration referred to in Paragraph 1 collected by the by the breeders' organisation for the breeder's benefit.*

*Article 23a<sup>(25)</sup>*

1. <sup>(26)</sup> *A holder of agricultural land, excluding a holder of agricultural land specified in Article 23 Paragraph 3, or an organisation representing holders of agricultural land, shall provide the breeders or breeders' organisations, on their request, with written information about the use of harvested material referred to in Article 23 Paragraph 2 Point 1 as propagating material within 30 days from the date of receiving the request.*
2. *The application referred to in Paragraph 1 shall include, in particular:*
  - 1) *the breeder's name and address of domicile or name and address of the breeder's seat;*
  - 2) *indication of:*

- a) *variety/varieties, with respect to which the breeder or breeders' organisation applies for information,*
  - b) *amount of royalty paid for the respective plant varieties, referred to in (a).*
3. *Method and scope of providing information referred to in Paragraph 1 shall be laid down in the agreement referred to in Article 23 (4).*
  4. *If the agreement referred to in Article 23 (4) is not concluded, information referred to in Paragraph 1 shall include:*
    - 1) *the name and address of domicile or name and address of the seat of the holder of agricultural land;*
    - 2) *data allowing identification of agricultural parcels within the meaning of the provisions on the national register of producers, agricultural holdings and register of aid applications, included in the agricultural holding of the holder of agricultural land;*
    - 3) *declaration of a holder of agricultural land on the use of or failure to use the harvested material referred to in Article 23 (2) (1) as propagating material with reference made to the denominations of varieties with respect to which the breeder has the exclusive right;*
    - 4) <sup>(27)</sup> *indication of the quantity of harvested material referred to in Article 23 Paragraph 2 Point 1 used as propagating material and the surface of the agricultural land on which the material was used;*
    - 5) *name and address of domicile or name and address of the seat of the processor who provided a service to the holder of agricultural land, consisting in the conditioning of harvested material referred to in Article 23 (2) (1) to be used as propagating material;*
    - 6) *name and address of domicile or name and address of the seat of the entity from which the holder of agricultural land purchased the certified propagating material of variety or varieties referred to in Paragraph 2 (2) (a), including the quantity of this material.*
  5. *The provisions of Paragraph 1, Paragraph 2 (1) and (2) (a) as well as Paragraph 4 in the scope of obligation to provide the breeder or breeders' organisation with written information is applicable to the State Plant Health and Seed Inspection, if it has such information.*

*Article 23b <sup>(28)</sup>*

1. <sup>(29)</sup> *The processor or processors' organisation shall provide the breeder or breeders' organisation, on their request, with written information about the service provided to the holder of agricultural land, consisting in conditioning the harvested material referred to in Article 23 Paragraph 2 Point 1 to be used as propagating material, within 30 days from the date of receiving the request.*
2. *The provisions of Article 23a (2) shall apply accordingly to the request referred to in Paragraph 1.*
3. *The method and scope of providing information referred to in Paragraph 1 shall be decided in the agreement concluded by the processor or processors' organisation and the breeder or breeders' organisation.*
4. *If the agreement specified in Paragraph 3 is not concluded, information referred to in Paragraph 1 shall include:*
  - 1) *name and address of domicile or the name and address of the seat of the processor;*

- 2) *declaration of a processor about performance of the service of conditioning the harvested material referred to in Article 23 (2) (1) to be used as propagating material with respect to the variety or varieties to which the breeder has the exclusive right, including the date of service performance;*
- 3) *quantity of harvested material referred to in Article 23 (2) (1) with respect to which the processor performed the service of conditioning the harvested material, as well as the quantity of propagating material obtained;*
- 4) *name and address of domicile or name and address of the seat of the holder of agricultural land, to whom the processor provided a service consisting in the conditioning of harvested material referred to in Article 23 (2) (1) to be used as propagating material.*

*Article 23c<sup>(30)</sup>*

1. *Breeders or breeders' organisations shall be entitled to check compliance of information referred to in Article 23a (1) and Article 23b (1) with the actual state.*
2. *The method and scope of the check referred to in Paragraph 1 shall be laid down in the agreement concluded between the breeder or breeders' organisation and:*
  - 1) *holder of agricultural land;*
  - 2) *organisation representing holders of agricultural land;*
  - 3) *processor;*
  - 4) *processors' organisation.*
3. *If the agreement referred to in Paragraph 2 is not concluded, inspection shall be carried out by the breeder or breeders' organisation or the person authorised pursuant to the breeder's or breeders' organisation authorisation.*
4. *In order to carry out the check:*
  - 1) *holder of agricultural land:*
    - a) *shall ensure access, on the request of the inspecting entity, to the documents confirming compliance of information provided to the breeder pursuant to Article 23a (1) and the actual state,*
    - b) *shall ensure access to agricultural land, farm buildings, working facilities and other utility facilities as well as the means of transport;*
  - 2) *processor:*
    - a) *shall provide access, to the following documents on the request of the inspecting entity:*
      - *documents concerning services consisting in conditioning of harvested material referred to in Article 23 (2) (1) to be used as propagating material,*
      - *documents with information on the quantity of harvested material referred to in Article 23 (2) (1) with respect to which the processor carried out conditioning of the harvested material as well as on the quantity of propagating material obtained,*
    - b) *shall ensure access to the processing or storing facilities and devices for the inspecting entity*
5. *The inspecting entity shall draw up inspection report.*

6. *The report shall be signed by the inspecting entity and the holder of agricultural land or the processor.*

7. *Should the holder of agricultural land or the processor refuse or be unable to sign the report, it shall be signed by the inspecting entity with a reference made in the report on refusal or the reasons preventing from signing of the report.*

#### Article 24

After the grant of the exclusive right the breeder shall be obliged to:

- 1) maintain the variety;
- 2) deliver to the Centre, free of charge, variety propagating material, as well as propagating material of the components used for production of the hybrid variety, in quantities essential for the performance of the DUS tests;
- 3) provide, upon request of the Centre, information and explanations concerning the variety;
- 4) enable the Centre to access to the documents related to the variety.

#### Article 25

Any person who makes use of the propagating material of the protected variety is obliged to, upon request of the breeder holding the exclusive right to this variety, provide him with written information concerning the quantity of propagating material of the protected variety and make a payment for the breeder equivalent to the royalty for exploitation of the exclusive right to this variety.

#### Article 26

1. If the breeder has been changed, the new breeder shall be obliged to notify of this fact in writing to the Centre within 30 days of the date, on which this change has taken place.
2. The breeder referred to in paragraph 1 shall attach a copy of the documents confirming his right to the variety.

#### Article 27

1. The exclusive right shall be effective starting from the date of making a decision on grant and shall last for:
  - 1) 30 years – in the case of vine, trees and potato varieties;
  - 2) 25 years – in the case of other varieties.

2. <sup>(31)</sup> *In cases where a breeder of the variety protected by the exclusive right in the Republic of Poland shall be granted the Community plant variety right, the exclusive right granted in the Republic of Poland shall be suspended for the period, throughout which the breeder shall enjoy the Community plant variety right.*

#### Article 28

1. The exclusive right, without prejudice to paragraph 2, shall expire if:
  - 1) propagating material;
  - 2) harvested material;

- 3) products produced directly from the harvested material;
- 4) varieties referred to in Art. 22 paragraph 1 intend 3  
- shall be sold or otherwise disposed of to others by the breeder or with his written consent.

2. The exclusive right shall not expire if the purchaser of the variety propagating material:

- 1) shall use it for renewed propagation;
- 2) shall export it to a country, which do not provide any protection of the exclusive right to the variety of the plant species in question, unless the harvested material shall be used for consumption purposes in that country.

#### Article 29

1. The director of the Centre shall cancel, in an administrative decision, the exclusive right of the breeder:

- 1) upon his own request;
- 2) if the variety does not comply with the conditions of uniformity or stability;
- 3) if the breeder:
  - a) does not maintain the variety,
  - b) is delayed over 6 months with the payment of fees referred to in Art. 19 paragraph 1,
  - c) renders impossible carrying out of a control of the maintenance of the variety and examination of the documents relating to the variety maintenance,
  - d) does not provide the information and explanations essential for carrying out of the DUS tests,
  - e) has not delivered, free of charge, the variety propagating material in quantities indispensable for carrying out of the DUS tests,
  - f) does not submit a new denomination to the variety in case where the denomination of the variety entered into the register of granted titles of exclusive rights referred to in Art. 36 paragraph 1, does not comply with the conditions listed in Art. 9 paragraph 1.

2. An appeal to the minister competent for agriculture shall lie from decision on the cancellation of the exclusive right of the breeder.

#### Article 30

1. The breeder holding an exclusive right may, on the basis of an exploitation right agreement, grant another person the authorisation licence for exploitation of the exclusive right.

2. The exploitation right agreement requires written form under clause of nullity.

3. Exploitation of the exclusive right may be restricted in the exploitation right agreement (limited licence); if in the exploitation right contract the scope of using the exclusive right has not been limited, the holder of an exploitation right has a right to exploit the exclusive right in the same scope as the licensor (unlimited licence).

4. In cases where the exclusive exploitation of the exclusive right has not been reserved in the exploitation right agreement, the grant of an exploitation right to one entity does not preclude

the possibility of granting the exploitation right to other entities, and also simultaneous exploitation of the exclusive right by the breeder (non-exclusive licence).

5. The party enjoying the exploitation right may grant another exploitation right (sub-licence) only with a written consent of the breeder; the grant of another one sub-licence shall be prohibited.

#### Article 31

1. If the breeder holding the exclusive right to a given variety does not place its propagating material or harvested material on the market, and this is demanded by important national economy interest, the minister competent for agriculture may grant, in a decision, a compulsory licence to another entity, unless the breeder has not placed the propagating material or harvested material on the market due to force majeure.

2. The compulsory licence right may also be granted if the applicant demonstrates that:

1) he applied for the exploitation right from the breeder, who has not introduced the variety propagating material on the market, or

2) the royalty demanded by the breeder is disproportional to the value of the propagating material, or

3) the proposed by the breeder quantity of propagating material is insufficient for the propagation of a given variety in order to place it on the market.

3. The compulsory licence shall be granted upon request of the interested party.

4. The compulsory licence shall be a non-exclusive one.

#### Article 32

1. Application for the grant of compulsory licence shall be filed to the minister competent for agriculture via the director of the Centre.

2. The director of the Centre shall forward the application referred to in paragraph 1 along with an opinion on the necessity of placing on the market of a specified quantity of propagating material or harvested material.

3. The application for the grant of compulsory licence shall include:

1) name, address and domicile of the applicant, or the site address;

2) name, address and domicile of the breeder referred to in Art. 31 paragraph 1, or the site address;

3) specification of the species in the Polish language and in Latin and the denomination of the variety, the applicant applies for;

4) specification of the proposed quantity of variety propagating material necessary for the multiplication;

5) specification of the proposed duration of the compulsory licence;

6) specification of the proposed remuneration to the breeder;

7) indication of an important national economy interest.



4. The application for the grant of a compulsory licence shall be accompanied by the declaration on fixed assets and equipment used for the propagation of the variety, along with description thereof.

#### Article 33

A compulsory licence right shall include:

- 1) the name, address and domicile of a person who has been granted the compulsory licence and his site address;
- 2) the name, address and domicile of the breeder or his site address;
- 3) specification of the species in Polish language and in Latin and the denomination of the variety;
- 4) specification of the duration of an the licence;
- 5) specification of the amount of the remuneration to the breeder;
- 6) specification of the quantity of propagating material needed for the multiplication of the variety in order to place it on the market.

#### Article 34

1. The minister competent for agriculture shall notify in writing to the director of the Centre on issuing of the decision on the grant of a compulsory licence.
2. The Centre shall publish in its Gazette information on compulsory licences granted.
3. The breeder referred to in Art. 31 paragraph 1 shall be obliged, within 30 days of the date of receipt of written information on issuing of the decision on the grant of a compulsory licence, provide to the holder of a compulsory licence the variety propagating material in quantities indispensable for the propagation of this variety in order to place it on the market.

#### Article 35

1. The minister competent for agriculture:

- 1) shall cancel a compulsory licence if the holder of the compulsory licence has not placed on the market the variety propagating material covered by the compulsory licence in the nearest growing period following the grant of the compulsory licence;
- 2) may cancel the compulsory licence on the request of the breeder referred to in Art. 31 paragraph 1, if the breeder placed on the market variety propagating material or harvested material of a variety covered by the granted compulsory licence.

2. The request referred to in paragraph 1 intend 2 shall be accompanied by a copy of documents evidencing that the breeder placed the propagating material on the market.

3. The minister competent for agriculture may cancel the compulsory licence in the case referred to paragraph 1 intend 2, if since the day of issuing of the decision, elapsed:

- 1) 2 years – in the case of annual varieties, or
- 2) 3 years – in the case of biennial varieties, or
- 3) 5 years – in the case of perennial varieties.

## Article 36

1. The Centre shall keep a register of granted titles of exclusive rights, hereinafter referred to as the "register", and a list of varieties, for which applications for the grant of an exclusive right have been filed, hereinafter referred to as the "list".

2. The register shall contain specification of the protected varieties and their breeders as well as the licensees, who were granted a compulsory licence.

3. The list is a specification of the varieties for which applications for the grant of the exclusive right have been filed as well as the breeders who were granted the provisional exclusive rights.

4. A variety entered into the list or the register shall receive a number, which consists of the consecutive number taken from the list or from the register and a capital letter standing for a given group of plants.

5. The variety number on the list shall be preceded additionally by capital letter T, which means that the variety has been granted the provisional exclusive right.

6. The following letter designations shall be used for individual plant groups:

1) R – agricultural plants;

2) W – vegetables;

3) S – fruit plants;

4) L – forest plants;

5) O – ornamental plants;

6) P – other plants.

7. The register shall contain:

1) the name, address and domicile of the breeder, or the site address;

2) the species name in Polish and in Latin and the variety denomination;

3) the date of the grant and expiry of an exclusive right;

4) the designation of the breeder's country;

5) information indicating whether or not the variety has been genetically modified.

8. The list shall contain:

1) the name and address and domicile of the breeder, or the site address;

2) the species name in Polish and in Latin and the variety denomination;

3) the date of the grant and expiry of a provisional exclusive right;

4) the designation of the breeder's country;

5) information indicating whether or not the variety has been genetically modified.

CHAPTER 2a <sup>(32)</sup>

## PURSUIT OF CLAIMS UNDER CIVIL LAW PROCEDURE

## Article 36a

- 1 *The breeder, whose exclusive right has been infringed, may demand from the person who infringed such right:*
- 1) *to cease infringing the right;*
  - 2) *to eliminate the results of the infringement;*
  - 3) *to compensate for the damages:*
    - a) *in line with general principles, or*
    - b) *by paying a certain amount of money corresponding to the license fee that would be due for granting the license by the breeder on the date of the claim; in the case of culpable infringement the amount would be a multiple of the remuneration, yet not higher than the multiple of three;*
  - 4) *to return the benefits received.*
2. *Regardless of the claims referred to in Paragraph 1 the breeder may demand a one-time or a repeated announcement in the press, suitable in its form and content, or making the court ruling issued in this case publicly known in part or in full, in the manner and extent established by the court.*
3. *On the request of infringer and with the consent of the breeder, the court may order the infringer to pay an appropriate amount to the breeder, when the infringement was accidental, if discontinuance of infringement or elimination of its effects would be disproportionately severe for the infringer.*
4. *When ruling on the right infringement, upon the request of the breeder, the court may rule on the illegally produced seed or the harvest material as well as means and materials used to produce them, in particular the court may rule to withdraw them from the market and furnish the breeder on account of the due compensation, or to destroy them. While ruling, the court shall take into account the gravity of the infringement and the interest of third parties.*
5. *It is conjectured that the means and materials referred to in Paragraph 4 belong to the person that infringed the exclusive right.*

## Article 36b

1. *The court competent for cases of infringement of the exclusive right of the place where the perpetrator is carrying his/her activities, or in which his/her property is located, shall also try the request of the person having a legal interest in it within 3 days following submission of the request to the court before the action is brought on:*
- 1) *for securing evidence and securing related claims;*
  - 2) *for obliging the infringer to deliver information and documentation identified by the court and significant for the claims, referred to in Article 36a (1);*

- 3) for obliging a person other than the infringer to deliver information significant for the claims, referred to in Article 36a (1) on the origin, distribution networks, quantities and the price of goods or services infringing the exclusive right, if:
- a) it has been found that the person is in hold of goods infringing the exclusive right, or
  - b) it has been found that the person uses the services infringing the exclusive right, or
  - c) it has been found that the person provides services used in activities infringing the exclusive right, or
  - d) such person has been pointed out by the person referred to under letters (a), (b) or c) as a person participating in production, manufacturing or distribution of goods or providing services infringing the exclusive right, and the above-mentioned activities are intended to obtain profit or other economic benefit directly or indirectly, yet they do not include activities of consumers acting in good faith.
2. While accepting evidence or trying the requests referred to in Paragraph 1, the court shall ensure confidentiality of the entrepreneur and other statutory secrets.
3. The obligation referred to in Paragraph. 1 (1) and (2) may be evaded by any one who has the right to deny testimony or to refuse answering questions posed to him/her in line with the provisions of the Code of Civil Procedure.
4. In justified cases the court decision to secure evidence referred to in Paragraph 1 (1) may be conditional on payment of a bail.
5. Objections against the court rulings in the cases referred to in Paragraph 1 shall be examined by the court within 7 days.
6. Article 733, Article 742 and Articles 744-746 of the Code of Civil Procedure shall apply to the evidence securing.

### CHAPTER 3

#### PENAL PROVISIONS

##### Article 37 <sup>(33)</sup>

1. Any person who:

- 1) violates a variety exclusive right;
  - 2) designates propagating material or harvested material of other or unknown variety with the denomination of a variety protected with the exclusive right
- shall be liable to a fine, detention order or deprivation of liberty up to one year.

##### Article 37a <sup>(34)</sup>

Whoever:

- 1) prevents the check of variety maintenance,
- 2) prevents access to documents concerning the variety maintenance,

- 3) *fails to provide propagating material of the varieties to the Centre for DUS tests or to the entity granted compulsory licence or provides it in an insufficient quantity or after the deadline set,*
- 4) <sup>(35)</sup> *fails to provide, within the required period, on the request of the breeder whose variety is protected by the exclusive right or the breeders' organisation, with information referred to in Article 23a Paragraph 1 or Article 23b Paragraph 1, or provides false information,*
- 5) *prevents the check referred to in Article 23c (1), to be carried out by the breeder or breeders' organisation*  
- *shall be punishable with fine.*

*Article 37b* <sup>(36)</sup>

*In the cases referred to in Article 37a judicial decisions shall be issued in accordance with the provisions of the Petty Offences Proceedings Code.*

CHAPTER 4

TRANSITIONAL AND FINAL PROVISIONS

Article 38

The compulsory licences issued on the basis of the provisions so far in force shall be valid until the end of the period for which they were issued.

Article 39

The register and the list, kept on the basis of the provisions so far in force, with the day of entry into force of this Law shall become accordingly the register and the list as understood in this Law.

Article 40

This Law shall enter into force on the day, on which the Republic of Poland shall receive the membership in the European Union.

**Footnotes:**

- <sup>(1)</sup> Article 2 (1) (1) as amended by Article 1 Subparagraph 1 (a) first indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- <sup>(2)</sup> Article 2 (1) (2) as amended by Article 1 Subparagraph 1 (a) first indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- <sup>(3)</sup> Article 2 (1) (7) b) as amended by Article 1 Subparagraph 1 (a) second indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- <sup>(4)</sup> Article 2 (1) (10) as amended by Article 1 Subparagraph 1 (a) third indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- <sup>(5)</sup> Article 2 (1) (13) as repealed by Article 1 Subparagraph 1 (a) fourth indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- <sup>(6)</sup> Article 2 (1) (14)  
- as added by Article 1 Subparagraph 1 (a) fifth indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006 ;  
- as amended by Article 1 Subparagraph 1 of the Act of 1 July 2011 (O.J.2011.186.1099) amending this Act on 21 September 2011.
- <sup>(7)</sup> Article 2 (1) (15)  
- as added by Article 1 Subparagraph 1 (a) fifth indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006  
- as amended by Article 1 Subparagraph 1 of the Act of 1 July 2011 (O.J.2011.186.1099) amending this Act on 21 September 2011.
- <sup>(8)</sup> Article 2 (1) (16) as added by Article 1 Subparagraph 1 (a) fifth indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- <sup>(9)</sup> Article 2 (3) as added by Article 1 Subparagraph 1 (b) of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.

- (10) Article 4 (1) as amended by Article 1 Subparagraph 2 (a) of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (11) Article 4 (6) as amended by Article 1 Subparagraph 2 (b) of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (12) Article 4a as added by Article 1 Subparagraph 3 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (13) Article 9 (3) as amended by Article 1 Subparagraph 4 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (14) Article 10 (3) as amended by Article 1 Subparagraph 5 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (15) Article 11 (3) (3) as repealed by Article 1 Subparagraph 6 (a) first indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (16) Article 11 (3) (5) as added by Article 1 Subparagraph 6 (a) second indent of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (17) Article 11 (5) as amended by Article 1 Subparagraph 6 (b) of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (18) Article 13 (1) as amended by Article 1 Subparagraph 7 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (19) Article 14 (1) as amended by Article 1 Subparagraph 8 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (20) Article 15 (6) as repealed by Article 1 Subparagraph 9 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (21) Article 17 (3) as repealed by Article 1 Subparagraph 10 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (22) Article 20 (3) as amended by Article 1 Subparagraph 11 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (23) Article 22 (1) (1) as amended by Article 1 Subparagraph 12 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (24) Article 23  
- as amended by Article 1 Subparagraph 13 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006  
- as amended by Article 1 Subparagraph 2 of the Act of 1 July 2011 (O.J.2011.186.1099) amending this Act on 21 September 2011.
- (25) Article 23a as added by Article 1 Subparagraph 14 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (26) Article 23a (1) as amended by Article 1 Subparagraph 3 a) of the Act of 1 July 2011 (O.J.2011.186.1099) amending this Act on 21 September 2011.
- (27) Article 23a (4) (4) as amended by Article 1 Subparagraph 3 b) of the Act of 1 July 2011 (O.J.2011.186.1099) amending this Act on 21 September 2011.
- (28) Article 23b as added by Article 1 Subparagraph 14 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (29) Article 23b (1) as amended by Article 1 Subparagraph 4 of the Act of 1 July 2011 (O.J.2011.186.1099) amending this Act on 21 September 2011.
- (30) Article 23c as added by Article 1 Subparagraph 14 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (31) Article 27 (2) as amended by Article 1 Subparagraph 15 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (32) Chapter 2a as added by Article 5 of the Act of 9 May 2007 amending the Act on copyrights and related rights and certain other acts (O.J.07.99.662) on 20 June 2007.
- (33) Article 37 as amended by Article 1 Subparagraph 16 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (34) Article 37a as added by Article 1 Subparagraph 17 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.
- (35) Article 37a (4) as amended by Article 1 Subparagraph 5 of the Act of 1 July 2011 (O.J.2011.186.1099) amending this Act on 21 September 2011.
- (36) Article 37b as added by Article 1 Subparagraph 17 of the Act of 9 June 2006 (O.J.06.126.877) amending this Act on 13 September 2006.

**SERBIA****Law on Protection of Plant Breeders' Rights****as amended in 2011**

(amended on November 22, 2011)

(published in the Official Gazette on November 24, 2011)

**I GENERAL PROVISIONS****Subject of the Law****Article 1**

This Law shall regulate conditions, manner and procedure for protection of plant breeders' rights.

Protection of breeders' rights referred to in paragraph 1 of this Article shall include conditions for granting breeders' rights, procedure for granting breeders' rights, breeders' rights (scope of plant breeders' rights, exceptions from breeders' rights, exhaustion of breeders' rights, provisional protection of breeders' rights), transfer of breeders' rights and ceding of rights for the usage of protected variety, termination of breeders' rights as well as civil and legal protection of breeders' rights.

This Law shall apply to all plant genera and species.

**Definitions****Article 2**

For the purpose of this Law:

1) "Plant variety" (hereinafter referred to as "the variety") shall mean a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a breeder's right are fully met, can be:

- defined by the expression of the characteristics resulting from a given genotype or combination of genotypes,
- distinguished from any other plant grouping by the expression of at least one of the said characteristics and
- considered as a unit with regard to its suitability for being propagated unchanged;

2) "Protected variety" shall mean a variety protected in accordance with provisions of this Law;

3) "Person" shall mean any natural or legal person;

4) "Domestic person" shall mean a person with permanent residence, or seat in the Republic of Serbia;

5) "Foreign person" shall mean a person with permanent residence, or seat outside the Republic of Serbia;

6) "Breeder" shall mean

- the person who bred, or discovered and developed, a variety,
- the employer of the person that has during the working relation bred, or discovered and developed, a variety or who has commissioned the latter's work,

- the successor in title of the first or second aforementioned person, as the case may be;
- 7) "Breeder's right" shall mean the right of the breeder provided for in this Law;
- 8) "Holder of breeders' right" shall mean a breeder who has been granted breeders' rights;
- 9) "Register of Applications for Plant Breeder's Rights" shall mean the register of all applications duly filed for protection of breeder's rights;
- 10) "Register of Protected Plant Varieties" shall mean the register of protected varieties and granted breeder's rights;
- 11) "Register of transferred breeders' rights" shall mean a register wherein transferred breeders' rights are entered;
- 12) "Register of license contracts " shall mean a register wherein license contracts are entered;
- 13) "UPOV" shall mean the International Union for the Protection of New Varieties of Plants.

#### Expert Council for Protection of Plant Breeders' Rights

##### Article 3

Ministry in charge of agriculture policy (hereinafter: the Ministry) shall conduct activities related to the protection of breeders' rights in the Republic of Serbia stipulated by this Law.

For the purposes of monitoring the conditions in the area of protection of breeders' rights, reviewing expert issues, providing professional opinions and suggestions, as well as for the participation in the implementation of project tasks in the area of breeders' rights, the Minister in charge of agriculture (hereinafter: the Minister) in compliance with regulations governing state administration, shall issue a decision on establishment of a special working group – Expert Council for Protection of Plant Breeders' Rights (hereinafter: the Expert Council).

#### Status of Breeders Regarding Rights to Protection of Breeders' Rights

##### Article 4

The breeders' right shall be granted to a breeder of a variety.

If two or more breeders have mutually bred, or discovered and developed the variety, they shall both have equal right to protection of breeders' rights.

If two or more breeders have independently bred, or discovered and developed the variety, breeders' right shall be granted to the first breeder that filed the application for granting plant breeders' right.

#### Status of a Foreign Person regarding Protection of Breeders' Rights

##### Article 5

With respect to grant and protection of breeder's rights in the Republic of Serbia foreign persons shall enjoy the same rights as domestic persons, if that stems from international treaties that are binding for the Republic of Serbia.

In the proceedings before the Ministry, a foreign person shall be represented by his authorized representative who has domicile in the Republic of Serbia.



## II CONDITIONS FOR GRANTING BREEDERS' RIGHTS

### General Conditions for Granting Breeders' Rights

#### Article 6

Breeders' rights shall be granted if the variety is new, distinct, uniform, and stable and if it meets conditions for giving the variety denomination, in compliance with the provisions of this Law.

#### Novelty

#### Article 7

A 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 in the Republic of Serbia earlier than one year, or within foreign territory earlier than four years and in the case of vine and tree varieties earlier than six years before the filing date.

The variety referred to in paragraph 1 of this Article shall be deemed to be new if it is disposed of to others under the following conditions:

- 1) by a contract on the transfer of rights to the successor in title;
- 2) by a contract on disposal of variety material between companies related through capital, where one company is owner of another company, or between companies that are owned by third company, provided that the disposal is not for purpose of exploitation of the variety;
- 3) by an agreement under which a person multiplies propagating material of a variety on behalf of the breeder where that agreement requires that the property in the multiplied material reverts to the breeder;
- 4) by a contract on testing in trial fields or laboratory for the purpose of variety evaluation.

A variety referred to in paragraph 1 of this Article shall be deemed to be new if availability of such variety by the breeder is the result of presenting such variety in exhibitions officially recognized pursuant to the Convention on International Exhibitions, concluded on November 22, 1928 in Paris.

#### Distinctness

#### Article 8

A variety shall be deemed to be distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of the filing of the application for the granting of a breeder's right.

In particular, the filing of an application for the granting of a breeder's right or for the entering of another variety in an official register of varieties, in any country or intergovernmental organization, shall be deemed to render that other variety a matter of common knowledge from the date of the application, provided that the application leads to the granting of a breeder's right or to the entering of the said other variety in the official register of varieties, as the case may be.

The Minister shall prescribe the procedural arrangements of variety distinctness evaluation.

## Uniformity

### Article 9

A variety shall be deemed to be uniform if, subject to the variation that may be expected from the particular features of its propagation, it is sufficiently uniform in its relevant characteristics.

The Minister shall prescribe the procedural arrangements of variety uniformity evaluation.

## Stability

### Article 10

A variety shall be deemed to be stable if its relevant characteristics remain unchanged after repeated propagation or, in case of a particular cycle of propagation, at the end of each such cycle.

The Minister shall prescribe the procedural arrangements of variety stability evaluation.

## Variety Denomination

### Article 11

The variety shall be designated by a denomination which will be its generic designation.

The denomination:

- 1) must enable the variety to be identified;
- 2) may not consist solely of figures except where this is an established practice for designating varieties;
- 3) must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder. In particular, it must be different from every denomination which designates, in the territory of any member of UPOV, an existing variety of the same plant species or of a closely related species;
- 4) cannot be unsuitable for usage in the Republic of Serbia.

Where the variety is already protected in the UPOV member or where an application for the protection of the same variety is filed in a member of UPOV, only the variety denomination which has been proposed or registered in that other member of UPOV may be submitted within the Republic of Serbia by the breeder.

Prior rights of third persons shall not be affected. If, by reason of a prior right, the use of the denomination of a variety is forbidden to a person who is obliged to use it, the Ministry shall require the breeder to submit another denomination for the variety.

The Minister shall prescribe which plant species are considered closely related.

## Proposing Variety Denomination

### Article 12

A breeder shall propose the variety denomination in his application for the granting of plant breeder's right.

The Ministry shall inform competent authorities of all UPOV members on issues related to the denomination of a variety, particularly on the proposal, registration and cancellation of the denomination for a variety.

Competent authorities of UPOV members may submit their objections regarding denominations to the Ministry.

### Cancellation of registered variety denomination

#### Article 13

The Ministry shall cancel any registered variety denomination if it is contrary to Article 11 of this Law or based on the court decision forbidding the use of a given denomination.

When a variety denomination has been cancelled, the Ministry shall notify the breeder thereof and invite him to submit a proposal for a new variety denomination within 60 days as of the date of receipt of such notification.

### Obligation to use the registered variety denomination

#### Article 14

Any person who offers for sale or markets the propagating material of a protected variety shall use the registered variety denomination.

The obligation to use the registered variety denomination shall not cease after the expiration of variety protection under Article 23 of this Law, except where, prior rights of third person prevent such use.

When a protected variety is offered for sale or marketed, a trademark, trade name or another similar identification may be associated with the registered variety denomination provided that the denomination is easily recognizable.

## III PROCEDURE FOR GRANTING PLANT BREEDERS' RIGHTS

### Application for Granting Plant Breeders' Right

#### Article 15

The procedure for grant of breeder's rights shall be initiated based on the application for granting plant breeder's right filed by the breeder or his authorized representative to the Ministry (hereinafter: the application for granting plant breeder's right).

With the application referred to in paragraph 1 of this Article, the breeder, or his authorized representative shall submit the documents on the breeding history of the variety and the proposal of the variety denomination and, upon the request from the Ministry, shall also be obliged to deliver appropriate samples of the propagating material of the variety for testing, for the purposes of determining fulfillment of conditions for granting breeders' rights.

Material of a variety, for which the application for granting breeders' right has been submitted, along with the documents related to that material shall be deemed as official secret and shall be handled as confidential information.

The Minister shall prescribe the form and contents of the application for granting breeders' right, as well as required documents, quantity and manner of submitting samples referred to in paragraph 2 of this Article.

### Examination whether the Application for Granting Breeder's Right is Complete

#### Article 16

Upon the receipt of the application, the Ministry shall determine whether the application is complete, i.e. whether it meets the conditions prescribed by the provisions of this Law.

If the Ministry determines that the application is not complete it shall state the reasons and invite the breeder, or his authorized representative to remove the detected deficiencies within 60 days upon receiving the notification.

If the breeder, or his authorized representative does not remove the deficiencies within the defined deadline, the Minister shall reject the application and issue a conclusion on such matter.

The Conclusion referred to in paragraph 3 of this Article shall be final and administrative proceedings may be initiated against it.

### Entry of the Application for Granting Breeders' Right and Proposed Denomination of a Variety into the Register of Applications

#### Article 17

Any application assessed as complete by the Ministry, and proposed denomination of a variety shall be entered into the Register of Applications for Granting Plant Breeders' Rights (hereinafter: the Register of Applications), which is kept by the Ministry and published in the website of the Ministry.

Notwithstanding paragraph 1 of this Article, the proposed denomination of a variety shall not be entered into the Register of Applications and published in the website of the Ministry if it has been determined that the proposed denomination is unsuitable for use in the Republic of Serbia.

In case referred to in paragraph 2 of this Article the Ministry shall invite the breeder to propose another denomination for a variety within three months.

The Minister shall issue a decision on rejection of the proposal regarding the denomination of a variety, if it has been determined that the proposed denomination is a designation which is contrary to Article 11 of this Law.

Register of Applications shall especially include:

- 1) Name and surname of a breeder, or his authorized representative;
- 2) Permanent residence, or seat of a breeder, or his authorized representative;
- 3) Proposed denomination for the variety and plant species;
- 4) Date and time of submitting the application for granting breeders right.

Information from the Register of Applications shall be open to public inspection, except information deemed confidential in compliance with Article 15, paragraph 3 of this Law.

The decision of the Minister referred to in paragraph 4 of this Article shall be final and administrative proceedings may be initiated against it.

The Minister shall prescribe in detail contents and manner of keeping the Register of Applications.

### Right of Priority for Granting Breeder's Right

#### Article 18

A breeder who has duly filed an application for the grant of a breeder's right with the competent authority of another UPOV member (hereinafter: the first application), shall enjoy the right of priority for granting breeder's rights, within the Republic of Serbia, for a period of 12 months from the date of the first application, provided that the day of filing shall not be included in this period.

In order to benefit from the right of priority, the breeder shall, in the subsequent application, claim the priority of the first application and within three months of filing the application for granting of the breeder's right to submit the following to the Ministry:

- 1) the proof regarding the priority date, which consist of a copy of the documents which constitute the first application, certified to be a true copy by the authority with which that application was filed,

2) samples or other evidence that the variety which is the subject matter of both applications is the same.

If the Ministry accepts the proof regarding the priority date, the application shall be deemed to have been filed at the date of the filing of the first application.

The breeder shall be allowed a period of two years after the expiration of the period of priority or, where the first application is rejected or withdrawn, a period of 12 months after such rejection or withdrawal, in which to furnish, to the Ministry, any necessary information, documents or material required for the purpose of the examination.

### Examination of the Application for Granting Breeder's Right

#### Article 19

In the process of examination of application for granting breeders' right, the Ministry shall examine the variety.

The Ministry may delegate activities related to variety examination referred to in paragraph 1 of this Article to a legal entity that in terms of staffing, equipment and devices meets conditions for execution of such examinations, or may accept results of previously conducted examinations of the variety.

The Ministry shall conclude a contract with legal entity referred to in paragraph 2 of this Article for the purposes of variety examination.

The Ministry may use results of technical examination of a variety obtained in other UPOV member.

The Minister shall issue a decision on fulfillment of conditions referred to in paragraph 2 of this Article.

The decision referred to in paragraph 5 of this Article shall be final and administrative proceedings may be instituted against it.

The Minister shall prescribe in detail the conditions that the legal entity referred to in paragraph 2 of this Article needs to comply with.

### Objection to the Proposal of Variety Denomination

#### Article 20

A person that considers that the proposed denomination of a variety does not fulfill conditions regarding the denomination of a protected variety may submit to the Ministry an objection to the proposal of the denomination entered into the Register of Applications and published in the website of the Ministry, within three months following the day of publication of the proposed denomination of the variety.

The Ministry shall deliver the objection referred to in paragraph 1 of this Article to the breeder and invite him to submit response to the objection within 30 days upon receiving the notification.

The breeder may propose a new denomination for a variety in the response to the objection.

If the proposed denomination is not in compliance with provisions of this Law, the Ministry shall order the breeder to deliver a proposal for a new denomination of a variety within 60 days upon receiving the objection.

If the breeder does not deliver a proposal for a new denomination of a variety within the defined deadline, the Minister shall reject the application for granting breeders' right and issue a conclusion on such matter.

The Conclusion referred to in paragraph 5 of this Article, shall be final and administrative proceedings may be instituted against it.

## Objection to Entry of the Application for Granting Breeders' Right into the Register of Applications

### Article 21

A person that considers that the variety is not new, distinct, uniform and stable or that the breeder is not entitled to breeders' right, may submit to the Ministry an objection to entry of the application for granting breeders' right into the Register of Application, within time frame starting from the day of publication of the application for granting breeders' rights until the day of adopting decision on granting breeders' rights or rejection of application for granting breeders' right.

The person filing the objection referred to in paragraph 1 of this Article shall be obliged, at the request by the Ministry, to deliver additional data and documents supporting his objection within 60 days.

If the person filing the objection fails to comply with the application referred to in paragraph 2 of this Article the Minister shall reject the request and issue a conclusion on such matter.

If the objection contains all required data and documents, the Ministry shall review the objection and submit response to the objection within 30 days.

The Ministry may conduct further examination of a variety, for the purposes of determining statements from the objections.

The conclusion referred to in paragraph 3 of this Article shall be final and administrative proceedings may be instituted against it.

## Decision on Granting Breeders' Rights

### Article 22

Based on the results of the examination and proposal of the Expert Council, the Minister shall issue a decision on granting breeders' right or rejection of application for granting breeders' right within 30 days following the day of providing proposal by the Expert Council.

The decision on granting breeders' rights referred to in paragraph 1 of this Article shall approve the denomination of a variety.

Decision referred to in paragraph 1 of this Article may also stipulate a decision on objection to the proposed denomination, and objection to entry of the application for granting breeders' right into the Register of Applications.

The variety that has been granted protection shall be entered into the Register of Protected Plant Varieties by the Ministry.

Register of Protected Plant Varieties shall especially include:

- 1) Denomination of the variety and plant species;
- 2) Name and surname of the breeder;
- 3) Permanent residence, or seat of a breeder;
- 4) Date of granting breeders' rights.

Data from the Register of Protected Plant Varieties shall be open to the public inspection.

List of protected varieties with data on the variety denomination and plant species, breeder, his permanent residence, or seat, number and date of decision on granting breeders' rights and other data shall be published in the "RS Official Gazette".

The decision of the Minister referred to in paragraph 1 of this Article shall be final and administrative proceedings may be initiated against it.

The Minister shall prescribe in detail contents and manner of keeping the Register of Protected Plant Varieties.

## Duration of Breeder's Rights

### Article 23

Breeder's rights to the protected variety shall expire 25 years after the grant thereof or 30 years after the grant thereof in case of potato, trees and vines.

The date of the granting breeder's rights shall be the date of the decision of the compliance with the conditions of protection.

## Delivery of Samples of Propagating Material of a Variety

### Article 24

Each holder of breeders' right shall be obliged upon request by the Ministry to deliver samples of propagating material of a variety for which he has been granted breeders' right, during the validity period of protection of breeders' rights referred to in Article 23 of this Law.

## IV BREEDERS' RIGHTS

### Scope of the Breeders' Right

#### Article 25

A Breeder shall have the right to indicate his name, and designation in the application for granting breeders' right, documentation, registers, public documents and publications.

Following acts in respect of propagating material of a protected variety shall require the authorization of the holder of the breeders' right, in compliance with conditions and limitations stipulated by the holder of the breeders' right:

- 1) production or reproduction (multiplication);
- 2) conditioning for the purpose of propagation;
- 3) offering for sale;
- 4) selling or other marketing;
- 5) exporting and importing;
- 6) stocking for any of the purposes referred to in subsections 1) to 5).

The acts referred to in paragraph 2 of this Article in respect of harvested material, including entire plants and parts of plants, obtained through the unauthorized use of the propagating material of the protected variety, shall require the authorization of the holder of the breeder's right, unless the holder of the breeder's right has had reasonable opportunity to exercise his right in relation to the said propagating material.

The acts referred to in paragraph 2 in respect of products made directly from harvested material of the protected variety falling within the provisions of paragraph 3 of this Article through the unauthorized use of the said harvested material shall require the authorization of the holder of the breeder's right, unless the holder of the breeder's right has had reasonable opportunity to exercise his right in relation to the said harvested material.

The provisions of paragraphs 2, 3 and 4 shall also apply in relation to:

- 1) varieties which are essentially derived from the protected variety, where the protected variety is not itself an essentially derived variety;
- 2) varieties which are not clearly distinguishable from the protected variety;
- 3) varieties whose production requires the repeated use of the protected variety.

For the purposes of paragraph 5, point 1), a variety shall be deemed to be essentially derived from another variety (the initial variety) when:

1) it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or from the combination of genotypes of the initial variety;

2) it is clearly distinguishable from the initial variety and;

3) except for the differences which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.

Essentially derived varieties may be obtained for example by the selection of a natural or induced mutant, or of a somaclonal variant, the selection of a variant individual from plants of the initial variety, backcrossing, or transformation by genetic engineering.

### Exceptions to the Breeder's Right

#### Article 26

Authorization of holder of breeders' right referred to in Article 25 of this Law shall not be necessary for acts:

1) done privately and for non-commercial purposes;

2) done for experimental purposes;

3) done for the purpose of breeding other varieties, and, except where the provisions of Article 25 paragraph 5 apply, acts referred to in Article 25 paragraphs 2, 3 and 4 in respect of such other varieties.

For a variety of plant species that is included in the list of species of agricultural plants involving exceptions to the plant breeder's rights, it is considered that breeder's rights shall not be infringed by a farmer who, within reasonable limits and subject to the safeguarding of the legitimate interests of the breeders, uses for propagating purposes, on his own holding, the product of the harvest which he has obtained by planting, on his own holding, the protected variety or a variety covered by paragraph 5 point 1) and 2) of Article 25 (hereinafter "farm saved seed").

Varieties of fruit, ornamentals, vegetables and forest trees shall not be included into the list of agricultural plants referred to in paragraph 2 of this Article.

Agricultural producers, except for small agricultural producers, shall be obliged to pay the holder of breeders' right a reasonable remuneration for using "farm saved seed" in compliance with market conditions, which is significantly lower than the level of remuneration of the purchased seed.

Agricultural producers shall be obliged to deliver in writing to the breeder, at his request, all necessary data regarding usage of "farm saved seed".

The Minister shall prescribe the list of species of agricultural plants referred to in paragraph 2 of this Article as well as elements for determining small agricultural producers referred to in paragraph 4 of this Article.

### Exhaustion of the Breeder's Right

#### Article 27

Breeder's right shall not extend to acts concerning any material of the protected variety, or of a variety covered by the provisions of paragraph 5 of article 25, which has been sold or otherwise marketed by the breeder, or with his consent, in the Republic of Serbia, unless such acts involve:



- 1) further propagation of the variety in question, or
- 2) exports of the material of the variety, which enables the propagation of the variety, into a country which does not protect varieties of the plant genus or species to which the variety belongs, except where the exported material is for final consumption purposes.

For the purposes of paragraph 1 of this Article, "material" means, in relation to a variety,

- 1) propagating material of any kind,
- 2) harvested material, including entire plants and parts of plants, and
- 3) any product made directly from the harvested material.

### Provisional Protection

#### Article 28

Throughout the period starting from the publication of the application for a breeder's right to the passing of the decision of a breeder's right, the applicant is considered to be the holder of the breeder's right in relation to any person who, during the above period, has carried out acts which, once the right is granted, require the right holder's authorization as provided in Article 25. Legal action in respect of provisional protection can only be initiated after the right is granted.

### V TRANSFER OF BREEDERS' RIGHTS AND CEDING USAGE RIGHTS TO PROTECTED VARIETY

#### Transfer of Breeders' Rights

#### Article 29

Holder of breeders' right may transfer his breeders' right in relation to the protected variety, in part or fully, to another person by means of contract.

The contract on transfer of breeders' rights referred to in paragraph 1 of this Article must be prepared in writing.

At the request of one of the contractual parties, the contract on transfer of breeders' rights referred to in paragraph 1 of this Article shall be entered into the Register of Transferred Breeders' Rights, which is kept by the Ministry.

The contract on transfer of breeders' rights referred to in paragraph 1 of this Article that is not entered in the Register of Transferred Breeders' Rights shall not be legally valid in respect of third persons.

Register of Transferred Breeders' Rights shall especially include:

- 1) Name and surname and address, or name and seat of the holder of breeders' right;
- 2) Name and surname and address, or name and seat of the person whom breeders' rights are transferred to;
- 3) Number and date of contract by which breeders rights are transferred;
- 4) Denomination of the variety and plant species.

Data from the Register of Transferred Breeders' Rights shall be open to the public inspection.

The Minister shall prescribe in detail contents and manner of keeping the Register of Transferred Breeders' Rights.

## Contractual Licenses

### Article 30

Holder of breeder's right may grant an exclusive or non-exclusive license relating to all or any of the rights provided in Article 25 to another person by means of license contract.

License contract referred to in paragraph 1 of this Article must be prepared in writing and contain the following: scope of the rights and time period for the license, as well as the amount of agreed compensation for such rights.

At the request of one of the contractual parties, the license contract referred to in paragraph 1 of this Article shall be entered in the Register of License Contracts, which is kept by the Ministry.

The license contract referred to in paragraph 1 of this Article not entered in the Register of License Contracts shall not be legally valid in respect of third persons.

Register of License Contracts shall especially include:

- 1) Name and surname and address, or name and seat of the holder of breeders' right;
- 2) Name and surname and address, or name and seat of the person to whom the license contract is granted to;
- 3) Number and date of license contract;
- 4) Variety denomination and plant species.

Data from the Register of License Contracts shall be open to the public inspection.

The Minister shall prescribe in detail contents and manner of keeping Register of License Contracts.

## Conditions for Granting Compulsory License

### Article 31

If the holder of breeders' right refuses to grant a license contract concerning protected varieties to other persons, or sets unreasonable conditions for such license contract, on request of the interested person the Minister may, having reviewed each individual case, issue a decision on granting compulsory license, only for reasons of public interest (national or other exceptional necessity for the protection of health and food of the population, protection of public interest in areas of vital significance to social, economic and technological development), provided that the holder of breeders' right, himself or through other person, does not exercise or insufficiently exercises the rights concerning the protected variety in the Republic of Serbia.

Interested person referred in paragraph 1 of this Article may be only a person proving that he has abilities and capacities needed for using protected plant variety.

Holder of breeders' right shall be promptly informed on the procedure on granting compulsory license.

Compulsory license shall not be issued if the holder of the breeders' right proves that there are reasons justifying the non-exercise or insufficient exercise of the rights concerning the protected variety.

The decision of the Minister referred to in paragraph 1 of this Article shall be final and administrative proceedings may be instituted against it.

## Scope and Duration of Compulsory License

### Article 32

Compulsory license shall be granted, only for reasons of public interest, for the purposes of providing supplies to the market of the Republic of Serbia.

Scope and duration of compulsory license shall be limited to the reasons of public interest for which it has been granted.

Compulsory license cannot be exclusive.

Compulsory license may be transferred only together with the company, or other legal entity, or part of a company, or other legal entity in which it is used.

## Remuneration for Using Protected Variety

### Article 33

A person to whom a compulsory license has been granted shall pay the holder of the breeder's right an equitable remuneration determined by mutual agreement of the parties.

When there is no agreement on the amount and modality of payment referred to in paragraph 1, the remuneration shall be determined by the competent court.

## Revocation and Extension of Compulsory License

### Article 34

If the conditions referred to in Article 31, paragraph 1 of this Law under which compulsory license was issued, are changed or if a person, to whom compulsory license was issued no longer meets conditions referred to in Article 31, paragraph 2 of this Law, the Minister may issue a decision on revocation of compulsory license.

If it is determined that conditions for issuing compulsory license are still met, the Minister may issue a decision on extension of validity of compulsory license, as requested by the interested person.

The decision of the Minister referred to in paragraphs 1 and 2 of this Article shall be final and administrative proceedings may be initiated against it.

## Obligation to Deliver Propagating Material for Compulsory License Purposes

### Article 35

The holder of the breeders' right shall be obliged to deliver, as requested by the Ministry, the quantity of propagating material necessary for the exploitation of the compulsory license, to the person to whom the compulsory license has been granted.

Holder of compulsory license shall be obliged to pay equitable remuneration to the holder of breeders' right for delivered propagating material, agreed by mutual consent between both parties.

If the parties fail to reach an agreement the amount and payment method of the competent court shall determine remuneration referred to in paragraph 2 of this Article.

## VI TERMINATION OF THE BREEDERS' RIGHT

### Termination of the Breeders' Right as Requested by the Holder of Breeders' Right

#### Article 36

Breeders' right may be terminated before expiry of deadline referred to in Article 23 of this Law if the holder of breeders' right submits the statement in writing to the Ministry indicating that he wishes to terminate breeders' right, on the day indicated in the declaration, or on the day of receipt of the declaration.

### Nullity of the Breeders' Right

#### Article 37

The Minister ex officio or as requested by the interested person shall issue a decision on declaring the nullity of decision on granted breeders' rights, if during the validity period of protection of breeders' rights the following is determined:

- 1) the variety was not new or not distinct at the time of the grant of the breeder's right;
- 2) where the grant of the breeder's right has been essentially based upon information and documents furnished by the breeder, the variety was not stable or was not uniform at the time of the grant of the breeder's right;
- 3) the breeder's right has been granted to a person who is not entitled to it, unless it is transferred to the person who is so entitled.

The decision of the Minister referred to in paragraph 1 of this Article shall be final and administrative proceedings may be initiated against it.

Decision on nullity of the decision on granted breeders' rights shall be entered into the Register of Protected Plant Varieties by the Ministry and published in "Official Gazette of the Republic of Serbia".

### Cancellation of the Breeders' Right

#### Article 38

Decision on granted breeders' right may be cancelled by the decision issued by the Minister, if:

- 1) it is established that the variety is no longer uniform or stable;
- 2) the holder of the breeder's right fails to provide the Ministry with the information, documents or material deemed necessary for verifying the maintenance of the variety;
- 3) the breeder fails to propose, where the denomination of the variety is cancelled after the grant of the right, another suitable denomination within 60 days referred to in Article 13 paragraph 2 of this Law.
- 4) the holder of the breeder's right fails to pay the annual fees to keep his right in force.

The decision of the Minister referred to in paragraph 1 of this Article shall be final and administrative proceedings may be instituted against it.

Decision on cancellation of the decision on granted breeders' rights shall be entered into the Register of Protected Plant Varieties by the Ministry and published in "Official Gazette of the Republic of Serbia".

## VII FEES

### Article 39

The fees for the testing of varieties and the annual fees for a breeder's right shall be paid by the breeder or the holder of breeder's right.

The amount of fees referred to in paragraph 1 of this Article shall be determined by the Government.

## VIII PROTECTION OF BREEDERS' RIGHTS

### Lawsuit Due to Violation of Breeders' Rights

#### Article 40

A person that violates breeder's rights shall be liable for damages, in compliance with the general legislation envisaging compensation for damages.

Holder of breeders' right whose right has been violated may, in addition to compensation for damages, seek that the person that violated his right be banned from further conduct of activities constituting such violation, as well as to have judgments determining the violation published at the cost of the defendant.

### Obsolescence of Lawsuit Due to Violation of Breeders' Rights

#### Article 41

Lawsuit due to violation of breeders' rights may be filed with the competent court within three years following the day of receiving information regarding violation of breeders' rights and of the identity of the party liable.

Upon expiration of five-year period following the day of occurrence of violation of breeders' rights, lawsuit may not be filed.

### Lawsuit for Determining the Status of a Breeder

#### Article 42

A breeder may file lawsuit with the competent court, requesting determination of his status of breeder and requesting his name, or designation to be stated in the application for granting breeders' right and accompanying documents and registers stipulated by this Law, if the request for granting breeders' rights or any other document contains any other person as a breeder.

Deadline within which lawsuit referred to in paragraph 1 of this Article may be filed shall not be limited.

## IX SUPERVISION

### Supervisory Inspection

#### Article 43

Supervision over the implementation of provisions of this Law and over the regulations adopted pursuant to this Law shall be done by the Ministry through inspectors.

Activities of inspector in the area of protection of breeders' rights may be conducted by an agricultural engineer with graduate degree, or agricultural engineer with master's degree, department of crop science or fruit science and viticulture or forest engineer with graduate degree, or forest engineer with master's degree, with no less than three years of work experience and state professional examination taken.

### Rights and Duties of an Inspector

#### Article 44

During the conduct of supervisory activities, the inspector shall have the right and duty to review:

- 1) Whether a variety is inspected according to the conditions stipulated in this Law;
- 2) Whether legal entity referred to in Article 19, paragraph 2 of this Law fulfills conditions for conducting of variety examination, in compliance with this Law.

### Measures Ordered by the Inspector

#### Article 45

When carrying out activities referred to in Article 44 of this Law, the inspector may:

- 1) Order legal entity, referred to in Article 19, paragraph 2 of this Law, to remove deficiencies, if he determines that the variety is not examined in compliance with conditions stipulated in this Law;
- 2) Order legal entity referred to in Article 19, paragraph 2 of this Law to remove deficiencies if he determines that the legal entity does not fulfill conditions for examination of varieties stipulated in this Law.

Measures referred to in paragraph 1 of this Article shall be ordered by decision issued by an inspector in the administrative proceedings.

### Obligations of Persons Subject to Supervisory Inspection

#### Article 46

Persons subject to supervisory inspection shall be obliged to enable the inspector the execution of the supervision, and to promptly provide him/her with necessary documents and other evidence for inspection, as well as to give statements on facts significant for implementation of supervision.

### Competence for Deciding on Complaints

#### Article 47

Complaint on decision of the inspector referred to in Article 45, paragraph 2 of this Law may be submitted to the Minister, within 8 days from the day of delivery of decision.

The Minister shall issue a decision regarding the complaint within thirty days following the day of complaint delivery.

Complaint shall not delay execution of the decision.

The decision of the Minister pursuant to the complaint referred to in paragraph 1 of this Article shall be final and administrative proceedings may be initiated against it.

## X ADMINISTRATIVE SANCTIONS

### Article 48

A legal entity shall be fined 300,000 to 3,000,000 dinars for a commercial offence if it:

- 1) Uses the denomination of a protected variety for any other existing variety belonging to same plant species or closely related species (Article 11, paragraph 2 point 3);
- 2) Offers for sell or markets propagating material of a protected variety, without using the registered variety denomination (Article 14, paragraph 1).

The responsible person in legal entity shall also be fined 50,000 to 200,000 dinars for the offence referred to in paragraph 1 of this Article.

In addition to fines, for activities referred to in paragraph 1 of this Article the protective measure may be pronounced to legal entity which prohibits such legal entity to perform certain business activity, and protective measure which prohibits responsible person to conduct certain duties for the period from six months to three years.

### Article 49

Legal entity shall be fined 100,000 to 1,000,000 dinars for offence, if such entity fails to deliver required quantity of propagating material, at the request of the competent authority, needed for exercising compulsory license, in compliance with Article 35, paragraph 1 of this Law.

The responsible person in legal entity shall also be fined 10,000 to 50,000 dinars for the offence referred to in paragraph 1 of this Article.

### Article 50

Natural person shall be fined 10,000 to 50,000 dinars for the offence if he/she conducts activities referred to in Article 48, paragraph 1 and Article 49, paragraph 1 of this Law.

## XI TRANSITIONAL AND FINAL PROVISIONS

### Article 51

Applications for granting breeders' rights filed prior to the day of entered into force of this Law which have not been resolved, shall be resolved pursuant to the provisions of this Law.

### Article 52

Application for granting breeders' right, in compliance with this Law, may be filed within three years following the date when this Law entered into force, for varieties that prior to coming into force of this Law, were entered into the appropriate official register of varieties, in compliance with laws regulating seed and propagating material, or variety registration or protection in any other UPOV member, or if application has been filed for granting breeders' right for such varieties in any UPOV member, and if breeders' right is granted pursuant to such application, in which case the novelty shall not be required.

The Minister shall issue the decision on granting breeders' right pursuant to the application, referred to in paragraph 1 of this Article, if it meets the requirements of Article 8 Paragraph 1, Article 9 Paragraph 1, Article 10 paragraph 1, and Article 11 of this Law.

Validity period of breeders' right on protected variety referred to in Article 23 of this Law for varieties subject to provisions stated in paragraph 1 of this Article shall commence on the day

of the first entry into the official register of protected varieties, or official register of registered varieties, depending which of the two dates occurred earlier.

If a breeders' right has been granted, based on the application for granting breeders' right referred to in paragraph 1 of this Article, the holder of the breeders' right shall be obliged, under reasonable conditions and within reasonable deadlines, to grant a license contract in order to allow the continuation of the acts that require the breeder's authorization which have been initiated in good faith by the third party, prior to granting of such right.

#### Article 53

Regulations related to the implementation of this Law shall be enacted within two years following the date when this Law came into force.

#### Article 54

Until the adoption of regulations by the authority provided for in this Law, the regulations passed in keeping with the Law on the Protection of Agricultural Crop and Forest Plant Varieties ("Official Gazette of FRY", no. 28/2000 and "Official Gazette of the Republic of Serbia", no. 101/05 / second law) shall be applied, provided that they are not contrary to the provisions of this Law.

#### Article 55

The Law on the Protection of Agricultural and Forest Plant Varieties ("Official Gazette of FRY", no. 28/2000 and "Official Gazette of the Republic of Serbia", no. 101/05/ second law) shall cease to be valid on the day this Law enters into force.

#### Article 56

This Law shall enter into force on the eight day following its publication in the "Official Gazette of the Republic of Serbia".



## UNITED STATES OF AMERICA

One Hundred Twelfth Congress  
of the  
United States of America  
AT THE FIRST SESSION  
Begun and held at the City of Washington on Wednesday,  
the fifth day of January, two thousand and eleven

### **An Act To amend title 35, United States Code, to provide for patent reform.**

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

#### SECTION 1. SHORT TITLE; TABLE OF CONTENTS.

(a) SHORT TITLE.—This Act may be cited as the “Leahy-Smith America Invents Act”.

(b) TABLE OF CONTENTS.—The table of contents for this Act is as follows:

- Sec. 1. Short title; table of contents.
- Sec. 2. Definitions.
- Sec. 3. First inventor to file.
- Sec. 4. Inventor’s oath or declaration.
- Sec. 5. Defense to infringement based on prior commercial use.
- Sec. 6. Post-grant review proceedings.
- Sec. 7. Patent Trial and Appeal Board.
- Sec. 8. Preissuance submissions by third parties.
- Sec. 9. Venue.
- Sec. 10. Fee setting authority.
- Sec. 11. Fees for patent services.
- Sec. 12. Supplemental examination.
- Sec. 13. Funding agreements.
- Sec. 14. Tax strategies deemed within the prior art.
- Sec. 15. Best mode requirement.
- Sec. 16. Marking.
- Sec. 17. Advice of counsel.
- Sec. 18. Transitional program for covered business method patents.
- Sec. 19. Jurisdiction and procedural matters.
- Sec. 20. Technical amendments.
- Sec. 21. Travel expenses and payment of administrative judges.
- Sec. 22. Patent and Trademark Office funding.
- Sec. 23. Satellite offices.

- Sec. 24. Designation of Detroit satellite office.
- Sec. 25. Priority examination for important technologies.
- Sec. 26. Study on implementation.
- Sec. 27. Study on genetic testing.
- Sec. 28. Patent Ombudsman Program for small business concerns.
- Sec. 29. Establishment of methods for studying the diversity of applicants.
- Sec. 30. Sense of Congress.
- Sec. 31. USPTO study on international patent protections for small businesses.
- Sec. 32. Pro bono program.
- Sec. 33. Limitation on issuance of patents.
- Sec. 34. Study of patent litigation.
- Sec. 35. Effective date.
- Sec. 36. Budgetary effects.
- Sec. 37. Calculation of 60-day period for application of patent term extension.

## **SEC. 2. DEFINITIONS.**

In this Act:

- (1) DIRECTOR.—The term “Director” means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.
- (2) OFFICE.—The term “Office” means the United States Patent and Trademark Office.
- (3) PATENT PUBLIC ADVISORY COMMITTEE.—The term “Patent Public Advisory Committee” means the Patent Public Advisory Committee established under section 5(a) of title 35, United States Code.
- (4) TRADEMARK ACT OF 1946.—The term “Trademark Act of 1946” means the Act entitled “An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes”, approved July 5, 1946 (15 U.S.C. 1051 et seq.) (commonly referred to as the “Trademark Act of 1946” or the “Lanham Act”).
- (5) TRADEMARK PUBLIC ADVISORY COMMITTEE.—The term “Trademark Public Advisory Committee” means the Trademark Public Advisory Committee established under section 5(a) of title 35, United States Code.

## **SEC. 3. FIRST INVENTOR TO FILE.**

(a) DEFINITIONS.—Section 100 of title 35, United States Code, is amended—

- (1) in subsection (e), by striking “or inter partes reexamination under section 311”; and
- (2) by adding at the end the following:

“(f) The term ‘inventor’ means the individual or, if a joint invention, the individuals collectively who invented or discovered the subject matter of the invention.

“(g) The terms ‘joint inventor’ and ‘coinventor’ mean any 1 of the individuals who invented or discovered the subject matter of a joint invention.

“(h) The term ‘joint research agreement’ means a written contract, grant, or cooperative agreement entered into by 2 or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.

“(i)(1) The term ‘effective filing date’ for a claimed invention in a patent or application for patent means—

“(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

“(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), or 365(b) or to the benefit of an earlier filing date under section 120, 121, or 365(c).

“(2) The effective filing date for a claimed invention in an application for reissue or reissued patent shall be determined by deeming the claim to the invention to have been contained in the patent for which reissue was sought.

“(j) The term ‘claimed invention’ means the subject matter defined by a claim in a patent or an application for a patent.”.

(b) CONDITIONS FOR PATENTABILITY.—

(1) IN GENERAL.—Section 102 of title 35, United States Code, is amended to read as follows:

**“§ 102. Conditions for patentability; novelty**

“(a) NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

“(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or

“(2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.

“(b) EXCEPTIONS.—

“(1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

“(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

“(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

“(2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

“(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

“(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

“(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

“(c) COMMON OWNERSHIP UNDER JOINT RESEARCH AGREEMENTS.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same

person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

“(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;

“(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

“(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

“(d) PATENTS AND PUBLISHED APPLICATIONS EFFECTIVE AS PRIOR ART.—For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

“(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

“(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.”.

(2) CONTINUITY OF INTENT UNDER THE CREATE ACT.—The enactment of section 102(c) of title 35, United States Code, under paragraph (1) of this subsection is done with the same intent to promote joint research activities that was expressed, including in the legislative history, through the enactment of the Cooperative Research and Technology Enhancement Act of 2004 (Public Law 108–453; the “CREATE Act”), the amendments of which are stricken by subsection (c) of this section. The United States Patent and Trademark Office shall administer section 102(c) of title 35, United States Code, in a manner consistent with the legislative history of the CREATE Act that was relevant to its administration by the United States Patent and Trademark Office.

(3) CONFORMING AMENDMENT.—The item relating to section 102 in the table of sections for chapter 10 of title 35, United States Code, is amended to read as follows:

“102. Conditions for patentability; novelty.”.

(c) CONDITIONS FOR PATENTABILITY; NONOBVIOUS SUBJECT MATTER.—Section 103 of title 35, United States Code, is amended to read as follows:

**“§ 103. Conditions for patentability; non-obvious subject matter**

“A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.”.

(d) REPEAL OF REQUIREMENTS FOR INVENTIONS MADE ABROAD.—Section 104 of title 35, United States Code, and the item relating to that section in the table of sections for chapter 10 of title 35, United States Code, are repealed.

(e) REPEAL OF STATUTORY INVENTION REGISTRATION.—

(1) IN GENERAL.—Section 157 of title 35, United States Code, and the item relating to that section in the table of sections for chapter 14 of title 35, United States Code, are repealed.

(2) REMOVAL OF CROSS REFERENCES.—Section 111(b)(8) of title 35, United States Code, is amended by striking “sections 115, 131, 135, and 157” and inserting “sections 131 and 135”.

(3) EFFECTIVE DATE.—The amendments made by this subsection shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any request for a statutory invention registration filed on or after that effective date.

(f) EARLIER FILING DATE FOR INVENTOR AND JOINT INVENTOR.—Section 120 of title 35, United States Code, is amended by striking “which is filed by an inventor or inventors named” and inserting “which names an inventor or joint inventor”.

(g) CONFORMING AMENDMENTS.—

(1) RIGHT OF PRIORITY.—Section 172 of title 35, United States Code, is amended by striking “and the time specified in section 102(d)”.

(2) LIMITATION ON REMEDIES.—Section 287(c)(4) of title 35, United States Code, is amended by striking “the earliest effective filing date of which is prior to” and inserting “which has an effective filing date before”.

(3) INTERNATIONAL APPLICATION DESIGNATING THE UNITED STATES: EFFECT.—Section 363 of title 35, United States Code, is amended by striking “except as otherwise provided in section 102(e) of this title”.

(4) PUBLICATION OF INTERNATIONAL APPLICATION: EFFECT.—Section 374 of title 35, United States Code, is amended by striking “sections 102(e) and 154(d)” and inserting “section 154(d)”.

(5) PATENT ISSUED ON INTERNATIONAL APPLICATION: EFFECT.—The second sentence of section 375(a) of title 35, United States Code, is amended by striking “Subject to section 102(e) of this title, such” and inserting “Such”.

(6) LIMIT ON RIGHT OF PRIORITY.—Section 119(a) of title 35, United States Code, is amended by striking “; but no patent shall be granted” and all that follows through “one year prior to such filing”.

(7) INVENTIONS MADE WITH FEDERAL ASSISTANCE.—Section 202(c) of title 35, United States Code, is amended—

(A) in paragraph (2)—

(i) by striking “publication, on sale, or public use,” and all that follows through “obtained in the United States” and inserting “the 1-year period referred to in section 102(b) would end before the end of that 2-year period”; and

(ii) by striking “prior to the end of the statutory” and inserting “before the end of that 1-year”; and

(B) in paragraph (3), by striking “any statutory bar date that may occur under this title due to publication, on sale, or public use” and inserting “the expiration of the 1-year period referred to in section 102(b)”.

(h) DERIVED PATENTS.— (1) IN GENERAL.—Section 291 of title 35, United States Code, is amended to read as follows:

**“§ 291. Derived Patents**

“(a) IN GENERAL.—The owner of a patent may have relief by civil action against the owner of another patent that claims the same invention and has an earlier effective filing date, if the invention claimed in such other patent was derived from the inventor of the invention claimed in the patent owned by the person seeking relief under this section.

“(b) FILING LIMITATION.—An action under this section may be filed only before the end of the 1-year period beginning on the date of the issuance of the first patent containing a

claim to the allegedly derived invention and naming an individual alleged to have derived such invention as the inventor or joint inventor.”.

(2) CONFORMING AMENDMENT.—The item relating to section 291 in the table of sections for chapter 29 of title 35, United States Code, is amended to read as follows:

“291. Derived patents.”.

(i) DERIVATION PROCEEDINGS.—Section 135 of title 35, United States Code, is amended to read as follows:

**“§ 135. Derivation proceedings**

“(a) INSTITUTION OF PROCEEDING.—An applicant for patent may file a petition to institute a derivation proceeding in the Office. The petition shall set forth with particularity the basis for finding that an inventor named in an earlier application derived the claimed invention from an inventor named in the petitioner’s application and, without authorization, the earlier application claiming such invention was filed. Any such petition may be filed only within the 1-year period beginning on the date of the first publication of a claim to an invention that is the same or substantially the same as the earlier application’s claim to the invention, shall be made under oath, and shall be supported by substantial evidence. Whenever the Director determines that a petition filed under this subsection demonstrates that the standards for instituting a derivation proceeding are met, the Director may institute a derivation proceeding. The determination by the Director whether to institute a derivation proceeding shall be final and nonappealable.

“(b) DETERMINATION BY PATENT TRIAL AND APPEAL BOARD.— In a derivation proceeding instituted under subsection (a), the Patent Trial and Appeal Board shall determine whether an inventor named in the earlier application derived the claimed invention from an inventor named in the petitioner’s application and, without authorization, the earlier application claiming such invention was filed. In appropriate circumstances, the Patent Trial and Appeal Board may correct the naming of the inventor in any application or patent at issue. The Director shall prescribe regulations setting forth standards for the conduct of derivation proceedings, including requiring parties to provide sufficient evidence to prove and rebut a claim of derivation.

“(c) DEFERRAL OF DECISION.—The Patent Trial and Appeal Board may defer action on a petition for a derivation proceeding until the expiration of the 3-month period beginning on the date on which the Director issues a patent that includes the claimed invention that is the subject of the petition. The Patent Trial and Appeal Board also may defer action on a petition for a derivation proceeding, or stay the proceeding after it has been instituted, until the termination of a proceeding under chapter 30, 31, or 32 involving the patent of the earlier applicant.

“(d) EFFECT OF FINAL DECISION.—The final decision of the Patent Trial and Appeal Board, if adverse to claims in an application for patent, shall constitute the final refusal by the Office on those claims. The final decision of the Patent Trial and Appeal Board, if adverse to claims in a patent, shall, if no appeal or other review of the decision has been or can be taken or had, constitute cancellation of those claims, and notice of such cancellation shall be endorsed on copies of the patent distributed after such cancellation.

“(e) SETTLEMENT.—Parties to a proceeding instituted under subsection (a) may terminate the proceeding by filing a written statement reflecting the agreement of the parties as to the correct inventors of the claimed invention in dispute. Unless the Patent Trial and Appeal Board finds the agreement to be inconsistent with the evidence of record, if any, it shall take action consistent with the agreement. Any written settlement or understanding of the parties shall be filed with the Director. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents or applications, and shall be made available only to Government agencies on written request, or to any person on a showing of good cause.

“(f) ARBITRATION.—Parties to a proceeding instituted under subsection (a) may, within such time as may be specified by the Director by regulation, determine such contest or any aspect thereof by arbitration. Such arbitration shall be governed by the provisions of title 9, to the extent such title is not inconsistent with this section. The parties shall give notice of any arbitration award to the Director, and such award shall, as between the parties to the arbitration, be dispositive of the issues to which it relates. The arbitration award shall be unenforceable until such notice is given. Nothing in this subsection shall preclude the Director from determining the patentability of the claimed inventions involved in the proceeding.”.

(j) ELIMINATION OF REFERENCES TO INTERFERENCES.—(1) Sections 134, 145, 146, 154, and 305 of title 35, United States Code, are each amended by striking “Board of Patent Appeals and Interferences” each place it appears and inserting “Patent Trial and Appeal Board”.

(2)(A) Section 146 of title 35, United States Code, is amended—

(i) by striking “an interference” and inserting “a derivation proceeding”; and

(ii) by striking “the interference” and inserting “the derivation proceeding”.

(B) The subparagraph heading for section 154(b)(1)(C) of title 35, United States Code, is amended to read as follows:

“(C) GUARANTEE OF ADJUSTMENTS FOR DELAYS DUE TO DERIVATION PROCEEDINGS, SECRECY ORDERS, AND APPEALS.—”.

(3) The section heading for section 134 of title 35, United States Code, is amended to read as follows:

**“§ 134. Appeal to the Patent Trial and Appeal Board”.**

(4) The section heading for section 146 of title 35, United States Code, is amended to read as follows:

**“§ 146. Civil action in case of derivation proceeding”.**

(5) The items relating to sections 134 and 135 in the table of sections for chapter 12 of title 35, United States Code, are amended to read as follows:

“134. Appeal to the Patent Trial and Appeal Board.

“135. Derivation proceedings.”.

(6) The item relating to section 146 in the table of sections for chapter 13 of title 35, United States Code, is amended to read as follows:

“146. Civil action in case of derivation proceeding.”.

(k) STATUTE OF LIMITATIONS.—

(1) IN GENERAL.—Section 32 of title 35, United States Code, is amended by inserting between the third and fourth sentences the following: “A proceeding under this section shall be commenced not later than the earlier of either the date that is 10 years after the date on which the misconduct forming the basis for the proceeding occurred, or 1 year after the date on which the misconduct forming the basis for the proceeding is made known to an officer or employee of the Office as prescribed in the regulations established under section 2(b)(2)(D).”.

(2) REPORT TO CONGRESS.—The Director shall provide on a biennial basis to the Judiciary Committees of the Senate and House of Representatives a report providing a short description of incidents made known to an officer or employee of the Office as prescribed in the regulations established under section 2(b)(2)(D) of title 35, United States Code, that reflect substantial evidence of misconduct before the Office but for which the Office was barred from commencing a proceeding under section 32 of title 35, United States Code, by the time limitation established by the fourth sentence of that section.

(3) EFFECTIVE DATE.—The amendment made by paragraph (1) shall apply in any case in which the time period for instituting a proceeding under section 32 of title 35, United States Code, had not lapsed before the date of the enactment of this Act.

(I) SMALL BUSINESS STUDY.—

(1) DEFINITIONS.—In this subsection—

(A) the term “Chief Counsel” means the Chief Counsel for Advocacy of the Small Business Administration;

(B) the term “General Counsel” means the General Counsel of the United States Patent and Trademark Office; and

(C) the term “small business concern” has the meaning given that term under section 3 of the Small Business Act (15 U.S.C. 632).

(2) STUDY.—

(A) IN GENERAL.—The Chief Counsel, in consultation with the General Counsel, shall conduct a study of the effects of eliminating the use of dates of invention in determining whether an applicant is entitled to a patent under title 35, United States Code.

(B) AREAS OF STUDY.—The study conducted under subparagraph (A) shall include examination of the effects of eliminating the use of invention dates, including examining—

(i) how the change would affect the ability of small business concerns to obtain patents and their costs of obtaining patents;

(ii) whether the change would create, mitigate, or exacerbate any disadvantages for applicants for patents that are small business concerns relative to applicants for patents that are not small business concerns, and whether the change would create any advantages for applicants for patents that are small business concerns relative to applicants for patents that are not small business concerns;

(iii) the cost savings and other potential benefits to small business concerns of the change; and

(iv) the feasibility and costs and benefits to small business concerns of alternative means of determining whether an applicant is entitled to a patent under title 35, United States Code.

(3) REPORT.—Not later than the date that is 1 year after the date of the enactment of this Act, the Chief Counsel shall submit to the Committee on Small Business and Entrepreneurship and the Committee on the Judiciary of the Senate and the Committee on Small Business and the Committee on the Judiciary of the House of Representatives a report on the results of the study under paragraph (2).

(m) REPORT ON PRIOR USER RIGHTS.—

(1) IN GENERAL.—Not later than the end of the 4-month period beginning on the date of the enactment of this Act, the Director shall report, to the Committee on the Judiciary of the Senate and the Committee on the Judiciary of the House of Representatives, the findings and recommendations of the Director on the operation of prior user rights in selected countries in the industrialized world. The report shall include the following:

(A) A comparison between patent laws of the United States and the laws of other industrialized countries, including members of the European Union and Japan, Canada, and Australia.

(B) An analysis of the effect of prior user rights on innovation rates in the selected countries.



(C) An analysis of the correlation, if any, between prior user rights and start-up enterprises and the ability to attract venture capital to start new companies.

(D) An analysis of the effect of prior user rights, if any, on small businesses, universities, and individual inventors.

(E) An analysis of legal and constitutional issues, if any, that arise from placing trade secret law in patent law.

(F) An analysis of whether the change to a first-to-file patent system creates a particular need for prior user rights.

(2) CONSULTATION WITH OTHER AGENCIES.—In preparing the report required under paragraph (1), the Director shall consult with the United States Trade Representative, the Secretary of State, and the Attorney General.

(n) EFFECTIVE DATE.—

(1) IN GENERAL.—Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any application for patent, and to any patent issuing thereon, that contains or contained at any time—

(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after the effective date described in this paragraph; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

(2) INTERFERING PATENTS.—The provisions of sections 102(g), 135, and 291 of title 35, United States Code, as in effect on the day before the effective date set forth in paragraph (1) of this subsection, shall apply to each claim of an application for patent, and any patent issued thereon, for which the amendments made by this section also apply, if such application or patent contains or contained at any time—

(A) a claim to an invention having an effective filing date as defined in section 100(i) of title 35, United States Code, that occurs before the effective date set forth in paragraph (1) of this subsection; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

(o) SENSE OF CONGRESS.—It is the sense of the Congress that converting the United States patent system from “first to invent” to a system of “first inventor to file” will promote the progress of science and the useful arts by securing for limited times to inventors the exclusive rights to their discoveries and provide inventors with greater certainty regarding the scope of protection provided by the grant of exclusive rights to their discoveries.

(p) SENSE OF CONGRESS.—It is the sense of the Congress that converting the United States patent system from “first to invent” to a system of “first inventor to file” will improve the United States patent system and promote harmonization of the United States patent system with the patent systems commonly used in nearly all other countries throughout the world with whom the United States conducts trade and thereby promote greater international uniformity and certainty in the procedures used for securing the exclusive rights of inventors to their discoveries.

#### **SEC. 4. INVENTOR'S OATH OR DECLARATION.**

(a) INVENTOR'S OATH OR DECLARATION.—

(1) IN GENERAL.—Section 115 of title 35, United States Code, is amended to read as follows:

**“§ 115. Inventor’s oath or declaration**

“(a) NAMING THE INVENTOR; INVENTOR’S OATH OR DECLARATION.— An application for patent that is filed under section 111(a) or commences the national stage under section 371 shall include, or be amended to include, the name of the inventor for any invention claimed in the application. Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.

“(b) REQUIRED STATEMENTS.—An oath or declaration under subsection (a) shall contain statements that—

“(1) the application was made or was authorized to be made by the affiant or declarant; and

“(2) such individual believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.

“(c) ADDITIONAL REQUIREMENTS.—The Director may specify additional information relating to the inventor and the invention that is required to be included in an oath or declaration under subsection (a).

“(d) SUBSTITUTE STATEMENT.—

“(1) IN GENERAL.—In lieu of executing an oath or declaration under subsection (a), the applicant for patent may provide a substitute statement under the circumstances described in paragraph (2) and such additional circumstances that the Director may specify by regulation.

“(2) PERMITTED CIRCUMSTANCES.—A substitute statement under paragraph (1) is permitted with respect to any individual who—

“(A) is unable to file the oath or declaration under subsection (a) because the individual—

“(i) is deceased;

“(ii) is under legal incapacity; or

“(iii) cannot be found or reached after diligent effort; or

“(B) is under an obligation to assign the invention but has refused to make the oath or declaration required under subsection (a).

“(3) CONTENTS.—A substitute statement under this subsection shall—

“(A) identify the individual with respect to whom the statement applies;

“(B) set forth the circumstances representing the permitted basis for the filing of the substitute statement in lieu of the oath or declaration under subsection (a); and

“(C) contain any additional information, including any showing, required by the Director.

“(e) MAKING REQUIRED STATEMENTS IN ASSIGNMENT OF RECORD.—An individual who is under an obligation of assignment of an application for patent may include the required statements under subsections (b) and (c) in the assignment executed by the individual, in lieu of filing such statements separately.

“(f) TIME FOR FILING.—A notice of allowance under section 151 may be provided to an applicant for patent only if the applicant for patent has filed each required oath or declaration under subsection

(a) or has filed a substitute statement under subsection

(d) or recorded an assignment meeting the requirements of subsection (e).

“(g) EARLIER-FILED APPLICATION CONTAINING REQUIRED STATEMENTS OR SUBSTITUTE STATEMENT.—

“(1) EXCEPTION.—The requirements under this section shall not apply to an individual with respect to an application for patent in which the individual is named as the inventor or a joint inventor and who claims the benefit under section 120, 121, or 365(c) of the filing of an earlier-filed application, if—

“(A) an oath or declaration meeting the requirements of subsection (a) was executed by the individual and was filed in connection with the earlier-filed application;

“(B) a substitute statement meeting the requirements of subsection (d) was filed in connection with the earlier filed application with respect to the individual; or

“(C) an assignment meeting the requirements of subsection (e) was executed with respect to the earlier-filed application by the individual and was recorded in connection with the earlier-filed application.

“(2) COPIES OF OATHS, DECLARATIONS, STATEMENTS, OR ASSIGNMENTS.—Notwithstanding paragraph (1), the Director may require that a copy of the executed oath or declaration, the substitute statement, or the assignment filed in connection with the earlier-filed application be included in the later-filed application.

“(h) SUPPLEMENTAL AND CORRECTED STATEMENTS; FILING ADDITIONAL STATEMENTS.—

“(1) IN GENERAL.—Any person making a statement required under this section may withdraw, replace, or otherwise correct the statement at any time. If a change is made in the naming of the inventor requiring the filing of 1 or more additional statements under this section, the Director shall establish regulations under which such additional statements may be filed.

“(2) SUPPLEMENTAL STATEMENTS NOT REQUIRED.—If an individual has executed an oath or declaration meeting the requirements of subsection (a) or an assignment meeting the requirements of subsection (e) with respect to an application for patent, the Director may not thereafter require that individual to make any additional oath, declaration, or other statement equivalent to those required by this section in connection with the application for patent or any patent issuing thereon.

“(3) SAVINGS CLAUSE.—A patent shall not be invalid or unenforceable based upon the failure to comply with a requirement under this section if the failure is remedied as provided under paragraph (1).

“(i) ACKNOWLEDGMENT OF PENALTIES.—Any declaration or statement filed pursuant to this section shall contain an acknowledgment that any willful false statement made in such declaration or statement is punishable under section 1001 of title 18 by fine or imprisonment of not more than 5 years, or both.”.

(2) RELATIONSHIP TO DIVISIONAL APPLICATIONS.—Section 121 of title 35, United States Code, is amended by striking “If a divisional application” and all that follows through “inventor.”.

(3) REQUIREMENTS FOR NONPROVISIONAL APPLICATIONS.— Section 111(a) of title 35, United States Code, is amended—

(A) in paragraph (2)(C), by striking “by the applicant” and inserting “or declaration”;

(B) in the heading for paragraph (3), by inserting “OR DECLARATION” after “AND OATH”; and

(C) by inserting “or declaration” after “and oath” each place it appears.

(4) CONFORMING AMENDMENT.—The item relating to section 115 in the table of sections for chapter 11 of title 35, United States Code, is amended to read as follows:

“115. Inventor’s oath or declaration.”.

(b) FILING BY OTHER THAN INVENTOR.—

(1) IN GENERAL.—Section 118 of title 35, United States Code, is amended to read as follows:

**“§ 118. Filing by other than inventor**

“A person to whom the inventor has assigned or is under an obligation to assign the invention may make an application for patent. A person who otherwise shows sufficient proprietary interest in the matter may make an application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is appropriate to preserve the rights of the parties. If the Director grants a patent on an application filed under this section by a person other than the inventor, the patent shall be granted to the real party in interest and upon such notice to the inventor as the Director considers to be sufficient.”.

(2) CONFORMING AMENDMENT.—Section 251 of title 35, United States Code, is amended in the third undesignated paragraph by inserting “or the application for the original patent was filed by the assignee of the entire interest” after “claims of the original patent”.

(c) SPECIFICATION.—Section 112 of title 35, United States Code, is amended—

(1) in the first undesignated paragraph—

(A) by striking “The specification” and inserting “(a) IN GENERAL.—The specification”; and

(B) by striking “of carrying out his invention” and inserting “or joint inventor of carrying out the invention”;

(2) in the second undesignated paragraph—

(A) by striking “The specification” and inserting “(b) CONCLUSION.—The specification”; and

(B) by striking “applicant regards as his invention” and inserting “inventor or a joint inventor regards as the invention”;

(3) in the third undesignated paragraph, by striking “A claim” and inserting “(c) FORM.—A claim”;

(4) in the fourth undesignated paragraph, by striking “Subject to the following paragraph,” and inserting “(d) REFERENCE IN DEPENDENT FORMS.—Subject to subsection (e),”;

(5) in the fifth undesignated paragraph, by striking “A claim” and inserting “(e) REFERENCE IN MULTIPLE DEPENDENT FORM.—A claim”; and

(6) in the last undesignated paragraph, by striking “An element” and inserting “(f) ELEMENT IN CLAIM FOR A COMBINATION.—An element”.

(d) CONFORMING AMENDMENTS.—

(1) Sections 111(b)(1)(A) of title 35, United States Code, is amended by striking “the first paragraph of section 112 of this title” and inserting “section 112(a)”.

(2) Section 111(b)(2) of title 35, United States Code, is amended by striking “the second through fifth paragraphs of section 112,” and inserting “subsections (b) through (e) of section 112,”.

(e) EFFECTIVE DATE.—The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent application that is filed on or after that effective date.

**SEC. 5. DEFENSE TO INFRINGEMENT BASED ON PRIOR COMMERCIAL USE.**

(a) IN GENERAL.—Section 273 of title 35, United States Code, is amended to read as follows:

**“§ 273. Defense to infringement based on prior commercial use**

“(a) IN GENERAL.—A person shall be entitled to a defense under section 282(b) with respect to subject matter consisting of a process, or consisting of a machine, manufacture, or composition of matter used in a manufacturing or other commercial process, that would otherwise infringe a claimed invention being asserted against the person if—

“(1) such person, acting in good faith, commercially used the subject matter in the United States, either in connection with an internal commercial use or an actual arm’s length sale or other arm’s length commercial transfer of a useful end result of such commercial use; and

“(2) such commercial use occurred at least 1 year before the earlier of either—

“(A) the effective filing date of the claimed invention; or

“(B) the date on which the claimed invention was disclosed to the public in a manner that qualified for the exception from prior art under section 102(b).

“(b) BURDEN OF PROOF.—A person asserting a defense under this section shall have the burden of establishing the defense by clear and convincing evidence.

“(c) ADDITIONAL COMMERCIAL USES.—

“(1) PREMARKETING REGULATORY REVIEW.—Subject matter for which commercial marketing or use is subject to a premarketing regulatory review period during which the safety or efficacy of the subject matter is established, including any period specified in section 156(g), shall be deemed to be commercially used for purposes of subsection (a)(1) during such regulatory review period.

“(2) NONPROFIT LABORATORY USE.—A use of subject matter by a nonprofit research laboratory or other nonprofit entity, such as a university or hospital, for which the public is the intended beneficiary, shall be deemed to be a commercial use for purposes of subsection (a)(1), except that a defense under this section may be asserted pursuant to this paragraph only for continued and noncommercial use by and in the laboratory or other nonprofit entity.

“(d) EXHAUSTION OF RIGHTS.—Notwithstanding subsection (e)(1), the sale or other disposition of a useful end result by a person entitled to assert a defense under this section in connection with a patent with respect to that useful end result shall exhaust the patent owner’s rights under the patent to the extent that such rights would have been exhausted had such sale or other disposition been made by the patent owner.

“(e) LIMITATIONS AND EXCEPTIONS.—

“(1) PERSONAL DEFENSE.—

“(A) IN GENERAL.—A defense under this section may be asserted only by the person who performed or directed the performance of the commercial use described in subsection (a), or by an entity that controls, is controlled by, or is under common control with such person.

“(B) TRANSFER OF RIGHT.—Except for any transfer to the patent owner, the right to assert a defense under this section shall not be licensed or assigned or transferred to another person except as an ancillary and subordinate part of a good-faith assignment or transfer for other reasons of the entire enterprise or line of business to which the defense relates.

“(C) RESTRICTION ON SITES.—A defense under this section, when acquired by a person as part of an assignment or transfer described in subparagraph (B), may only be asserted for uses at sites where the subject matter that would otherwise infringe a claimed invention is in use before the later of the

effective filing date of the claimed invention or the date of the assignment or transfer of such enterprise or line of business.

“(2) DERIVATION.—A person may not assert a defense under this section if the subject matter on which the defense is based was derived from the patentee or persons in privity with the patentee.

“(3) NOT A GENERAL LICENSE.—The defense asserted by a person under this section is not a general license under all claims of the patent at issue, but extends only to the specific subject matter for which it has been established that a commercial use that qualifies under this section occurred, except that the defense shall also extend to variations in the quantity or volume of use of the claimed subject matter, and to improvements in the claimed subject matter that do not infringe additional specifically claimed subject matter of the patent.

“(4) ABANDONMENT OF USE.—A person who has abandoned commercial use (that qualifies under this section) of subject matter may not rely on activities performed before the date of such abandonment in establishing a defense under this section with respect to actions taken on or after the date of such abandonment.

“(5) UNIVERSITY EXCEPTION.—

“(A) IN GENERAL.—A person commercially using subject matter to which subsection (a) applies may not assert a defense under this section if the claimed invention with respect to which the defense is asserted was, at the time the invention was made, owned or subject to an obligation of assignment to either an institution of higher education (as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)), or a technology transfer organization whose primary purpose is to facilitate the commercialization of technologies developed by one or more such institutions of higher education.

“(B) EXCEPTION.—Subparagraph (A) shall not apply if any of the activities required to reduce to practice the subject matter of the claimed invention could not have been undertaken using funds provided by the Federal Government.

“(f) UNREASONABLE ASSERTION OF DEFENSE.—If the defense under this section is pleaded by a person who is found to infringe the patent and who subsequently fails to demonstrate a reasonable basis for asserting the defense, the court shall find the case exceptional for the purpose of awarding attorney fees under section 285.

“(g) INVALIDITY.—A patent shall not be deemed to be invalid under section 102 or 103 solely because a defense is raised or established under this section.”.

(b) CONFORMING AMENDMENT.—The item relating to section 273 in the table of sections for chapter 28 of title 35, United States Code, is amended to read as follows:

“273. Defense to infringement based on prior commercial use.”.

(c) EFFECTIVE DATE.—The amendments made by this section shall apply to any patent issued on or after the date of the enactment of this Act.

## **SEC. 6. POST-GRANT REVIEW PROCEEDINGS.**

(a) INTER PARTES REVIEW.—Chapter 31 of title 35, United States Code, is amended to read as follows:

### **“CHAPTER 31—INTER PARTES REVIEW**

“Sec.

“311. Inter partes review.

“312. Petitions.

“313. Preliminary response to petition.

“314. Institution of inter partes review.

“315. Relation to other proceedings or actions.

“316. Conduct of inter partes review.

“317. Settlement.

“318. Decision of the Board.

“319. Appeal.

### “§ 311. Inter partes review

“(a) IN GENERAL.—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the review.

“(b) SCOPE.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

“(c) FILING DEADLINE.—A petition for inter partes review shall be filed after the later of either—

“(1) the date that is 9 months after the grant of a patent or issuance of a reissue of a patent; or

“(2) if a post-grant review is instituted under chapter 32, the date of the termination of such post-grant review.

### “§ 312. Petitions

“(a) REQUIREMENTS OF PETITION.—A petition filed under section 311 may be considered only if—

“(1) the petition is accompanied by payment of the fee established by the Director under section 311;

“(2) the petition identifies all real parties in interest;

“(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—

“(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

“(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on expert opinions;

“(4) the petition provides such other information as the Director may require by regulation; and

“(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

“(b) PUBLIC AVAILABILITY.—As soon as practicable after the receipt of a petition under section 311, the Director shall make the petition available to the public.

### “§ 313. Preliminary response to petition

“If an inter partes review petition is filed under section 311, the patent owner shall have the right to file a preliminary response to the petition, within a time period set by the Director, that sets forth reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement of this chapter.

**“§ 314. Institution of inter partes review**

“(a) THRESHOLD.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

“(b) TIMING.—The Director shall determine whether to institute an inter partes review under this chapter pursuant to a petition filed under section 311 within 3 months after—

“(1) receiving a preliminary response to the petition under section 313; or

“(2) if no such preliminary response is filed, the last date on which such response may be filed.

“(c) NOTICE.—The Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.

“(d) NO APPEAL.—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.

**“§ 315. Relation to other proceedings or actions**

“(a) INFRINGER’S CIVIL ACTION.—

“(1) INTER PARTES REVIEW BARRED BY CIVIL ACTION.—An inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

“(2) STAY OF CIVIL ACTION.—If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for inter partes review of the patent, that civil action shall be automatically stayed until either—

“(A) the patent owner moves the court to lift the stay;

“(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or

“(C) the petitioner or real party in interest moves the court to dismiss the civil action.

“(3) TREATMENT OF COUNTERCLAIM.—A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.

“(b) PATENT OWNER’S ACTION.—An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

“(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

“(d) MULTIPLE PROCEEDINGS.—Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including



providing for stay, transfer, consolidation, or termination of any such matter or proceeding.

“(e) ESTOPPEL.—

“(1) PROCEEDINGS BEFORE THE OFFICE.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

“(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

### “§ 316. Conduct of inter partes review

“(a) REGULATIONS.—The Director shall prescribe regulations—

“(1) providing that the file of any proceeding under this chapter shall be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion;

“(2) setting forth the standards for the showing of sufficient grounds to institute a review under section 314(a);

“(3) establishing procedures for the submission of supplemental information after the petition is filed;

“(4) establishing and governing inter partes review under this chapter and the relationship of such review to other proceedings under this title;

“(5) setting forth standards and procedures for discovery of relevant evidence, including that such discovery shall be limited to—

“(A) the deposition of witnesses submitting affidavits or declarations; and

“(B) what is otherwise necessary in the interest of justice;

“(6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding;

“(7) providing for protective orders governing the exchange and submission of confidential information;

“(8) providing for the filing by the patent owner of a response to the petition under section 313 after an inter partes review has been instituted, and requiring that the patent owner file with such response, through affidavits or declarations, any additional factual evidence and expert opinions on which the patent owner relies in support of the response;

“(9) setting forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims, and ensuring that any information submitted by the patent owner in support of any amendment entered under subsection (d) is made available to the public as part of the prosecution history of the patent;

“(10) providing either party with the right to an oral hearing as part of the proceeding;

“(11) requiring that the final determination in an inter partes review be issued not later than 1 year after the date on which the Director notices the institution of a review under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 315(c);

“(12) setting a time period for requesting joinder under section 315(c); and

“(13) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director.

“(b) CONSIDERATIONS.—In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.

“(c) PATENT TRIAL AND APPEAL BOARD.—The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each inter partes review instituted under this chapter.

“(d) AMENDMENT OF THE PATENT.—

“(1) IN GENERAL.—During an inter partes review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

“(A) Cancel any challenged patent claim.

“(B) For each challenged claim, propose a reasonable number of substitute claims.

“(2) ADDITIONAL MOTIONS.—Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317, or as permitted by regulations prescribed by the Director.

“(3) SCOPE OF CLAIMS.—An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

“(e) EVIDENTIARY STANDARDS.—In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.

#### “§ 317. Settlement

“(a) IN GENERAL.—An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. If the inter partes review is terminated with respect to a petitioner under this section, no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that inter partes review. If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).

“(b) AGREEMENTS IN WRITING.—Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

**“§ 318. Decision of the Board**

“(a) FINAL WRITTEN DECISION.—If an inter partes review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 316(d).

“(b) CERTIFICATE.—If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.

“(c) INTERVENING RIGHTS.—Any proposed amended or new claim determined to be patentable and incorporated into a patent following an inter partes review under this chapter shall have the same effect as that specified in section 252 for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).

“(d) DATA ON LENGTH OF REVIEW.—The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each inter partes review.

**“§ 319. Appeal**

“A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) may appeal the decision pursuant to sections 141 through 144. Any party to the inter partes review shall have the right to be a party to the appeal.”

(b) CONFORMING AMENDMENT.—The table of chapters for part III of title 35, United States Code, is amended by striking the item relating to chapter 31 and inserting the following:

“31. Inter Partes Review ..... 311”.

(c) REGULATIONS AND EFFECTIVE DATE.—

(1) REGULATIONS.—The Director shall, not later than the date that is 1 year after the date of the enactment of this Act, issue regulations to carry out chapter 31 of title 35, United States Code, as amended by subsection (a) of this section.

(2) APPLICABILITY.—

(A) IN GENERAL.—The amendments made by subsection (a) shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.

(B) GRADUATED IMPLEMENTATION.—The Director may impose a limit on the number of inter partes reviews that may be instituted under chapter 31 of title 35, United States Code, during each of the first 4 1-year periods in which the amendments made by subsection (a) are in effect, if such number in each year equals or exceeds the number of inter partes reexaminations that are ordered under chapter 31 of title 35, United States Code, in the last fiscal year ending before the effective date of the amendments made by subsection (a).

(3) TRANSITION.—

(A) IN GENERAL.—Chapter 31 of title 35, United States Code, is amended—

(i) in section 312—

(I) in subsection (a)—

(aa) in the first sentence, by striking “a substantial new question of patentability affecting any claim of the patent concerned is raised by the request,” and inserting “the information presented in

the request shows that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request,"; and

(bb) in the second sentence, by striking "The existence of a substantial new question of patentability" and inserting "A showing that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request"; and

(II) in subsection (c), in the second sentence, by striking "no substantial new question of patentability has been raised," and inserting "the showing required by subsection (a) has not been made,"; and

(ii) in section 313, by striking "a substantial new question of patentability affecting a claim of the patent is raised" and inserting "it has been shown that there is a reasonable likelihood that the requester would prevail with respect to at least 1 of the claims challenged in the request".

(B) APPLICATION.—The amendments made by this paragraph—

(i) shall take effect on the date of the enactment of this Act; and

(ii) shall apply to requests for inter partes reexamination that are filed on or after such date of enactment, but before the effective date set forth in paragraph (2)(A) of this subsection.

(C) CONTINUED APPLICABILITY OF PRIOR PROVISIONS.—The provisions of chapter 31 of title 35, United States Code, as amended by this paragraph, shall continue to apply to requests for inter partes reexamination that are filed before the effective date set forth in paragraph (2)(A) as if subsection (a) had not been enacted.

(d) POST-GRANT REVIEW.—Part III of title 35, United States Code, is amended by adding at the end the following:

**"CHAPTER 32—POST-GRANT REVIEW**

"Sec.

"321. Post-grant review.

"322. Petitions.

"323. Preliminary response to petition.

"324. Institution of post-grant review.

"325. Relation to other proceedings or actions.

"326. Conduct of post-grant review.

"327. Settlement.

"328. Decision of the Board.

"329. Appeal.

**"§ 321. Post-grant review**

"(a) IN GENERAL.—Subject to the provisions of this chapter, a person who is not the owner of a patent may file with the Office a petition to institute a post-grant review of the patent. The Director shall establish, by regulation, fees to be paid by the person requesting the review, in such amounts as the Director determines to be reasonable, considering the aggregate costs of the post-grant review.

"(b) SCOPE.—A petitioner in a post-grant review may request to cancel as unpatentable 1 or more claims of a patent on any ground that could be raised under paragraph (2) or (3) of section 282(b) (relating to invalidity of the patent or any claim).

“(c) FILING DEADLINE.—A petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent or of the issuance of a reissue patent (as the case may be).

#### “§ 322. Petitions

“(a) REQUIREMENTS OF PETITION.—A petition filed under section 321 may be considered only if—

“(1) the petition is accompanied by payment of the fee established by the Director under section 321;

“(2) the petition identifies all real parties in interest;

“(3) the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, including—

“(A) copies of patents and printed publications that the petitioner relies upon in support of the petition; and

“(B) affidavits or declarations of supporting evidence and opinions, if the petitioner relies on other factual evidence or on expert opinions;

“(4) the petition provides such other information as the Director may require by regulation; and

“(5) the petitioner provides copies of any of the documents required under paragraphs (2), (3), and (4) to the patent owner or, if applicable, the designated representative of the patent owner.

“(b) PUBLIC AVAILABILITY.—As soon as practicable after the receipt of a petition under section 321, the Director shall make the petition available to the public.

#### “§ 323. Preliminary response to petition

“If a post-grant review petition is filed under section 321, the patent owner shall have the right to file a preliminary response to the petition, within a time period set by the Director, that sets forth reasons why no post-grant review should be instituted based upon the failure of the petition to meet any requirement of this chapter.

#### “§ 324. Institution of post-grant review

“(a) THRESHOLD.—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

“(b) ADDITIONAL GROUNDS.—The determination required under subsection (a) may also be satisfied by a showing that the petition raises a novel or unsettled legal question that is important to other patents or patent applications.

“(c) TIMING.—The Director shall determine whether to institute a post-grant review under this chapter pursuant to a petition filed under section 321 within 3 months after—

“(1) receiving a preliminary response to the petition under section 323; or

“(2) if no such preliminary response is filed, the last date on which such response may be filed.

“(d) NOTICE.—The Director shall notify the petitioner and patent owner, in writing, of the Director’s determination under subsection (a) or (b), and shall make such notice available to the public as soon as is practicable. Such notice shall include the date on which the review shall commence.

“(e) NO APPEAL.—The determination by the Director whether to institute a post-grant review under this section shall be final and nonappealable.

**“§ 325. Relation to other proceedings or actions****“(a) INFRINGER’S CIVIL ACTION.—**

“(1) POST-GRANT REVIEW BARRED BY CIVIL ACTION.—A postgrant review may not be instituted under this chapter if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.

“(2) STAY OF CIVIL ACTION.—If the petitioner or real party in interest files a civil action challenging the validity of a claim of the patent on or after the date on which the petitioner files a petition for post-grant review of the patent, that civil action shall be automatically stayed until either—

“(A) the patent owner moves the court to lift the stay;

“(B) the patent owner files a civil action or counterclaim alleging that the petitioner or real party in interest has infringed the patent; or

“(C) the petitioner or real party in interest moves the court to dismiss the civil action.

“(3) TREATMENT OF COUNTERCLAIM.—A counterclaim challenging the validity of a claim of a patent does not constitute a civil action challenging the validity of a claim of a patent for purposes of this subsection.

“(b) PRELIMINARY INJUNCTIONS.—If a civil action alleging infringement of a patent is filed within 3 months after the date on which the patent is granted, the court may not stay its consideration of the patent owner’s motion for a preliminary injunction against infringement of the patent on the basis that a petition for post-grant review has been filed under this chapter or that such a post-grant review has been instituted under this chapter.

“(c) JOINDER.—If more than 1 petition for a post-grant review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant review.

“(d) MULTIPLE PROCEEDINGS.—Notwithstanding sections 135(a), 251, and 252, and chapter 30, during the pendency of any postH. grant review under this chapter, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the post-grant review or other proceeding or matter may proceed, including providing for the stay, transfer, consolidation, or termination of any such matter or proceeding. In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

**“(e) ESTOPPEL.—**

“(1) PROCEEDINGS BEFORE THE OFFICE.—The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that post-grant review.

“(2) CIVIL ACTIONS AND OTHER PROCEEDINGS.—The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that post-grant review.

“(f) REISSUE PATENTS.—A post-grant review may not be instituted under this chapter if the petition requests cancellation of a claim in a reissue patent that is identical to or narrower than a claim in the original patent from which the reissue patent was issued, and the time limitations in section 321(c) would bar filing a petition for a post-grant review for such original patent.

**“§ 326. Conduct of post-grant review**

“(a) REGULATIONS.—The Director shall prescribe regulations—

“(1) providing that the file of any proceeding under this chapter shall be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion;

“(2) setting forth the standards for the showing of sufficient grounds to institute a review under subsections (a) and (b) of section 324;

“(3) establishing procedures for the submission of supplemental information after the petition is filed;

“(4) establishing and governing a post-grant review under this chapter and the relationship of such review to other proceedings under this title;

“(5) setting forth standards and procedures for discovery of relevant evidence, including that such discovery shall be limited to evidence directly related to factual assertions advanced by either party in the proceeding;

“(6) prescribing sanctions for abuse of discovery, abuse of process, or any other improper use of the proceeding, such as to harass or to cause unnecessary delay or an unnecessary increase in the cost of the proceeding;

“(7) providing for protective orders governing the exchange and submission of confidential information;

“(8) providing for the filing by the patent owner of a response to the petition under section 323 after a post-grant review has been instituted, and requiring that the patent owner file with such response, through affidavits or declarations, any additional factual evidence and expert opinions on which the patent owner relies in support of the response;

“(9) setting forth standards and procedures for allowing the patent owner to move to amend the patent under subsection (d) to cancel a challenged claim or propose a reasonable number of substitute claims, and ensuring that any information submitted by the patent owner in support of any amendment entered under subsection (d) is made available to the public as part of the prosecution history of the patent;

“(10) providing either party with the right to an oral hearing as part of the proceeding;

“(11) requiring that the final determination in any postgrant review be issued not later than 1 year after the date on which the Director notices the institution of a proceeding under this chapter, except that the Director may, for good cause shown, extend the 1-year period by not more than 6 months, and may adjust the time periods in this paragraph in the case of joinder under section 325(c); and

“(12) providing the petitioner with at least 1 opportunity to file written comments within a time period established by the Director.

“(b) CONSIDERATIONS.—In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.

“(c) PATENT TRIAL AND APPEAL BOARD.—The Patent Trial and Appeal Board shall, in accordance with section 6, conduct each post-grant review instituted under this chapter.

“(d) AMENDMENT OF THE PATENT.—

“(1) IN GENERAL.—During a post-grant review instituted under this chapter, the patent owner may file 1 motion to amend the patent in 1 or more of the following ways:

“(A) Cancel any challenged patent claim.

“(B) For each challenged claim, propose a reasonable number of substitute claims.

“(2) ADDITIONAL MOTIONS.—Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 327, or upon the request of the patent owner for good cause shown.

“(3) SCOPE OF CLAIMS.—An amendment under this subsection may not enlarge the scope of the claims of the patent or introduce new matter.

“(e) EVIDENTIARY STANDARDS.—In a post-grant review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.

#### “§ 327. Settlement

“(a) IN GENERAL.—A post-grant review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. If the post-grant review is terminated with respect to a petitioner under this section, no estoppel under section 325(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that post-grant review. If no petitioner remains in the post-grant review, the Office may terminate the post-grant review or proceed to a final written decision under section 328(a).

“(b) AGREEMENTS IN WRITING.—Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of a post-grant review under this section shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office before the termination of the post-grant review as between the parties. At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

#### “§ 328. Decision of the Board

“(a) FINAL WRITTEN DECISION.—If a post-grant review is instituted and not dismissed under this chapter, the Patent Trial and Appeal Board shall issue a final written decision with respect to the patentability of any patent claim challenged by the petitioner and any new claim added under section 326(d).

“(b) CERTIFICATE.—If the Patent Trial and Appeal Board issues a final written decision under subsection (a) and the time for appeal has expired or any appeal has terminated, the Director shall issue and publish a certificate canceling any claim of the patent finally determined to be unpatentable, confirming any claim of the patent determined to be patentable, and incorporating in the patent by operation of the certificate any new or amended claim determined to be patentable.

“(c) INTERVENING RIGHTS.—Any proposed amended or new claim determined to be patentable and incorporated into a patent following a post-grant review under this



chapter shall have the same effect as that specified in section 252 of this title for reissued patents on the right of any person who made, purchased, or used within the United States, or imported into the United States, anything patented by such proposed amended or new claim, or who made substantial preparation therefor, before the issuance of a certificate under subsection (b).

“(d) DATA ON LENGTH OF REVIEW.—The Office shall make available to the public data describing the length of time between the institution of, and the issuance of a final written decision under subsection (a) for, each post-grant review.

### “§ 329. Appeal

“A party dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 328(a) may appeal the decision pursuant to sections 141 through 144. Any party to the post-grant review shall have the right to be a party to the appeal.”.

(e) CONFORMING AMENDMENT.—The table of chapters for part III of title 35, United States Code, is amended by adding at the end the following:

“32. Post-Grant Review ..... 321”.

(f) REGULATIONS AND EFFECTIVE DATE.—

(1) REGULATIONS.—The Director shall, not later than the date that is 1 year after the date of the enactment of this Act, issue regulations to carry out chapter 32 of title 35, United States Code, as added by subsection (d) of this section.

(2) APPLICABILITY.—

(A) IN GENERAL.—The amendments made by subsection (d) shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and, except as provided in section 18 and in paragraph (3), shall apply only to patents described in section 3(n)(1).

(B) LIMITATION.—The Director may impose a limit on the number of post-grant reviews that may be instituted under chapter 32 of title 35, United States Code, during each of the first 4 1-year periods in which the amendments made by subsection (d) are in effect.

(3) PENDING INTERFERENCES.—

(A) PROCEDURES IN GENERAL.—The Director shall determine, and include in the regulations issued under paragraph (1), the procedures under which an interference commenced before the effective date set forth in paragraph (2)(A) is to proceed, including whether such interference—

(i) is to be dismissed without prejudice to the filing of a petition for a post-grant review under chapter 32 of title 35, United States Code; or

(ii) is to proceed as if this Act had not been enacted.

(B) PROCEEDINGS BY PATENT TRIAL AND APPEAL BOARD.—For purposes of an interference that is commenced before the effective date set forth in paragraph (2)(A), the Director may deem the Patent Trial and Appeal Board to be the Board of Patent Appeals and Interferences, and may allow the Patent Trial and Appeal Board to conduct any further proceedings in that interference.

(C) APPEALS.—The authorization to appeal or have remedy from derivation proceedings in sections 141(d) and 146 of title 35, United States Code, as amended by this Act, and the jurisdiction to entertain appeals from derivation proceedings in section 1295(a)(4)(A) of title 28, United States Code, as amended by this Act, shall be deemed to extend to any final decision in an interference that is commenced before the effective date set forth in paragraph (2)(A) of this subsection and that is not dismissed pursuant to this paragraph.

(g) CITATION OF PRIOR ART AND WRITTEN STATEMENTS.—

(1) IN GENERAL.—Section 301 of title 35, United States Code, is amended to read as follows:

**“§ 301. Citation of prior art and written statements**

“(a) IN GENERAL.—Any person at any time may cite to the Office in writing—

“(1) prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent; or

“(2) statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent.

“(b) OFFICIAL FILE.—If the person citing prior art or written statements pursuant to subsection (a) explains in writing the pertinence and manner of applying the prior art or written statements to at least 1 claim of the patent, the citation of the prior art or written statements and the explanation thereof shall become a part of the official file of the patent.

“(c) ADDITIONAL INFORMATION.—A party that submits a written statement pursuant to subsection (a)(2) shall include any other documents, pleadings, or evidence from the proceeding in which the statement was filed that addresses the written statement.

“(d) LIMITATIONS.—A written statement submitted pursuant to subsection (a)(2), and additional information submitted pursuant to subsection (c), shall not be considered by the Office for any purpose other than to determine the proper meaning of a patent claim in a proceeding that is ordered or instituted pursuant to section 304, 314, or 324. If any such written statement or additional information is subject to an applicable protective order, such statement or information shall be redacted to exclude information that is subject to that order.

“(e) CONFIDENTIALITY.—Upon the written request of the person citing prior art or written statements pursuant to subsection (a), that person’s identity shall be excluded from the patent file and kept confidential.”.

(2) CONFORMING AMENDMENT.—The item relating to section 301 in the table of sections for chapter 30 of title 35, United States Code, is amended to read as follows:

“301. Citation of prior art and written statements.”.

(3) EFFECTIVE DATE.—The amendments made by this subsection shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.

(h) REEXAMINATION.—

(1) DETERMINATION BY DIRECTOR.—

(A) IN GENERAL.—Section 303(a) of title 35, United States Code, is amended by striking “section 301 of this title” and inserting “section 301 or 302”.

(B) EFFECTIVE DATE.—The amendment made by this paragraph shall take effect upon the expiration of the 1- year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.

(2) APPEAL.—

(A) IN GENERAL.—Section 306 of title 35, United States Code, is amended by striking “145” and inserting “144”.

(B) EFFECTIVE DATE.—The amendment made by this paragraph shall take effect on the date of the enactment of this Act and shall apply to any appeal of a reexamination before the Board of Patent Appeals and Interferences or the Patent

Trial and Appeal Board that is pending on, or brought on or after, the date of the enactment of this Act.

## **SEC. 7. PATENT TRIAL AND APPEAL BOARD.**

### **(a) COMPOSITION AND DUTIES.—**

(1) IN GENERAL.—Section 6 of title 35, United States Code, is amended to read as follows:

#### **“§ 6. Patent Trial and Appeal Board**

“(a) IN GENERAL.—There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Secretary, in consultation with the Director. Any reference in any Federal law, Executive order, rule, regulation, or delegation of authority, or any document of or pertaining to the Board of Patent Appeals and Interferences is deemed to refer to the Patent Trial and Appeal Board.

“(b) DUTIES.—The Patent Trial and Appeal Board shall—

“(1) on written appeal of an applicant, review adverse decisions of examiners upon applications for patents pursuant to section 134(a);

“(2) review appeals of reexaminations pursuant to section 134(b);

“(3) conduct derivation proceedings pursuant to section 135; and

“(4) conduct inter partes reviews and post-grant reviews pursuant to chapters 31 and 32.

“(c) 3-MEMBER PANELS.—Each appeal, derivation proceeding, post-grant review, and inter partes review shall be heard by at least 3 members of the Patent Trial and Appeal Board, who shall be designated by the Director. Only the Patent Trial and Appeal Board may grant rehearings.

“(d) TREATMENT OF PRIOR APPOINTMENTS.—The Secretary of Commerce may, in the Secretary’s discretion, deem the appointment of an administrative patent judge who, before the date of the enactment of this subsection, held office pursuant to an appointment by the Director to take effect on the date on which the Director initially appointed the administrative patent judge. It shall be a defense to a challenge to the appointment of an administrative patent judge on the basis of the judge’s having been originally appointed by the Director that the administrative patent judge so appointed was acting as a de facto officer.”.

(2) CONFORMING AMENDMENT.—The item relating to section 6 in the table of sections for chapter 1 of title 35, United States Code, is amended to read as follows:

“6. Patent Trial and Appeal Board.”.

### **(b) ADMINISTRATIVE APPEALS.—**Section 134 of title 35, United States Code, is amended—

(1) in subsection (b), by striking “any reexamination proceeding” and inserting “a reexamination”; and

(2) by striking subsection (c).

### **(c) CIRCUIT APPEALS.—**

(1) IN GENERAL.—Section 141 of title 35, United States Code, is amended to read as follows:

#### **“§ 141. Appeal to Court of Appeals for the Federal Circuit**

“(a) EXAMINATIONS.—An applicant who is dissatisfied with the final decision in an appeal to the Patent Trial and Appeal Board under section 134(a) may appeal the Board’s

decision to the United States Court of Appeals for the Federal Circuit. By filing such an appeal, the applicant waives his or her right to proceed under section 145.

“(b) REEXAMINATIONS.—A patent owner who is dissatisfied with the final decision in an appeal of a reexamination to the Patent Trial and Appeal Board under section 134(b) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.

“(c) POST-GRANT AND INTER PARTES REVIEWS.—A party to an inter partes review or a post-grant review who is dissatisfied with the final written decision of the Patent Trial and Appeal Board under section 318(a) or 328(a) (as the case may be) may appeal the Board’s decision only to the United States Court of Appeals for the Federal Circuit.

“(d) DERIVATION PROCEEDINGS.—A party to a derivation proceeding who is dissatisfied with the final decision of the Patent Trial and Appeal Board in the proceeding may appeal the decision to the United States Court of Appeals for the Federal Circuit, but such appeal shall be dismissed if any adverse party to such derivation proceeding, within 20 days after the appellant has filed notice of appeal in accordance with section 142, files notice with the Director that the party elects to have all further proceedings conducted as provided in section 146. If the appellant does not, within 30 days after the filing of such notice by the adverse party, file a civil action under section 146, the Board’s decision shall govern the further proceedings in the case.”.

(2) JURISDICTION.—Section 1295(a)(4)(A) of title 28, United States Code, is amended to read as follows:

“(A) the Patent Trial and Appeal Board of the United States Patent and Trademark Office with respect to a patent application, derivation proceeding, reexamination, post-grant review, or inter partes review under title 35, at the instance of a party who exercised that party’s right to participate in the applicable proceeding before or appeal to the Board, except that an applicant or a party to a derivation proceeding may also have remedy by civil action pursuant to section 145 or 146 of title 35; an appeal under this subparagraph of a decision of the Board with respect to an application or derivation proceeding shall waive the right of such applicant or party to proceed under section 145 or 146 of title 35;”.

(3) PROCEEDINGS ON APPEAL.—Section 143 of title 35, United States Code, is amended—

(A) by striking the third sentence and inserting the following: “In an ex parte case, the Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all of the issues raised in the appeal. The Director shall have the right to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board in a derivation proceeding under section 135 or in an inter partes or postgrant review under chapter 31 or 32.”; and

(B) by striking the last sentence.

(d) CONFORMING AMENDMENTS.—

(1) ATOMIC ENERGY ACT OF 1954.—Section 152 of the Atomic Energy Act of 1954 (42 U.S.C. 2182) is amended in the third undesignated paragraph—

(A) by striking “Board of Patent Appeals and Interferences” each place it appears and inserting “Patent Trial and Appeal Board”; and

(B) by inserting “and derivation” after “established for interference”.

(2) TITLE 51.—Section 20135 of title 51, United States Code, is amended—

(A) in subsections (e) and (f), by striking “Board of Patent Appeals and Interferences” each place it appears and inserting “Patent Trial and Appeal Board”; and

(B) in subsection (e), by inserting “and derivation” after “established for interference”.

(e) **EFFECTIVE DATE.**—The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to proceedings commenced on or after that effective date, except that—

(1) the extension of jurisdiction to the United States Court of Appeals for the Federal Circuit to entertain appeals of decisions of the Patent Trial and Appeal Board in reexaminations under the amendment made by subsection (c)(2) shall be deemed to take effect on the date of the enactment of this Act and shall extend to any decision of the Board of Patent Appeals and Interferences with respect to a reexamination that is entered before, on, or after the date of the enactment of this Act;

(2) the provisions of sections 6, 134, and 141 of title 35, United States Code, as in effect on the day before the effective date of the amendments made by this section shall continue to apply to inter partes reexaminations that are requested under section 311 of such title before such effective date;

(3) the Patent Trial and Appeal Board may be deemed to be the Board of Patent Appeals and Interferences for purposes of appeals of inter partes reexaminations that are requested under section 311 of title 35, United States Code, before the effective date of the amendments made by this section; and

(4) the Director's right under the fourth sentence of section 143 of title 35, United States Code, as amended by subsection (c)(3) of this section, to intervene in an appeal from a decision entered by the Patent Trial and Appeal Board shall be deemed to extend to inter partes reexaminations that are requested under section 311 of such title before the effective date of the amendments made by this section.

## **SEC. 8. PREISSUANCE SUBMISSIONS BY THIRD PARTIES.**

(a) **IN GENERAL.**—Section 122 of title 35, United States Code, is amended by adding at the end the following:

“(e) **PREISSUANCE SUBMISSIONS BY THIRD PARTIES.**—

“(1) **IN GENERAL.**—Any third party may submit for consideration and inclusion in the record of a patent application, any patent, published patent application, or other printed publication of potential relevance to the examination of the application, if such submission is made in writing before the earlier of—

“(A) the date a notice of allowance under section 151 is given or mailed in the application for patent; or

“(B) the later of—

“(i) 6 months after the date on which the application for patent is first published under section 122 by the Office, or

“(ii) the date of the first rejection under section 132 of any claim by the examiner during the examination of the application for patent.

“(2) **OTHER REQUIREMENTS.**—Any submission under paragraph (1) shall—

“(A) set forth a concise description of the asserted relevance of each submitted document;

“(B) be accompanied by such fee as the Director may prescribe; and

“(C) include a statement by the person making such submission affirming that the submission was made in compliance with this section.”.

(b) **EFFECTIVE DATE.**—The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent application filed before, on, or after that effective date.

## **SEC. 9. VENUE.**

(a) **TECHNICAL AMENDMENTS RELATING TO VENUE.**—Sections 32, 145, 146, 154(b)(4)(A), and 293 of title 35, United States Code, and section 21(b)(4) of the Trademark Act of 1946

(15 U.S.C. 1071(b)(4)), are each amended by striking “United States District Court for the District of Columbia” each place that term appears and inserting “United States District Court for the Eastern District of Virginia”.

(b) EFFECTIVE DATE.—The amendments made by this section shall take effect on the date of the enactment of this Act and shall apply to any civil action commenced on or after that date.

## **SEC. 10. FEE SETTING AUTHORITY.**

(a) FEE SETTING.—

(1) IN GENERAL.—The Director may set or adjust by rule any fee established, authorized, or charged under title 35, United States Code, or the Trademark Act of 1946 (15 U.S.C. 1051 et seq.), for any services performed by or materials furnished by, the Office, subject to paragraph (2).

(2) FEES TO RECOVER COSTS.—Fees may be set or adjusted under paragraph (1) only to recover the aggregate estimated costs to the Office for processing, activities, services, and materials relating to patents (in the case of patent fees) and trademarks (in the case of trademark fees), including administrative costs of the Office with respect to such patent or trademark fees (as the case may be).

(b) SMALL AND MICRO ENTITIES.—The fees set or adjusted under subsection (a) for filing, searching, examining, issuing, appealing, and maintaining patent applications and patents shall be reduced by 50 percent with respect to the application of such fees to any small entity that qualifies for reduced fees under section 41(h)(1) of title 35, United States Code, and shall be reduced by 75 percent with respect to the application of such fees to any micro entity as defined in section 123 of that title (as added by subsection (g) of this section).

(c) REDUCTION OF FEES IN CERTAIN FISCAL YEARS.—In each fiscal year, the Director—

(1) shall consult with the Patent Public Advisory Committee and the Trademark Public Advisory Committee on the advisability of reducing any fees described in subsection (a); and

(2) after the consultation required under paragraph (1), may reduce such fees.

(d) ROLE OF THE PUBLIC ADVISORY COMMITTEE.—The Director shall—

(1) not less than 45 days before publishing any proposed fee under subsection (a) in the Federal Register, submit the proposed fee to the Patent Public Advisory Committee or the Trademark Public Advisory Committee, or both, as appropriate;

(2)(A) provide the relevant advisory committee described in paragraph (1) a 30-day period following the submission of any proposed fee, in which to deliberate, consider, and comment on such proposal;

(B) require that, during that 30-day period, the relevant advisory committee hold a public hearing relating to such proposal; and

(C) assist the relevant advisory committee in carrying out that public hearing, including by offering the use of the resources of the Office to notify and promote the hearing to the public and interested stakeholders;

(3) require the relevant advisory committee to make available to the public a written report setting forth in detail the comments, advice, and recommendations of the committee regarding the proposed fee; and

(4) consider and analyze any comments, advice, or recommendations received from the relevant advisory committee before setting or adjusting (as the case may be) the fee.

(e) PUBLICATION IN THE FEDERAL REGISTER.—

(1) PUBLICATION AND RATIONALE.—The Director shall—

(A) publish any proposed fee change under this section in the Federal Register;

(B) include, in such publication, the specific rationale and purpose for the proposal, including the possible expectations or benefits resulting from the proposed change; and

(C) notify, through the Chair and Ranking Member of the Committees on the Judiciary of the Senate and the House of Representatives, the Congress of the proposed change not later than the date on which the proposed change is published under subparagraph (A).

(2) PUBLIC COMMENT PERIOD.—The Director shall, in the publication under paragraph (1), provide the public a period of not less than 45 days in which to submit comments on the proposed change in fees.

(3) PUBLICATION OF FINAL RULE.—The final rule setting or adjusting a fee under this section shall be published in the Federal Register and in the Official Gazette of the Patent and Trademark Office.

(4) CONGRESSIONAL COMMENT PERIOD.—A fee set or adjusted under subsection (a) may not become effective—

(A) before the end of the 45-day period beginning on the day after the date on which the Director publishes the final rule adjusting or setting the fee under paragraph (3); or

(B) if a law is enacted disapproving such fee.

(5) RULE OF CONSTRUCTION.—Rules prescribed under this section shall not diminish—

(A) the rights of an applicant for a patent under title 35, United States Code, or for a mark under the Trademark Act of 1946; or

(B) any rights under a ratified treaty.

(f) RETENTION OF AUTHORITY.—The Director retains the authority under subsection (a) to set or adjust fees only during such period as the Patent and Trademark Office remains an agency within the Department of Commerce.

(g) MICRO ENTITY DEFINED.—

(1) IN GENERAL.—Chapter 11 of title 35, United States

Code, is amended by adding at the end the following new section:

**“§ 123. Micro entity defined**

“(a) IN GENERAL.—For purposes of this title, the term ‘micro entity’ means an applicant who makes a certification that the applicant—

“(1) qualifies as a small entity, as defined in regulations issued by the Director;

“(2) has not been named as an inventor on more than 4 previously filed patent applications, other than applications filed in another country, provisional applications under section 111(b), or international applications filed under the treaty defined in section 351(a) for which the basic national fee under section 41(a) was not paid;

“(3) did not, in the calendar year preceding the calendar year in which the applicable fee is being paid, have a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding 3 times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census; and

“(4) has not assigned, granted, or conveyed, and is not under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding 3 times

the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

“(b) APPLICATIONS RESULTING FROM PRIOR EMPLOYMENT.—An applicant is not considered to be named on a previously filed application for purposes of subsection (a)(2) if the applicant has assigned, or is under an obligation by contract or law to assign, all ownership rights in the application as the result of the applicant’s previous employment.

“(c) FOREIGN CURRENCY EXCHANGE RATE.—If an applicant’s or entity’s gross income in the preceding calendar year is not in United States dollars, the average currency exchange rate, as reported by the Internal Revenue Service, during that calendar year shall be used to determine whether the applicant’s or entity’s gross income exceeds the threshold specified in paragraphs (3) or (4) of subsection (a).

“(d) INSTITUTIONS OF HIGHER EDUCATION.—For purposes of this section, a micro entity shall include an applicant who certifies that—

“(1) the applicant’s employer, from which the applicant obtains the majority of the applicant’s income, is an institution of higher education as defined in section 101(a) of the Higher Education Act of 1965 (20 U.S.C. 1001(a)); or

“(2) the applicant has assigned, granted, conveyed, or is under an obligation by contract or law, to assign, grant, or convey, a license or other ownership interest in the particular applications to such an institution of higher education.

“(e) DIRECTOR’S AUTHORITY.—In addition to the limits imposed by this section, the Director may, in the Director’s discretion, impose income limits, annual filing limits, or other limits on who may qualify as a micro entity pursuant to this section if the Director determines that such additional limits are reasonably necessary to avoid an undue impact on other patent applicants or owners or are otherwise reasonably necessary and appropriate. At least 3 months before any limits proposed to be imposed pursuant to this subsection take effect, the Director shall inform the Committee on the Judiciary of the House of Representatives and the Committee on the Judiciary of the Senate of any such proposed limits.”.

(2) CONFORMING AMENDMENT.—Chapter 11 of title 35, United States Code, is amended by adding at the end the following new item:

“123. Micro entity defined.”.

(h) ELECTRONIC FILING INCENTIVE.—

(1) IN GENERAL.—Notwithstanding any other provision of this section, an additional fee of \$400 shall be established for each application for an original patent, except for a design, plant, or provisional application, that is not filed by electronic means as prescribed by the Director. The fee established by this subsection shall be reduced by 50 percent for small entities that qualify for reduced fees under section 41(h)(1) of title 35, United States Code. All fees paid under this subsection shall be deposited in the Treasury as an offsetting receipt that shall not be available for obligation or expenditure.

(2) EFFECTIVE DATE.—This subsection shall take effect upon the expiration of the 60-day period beginning on the date of the enactment of this Act.

(i) EFFECTIVE DATE; SUNSET.—

(1) EFFECTIVE DATE.—Except as provided in subsection (h), this section and the amendments made by this section shall take effect on the date of the enactment of this Act.

(2) SUNSET.—The authority of the Director to set or adjust any fee under subsection (a) shall terminate upon the expiration of the 7-year period beginning on the date of the enactment of this Act.

(3) PRIOR REGULATIONS NOT AFFECTED.—The termination of authority under this subsection shall not affect any regulations issued under this section before the effective



date of such termination or any rulemaking proceeding for the issuance of regulations under this section that is pending on such date.

## **SEC. 11. FEES FOR PATENT SERVICES.**

(a) GENERAL PATENT SERVICES.—Subsections (a) and (b) of section 41 of title 35, United States Code, are amended to read as follows:

“(a) GENERAL FEES.—The Director shall charge the following fees:

“(1) FILING AND BASIC NATIONAL FEES.—

“(A) On filing each application for an original patent, except for design, plant, or provisional applications, \$330.

“(B) On filing each application for an original design patent, \$220.

“(C) On filing each application for an original plant patent, \$220.

“(D) On filing each provisional application for an original patent, \$220.

“(E) On filing each application for the reissue of a patent, \$330.

“(F) The basic national fee for each international application filed under the treaty defined in section 351(a) entering the national stage under section 371, \$330.

“(G) In addition, excluding any sequence listing or computer program listing filed in an electronic medium as prescribed by the Director, for any application the specification and drawings of which exceed 100 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium), \$270 for each additional 50 sheets of paper (or equivalent as prescribed by the Director if filed in an electronic medium) or fraction thereof.

“(2) EXCESS CLAIMS FEES.—

“(A) IN GENERAL.—In addition to the fee specified in paragraph (1)—

“(i) on filing or on presentation at any other time, \$220 for each claim in independent form in excess of 3;

“(ii) on filing or on presentation at any other time, \$52 for each claim (whether dependent or independent) in excess of 20; and

“(iii) for each application containing a multiple dependent claim, \$390.

“(B) MULTIPLE DEPENDENT CLAIMS.—For the purpose of computing fees under subparagraph (A), a multiple dependent claim referred to in section 112 or any claim depending therefrom shall be considered as separate dependent claims in accordance with the number of claims to which reference is made.

“(C) REFUNDS; ERRORS IN PAYMENT.—The Director may by regulation provide for a refund of any part of the fee specified in subparagraph (A) for any claim that is canceled before an examination on the merits, as prescribed by the Director, has been made of the application under section 131. Errors in payment of the additional fees under this paragraph may be rectified in accordance with regulations prescribed by the Director.

“(3) EXAMINATION FEES.—

“(A) IN GENERAL.—

“(i) For examination of each application for an original patent, except for design, plant, provisional, or international applications, \$220.

“(ii) For examination of each application for an original design patent, \$140.

“(iii) For examination of each application for an original plant patent, \$170.

“(iv) For examination of the national stage of each international application, \$220.

“(v) For examination of each application for the reissue of a patent, \$650.

“(B) APPLICABILITY OF OTHER FEE PROVISIONS.—The provisions of paragraphs (3) and (4) of section 111(a) relating to the payment of the fee for filing the application shall apply to the payment of the fee specified in subparagraph (A) with respect to an application filed under section 111(a). The provisions of section 371(d) relating to the payment of the national fee shall apply to the payment of the fee specified in subparagraph (A) with respect to an international application.

“(4) ISSUE FEES.—

“(A) For issuing each original patent, except for design or plant patents, \$1,510.

“(B) For issuing each original design patent, \$860.

“(C) For issuing each original plant patent, \$1,190.

“(D) For issuing each reissue patent, \$1,510.

“(5) DISCLAIMER FEE.—On filing each disclaimer, \$140.

“(6) APPEAL FEES.—

“(A) On filing an appeal from the examiner to the Patent Trial and Appeal Board, \$540.

“(B) In addition, on filing a brief in support of the appeal, \$540, and on requesting an oral hearing in the appeal before the Patent Trial and Appeal Board, \$1,080.

“(7) REVIVAL FEES.—On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,620, unless the petition is filed under section 133 or 151, in which case the fee shall be \$540.

“(8) EXTENSION FEES.—For petitions for 1-month extensions of time to take actions required by the Director in an application—

“(A) on filing a first petition, \$130;

“(B) on filing a second petition, \$360; and

“(C) on filing a third or subsequent petition, \$620.

“(b) MAINTENANCE FEES.—

“(1) IN GENERAL.—The Director shall charge the following fees for maintaining in force all patents based on applications filed on or after December 12, 1980:

“(A) Three years and 6 months after grant, \$980.

“(B) Seven years and 6 months after grant, \$2,480.

“(C) Eleven years and 6 months after grant, \$4,110.

“(2) GRACE PERIOD; SURCHARGE.—Unless payment of the applicable maintenance fee under paragraph (1) is received in the Office on or before the date the fee is due or within a grace period of 6 months thereafter, the patent shall expire as of the end of such grace period. The Director may require the payment of a surcharge as a condition of accepting within such 6-month grace period the payment of an applicable maintenance fee.

“(3) NO MAINTENANCE FEE FOR DESIGN OR PLANT PATENT.—No fee may be established for maintaining a design or plant patent in force.”.

(b) DELAYS IN PAYMENT.—Subsection (c) of section 41 of title 35, United States Code, is amended—

(1) by striking “(c)(1) The Director” and inserting:

“(c) DELAYS IN PAYMENT OF MAINTENANCE FEES.—

“(1) ACCEPTANCE.—The Director”; and

(2) by striking “(2) A patent” and inserting:

“(2) EFFECT ON RIGHTS OF OTHERS.—A patent”.

(c) PATENT SEARCH FEES.—Subsection (d) of section 41 of title 35, United States Code, is amended to read as follows:

“(d) PATENT SEARCH AND OTHER FEES.—

“(1) PATENT SEARCH FEES.—

“(A) IN GENERAL.—The Director shall charge the fees specified under subparagraph (B) for the search of each application for a patent, except for provisional applications. The Director shall adjust the fees charged under this paragraph to ensure that the fees recover an amount not to exceed the estimated average cost to the Office of searching applications for patent by Office personnel.

“(B) SPECIFIC FEES.—The fees referred to in subparagraph (A) are—

“(i) \$540 for each application for an original patent, except for design, plant, provisional, or international applications;

“(ii) \$100 for each application for an original design patent;

“(iii) \$330 for each application for an original plant patent;

“(iv) \$540 for the national stage of each international application; and

“(v) \$540 for each application for the reissue of a patent.

“(C) APPLICABILITY OF OTHER PROVISIONS.—The provisions of paragraphs (3) and (4) of section 111(a) relating to the payment of the fee for filing the application shall apply to the payment of the fee specified in this paragraph with respect to an application filed under section 111(a). The provisions of section 371(d) relating to the payment of the national fee shall apply to the payment of the fee specified in this paragraph with respect to an international application.

“(D) REFUNDS.—The Director may by regulation provide for a refund of any part of the fee specified in this paragraph for any applicant who files a written declaration of express abandonment as prescribed by the Director before an examination has been made of the application under section 131.

“(2) OTHER FEES.—

“(A) IN GENERAL.—The Director shall establish fees for all other processing, services, or materials relating to patents not specified in this section to recover the estimated average cost to the Office of such processing, services, or materials, except that the Director shall charge the following fees for the following services:

“(i) For recording a document affecting title, \$40 per property.

“(ii) For each photocopy, \$.25 per page.

“(iii) For each black and white copy of a patent, \$3.

“(B) COPIES FOR LIBRARIES.—The yearly fee for providing a library specified in section 12 with uncertified printed copies of the specifications and drawings for all patents in that year shall be \$50.”.

(d) FEES FOR SMALL ENTITIES.—Subsection (h) of section 41 of title 35, United States Code, is amended to read as follows:

“(h) FEES FOR SMALL ENTITIES.—

“(1) REDUCTIONS IN FEES.—Subject to paragraph (3), fees charged under subsections (a), (b), and (d)(1) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.

“(2) SURCHARGES AND OTHER FEES.—With respect to its application to any entity described in paragraph (1), any surcharge or fee charged under subsection (c) or (d) shall not be higher than the surcharge or fee required of any other entity under the same or substantially similar circumstances.

“(3) REDUCTION FOR ELECTRONIC FILING.—The fee charged under subsection (a)(1)(A) shall be reduced by 75 percent with respect to its application to any entity to which paragraph (1) applies, if the application is filed by electronic means as prescribed by the Director.”.

(e) TECHNICAL AMENDMENTS.—Section 41 of title 35, United States Code, is amended—

(1) in subsection (e), in the first sentence, by striking “The Director” and inserting “WAIVER OF FEES; COPIES REGARDING NOTICE.—The Director”;

(2) in subsection (f), by striking “The fees” and inserting “ADJUSTMENT OF FEES.—The fees”;

(3) by repealing subsection (g); and

(4) in subsection (i)—

(A) by striking “(i)(1) The Director” and inserting the following:

“(i) ELECTRONIC PATENT AND TRADEMARK DATA.—

“(1) MAINTENANCE OF COLLECTIONS.—The Director”;

(B) by striking “(2) The Director” and inserting the following:

“(2) AVAILABILITY OF AUTOMATED SEARCH SYSTEMS.—The Director”;

(C) by striking “(3) The Director” and inserting the following:

“(3) ACCESS FEES.—The Director”;

(D) by striking “(4) The Director” and inserting the following:

“(4) ANNUAL REPORT TO CONGRESS.—The Director”.

(f) ADJUSTMENT OF TRADEMARK FEES.—Section 802(a) of division B of the Consolidated Appropriations Act, 2005 (Public Law 108–447) is amended—

(1) in the first sentence, by striking “During fiscal years 2005, 2006, and 2007,”, and inserting “Until such time as the Director sets or adjusts the fees otherwise,”; and

(2) in the second sentence, by striking “During fiscal years 2005, 2006, and 2007, the” and inserting “The”.

(g) EFFECTIVE DATE, APPLICABILITY, AND TRANSITION PROVISIONS.—Section 803(a) of division B of the Consolidated Appropriations Act, 2005 (Public Law 108–447) is amended by striking “and shall apply only with respect to the remaining portion of fiscal year 2005 and fiscal year 2006”.

(h) PRIORITIZED EXAMINATION FEE.—

(1) IN GENERAL.—

(A) FEE.—

(i) PRIORITIZED EXAMINATION FEE.—A fee of \$4,800 shall be established for filing a request, pursuant to section 2(b)(2)(G) of title 35, United States Code, for prioritized examination of a nonprovisional application for an original utility or plant patent.

(ii) ADDITIONAL FEES.—In addition to the prioritized examination fee under clause (i), the fees due on an application for which prioritized examination is being sought are the filing, search, and examination fees (including any applicable excess claims and application size fees), processing fee, and publication fee for that application.

(B) REGULATIONS; LIMITATIONS.—

(i) REGULATIONS.—The Director may by regulation prescribe conditions for acceptance of a request under subparagraph (A) and a limit on the number of filings for prioritized examination that may be accepted.

(ii) LIMITATION ON CLAIMS.— Until regulations are prescribed under clause (i), no application for which prioritized examination is requested may contain or be amended to contain more than 4 independent claims or more than 30 total claims.

(iii) LIMITATION ON TOTAL NUMBER OF REQUESTS.— The Director may not accept in any fiscal year more than 10,000 requests for prioritization until regulations are prescribed under this subparagraph setting another limit.

(2) REDUCTION IN FEES FOR SMALL ENTITIES.—The Director shall reduce fees for providing prioritized examination of nonprovisional applications for original utility and plant patents by 50 percent for small entities that qualify for reduced fees under section 41(h)(1) of title 35, United States Code.

(3) DEPOSIT OF FEES.—All fees paid under this subsection shall be credited to the United States Patent and Trademark Office Appropriation Account, shall remain available until expended, and may be used only for the purposes specified in section 42(c)(3)(A) of title 35, United States Code.

(4) EFFECTIVE DATE AND TERMINATION.—

(A) EFFECTIVE DATE.—This subsection shall take effect on the date that is 10 days after the date of the enactment of this Act.

(B) TERMINATION.—The fee imposed under paragraph (1)(A)(i), and the reduced fee under paragraph (2), shall terminate on the effective date of the setting or adjustment of the fee under paragraph (1)(A)(i) pursuant to the exercise of the authority under section 10 for the first time with respect to that fee.

(i) APPROPRIATION ACCOUNT TRANSITION FEES.—

(1) SURCHARGE.—

(A) IN GENERAL.—There shall be a surcharge of 15 percent, rounded by standard arithmetic rules, on all fees charged or authorized by subsections (a), (b), and (d)(1) of section 41, and section 132(b), of title 35, United States Code. Any surcharge imposed under this subsection is, and shall be construed to be, separate from and in addition to any other surcharge imposed under this Act or any other provision of law.

(B) DEPOSIT OF AMOUNTS.—Amounts collected pursuant to the surcharge imposed under subparagraph (A) shall be credited to the United States Patent and Trademark Appropriation Account, shall remain available until expended, and may be used only for the purposes specified in section 42(c)(3)(A) of title 35, United States Code.

(2) EFFECTIVE DATE AND TERMINATION OF SURCHARGE.—The surcharge provided for in paragraph (1)—

(A) shall take effect on the date that is 10 days after the date of the enactment of this Act; and

(B) shall terminate, with respect to a fee to which paragraph (1)(A) applies, on the effective date of the setting or adjustment of that fee pursuant to the exercise of the authority under section 10 for the first time with respect to that fee.

(j) EFFECTIVE DATE.—Except as otherwise provided in this section, this section and the amendments made by this section shall take effect on the date of the enactment of this Act.

## SEC. 12. SUPPLEMENTAL EXAMINATION.

(a) IN GENERAL.—Chapter 25 of title 35, United States Code, is amended by adding at the end the following:

### “§ 257. Supplemental examinations to consider, reconsider, or correct information

“(a) REQUEST FOR SUPPLEMENTAL EXAMINATION.—A patent owner may request supplemental examination of a patent in the Office to consider, reconsider, or correct information believed to be relevant to the patent, in accordance with such requirements as the Director may establish. Within 3 months after the date a request for supplemental examination meeting the requirements of this section is received, the Director shall conduct the supplemental examination and shall conclude such examination by issuing a certificate indicating whether the information presented in the request raises a substantial new question of patentability.

“(b) REEXAMINATION ORDERED.—If the certificate issued under subsection (a) indicates that a substantial new question of patentability is raised by 1 or more items of information in the request, the Director shall order reexamination of the patent. The reexamination shall be conducted according to procedures established by chapter 30, except that the patent owner shall not have the right to file a statement pursuant to section 304. During the reexamination, the Director shall address each substantial new question of patentability identified during the supplemental examination, notwithstanding the limitations in chapter 30 relating to patents and printed publication or any other provision of such chapter.

“(c) EFFECT.—

“(1) IN GENERAL.—A patent shall not be held unenforceable on the basis of conduct relating to information that had not been considered, was inadequately considered, or was incorrect in a prior examination of the patent if the information was considered, reconsidered, or corrected during a supplemental examination of the patent. The making of a request under subsection (a), or the absence thereof, shall not be relevant to enforceability of the patent under section 282.

“(2) EXCEPTIONS.—

“(A) PRIOR ALLEGATIONS.—Paragraph (1) shall not apply to an allegation pled with particularity in a civil action, or set forth with particularity in a notice received by the patent owner under section 505(j)(2)(B)(iv)(II) of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. 355(j)(2)(B)(iv)(II)), before the date of a supplemental examination request under subsection (a) to consider, reconsider, or correct information forming the basis for the allegation.

“(B) PATENT ENFORCEMENT ACTIONS.—In an action brought under section 337(a) of the Tariff Act of 1930 (19 U.S.C. 1337(a)), or section 281 of this title, paragraph (1) shall not apply to any defense raised in the action that is based upon information that was considered, reconsidered, or corrected pursuant to a supplemental examination request under subsection (a), unless the supplemental examination, and any reexamination ordered pursuant to the request, are concluded before the date on which the action is brought.

“(d) FEES AND REGULATIONS.—

“(1) FEES.—The Director shall, by regulation, establish fees for the submission of a request for supplemental examination of a patent, and to consider each item of information submitted in the request. If reexamination is ordered under subsection (b), fees established and applicable to ex parte reexamination proceedings under chapter 30 shall be paid, in addition to fees applicable to supplemental examination.

“(2) REGULATIONS.—The Director shall issue regulations governing the form, content, and other requirements of requests for supplemental examination, and establishing procedures for reviewing information submitted in such requests.

“(e) FRAUD.—If the Director becomes aware, during the course of a supplemental examination or reexamination proceeding ordered under this section, that a material fraud on the Office may have been committed in connection with the patent that is the subject of the supplemental examination, then in addition to any other actions the Director is authorized to take, including the cancellation of any claims found to be invalid under section 307 as a result of a reexamination ordered under this section, the Director shall also refer the matter to the Attorney General for such further action as the Attorney General may deem appropriate. Any such referral shall be treated as confidential, shall not be included in the file of the patent, and shall not be disclosed to the public unless the United States charges a person with a criminal offense in connection with such referral.

“(f) RULE OF CONSTRUCTION.—Nothing in this section shall be construed—

“(1) to preclude the imposition of sanctions based upon criminal or antitrust laws (including section 1001(a) of title 18, the first section of the Clayton Act, and section 5 of the Federal Trade Commission Act to the extent that section relates to unfair methods of competition);

“(2) to limit the authority of the Director to investigate issues of possible misconduct and impose sanctions for misconduct in connection with matters or proceedings before the Office; or

“(3) to limit the authority of the Director to issue regulations under chapter 3 relating to sanctions for misconduct by representatives practicing before the Office.”.

(b) CONFORMING AMENDMENT.—The table of sections for chapter 25 of title 35, United States Code, is amended by adding at the end the following new item:

“257. Supplemental examinations to consider, reconsider, or correct information.”.

(c) EFFECTIVE DATE.—The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.

### **SEC. 13. FUNDING AGREEMENTS.**

(a) IN GENERAL.—Section 202(c)(7)(E)(i) of title 35, United States Code, is amended—

(1) by striking “75 percent” and inserting “15 percent”;

(2) by striking “25 percent” and inserting “85 percent”; and

(3) by striking “as described above in this clause (D);” and inserting “described above in this clause;”.

(b) EFFECTIVE DATE.—The amendments made by this section shall take effect on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that date.

### **SEC. 14. TAX STRATEGIES DEEMED WITHIN THE PRIOR ART.**

(a) IN GENERAL.—For purposes of evaluating an invention under section 102 or 103 of title 35, United States Code, any strategy for reducing, avoiding, or deferring tax liability, whether

known or unknown at the time of the invention or application for patent, shall be deemed insufficient to differentiate a claimed invention from the prior art.

(b) DEFINITION.—For purposes of this section, the term “tax liability” refers to any liability for a tax under any Federal, State, or local law, or the law of any foreign jurisdiction, including any statute, rule, regulation, or ordinance that levies, imposes, or assesses such tax liability.

(c) EXCLUSIONS.—This section does not apply to that part of an invention that—

(1) is a method, apparatus, technology, computer program product, or system, that is used solely for preparing a tax or information return or other tax filing, including one that records, transmits, transfers, or organizes data related to such filing; or

(2) is a method, apparatus, technology, computer program product, or system used solely for financial management, to the extent that it is severable from any tax strategy or does not limit the use of any tax strategy by any taxpayer or tax advisor.

(d) RULE OF CONSTRUCTION.—Nothing in this section shall be construed to imply that other business methods are patentable or that other business method patents are valid.

(e) EFFECTIVE DATE; APPLICABILITY.—This section shall take effect on the date of the enactment of this Act and shall apply to any patent application that is pending on, or filed on or after, that date, and to any patent that is issued on or after that date.

#### **SEC. 15. BEST MODE REQUIREMENT.**

(a) IN GENERAL.—Section 282 of title 35, United States Code, is amended in the second undesignated paragraph by striking paragraph (3) and inserting the following:

“(3) Invalidity of the patent or any claim in suit for failure to comply with—

“(A) any requirement of section 112, except that the failure to disclose the best mode shall not be a basis on which any claim of a patent may be canceled or held invalid or otherwise unenforceable; or

“(B) any requirement of section 251.”.

(b) CONFORMING AMENDMENT.—Sections 119(e)(1) and 120 of title 35, United States Code, are each amended by striking “the first paragraph of section 112 of this title” and inserting “section 112(a) (other than the requirement to disclose the best mode)”.

(c) EFFECTIVE DATE.—The amendments made by this section shall take effect upon the date of the enactment of this Act and shall apply to proceedings commenced on or after that date.

#### **SEC. 16. MARKING.**

(a) VIRTUAL MARKING.—

(1) IN GENERAL.—Section 287(a) of title 35, United States Code, is amended by striking “or when,” and inserting “or by fixing thereon the word ‘patent’ or the abbreviation ‘pat.’ together with an address of a posting on the Internet, accessible to the public without charge for accessing the address, that associates the patented article with the number of the patent, or when,”.

(2) EFFECTIVE DATE.—The amendment made by this subsection shall apply to any case that is pending on, or commenced on or after, the date of the enactment of this Act.

(3) REPORT.—Not later than the date that is 3 years after the date of the enactment of this Act, the Director shall submit a report to Congress that provides—

(A) an analysis of the effectiveness of “virtual marking”, as provided in the amendment made by paragraph (1) of this subsection, as an alternative to the physical marking of articles;

(B) an analysis of whether such virtual marking has limited or improved the ability of the general public to access information about patents;

(C) an analysis of the legal issues, if any, that arise from such virtual marking; and



(D) an analysis of the deficiencies, if any, of such virtual marking.

(b) FALSE MARKING.—

(1) CIVIL PENALTY.—Section 292(a) of title 35, United States Code, is amended by adding at the end the following:

“Only the United States may sue for the penalty authorized by this subsection.”.

(2) CIVIL ACTION FOR DAMAGES.—Subsection (b) of section 292 of title 35, United States Code, is amended to read as follows:

“(b) A person who has suffered a competitive injury as a result of a violation of this section may file a civil action in a district court of the United States for recovery of damages adequate to compensate for the injury.”.

(3) EXPIRED PATENTS.—Section 292 of title 35, United States Code, is amended by adding at the end the following:

“(c) The marking of a product, in a manner described in subsection (a), with matter relating to a patent that covered that product but has expired is not a violation of this section.”.

(4) EFFECTIVE DATE.—The amendments made by this subsection shall apply to all cases, without exception, that are pending on, or commenced on or after, the date of the enactment of this Act.

**SEC. 17. ADVICE OF COUNSEL.**

(a) IN GENERAL.—Chapter 29 of title 35, United States Code, is amended by adding at the end the following:

**“§ 298. Advice of counsel**

“The failure of an infringer to obtain the advice of counsel with respect to any allegedly infringed patent, or the failure of the infringer to present such advice to the court or jury, may not be used to prove that the accused infringer willfully infringed the patent or that the infringer intended to induce infringement of the patent.”.

(b) CONFORMING AMENDMENT.—The table of sections for chapter 29 of title 35, United States Code, is amended by adding at the end the following: “298. Advice of counsel.”.

**SEC. 18. TRANSITIONAL PROGRAM FOR COVERED BUSINESS METHOD PATENTS.**

(a) TRANSITIONAL PROGRAM.—

(1) ESTABLISHMENT.—Not later than the date that is 1 year after the date of the enactment of this Act, the Director shall issue regulations establishing and implementing a transitional post-grant review proceeding for review of the validity of covered business method patents. The transitional proceeding implemented pursuant to this subsection shall be regarded as, and shall employ the standards and procedures of, a postgrant review under chapter 32 of title 35, United States Code, subject to the following:

(A) Section 321(c) of title 35, United States Code, and subsections (b), (e)(2), and (f) of section 325 of such title shall not apply to a transitional proceeding.

(B) A person may not file a petition for a transitional proceeding with respect to a covered business method patent unless the person or the person’s real party in interest or privy has been sued for infringement of the patent or has been charged with infringement under that patent.

(C) A petitioner in a transitional proceeding who challenges the validity of 1 or more claims in a covered business method patent on a ground raised under section 102 or 103 of title 35, United States Code, as in effect on the day before the effective date set forth in section 3(n)(1), may support such ground only on the basis of— (i) prior art that is described by section 102(a) of such title of such title (as in effect on the day before such effective date); or

## (ii) prior art that—

(I) discloses the invention more than 1 year before the date of the application for patent in the United States; and

(II) would be described by section 102(a) of such title (as in effect on the day before the effective date set forth in section 3(n)(1)) if the disclosure had been made by another before the invention thereof by the applicant for patent.

(D) The petitioner in a transitional proceeding that results in a final written decision under section 328(a) of title 35, United States Code, with respect to a claim in a covered business method patent, or the petitioner's real party in interest, may not assert, either in a civil action arising in whole or in part under section 1338 of title 28, United States Code, or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337), that the claim is invalid on any ground that the petitioner raised during that transitional proceeding.

(E) The Director may institute a transitional proceeding only for a patent that is a covered business method patent.

(2) EFFECTIVE DATE.—The regulations issued under paragraph (1) shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any covered business method patent issued before, on, or after that effective date, except that the regulations shall not apply to a patent described in section 6(f)(2)(A) of this Act during the period in which a petition for postgrant review of that patent would satisfy the requirements of section 321(c) of title 35, United States Code.

## (3) SUNSET.—

(A) IN GENERAL.—This subsection, and the regulations issued under this subsection, are repealed effective upon the expiration of the 8-year period beginning on the date that the regulations issued under to paragraph (1) take effect.

(B) APPLICABILITY.—Notwithstanding subparagraph (A), this subsection and the regulations issued under this subsection shall continue to apply, after the date of the repeal under subparagraph (A), to any petition for a transitional proceeding that is filed before the date of such repeal.

## (b) REQUEST FOR STAY.—

(1) IN GENERAL.—If a party seeks a stay of a civil action alleging infringement of a patent under section 281 of title 35, United States Code, relating to a transitional proceeding for that patent, the court shall decide whether to enter a stay based on—

(A) whether a stay, or the denial thereof, will simplify the issues in question and streamline the trial;

(B) whether discovery is complete and whether a trial date has been set;

(C) whether a stay, or the denial thereof, would unduly prejudice the nonmoving party or present a clear tactical advantage for the moving party; and

(D) whether a stay, or the denial thereof, will reduce the burden of litigation on the parties and on the court.

(2) REVIEW.—A party may take an immediate interlocutory appeal from a district court's decision under paragraph (1). The United States Court of Appeals for the Federal Circuit shall review the district court's decision to ensure consistent application of established precedent, and such review may be de novo.

(c) ATM EXEMPTION FOR VENUE PURPOSES.—In an action for infringement under section 281 of title 35, United States Code, of a covered business method patent, an automated teller

machine shall not be deemed to be a regular and established place of business for purposes of section 1400(b) of title 28, United States Code.

(d) DEFINITION.—

(1) IN GENERAL.—For purposes of this section, the term “covered business method patent” means a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.

(2) REGULATIONS.—To assist in implementing the transitional proceeding authorized by this subsection, the Director shall issue regulations for determining whether a patent is for a technological invention.

(e) RULE OF CONSTRUCTION.—Nothing in this section shall be construed as amending or interpreting categories of patent-eligible subject matter set forth under section 101 of title 35, United States Code.

## SEC. 19. JURISDICTION AND PROCEDURAL MATTERS.

(a) STATE COURT JURISDICTION.—Section 1338(a) of title 28, United States Code, is amended by striking the second sentence and inserting the following: “No State court shall have jurisdiction over any claim for relief arising under any Act of Congress relating to patents, plant variety protection, or copyrights. For purposes of this subsection, the term ‘State’ includes any State of the United States, the District of Columbia, the Commonwealth of Puerto Rico, the United States Virgin Islands, American Samoa, Guam, and the Northern Mariana Islands.”.

(b) COURT OF APPEALS FOR THE FEDERAL CIRCUIT.—Section 1295(a)(1) of title 28, United States Code, is amended to read as follows:

“(1) of an appeal from a final decision of a district court of the United States, the District Court of Guam, the District Court of the Virgin Islands, or the District Court of the Northern Mariana Islands, in any civil action arising under, or in any civil action in which a party has asserted a compulsory counterclaim arising under, any Act of Congress relating to patents or plant variety protection;”.

(c) REMOVAL.—

(1) IN GENERAL.—Chapter 89 of title 28, United States Code, is amended by adding at the end the following new section:

**“§ 1454. Patent, plant variety protection, and copyright cases**

“(a) IN GENERAL.—A civil action in which any party asserts a claim for relief arising under any Act of Congress relating to patents, plant variety protection, or copyrights may be removed to the district court of the United States for the district and division embracing the place where the action is pending.

“(b) SPECIAL RULES.—The removal of an action under this section shall be made in accordance with section 1446, except that if the removal is based solely on this section—

“(1) the action may be removed by any party; and

“(2) the time limitations contained in section 1446(b) may be extended at any time for cause shown.

“(c) CLARIFICATION OF JURISDICTION IN CERTAIN CASES.—The court to which a civil action is removed under this section is not precluded from hearing and determining any claim in the civil action because the State court from which the civil action is removed did not have jurisdiction over that claim.

“(d) REMAND.—If a civil action is removed solely under this section, the district court—

“(1) shall remand all claims that are neither a basis for removal under subsection (a) nor within the original or supplemental jurisdiction of the district court under any Act of Congress; and

“(2) may, under the circumstances specified in section 1367(c), remand any claims within the supplemental jurisdiction of the district court under section 1367.”.

(2) CONFORMING AMENDMENT.—The table of sections for chapter 89 of title 28, United States Code, is amended by adding at the end the following new item:

“1454. Patent, plant variety protection, and copyright cases.”.

(d) PROCEDURAL MATTERS IN PATENT CASES.—

(1) JOINDER OF PARTIES AND STAY OF ACTIONS.—Chapter 29 of title 35, United States Code, as amended by this Act, is further amended by adding at the end the following new section:

**“§ 299. Joinder of parties**

“(a) JOINDER OF ACCUSED INFRINGERS.—With respect to any civil action arising under any Act of Congress relating to patents, other than an action or trial in which an act of infringement under section 271(e)(2) has been pled, parties that are accused infringers may be joined in one action as defendants or counterclaim defendants, or have their actions consolidated for trial, or counterclaim defendants only if—

“(1) any right to relief is asserted against the parties jointly, severally, or in the alternative with respect to or arising out of the same transaction, occurrence, or series of transactions or occurrences relating to the making, using, importing into the United States, offering for sale, or selling of the same accused product or process; and

“(2) questions of fact common to all defendants or counterclaim defendants will arise in the action.

“(b) ALLEGATIONS INSUFFICIENT FOR JOINDER.—For purposes of this subsection, accused infringers may not be joined in one action as defendants or counterclaim defendants, or have their actions consolidated for trial, based solely on allegations that they each have infringed the patent or patents in suit.

“(c) WAIVER.—A party that is an accused infringer may waive the limitations set forth in this section with respect to that party.”.

(2) CONFORMING AMENDMENT.—The table of sections for chapter 29 of title 35, United States Code, as amended by this Act, is further amended by adding at the end the following new item:

“299. Joinder of parties.”.

(e) EFFECTIVE DATE.—The amendments made by this section shall apply to any civil action commenced on or after the date of the enactment of this Act.

**SEC. 20. TECHNICAL AMENDMENTS.**

(a) JOINT INVENTIONS.—Section 116 of title 35, United States Code, is amended—

(1) in the first undesignated paragraph, by striking “When” and inserting “(a) JOINT INVENTIONS.—When”;

(2) in the second undesignated paragraph, by striking “If a joint inventor” and inserting “(b) OMITTED INVENTOR.—If a joint inventor”;

(3) in the third undesignated paragraph—

(A) by striking “Whenever” and inserting “(c) CORRECTION OF ERRORS IN APPLICATION.—Whenever”;

and

(B) by striking “and such error arose without any deceptive intention on his part,”.

(b) FILING OF APPLICATION IN FOREIGN COUNTRY.—Section 184 of title 35, United States Code, is amended—

(1) in the first undesignated paragraph—

(A) by striking “Except when” and inserting “(a) FILING IN FOREIGN COUNTRY.— Except when”; and

(B) by striking “and without deceptive intent”;

(2) in the second undesignated paragraph, by striking “The term” and inserting “(b) APPLICATION.—The term”; and

(3) in the third undesignated paragraph, by striking “The scope” and inserting “(c) SUBSEQUENT MODIFICATIONS, AMENDMENTS, AND SUPPLEMENTS.—The scope”.

(c) FILING WITHOUT A LICENSE.—Section 185 of title 35, United States Code, is amended by striking “and without deceptive intent”.

(d) REISSUE OF DEFECTIVE PATENTS.—Section 251 of title 35, United States Code, is amended—

(1) in the first undesignated paragraph—

(A) by striking “Whenever” and inserting “(a) IN GENERAL.—Whenever”; and

(B) by striking “without any deceptive intention”;

(2) in the second undesignated paragraph, by striking “The Director” and inserting “(b) MULTIPLE REISSUED PATENTS.—The Director”;

(3) in the third undesignated paragraph, by striking “The provisions” and inserting “(c) APPLICABILITY OF THIS TITLE.— The provisions”; and

(4) in the last undesignated paragraph, by striking “No reissued patent” and inserting “(d) REISSUE PATENT ENLARGING SCOPE OF CLAIMS.—No reissued patent”.

(e) EFFECT OF REISSUE.—Section 253 of title 35, United States Code, is amended—

(1) in the first undesignated paragraph, by striking “Whenever, without any deceptive intention,” and inserting “(a) IN GENERAL.—Whenever”; and

(2) in the second undesignated paragraph, by striking “In like manner” and inserting “(b) ADDITIONAL DISCLAIMER OR DEDICATION.—In the manner set forth in subsection (a),”.

(f) CORRECTION OF NAMED INVENTOR.—Section 256 of title 35, United States Code, is amended—

(1) in the first undesignated paragraph—

(A) by striking “Whenever” and inserting “(a) CORRECTION.—Whenever”; and

(B) by striking “and such error arose without any deceptive intention on his part”; and

(2) in the second undesignated paragraph, by striking “The error” and inserting “(b) PATENT VALID IF ERROR CORRECTED.— The error”.

(g) PRESUMPTION OF VALIDITY.—Section 282 of title 35, United States Code, is amended—

(1) in the first undesignated paragraph—

(A) by striking “A patent” and inserting “(a) IN GENERAL.— A patent”; and

(B) by striking the third sentence;

(2) in the second undesignated paragraph—

(A) by striking “The following” and inserting “(b) DEFENSES.—The following”;

(B) in paragraph (1), by striking “unforceability,” and inserting “unenforceability.”; and

(C) in paragraph (2), by striking “patentability,” and inserting “patentability.”; and

(3) in the third undesignated paragraph—

(A) by striking “In actions involving the validity or infringement of a patent” and inserting “(c) NOTICE OF ACTIONS; ACTIONS DURING EXTENSION OF PATENT TERM.— In an action involving the validity or infringement of a patent”; and

(B) by striking “Claims Court” and inserting “Court of Federal Claims”.

(h) ACTION FOR INFRINGEMENT.—Section 288 of title 35, United States Code, is amended by striking “, without deceptive intention,”.

(i) REVISER’S NOTES.—

(1) Section 3(e)(2) of title 35, United States Code, is amended by striking “this Act,” and inserting “that Act,”.

(2) Section 202 of title 35, United States Code, is amended—

(A) in subsection (b)(3), by striking “the section 203(b)” and inserting “section 203(b)”;

(B) in subsection (c)(7)(D), by striking “except where it proves” and all that follows through “small business firms; and” and inserting: “except where it is determined to be infeasible following a reasonable inquiry, a preference in the licensing of subject inventions shall be given to small business firms; and”.

(3) Section 209(d)(1) of title 35, United States Code, is amended by striking “nontransferrable” and inserting “nontransferable”.

(4) Section 287(c)(2)(G) of title 35, United States Code, is amended by striking “any state” and inserting “any State”.

(5) Section 371(b) of title 35, United States Code, is amended by striking “of the treaty” and inserting “of the treaty.”.

(j) UNNECESSARY REFERENCES.—

(1) IN GENERAL.—Title 35, United States Code, is amended by striking “of this title” each place that term appears.

(2) EXCEPTION.—The amendment made by paragraph (1) shall not apply to the use of such term in the following sections of title 35, United States Code:

(A) Section 1(c).

(B) Section 101.

(C) Subsections (a) and (b) of section 105.

(D) The first instance of the use of such term in section 111(b)(8).

(E) Section 161.

(F) Section 164.

(G) Section 171.

(H) Section 251(c), as so designated by this section.

(I) Section 261.

(J) Subsections (g) and (h) of section 271.

(K) Section 287(b)(1).

(L) Section 289.

(M) The first instance of the use of such term in section 375(a).

(k) ADDITIONAL TECHNICAL AMENDMENTS.—Sections 155 and 155A of title 35, United States Code, and the items relating to those sections in the table of sections for chapter 14 of such title, are repealed.

(l) EFFECTIVE DATE.—The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to proceedings commenced on or after that effective date.

## **SEC. 21. TRAVEL EXPENSES AND PAYMENT OF ADMINISTRATIVE JUDGES.**

(a) AUTHORITY TO COVER CERTAIN TRAVEL RELATED EXPENSES.—Section 2(b)(11) of title 35, United States Code, is amended by inserting “, and the Office is authorized to expend funds to cover the subsistence expenses and travel-related expenses, including per diem, lodging costs, and transportation costs, of persons attending such programs who are not Federal employees” after “world”.

(b) PAYMENT OF ADMINISTRATIVE JUDGES.—Section 3(b) of title 35, United States Code, is amended by adding at the end the following:

“(6) ADMINISTRATIVE PATENT JUDGES AND ADMINISTRATIVE TRADEMARK JUDGES.—The Director may fix the rate of basic pay for the administrative patent judges appointed pursuant to section 6 and the administrative trademark judges appointed pursuant to section 17 of the Trademark Act of 1946 (15 U.S.C. 1067) at not greater than the rate of basic pay payable for level III of the Executive Schedule under section 5314 of title 5. The payment of a rate of basic pay under this paragraph shall not be subject to the pay limitation under section 5306(e) or 5373 of title 5.”.

## **SEC. 22. PATENT AND TRADEMARK OFFICE FUNDING.**

(a) IN GENERAL.—Section 42(c) of title 35, United States Code, is amended—

(1) by striking “(c)” and inserting “(c)(1)”;

(2) in the first sentence, by striking “shall be available” and inserting “shall, subject to paragraph (3), be available”;

(3) by striking the second sentence; and

(4) by adding at the end the following:

“(2) There is established in the Treasury a Patent and Trademark Fee Reserve Fund. If fee collections by the Patent and Trademark Office for a fiscal year exceed the amount appropriated to the Office for that fiscal year, fees collected in excess of the appropriated amount shall be deposited in the Patent and Trademark Fee Reserve Fund. To the extent and in the amounts provided in appropriations Acts, amounts in the Fund shall be made available until expended only for obligation and expenditure by the Office in accordance with paragraph (3).

“(3)(A) Any fees that are collected under sections 41, 42, and 376, and any surcharges on such fees, may only be used for expenses of the Office relating to the processing of patent applications and for other activities, services, and materials relating to patents and to cover a share of the administrative costs of the Office relating to patents.

“(B) Any fees that are collected under section 31 of the Trademark Act of 1946, and any surcharges on such fees, may only be used for expenses of the Office relating to the processing of trademark registrations and for other activities, services, and materials relating to trademarks and to cover a share of the administrative costs of the Office relating to trademarks.”.

(b) EFFECTIVE DATE.—The amendments made by this section shall take effect on October 1, 2011.

**SEC. 23. SATELLITE OFFICES.**

(a) ESTABLISHMENT.—Subject to available resources, the Director shall, by not later than the date that is 3 years after the date of the enactment of this Act, establish 3 or more satellite offices in the United States to carry out the responsibilities of the Office.

(b) PURPOSES.—The purposes of the satellite offices established under subsection (a) are to—

- (1) increase outreach activities to better connect patent filers and innovators with the Office;
- (2) enhance patent examiner retention;
- (3) improve recruitment of patent examiners;
- (4) decrease the number of patent applications waiting for examination; and
- (5) improve the quality of patent examination.

(c) REQUIRED CONSIDERATIONS.—

(1) IN GENERAL.—In selecting the location of each satellite office to be established under subsection (a), the Director—

(A) shall ensure geographic diversity among the offices, including by ensuring that such offices are established in different States and regions throughout the Nation;

(B) may rely upon any previous evaluations by the Office of potential locales for satellite offices, including any evaluations prepared as part of the Office's Nationwide Workforce Program that resulted in the 2010 selection of Detroit, Michigan, as the first satellite office of the Office;

(C) shall evaluate and consider the extent to which the purposes of satellite offices listed under subsection (b) will be achieved;

(D) shall consider the availability of scientific and technically knowledgeable personnel in the region from which to draw new patent examiners at minimal recruitment cost; and

(E) shall consider the economic impact to the region.

(2) OPEN SELECTION PROCESS.—Nothing in paragraph (1) shall constrain the Office to only consider its evaluations in selecting the Detroit, Michigan, satellite office.

(d) REPORT TO CONGRESS.—Not later than the end of the third fiscal year that begins after the date of the enactment of this Act, the Director shall submit a report to Congress on—

(1) the rationale of the Director in selecting the location of any satellite office required under subsection (a), including an explanation of how the selected location will achieve the purposes of satellite offices listed under subsection (b) and how the required considerations listed under subsection (c) were met;

(2) the progress of the Director in establishing all such satellite offices; and

(3) whether the operation of existing satellite offices is achieving the purposes under subsection (b).

**SEC. 24. DESIGNATION OF DETROIT SATELLITE OFFICE.**

(a) DESIGNATION.—The satellite office of the United States Patent and Trademark Office to be located in Detroit, Michigan, shall be known and designated as the "Elijah J. McCoy United States Patent and Trademark Office".

(b) REFERENCES.—Any reference in a law, map, regulation, document, paper, or other record of the United States to the satellite office of the United States Patent and Trademark Office to be located in Detroit, Michigan, referred to in subsection (a) shall be deemed to be a reference to the "Elijah J. McCoy United States Patent and Trademark Office".



**SEC. 25. PRIORITY EXAMINATION FOR IMPORTANT TECHNOLOGIES.**

Section 2(b)(2) of title 35, United States Code, is amended—

- (1) in subparagraph (E), by striking “and” after the semicolon;
- (2) in subparagraph (F), by inserting “and” after the semicolon;
- (3) by adding at the end the following:

“(G) may, subject to any conditions prescribed by the Director and at the request of the patent applicant, provide for prioritization of examination of applications for products, processes, or technologies that are important to the national economy or national competitiveness without recovering the aggregate extra cost of providing such prioritization, notwithstanding section 41 or any other provision of law;”.

**SEC. 26. STUDY ON IMPLEMENTATION.**

(a) PTO STUDY.—The Director shall conduct a study on the manner in which this Act and the amendments made by this Act are being implemented by the Office, and on such other aspects of the patent policies and practices of the Federal Government with respect to patent rights, innovation in the United States, competitiveness of United States markets, access by small businesses to capital for investment, and such other issues, as the Director considers appropriate.

(b) REPORT TO CONGRESS.—The Director shall, not later than the date that is 4 years after the date of the enactment of this Act, submit to the Committees on the Judiciary of the House of Representatives and the Senate a report on the results of the study conducted under subsection (a), including recommendations for any changes to laws and regulations that the Director considers appropriate.

**SEC. 27. STUDY ON GENETIC TESTING.**

(a) IN GENERAL.—The Director shall conduct a study on effective ways to provide independent, confirming genetic diagnostic test activity where gene patents and exclusive licensing for primary genetic diagnostic tests exist.

(b) ITEMS INCLUDED IN STUDY.—The study shall include an examination of at least the following:

- (1) The impact that the current lack of independent second opinion testing has had on the ability to provide the highest level of medical care to patients and recipients of genetic diagnostic testing, and on inhibiting innovation to existing testing and diagnoses.
- (2) The effect that providing independent second opinion genetic diagnostic testing would have on the existing patent and license holders of an exclusive genetic test.
- (3) The impact that current exclusive licensing and patents on genetic testing activity has on the practice of medicine, including but not limited to: the interpretation of testing results and performance of testing procedures.
- (4) The role that cost and insurance coverage have on access to and provision of genetic diagnostic tests.

(c) CONFIRMING GENETIC DIAGNOSTIC TEST ACTIVITY DEFINED.—For purposes of this section, the term “confirming genetic diagnostic test activity” means the performance of a genetic diagnostic test, by a genetic diagnostic test provider, on an individual solely for the purpose of providing the individual with an independent confirmation of results obtained from another test provider’s prior performance of the test on the individual.

(d) REPORT.—Not later than 9 months after the date of enactment of this Act, the Director shall report to the Committee on the Judiciary of the Senate and the Committee on the Judiciary of the House of Representatives on the findings of the study and provide recommendations for establishing the availability of such independent confirming genetic diagnostic test activity.

**SEC. 28. PATENT OMBUDSMAN PROGRAM FOR SMALL BUSINESS CONCERNS.**

Using available resources, the Director shall establish and maintain in the Office a Patent Ombudsman Program. The duties of the Program's staff shall include providing support and services relating to patent filings to small business concerns and independent inventors.

**SEC. 29. ESTABLISHMENT OF METHODS FOR STUDYING THE DIVERSITY OF APPLICANTS.**

The Director shall, not later than the end of the 6-month period beginning on the date of the enactment of this Act, establish methods for studying the diversity of patent applicants, including those applicants who are minorities, women, or veterans. The Director shall not use the results of such study to provide any preferential treatment to patent applicants.

**SEC. 30. SENSE OF CONGRESS.**

It is the sense of Congress that the patent system should promote industries to continue to develop new technologies that spur growth and create jobs across the country which includes protecting the rights of small businesses and inventors from predatory behavior that could result in the cutting off of innovation.

**SEC. 31. USPTO STUDY ON INTERNATIONAL PATENT PROTECTIONS FOR SMALL BUSINESSES.**

(a) STUDY REQUIRED.—The Director, in consultation with the Secretary of Commerce and the Administrator of the Small Business Administration, shall, using the existing resources of the Office, carry out a study—

- (1) to determine how the Office, in coordination with other Federal departments and agencies, can best help small businesses with international patent protection; and
- (2) whether, in order to help small businesses pay for the costs of filing, maintaining, and enforcing international patent applications, there should be established either—
  - (A) a revolving fund loan program to make loans to small businesses to defray the costs of such applications, maintenance, and enforcement and related technical assistance; or
  - (B) a grant program to defray the costs of such applications, maintenance, and enforcement and related technical assistance.

(b) REPORT.—Not later than 120 days after the date of the enactment of this Act, the Director shall issue a report to the Congress containing—

- (1) all findings and determinations made in carrying out the study required under subsection (a);
- (2) a statement of whether the determination was made that—
  - (A) a revolving fund loan program described under subsection (a)(2)(A) should be established;
  - (B) a grant program described under subsection (a)(2)(B) should be established; or
  - (C) neither such program should be established; and
- (3) any legislative recommendations the Director may have developed in carrying out such study.

**SEC. 32. PRO BONO PROGRAM.**

(a) IN GENERAL.—The Director shall work with and support intellectual property law associations across the country in the establishment of pro bono programs designed to assist financially under-resourced independent inventors and small businesses.

(b) EFFECTIVE DATE.—This section shall take effect on the date of the enactment of this Act.

**SEC. 33. LIMITATION ON ISSUANCE OF PATENTS.**

(a) LIMITATION.—Notwithstanding any other provision of law, no patent may issue on a claim directed to or encompassing a human organism.

(b) EFFECTIVE DATE.—

(1) IN GENERAL.—Subsection (a) shall apply to any application for patent that is pending on, or filed on or after, the date of the enactment of this Act.

(2) PRIOR APPLICATIONS.—Subsection (a) shall not affect the validity of any patent issued on an application to which paragraph (1) does not apply.

**SEC. 34. STUDY OF PATENT LITIGATION.**

(a) GAO STUDY.—The Comptroller General of the United States shall conduct a study of the consequences of litigation by nonpracticing entities, or by patent assertion entities, related to patent claims made under title 35, United States Code, and regulations authorized by that title.

(b) CONTENTS OF STUDY.—The study conducted under this section shall include the following:

(1) The annual volume of litigation described in subsection (a) over the 20-year period ending on the date of the enactment of this Act.

(2) The volume of cases comprising such litigation that are found to be without merit after judicial review.

(3) The impacts of such litigation on the time required to resolve patent claims.

(4) The estimated costs, including the estimated cost of defense, associated with such litigation for patent holders, patent licensors, patent licensees, and inventors, and for users of alternate or competing innovations.

(5) The economic impact of such litigation on the economy of the United States, including the impact on inventors, job creation, employers, employees, and consumers.

(6) The benefit to commerce, if any, supplied by non-practicing entities or patent assertion entities that prosecute such litigation.

(c) REPORT TO CONGRESS.—The Comptroller General shall, not later than the date that is 1 year after the date of the enactment of this Act, submit to the Committee on the Judiciary of the House of Representatives and the Committee on the Judiciary of the Senate a report on the results of the study required under this section, including recommendations for any changes to laws and regulations that will minimize any negative impact of patent litigation that was the subject of such study.

**SEC. 35. EFFECTIVE DATE.**

Except as otherwise provided in this Act, the provisions of this Act shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued on or after that effective date.

**SEC. 36. BUDGETARY EFFECTS.**

The budgetary effects of this Act, for the purpose of complying with the Statutory Pay-As-You-Go Act of 2010, shall be determined by reference to the latest statement titled “Budgetary Effects of PAYGO Legislation” for this Act, submitted for printing in the Congressional Record by the Chairman of the House Budget Committee, provided that such statement has been submitted prior to the vote on passage.

**SEC. 37. CALCULATION OF 60-DAY PERIOD FOR APPLICATION OF PATENT TERM EXTENSION.**

(a) IN GENERAL.—Section 156(d)(1) of title 35, United States Code, is amended by adding at the end the following flush sentence: “For purposes of determining the date on which a product receives permission under the second sentence of this paragraph, if such permission is transmitted after 4:30 P.M., Eastern Time, on a business day, or is transmitted on a day that is

not a business day, the product shall be deemed to receive such permission on the next business day. For purposes of the preceding sentence, the term 'business day' means any Monday, Tuesday, Wednesday, Thursday, or Friday, excluding any legal holiday under section 6103 of title 5."

(b) APPLICABILITY.—The amendment made by subsection (a) shall apply to any application for extension of a patent term under section 156 of title 35, United States Code, that is pending on, that is filed after, or as to which a decision regarding the application is subject to judicial review on, the date of the enactment of this Act.

*Speaker of the House of Representatives.*

*Vice President of the United States and President of the Senate.*

Release date: September 16, 2011

### **America Invents Act: Effective Dates**

The America Invents Act (AIA) contains a general “Effective Date” provision in Section 35, which states: “Except as otherwise provided in this Act, the provisions of this Act shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued on or after that effective date.” The America Invents Act was enacted in law on September 16, 2011.

The provisions in this “Effective Date” table are ordered based upon the effective date. Provisions with the same effective date are highlighted in the same color.

<b>Provision</b>	<b>Section of AIA</b>	<b>Statutory Language for Effective Date</b>	<b>Effective Date</b>
<b>Pro Bono Program</b>	<b>32</b>	This section shall take effect on the date of enactment of this Act.	<b>September 16, 2011</b>
<b>Inter Partes Reexamination transition for threshold</b>	<b>6</b>	(B) APPLICATION.—The amendments made by this paragraph— (i) shall take effect on the date of the enactment of this Act; and (ii) shall apply to requests for inter partes reexamination that are filed on or after such date of enactment, but before the effective date set forth in paragraph (2)(A) of this subsection.	<b>September 16, 2011</b>
<b>Tax strategies are deemed within the prior art</b>	<b>14</b>	(e) EFFECTIVE DATE; APPLICABILITY.— This section shall take effect on the date of the enactment of this Act and shall apply to any patent application that is pending on, or filed on or after, that date, and to any patent that is issued on or after that date.	<b>September 16, 2011</b>
<b>Best mode</b>	<b>15</b>	The amendments made by this section shall take effect upon the date of the enactment of this Act and shall apply to proceedings commenced on or after that date.	<b>September 16, 2011</b>
<b>Human organism prohibition</b>	<b>33</b>	Effective Date: (1) In General. — Subsection (a) shall apply to any application for patent that is pending on, or filed on or after, the date of enactment of this Act.	<b>September 16, 2011</b>
<b>Virtual and false marking</b>	<b>16</b>	EFFECTIVE DATE. —The amendment made by this subsection shall apply to any case that is pending on, or commenced on or after that date of enactment of this Act.	<b>September 16, 2011</b>
<b>Venue change from DDC to EDVA for suits brought under 35 U.S.C. §§ 32, 145, 146, 154 (b) (4)(A), and 293</b>	<b>9</b>	The amendments made by this section shall take effect upon the date of the enactment of this Act and shall apply to any civil action commenced on or after that date.	<b>September 16, 2011</b>
<b>OED Statute of Limitations</b>	<b>3</b>	(3) EFFECTIVE DATE.—The amendment made by paragraph (1) shall apply in any case in which the time period for instituting a proceeding under section 32 of title 35, United States Code, had not lapsed before the date of the enactment of this Act.	<b>September 16, 2011</b>

<b>Provision</b>	<b>Section of AIA</b>	<b>Statutory Language for Effective Date</b>	<b>Effective Date</b>
<b>Fee Setting Authority</b>	<b>10</b>	Except as provided in subsection (h), this section and the amendments made by this section shall take effect upon the date of the enactment of this Act.	<b>September 16, 2011</b> <b>(Note: new fees will become effective after rulemaking consistent with statute)</b>
<b>Establishment of micro-entity</b>	<b>10</b>	Except as provided in subsection (h), this section and the amendments made by this section shall take effect upon the date of the enactment of this Act.	<b>September 16, 2011</b>
<b>Prioritized examination</b>	<b>11</b>	(A) EFFECTIVE DATE . – This subsection shall take effect on the date that is 10 days after the date of enactment of this Act.	<b>September 26, 2011</b>
<b>15% transition surcharge</b>	<b>11</b>	EFFECTIVE DATE AND TERMINATION OF SURCHARGE. – The surcharge provided for in paragraph (1) – (A) shall take effect on the date that is 10 days after the date of enactment of this Act.	<b>September 26, 2011</b>
<b>Reserve fund</b>	<b>22</b>	EFFECTIVE DATE. — The amendments made by this section shall take effect on October 1, 2011.	<b>October 1, 2011</b>
<b>Electronic filing incentive</b>	<b>10</b>	(h)(2) Effective Date. — This subsection shall take effect upon the expiration of the 60 day period beginning on the date of enactment of this Act.	<b>November 15, 2011</b>
<b>International Protection for Small Businesses Report</b>	<b>31</b>	Not later than 120 days after the date of enactment of this Act, the Director shall issue a report to the Congress ...	<b>January 14, 2012</b>
<b>Prior User Rights Report</b>	<b>3</b>	Not later than the end of the 4-month period beginning on the date of enactment of this Act, the Director shall report, to the Committee.	<b>January 16, 2012</b>
<b>Diversity of Applicants Program Established</b>	<b>29</b>	The Director shall, not later than the end of the 6-month period beginning on the date of the enactment of this Act, establish methods...	<b>March 16, 2012</b>
<b>Genetic Testing Report</b>	<b>27</b>	Not later than 9 months after the date of enactment of this Act, the Director shall report ... on the findings of the study...	<b>June 16, 2012</b>
<b>Inventor's oath or declaration</b>	<b>4</b>	EFFECTIVE DATE.—The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent application filed before, on, or after that effective date.	<b>September 16, 2012</b>
<b>Third party submission of prior art in a patent application</b>	<b>8</b>	EFFECTIVE DATE.—The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent application filed before, on, or after that effective date.	<b>September 16, 2012</b>
<b>Supplemental examination</b>	<b>12</b>	EFFECTIVE DATE.—The amendments made by this section shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.	<b>September 16, 2012</b>

<b>Provision</b>	<b>Section of AIA</b>	<b>Statutory Language for Effective Date</b>	<b>Effective Date</b>
<b>Citation of prior art in a patent file</b>	<b>6</b>	EFFECTIVE DATE.—The amendments made by this subsection shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.	<b>September 16, 2012</b>
<b>Priority examination for important technologies</b>	<b>25</b>	No express provision; Section 35 applies.	<b>September 16, 2012</b>
<b>Inter partes review</b>	<b>6</b>	(2) APPLICABILITY.— (A) IN GENERAL.—The amendments made by subsection (a) shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and shall apply to any patent issued before, on, or after that effective date.	<b>September 16, 2012</b>
<b>Post-grant review</b>	<b>6</b>	(2) APPLICABILITY.— (A) IN GENERAL.—The amendments made by subsection (d) shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act and, except as provided in section 18 and in paragraph (3) shall apply only to patents described in section 3(n)(1).	<b>September 16, 2012</b>
<b>Transitional program for covered business method patents</b>	<b>18</b>	The regulations issued under paragraph (1) shall take effect upon the expiration of the 1-year period beginning on the date of the enactment of this Act.	<b>September 16, 2012</b>
<b>Patent Ombudsman for Small Businesses Program Established</b>	<b>28</b>	No express provision; Section 35 applies.	<b>September 16, 2012</b>
<b>Effects of First-Inventor-to-File on Small Business Report</b>	<b>3</b>	Not later than the date that is 1 year after the date of the enactment of this Act, the Chief Counsel shall submit to the Committee.	<b>September 16, 2012</b>
<b>Patent Litigation Report</b>	<b>34</b>	The Comptroller General shall, not later than the date that is 1 year after the date of enactment of this Act, submit to the Committee...	<b>September 16, 2012</b>
<b>First-Inventor-to-File</b>	<b>3</b>	(n) EFFECTIVE DATE.— (1) IN GENERAL.—Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to...	<b>March 16, 2013</b>
<b>Derivation proceedings</b>	<b>3</b>	(n) EFFECTIVE DATE.— (1) IN GENERAL.—Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to...	<b>March 16, 2013</b>

<b>Provision</b>	<b>Section of AIA</b>	<b>Statutory Language for Effective Date</b>	<b>Effective Date</b>
<b>Repeal of Statutory Invention Registration</b>	<b>3</b>	EFFECTIVE DATE.—The amendments made by this subsection shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act, and shall apply to any request for a statutory invention registration filed on or after that effective date.	<b>March 16, 2013</b>
<b>Report on Misconduct Before the Office Report</b>	<b>3</b>	(n) EFFECTIVE DATE.— (1) IN GENERAL.—Except as otherwise provided in this section, the amendments made by this section shall take effect upon the expiration of the 18-month period beginning on the date of the enactment of this Act.	<b>March 16, 2013 (Reports are due biennially after effective date)</b>
<b>Open Satellite Offices</b>	<b>23</b>	Subject to available resources, the Director shall, not later than the date that is 3 years after the date of the enactment of this Act, establish 3 or more satellite Offices in the United States to carry out the responsibilities of the Office.	<b>September 16, 2014</b>
<b>Virtual Marking Report</b>	<b>16</b>	Not later than the date that is 3 years after the date of the enactment of this Act, the Director shall submit a report to Congress that provides...	<b>September 16, 2014</b>
<b>Satellite Offices Report</b>	<b>23</b>	Not later than the end of the third fiscal year that begins after the date of the enactment of this Act, the Director shall submit a report to Congress.	<b>September 30, 2014</b>
<b>AIA Implementation Report</b>	<b>26</b>	The Director shall, not later than the date that is 4 years after the date of the enactment of this Act, submit to the Committees...	<b>September 16, 2015</b>



## VIET NAM

### Order No. 12/2009/L-CTN of June 29, 2009, on the promulgation of law

THE PRESIDENT OF THE SOCIALIST REPUBLIC OF VIETNAM

Pursuant to Articles 103 and 106 of the 1992 Constitution of the Socialist Republic of Vietnam, which was amended and supplemented under Resolution No. 51/2001/QH10 of December 25, 2001, of the Xth National Assembly, the 10th session;

Pursuant to Article 91 of the Law on Organization of the National Assembly;

Pursuant to Article 57 of the Law on Promulgation of Legal Documents,

PROMULGATES:

the Law Amending and Supplementing a Number of Articles of the Law on Intellectual Property,

which was passed on June 19, 2009, by the XIIth National Assembly of the Socialist Republic of Vietnam at its 5th session.

President of the Socialist Republic of Vietnam

NGUYEN MINH TRIET

### Law of 2009 Amending and Supplementing a Number of Articles of the Law on Intellectual Property

(adopted on June 19, 2009)

(entered into force on January 1, 2010)

(No. 36/2009/QH12)

Pursuant to the 1992 Constitution of the Socialist Republic of Vietnam, which was amended and supplemented under Resolution No. 51/2001/QH10;

The National Assembly promulgates the Law Amending and Supplementing a Number of Articles of the Law on Intellectual Property.

#### Article 1.

To amend and supplement a number of articles of the Law on Intellectual Property:

##### 1. To amend and supplement Article 3 as follows:

"**Article 3.** Subject matters of intellectual property rights

1. Subject matters of copyright include literary, artistic and scientific works; subject matters of copyright-related rights include performances, phonograms, video recordings, broadcasts and encrypted program-carrying satellite signals.

2. Subject matters of industrial property rights include inventions, industrial designs, layout-designs of semiconductor integrated circuits, trade secrets, marks, trade names and geographical indications.

3. Subject matters of rights to plant varieties include reproductive and harvested materials."

##### 2. To amend and supplement Article 4 as follows:

"**Article 4.** Interpretation of terms

In this Law, the terms below are construed as follows:

1. *Intellectual property rights* means rights of organizations and individuals to intellectual assets, including copyright and copyright-related rights, industrial property rights and rights to plant varieties.
2. *Copyright* means rights of organizations and individuals to works they have created or own.
3. *Copyright-related rights* (below referred to as related rights) means rights of organizations and individuals to performances, phonograms, video recordings, broadcasts and encrypted program-carrying satellite signals.
4. *Industrial property rights* means rights of organizations and individuals to inventions, industrial designs, layout-designs of semiconductor integrated circuits, trade secrets, marks, trade names, geographical indications and trade secrets they have created or own, and the right to repression of unfair competition.
5. *Rights to plant varieties* means rights of organizations and individuals to new plant varieties they have selected, created or discovered and developed, or own.
6. *Intellectual property right holder* means an owner of intellectual property rights or an organization or individual that is assigned intellectual property rights by the owner.
7. *Work* means a creation of the mind in the literary, artistic or scientific domain, whatever may be the mode or form of its expression.
8. *Derivative work* means a work which is translated from one language into another, adapted, modified, transformed, compiled, annotated or selected.
9. *Published work*, phonogram or video recording means a work, phonogram or video recording which has been made available in a reasonable quantity of copies to the public with the permission of the copyright holder or related right holder.
10. *Reproduction* means the making of one or many copies of a work or a phonogram or video recording by whatever mode or in whatever form, including the backup of the work in electronic form.
11. *Broadcasting* means the transmission of the sound or image or both of a work, a performance, a phonogram, a video recording or a broadcast to the public by wire or wireless means, including satellite transmission, in such a way that members of the public may access that work from a place and at a time they themselves select.
12. *Invention* means a technical solution in the form of a product or a process which is intended to solve a problem by application of laws of nature.
13. *Industrial design* means a specific appearance of a product embodied by three-dimensional configurations, lines, colors, or a combination of these elements.
14. *Semiconductor integrated circuit* means a product, in its final form or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections, are integrally formed in or on a piece of semiconductor material and which is intended to perform an electronic function. Integrated circuit is synonymous to IC, chip and microelectronic circuit.
15. *Layout-design of semiconductor integrated circuit* (below referred to as layout-design) means a three-dimensional disposition of circuit elements and their interconnections in a semiconductor integrated circuit.
16. *Mark* means any sign used to distinguish goods or services of different organizations or individuals.
17. *Collective mark* means a mark used to distinguish goods or services of members from those of non-members of an organization which is the owner of such mark.
18. *Certification mark* means a mark which is authorized by its owner to be used by another organization or individual on the latter's goods or services, for the purpose of certifying the origin, raw materials, materials, mode of manufacture of goods or manner of provision of services, quality, accuracy, safety or other characteristics of goods or services bearing the mark.

19. *Integrated mark* means identical or similar marks registered by the same entity and intended for use on products or services which are of the same type or similar types or interrelated.

20. *Well-known mark* means a mark widely known by consumers throughout the Vietnamese territory.

21. *Trade name* means a designation of an organization or individual in business activities, capable of distinguishing the business entity bearing it from another entity in the same business domain and area.

A business area mentioned in this Clause means a geographical area where a business entity has its partners, customers or earns its reputation.

22. *Geographical indication* means a sign which identifies a product as originating from a specific region, locality, territory or country.

23. *Trade secret* means information obtained from financial or intellectual investment activities, which has not yet been disclosed and can be used in business.

24. *Plant variety* means a plant grouping within a single botanical taxonomy of the lowest known rank, which is morphologically uniform and suitable for being propagated unchanged, and can be defined by the expression of phenotypes resulting from a genotype or a combination of given genotypes, and distinguished from any other plant grouping by the expression of at least one inheritable phenotype.

25. *Protection title* means a document granted by a competent state agency to an organization or individual in order to establish industrial property rights to an invention, industrial design, layout-design, trademark or geographical indication; or rights to a plant variety.

26. *Reproductive material* means a plant or a part thereof capable of growing into a new plant for use in reproduction or cultivation.

27. *Harvested material* means a plant or a part thereof obtained from the cultivation of a reproductive material."

### **3. To amend and supplement Article 7 as follows:**

"**Article 7.** Limitations on intellectual property rights

1. Intellectual property right holders may only exercise their rights within the scope and term of protection provided for in this Law.
2. The exercise of intellectual property rights must neither prejudice the State's interests, public interests, legitimate rights and interests of other organizations and individuals, nor violate other relevant provisions of law.
3. In the circumstances where the achievement of defense, security, people's livelihood objectives and other interests of the State and society specified in this Law needs to be guaranteed, the State may prohibit or restrict the exercise of intellectual property rights by the holders or compel the licensing by the holders of one or several of their rights to other organizations or individuals under appropriate terms. The limitation on rights to inventions classified as state secrets complies with regulations of the Government."

### **4. To amend and supplement Article 8 as follows:**

"**Article 8.** The State's intellectual property policies

1. To recognize and protect intellectual property rights of organizations and individuals on the basis of harmonizing benefits of intellectual property rights holders and public interests; not to protect intellectual property objects which are contrary to social ethics and public order and prejudicial to defense and security.
2. To encourage and promote the creation and utilization of intellectual assets in order to contribute to socio-economic development and improvement of the people's material and spiritual life.

3. To provide financial supports for the receipt and exploitation of assigned intellectual property rights in public interests; to encourage organizations and individuals at home or abroad to provide financial aid for creative activities and the protection of intellectual property rights.

4. To prioritize investment in training and retraining the contingent of cadres, civil servants, public employees and other relevant subjects engaged in the protection of intellectual property rights and the research into and application of sciences and technologies to the protection of intellectual property rights.

5. To mobilize social resources for investment in raising the capacity of the system to protect intellectual property rights, thereby meeting requirements of socio-economic development and international economic integration."

**5. To amend and supplement Article 14 as follows:**

"**Article 14.** Types of works eligible for copyright protection

1. Literary, artistic and scientific works eligible for copyright protection include:

a/ Literary and scientific works, textbooks, teaching courses and other works expressed in written languages or other characters;

b/ Lectures, addresses and other sermons;

c/ Press works;

d/ Musical works;

e/ Dramatic works;

f/ Cinematographic works and works created by a process analogous to cinematography (below collectively referred to as cinematographic works);

g/ Plastic-art works and works of applied art;

h/ Photographic works;

i/ Architectural works;

j/ Sketches, plans, maps and drawings related to topography, architecture or scientific works;

k/ Folklore and folk art works of folk culture;

l/ Computer programs and data compilations.

2. Derivative works shall be protected under Clause 1 of this Article only if it is not prejudicial to the copyright to works used to create these derivative works.

3. Protected works defined in Clauses 1 and 2 of this Article must be created personally by authors through their intellectual labor without copying others' works.

4. The Government shall guide in detail the types of works specified in Clause 1 of this Article."

**6. To amend and supplement Article 25 as follows:**

"**Article 25.** Cases of use of published works in which permission and payment of royalties or remunerations are not required

1. Cases of use of published works in which permission or payment of royalties or remunerations is not required include:

a/ Duplication of works for personal scientific research or teaching purpose;

b/ Reasonable recitation of works without misrepresenting the authors' views for commentary or illustrative purpose;

c/ Recitation of works without misrepresenting the authors' views in articles published in newspapers or periodicals, in radio or television broadcasts, or documentaries;

d/ Recitation of works in schools for lecturing purpose without misrepresenting the authors' views and not for commercial purpose;

- e/ Reprographic reproduction of works by libraries for archival and research purpose;
- f/ Performance of dramatic works or other performing-art works in mass cultural, communication or mobilization activities without collecting any charges in any form;
- g/ Audiovisual recording of performances for the purpose of reporting current events or for teaching purpose;
- h/ Photographing or televising of plastic art, architectural, photographic, applied-art works displayed at public places for the purpose of presenting images of these works;
- i/ Transcription of works into Braille or characters of other languages for the blind;
- j/ Importation of copies of others' works for personal use.

2. Organizations and individuals that use works defined in Clause 1 of this Article may neither affect the normal utilization of these works nor prejudice the rights of the authors or copyright holders; and shall indicate the authors' names, and sources and origins of these works.

3. The provisions of Points a and e, Clause 1 of this Article are not applicable to architectural works, plastic works and computer programs."

#### **7. To amend and supplement Article 26 as follows:**

**"Article 26.** Cases of use of published works in which permission is not required but the payment of royalties or remunerations is required

1. Broadcasting organizations that use published works in making their broadcasts, which are sponsored, advertised or charged in whatever form, are not required to obtain permission but have to pay royalties or remunerations to copyright holders from the date of use. Levels of royalties, remunerations or other material benefits and modes of payment shall be agreed upon by involved parties. If no agreement is reached, involved parties shall comply with regulations of the Government or institute lawsuits at court under law.

Broadcasting organizations that use published works in making their broadcasts, which are not sponsored, advertised or charged in whatever form, are not required to obtain permission but have to pay royalties or remunerations to copyright holders from the date of use under regulations of the Government.

2. Organizations and individuals that use works under Clause 1 of this Article must neither affect the normal utilization of these works nor prejudice the rights of the authors or copyright holders; and shall indicate the authors' names, and sources and origins of the works.

3. The use of works in the cases specified in Clause 1 of this Article does not apply to cinematographic works."

#### **8. To amend and supplement Article 27 as follows:**

**"Article 27.** Term of copyright protection

1. The moral rights provided for in Clauses 1, 2 and 4, Article 19 of this Law shall be protected for an indefinite term.

2. The moral rights provided for in Clause 3, Article 19 and the economic rights provided for in Article 20 of this Law enjoy the following term of protection:

a/ Cinematographic works, photographic works, works of applied art and anonymous works have a term of protection of seventy five years from the date of first publication. For cinematographic works, photographic works and works of applied art which remain unpublished within twenty five years from the date of fixation, the term of protection is one hundred years from the date of fixation. For anonymous works, when information on their authors is published, the term of protection will be calculated under Point b of this Clause.

b/ A work not specified at Point a of this Clause is protected for the whole life of the author and for fifty years after his/her death. For a work under joint authorship, the term of protection expires in the fiftieth year after the death of the last surviving co-author;

c/ The term of protection specified at Points a and b of this Clause expires at 24:00 hrs of December 31 of the year of expiration of the copyright protection term."

**9. To amend and supplement Article 30 as follows:**

**"Article 30.** Rights of producers of phonograms and video recordings

1. Producers of phonograms and video recordings have the exclusive right to exercise or authorize others to exercise the following rights:

a/ To directly or indirectly reproduce their phonograms and video recordings;

b/ To import and distribute to the public their original phonograms and video recordings and copies thereof by sale, rent or distribution by whatever technical means accessible by the public.

2. Producers of phonograms and video recordings will enjoy material benefits when their phonograms and video recordings are distributed to the public."

**10. To amend and supplement Article 33 as follows:**

**"Article 33.** Cases of use of related rights in which permission is not required but payment of royalties or remunerations is required

1. Organizations and individuals that directly or indirectly use phonograms or video recordings already published for commercial purposes in making their broadcasts, which are sponsored, advertised or charged in whatever form, are not required to obtain permission but have to pay agreed royalties or remunerations to authors, copyright holders, performers or producers of phonograms or video recordings, or broadcasting organizations from the date of use. In case no agreement is reached, they shall comply with regulations of the Government or institute lawsuits at court under law.

Organizations and individuals that directly or indirectly use phonograms or video recordings already published for commercial purposes in making their broadcasts, which are not sponsored, advertised or charged in whatever form, are not required to obtain permission but have to pay agreed royalties or remunerations to authors, copyright holders, performers or producers of phonograms or video recordings, or broadcasting organizations from the date of use under regulations of the Government.

2. Organizations and individuals that use phonograms or video recordings already published in their business or commercial activities are not required to obtain permission but have to pay agreed royalties or remunerations to authors, copyright holders, performers or producers of phonograms or video recordings, or broadcasting organizations from the date of use. In case no agreement is reached, they shall comply with regulations of the Government or institute lawsuits at court under law.

3. Organizations and individuals that use the rights provided for in Clauses 1 and 2 of this Article must neither affect the normal utilization of performances, phonograms, video recordings or broadcasts, nor prejudice the rights of performers, producers of phonograms and video recordings, and broadcasting organizations."

**11. To amend and supplement Article 41 as follows:**

**"Article 41.** Copyright holders being right assignees

1. Organizations and individuals that are assigned one, several or all of the rights specified in Article 20 and Clause 3, Article 19 of this Law under contracts are copyright holders.

2. Organizations and individuals that are managing anonymous works enjoy rights of owners until the names of authors of these works are identified."

**12. To amend and supplement Article 42 as follows:**

**"Article 42.** Copyright holders being the State

1. The State is the holder of copyright to the following works:

a/ Anonymous works, except those specified in Clause 2, Article 41 of this Law;

b/ Works of which terms of protection have not expired but their copyright holders die without heirs, their heirs renounce succession or are deprived of the right to succession.

c/ Works over which the ownership right has been assigned by their copyright holders to the State.

2. The Government shall specify the use of works under state ownership."

**13. To amend and supplement Article 87 as follows:**

"**Article 87.** Right to register marks

1. Organizations and individuals may register marks to be used for goods they produce or services they provide.

2. Organizations and individuals that conduct lawful commercial activities may register marks for products they are marketing but produced by others, provided that the producers neither use such marks for their products nor object to such registration.

3. Lawfully established collective organizations may register collective marks to be used by their members under regulations on use of collective marks. For signs indicating geographical origins of goods or services, organizations that may register them are collective organizations of organizations or individuals engaged in production or trading in relevant localities. For other geographical names or signs indicating geographical origins of local specialties of Vietnam, the registration must be permitted by competent state agencies.

4. Organizations with the function of controlling and certifying the quality, properties, origin or other relevant criteria of goods or services may register certification marks, provided that they are not engaged in the production or trading of these goods or services. For other geographical names or signs indicating geographical origins of local specialties of Vietnam, the registration thereof must be permitted by a competent state agency.

5. Two or more organizations or individuals may jointly register a mark in order to become its co-owners on the following conditions:

a/ This mark is used in the names of all co-owners or used for goods or services which are produced or traded with the participation of all co-owners;

b/ The use of this mark causes no confusion to consumers as to the origin of goods or services.

6. Persons having the registration right defined in Clauses 1, 2, 3, 4 and 5 of this Article, including those having filed registration applications, may assign the registration right to other organizations or individuals in the form of written contracts, bequeathal or inheritance under law, provided that the assigned organizations or individuals satisfy the relevant conditions on the persons having the registration right.

7. For a mark protected in a country being a contracting party to a treaty which prohibits the representative or agent of a mark owner to register such mark and to which the Socialist Republic of Vietnam is also a contracting party, this representative or agent is not permitted to register the mark unless it is so agreed by the mark owner, unless a justifiable reason is available."

**14. To amend and supplement Article 90 as follows:**

"**Article 90.** The first-to-file principle

1. In case many applications are filed for registration of the same invention or similar inventions, or for registration of industrial designs identical with or insignificantly different from one another, the protection title may only be granted to the valid application with the earliest priority or filing date among applications satisfying all the conditions for the grant of a protection title.

2. In case there are many applications filed by different persons for registration of identical or confusingly similar marks for identical or similar products or services, or in case there are many applications filed by the same person for registration of identical marks for identical products or services, the protection title may only be granted for the mark in the valid

application with the earliest priority or filing date among applications satisfying all the conditions for the grant of a protection title.

3. In case there are many registration applications specified in Clauses 1 and 2 of this Article and satisfying all the conditions for the grant of a protection title and having the same earliest priority or filing date, the protection title may only be granted for the object of a single application out of these applications under an agreement of all applicants. Without such agreement, all relevant objects of these applications will be refused for the grant of a protection title."

**15. To amend and supplement Article 119 as follows:**

**"Article 119.** Time limit for processing industrial property registration applications

1. An industrial property registration application will have its form examined within one month from the filing date.

2. An industrial property registration application shall be substantively examined within the following time limits:

a/ For an invention, eighteen months from the date of its publication if a request for substantive examination is filed before the date of application publication, or from the date of receipt of a request for substantive examination if such request is filed after the date of application publication;

b/ For a mark, nine months from the date of application publication;

c/ For an industrial design, seven months from the date of application publication;

d/ For a geographical indication, six months from the date of application publication.

3. The time limit for re-examination of an industrial property registration application is equal to two-thirds of the time limit for the initial examination and may, in complicated cases, be prolonged but must not exceed the time limit for the initial examination.

4. The duration for modification or supplementation of applications by applicants will not be counted into the time limit specified in Clause 1, 2 or 3 of this Article. The time limit for processing requests for modification or supplementation of applications must not exceed one-third of the corresponding time limit specified in Clause 1 or 2 of this Article."

**16. To amend and supplement Article 134 as follows:**

**"Article 134.** Right of prior use of inventions and industrial designs

1. In case a person has, before the filing date or priority date (if any) of an invention or industrial design registration application, used or prepared necessary conditions for using an invention or industrial design identical with the protected invention or industrial design stated in that registration application but created independently (below referred to as prior use right holder), then after a protection title is granted, he/she may continue using such invention or industrial design within the scope and volume of use or use preparations without having to obtain permission of or paying compensations to the owner of the protected invention or industrial design. The exercise of the right of prior users of inventions or industrial designs is not regarded as an infringement upon the right of invention or industrial design owners.

2. Holders of prior use right to inventions or industrial designs may not assign such right to others, unless that right is assigned together with the transfer of business or production establishments which have used or are prepared to use the inventions or industrial designs. Prior use right holders may not expand the use scope and volume unless it is so permitted by invention or industrial design owners."

**17. To amend and supplement Article 154 as follows:**

**"Article 154.** Conditions for industrial property representation service business

Organizations that satisfy the following conditions may provide industrial property representation services as industrial property representation service organizations:



1. Being law-practicing businesses, cooperatives or organizations, or scientific and technological service organizations lawfully established and operating, except foreign law-practicing organizations operating in Vietnam;
2. Having the function of providing industrial property representation services, which is stated in their business registration certificates or operation registration certificates (below collectively referred to as business registration certificates);
3. Their heads or persons authorized by their heads must satisfy the conditions for industrial property representation service practice, specified in Clause 1, Article 155 of this Law."

**18. To amend and supplement Article 157 as follows:**

**"Article 157.** Organizations and individuals that have rights to plant varieties protected

1. Organizations and individuals that have rights to plant varieties protected are those that select and breed or discover and develop plant varieties or invest in the selection and breeding or the discovery and development of plant varieties or are transferred rights to plant varieties.
2. Organizations and individuals defined in Clause 1 of this Article include Vietnamese organizations and individuals; organizations and individuals of foreign countries which have concluded with the Socialist Republic of Vietnam agreements on the protection of plant varieties; foreign organizations and individuals that have permanent offices or residences in Vietnam or have establishments producing or trading in plant varieties in Vietnam; foreign organizations and individuals that have permanent offices or residences or establishments producing or trading in plant varieties in countries which have concluded with the Socialist Republic of Vietnam agreements on the protection of plant varieties."

**19. To amend and supplement Article 160 as follows:**

**"Article 160.** Distinctness of plant varieties

1. A plant variety will be considered distinct if it is clearly distinguishable from any other plant variety whose existence is a matter of common knowledge at the time of filing the application or the priority date, as the case may be.
2. Plant varieties whose existence is a matter of common knowledge defined in Clause 1 of this Article are those falling into one of the following cases:
  - a/ Their reproductive or harvested materials have been widely used in the market of any country at the time of filing of the protection registration application;
  - b/ They have been protected or registered in the list of plant varieties in any country;
  - c/ They are subject matters of protection registration applications or applications for registration in the list of plant varieties in any country, provided that these applications are not rejected."

**20. To amend and supplement Article 163 as follows:**

**"Article 163.** Denominations of plant varieties

1. The registrant shall designate with the state management agency in charge of rights to plant varieties a proper denomination for a plant variety which must be the same as the denomination already registered for protection in any country which has concluded with the Socialist Republic of Vietnam an agreement on the protection of plant varieties.
2. The denomination of a plant variety shall be considered proper if it is distinguishable from those of other plant varieties of common knowledge in the same or similar species.
3. Denominations of plant varieties shall be considered improper in the following cases:
  - a/ They consist of numerals only, unless such numerals are relevant to characteristics or the breeding of such varieties;
  - b/ They violate social ethics;
  - c/ They may easily cause misleading as to features or characteristics of such varieties;

- d/ They may easily cause misleading as to identifications of the breeders;
  - e/ They are identical or confusingly similar to marks, trade names or geographical indications protected before the date of publication of protection registration applications of such plant varieties;
  - f/ They affect prior rights of other organizations or individuals.
4. Organizations and individuals that offer for sale or market reproductive materials of plant varieties shall use the denominations of such plant varieties as stated in their protection titles even after the expiration of the term of protection.
5. When denominations of plant varieties are combined with trademarks, trade names or indications similar to denominations of plant varieties already registered for sale offer or marketed, such denominations must still be distinguishable."

## **21. To amend and supplement Article 165 as follows:**

### **"Article 165.** Registration of rights to plant varieties

1. Organizations and individuals defined in Article 157 of this Law may file applications for registration of rights to plant varieties (below referred to as protection registration applications) directly or through their lawful representatives in Vietnam.
2. Organizations that satisfy the following conditions may provide services of representing rights to plant varieties in the capacity as rights-to-plant varieties representation service organizations:
  - a/ Being Vietnamese law-practicing businesses, cooperatives or organizations, scientific and technological service organizations which are lawfully established and operating, except foreign law-practicing organizations practicing in Vietnam;
  - b/ Having the function of providing rights-to-plant varieties representation services as stated in their business registration certificates or operation registration certificates (below collectively referred to as business registration certificates);
3. Heads of those organizations or persons authorized by heads of those organizations who satisfy the conditions specified in Clauses 4 and 5 of this Article may provide services of representing rights to plant varieties.
4. Individuals shall be allowed to provide services of representing rights to plant varieties when satisfying the following conditions:
  - a/ Possessing a rights-to-plant varieties representation service practice certificate;
  - b/ Working in a rights-to-plant varieties representation service organization.
5. Individuals who satisfy the following conditions will be granted rights-to-plant varieties representation service practice certificates:
  - a/ Being a Vietnamese citizen and having the full civil act capacity;
  - b/ Permanently residing in Vietnam;
  - c/ Possessing a university degree;
  - d/ Having personally conducted legal activities related to rights to plant varieties for five or more consecutive years, or personally examined various applications for registration of rights to plant varieties in a national or international office for rights to plant varieties for five or more consecutive years, or graduated from a training course on the law on rights to plant varieties as recognized by a competent agency;
  - e/ Being other than civil servants or public employees currently working in state agencies competent to establish and secure the enforcement of rights to plant varieties;
  - f/ Having passed an examination of the profession of representing rights to plant varieties, organized by a competent agency.

6. The Government shall specify lawful representatives for filing applications and rights-to-plant varieties representation service organizations."

**22. To amend and supplement Article 186 as follows:**

**"Article 186.** Rights of protection certificate holders

1. A protection certificate holder has the right to exercise or authorize others to exercise the following rights to reproductive materials of a protected plant variety:

- a/ To conduct production or propagation;
- b/ To process them for the purpose of propagation;
- c/ To offer them for sale;
- d/ To sell them or conduct other marketing activities;
- e/ To export them;
- f/ To import them;
- g/ To store them for conducting acts specified at Points a, b, c, d, e and f of this Clause.

2. Rights of a plant variety protection title holder provided for in Clause 1 of this Article are applicable to materials harvested from the illegal use of reproductive materials of a protected plant variety, unless the protection title holder does not exercise his/her rights to reproductive materials though having an opportunity to do so.

3. To prevent others from using the plant variety under Article 188 of this Law.

4. To pass by inheritance or bequeath or assign the rights to the plant variety under Chapter XV of this Law."

**23. To amend and supplement Article 187 as follows:**

**"Article 187.** Extension of rights of protection certificate holders

Rights of a protection certificate holder may be extended to the following plant varieties:

1. Plant varieties which originate mainly from the protected plant variety, unless such protected plant variety itself originates from another protected plant variety.

A plant variety is considered originating from a protected plant variety if such plant variety still retains the expression of the essential characteristics resulting from the genotype or combination of genotypes of the protected variety, except differences resulting from impacts on the protected variety;

- 2. Plant varieties which are not definitely distinct from the protected plant variety;
- 3. Plant varieties the production of which requires the repeated use of the protected plant variety."

**24. To supplement and supplement Article 190 as follows:**

**"Article 190.** Limitations on rights of plant variety protection certificate holders

1. The following acts are not regarded as infringements of rights to protected plant varieties:

- a/ Using plant varieties for personal and non-commercial purposes;
- b/ Using plant varieties for testing purposes;
- c/ Using plant varieties to create new plant varieties, except the case specified in Article 187 of this Law;
- d/ Using harvested materials of protected plant varieties by individual production households for self-propagation and cultivation in the next season on their own land areas.

2. Rights to plant varieties are not applicable to acts related to materials of protected plant varieties which have been sold or otherwise brought into the Vietnamese or foreign markets by protection certificate holders or their licensees, except the following acts:

- a/ Acts relating to further propagation of such plant varieties;
- b/ Acts relating to export of reproductive materials of such plant varieties to countries where the genera or species of such plant varieties are not protected, unless such materials are exported for consumption purpose."

**25. To amend and supplement Article 194 as follows:**

**"Article 194.** Assignment of rights to plant varieties

1. Assignment of rights to a plant variety means the transfer by the plant variety protection certificate holder of all rights to that plant variety to the assignee. The assignee will become the plant variety protection certificate holder from the date of registration of the assignment contract with a state management agency in charge of rights to plant varieties according to law-prescribed procedures.
2. In case rights to a plant variety are under joint ownership, the assignment of these rights to another person must be agreed upon by all co-owners.
3. The assignment of rights to a plant variety must be effected in the form of written contract.
4. The assignment of rights to a plant variety created with state budget funds complies with the Law on Technology Transfer."

**26. To amend and supplement Article 201 as follows:**

**"Article 201.** Intellectual property assessment

1. Intellectual property assessment means the use by organizations or individuals defined in Clauses 2 and 3 of this Article of their professional knowledge and expertise to assess and make conclusion on matters related to intellectual property rights.
2. Businesses, cooperatives, non-business units or law-practicing organizations, except foreign law-practicing organizations practicing in Vietnam which satisfy the following conditions may conduct intellectual property assessment:
  - a/ Having personnel and physical-technical foundations meeting law-prescribed requirements on assessment operations;
  - b/ Having the function of conducting intellectual property assessment as stated in their business registration certificates or operation registration certificates;
  - c/ Their heads or persons authorized by their heads possess intellectual property assessor cards.
3. Individuals who fully satisfy the following conditions may be granted intellectual property assessor cards by competent state agencies:
  - a/ Being a Vietnamese citizen and having full civil act capacity;
  - b/ Permanently residing in Vietnam;
  - c/ Possessing good ethical qualities;
  - d/ Possessing a university or higher degree in a profession relevant to domains in which an assessor card is applied for, having conducted professional activities in these domains for five or more years and passed a professional assessment examination.
4. State agencies competent to handle acts of infringing upon intellectual property rights may request intellectual property assessment when handling cases or matters they have accepted.
5. Intellectual property right holders and other related organizations and individuals may request intellectual property assessment to protect their legitimate rights and interests.
6. The Government shall specify intellectual property assessment organization and activities."

**27. To amend and supplement Article 211 as follows:**

**"Article 211.** Intellectual property right infringements subject to administrative sanction

1. Organizations and individuals that commit any of the following acts of infringing upon intellectual property rights shall be administratively sanctioned:

- a/ Infringing upon intellectual property rights which causes damage to authors, owners, consumers or society;
- b/ Producing, importing, transporting or trading in intellectual property counterfeit goods defined in Article 213 of this Law or assigning others to do so;
- c/ Producing, importing, transporting, trading in or storing stamps, labels or other articles bearing a counterfeit mark or geographical indication or assigning others to do so.

2. The Government shall specify acts of infringing upon intellectual property rights which shall be administratively sanctioned, sanctioning forms and levels, and sanctioning procedures.

3. Organizations and individuals that commit acts of unfair competition in intellectual property shall be administratively sanctioned under the competition law."

**28. To amend and supplement Article 214 as follows:**

**"Article 214.** Forms of administrative sanction and remedies

1. Organizations and individuals that commit acts of infringing upon intellectual property rights defined in Clause 1, Article 211 of this Law shall be compelled to terminate their infringing acts and imposed one of the following principal sanctions:

- a/ Caution;
- b/ Fine.

2. Depending on the nature and seriousness of their infringements, intellectual property rights-infringing organizations or individuals are also subject to either of the following additional sanctions:

- a/ Confiscation of intellectual property counterfeit goods, raw materials, materials and means used mainly for the production or trading of these intellectual property counterfeit goods;
- b/ Suspension for a definite time of business activities in domains where infringements have been committed.

3. In addition to the sanctions specified in Clauses 1 and 2 of this Article, intellectual property rights infringers are also subject to either or both of the following consequence remedies:

- a/ Compelled destruction or distribution or use for non-commercial purposes of intellectual property counterfeit goods as well as raw materials, materials and means used mainly for the production or trading of these intellectual property counterfeit goods, provided that the destruction, distribution or use does not affect the exploitation of rights by intellectual property right holders;
- b/ Compelled transportation out of Vietnamese territory of transit goods infringing upon intellectual property rights or compelled re-export of intellectual property counterfeit goods, as well as imported means, raw materials and materials used mainly for the production or trading of these intellectual property counterfeit goods, after infringing elements are removed from these goods.

4. Administrative sanctions and the competence to administratively sanction infringements upon intellectual property rights comply with the law on handling of administrative violations."

**29. To amend and supplement Article 218 as follows:**

**"Article 218.** Procedures for application of the measure of suspension of customs procedures

1. When persons requesting the suspension of customs procedures have fulfilled their obligations specified in Article 217 of this Law, customs offices shall issue decisions on suspension of customs procedures with regard to goods lots in question.

2. The duration of suspension of customs procedures is ten working days after the customs procedure suspension requester receives the customs office's notice of customs procedures suspension. In case the customs procedure suspension requester has a justifiable reason, this

duration may be prolonged but must not exceed twenty working days, provided that the requester deposits a security specified in Clause 2, Article 217 of this Law.

3. Upon the expiration of the duration specified in Clause 2 of this Article, if customs procedure suspension requesters do not institute civil lawsuits and customs offices decide not to accept the cases for handling of administrative violations of goods lot exporters or importers according to administrative procedures, customs offices have the following responsibilities:

a/ To continue carrying out customs procedures for goods lots in question;

b/ To compel customs procedure suspension requesters to compensate all the damage caused to goods lot owners due to their unreasonable requests, and pay expenses for the warehousing and preservation of goods as well as other expenses incurred by customs offices and other related agencies, organizations and individuals under the customs law;

c/ To refund to customs procedure suspension requesters the remaining security amount after the obligation of paying compensations and expenses specified at Point b of this Clause is fulfilled."

### **30. To amend and supplement Article 220 as follows:**

**"Article 220.** Transitional provisions

1. Copyright and related rights protected under legal documents which took effect before the effective date of this Law continue to be protected under this Law if they remain in the term of protection by that date.

2. Applications for registration of copyright, related rights, inventions, utility solutions, industrial designs, trademarks, appellations of origin of goods, layout-designs or plant varieties, which have been filed with competent agencies before the effective date of this Law, continue to be processed under legal documents effective at the time of their filing.

3. All rights and obligations conferred by protection titles granted under the provisions of law which are effective before the effective date of this Law and procedures for maintenance, renewal, modification, invalidation, licensing, ownership assignment, settlement of disputes relating to these protection titles are governed by this Law, except grounds for invalidation of protection titles which are subject to the provisions of law which are effective at the time of grant of these protection titles. This provision also applies to decisions on registration of appellations of origin of goods issued under the provisions of law which are effective before the effective date of this Law. State management agencies in charge of industrial property rights shall carry out procedures for the grant of geographical indication registration certificates for appellations of origin of goods.

4. Trade secrets and trade names which have been existing and protected under the Government's Decree No. 54/2000/ND-CP of October 3, 2000, on the protection of industrial property rights to trade secrets, geographical indications, trade names and the protection of the right to repression of industrial property-related unfair competition, continue to be protected under this Law.

5. From the effective date of this Law, geographical indications, including those protected under the Decree mentioned in Clause 4 of this Article, may only be protected after they are registered under this Law."

**Article 2.** To replace the phrase "Ministry of Culture and Information" with the phrase "Ministry of Culture, Sports and Tourism" in Clauses 2, 3 and 5, Article 11; Point a, Clause 2, Article 50; and Clause 4, Article 51 of Law No. 50/2005/QH11 on Intellectual Property.

### **Article 3.**

1. This Law takes effect on January 1, 2010.

2. The Government shall detail and guide the implementation of articles and clauses of this Law assigned to it, and guide other necessary contents of this Law to meet state management requirements.

This Law was passed on June 19, 2009, by the XIIth National Assembly of the Socialist Republic of Vietnam at its 5th session.

Chairman of the National Assembly

NGUYEN PHU TRONG

[End of Gazette and Newsletter]