

## PLANT PATENTS - THE FORGOTTEN PATENT

On September 16, 2011, President Obama signed into law the most comprehensive change to the U.S. patent law in over 60 years, the America Invents Act (“AIA”). The changes to U.S. patent laws were monumental and intended to bring U.S. patent laws more in line with the patent laws of the rest of the world. Unfortunately, plant patents, a forgotten aspect of U.S. patent law, was not addressed with AIA and were not brought in line with the rest of the world.

In the United States, a plant patent is a property right that protects asexually-reproduced plant varieties, including many ornamental plants, trees, vines, and fruit plants. A U.S. plant patent provides the owner of the plant patent the right for twenty years from the filing of a patent application to exclude others from making, using, offering for sale or selling the protected plant, or any of its parts, throughout the United States.

Plant patent protection is an interesting form of protection that is unique to the United States. In contrast to plant patent protection, many countries use various forms of Plant Breeders’ Rights for protection of plants, based on the International Union for the Protection of New Varieties of Plants (“UPOV”) treaties of 1972, 1978 and 1991. The scope of protection of a protected plant under UPOV is based on the treaty date that was signed and incorporated by each country.

While both U.S. plant patents and Plant Breeders’ Rights provide various levels of protection for a novel plant, there is one very important difference between the two that creates havoc for plant breeders in the United States and around the world. That is, under United States patent law, a plant patent application for a novel plant must be filed *within one year of the date the plant is first disclosed anywhere in the world*. For most breeders and companies, this disclosure usually consists of the first sale or offer for sale of the subject plant. The intent of this law is to promote the progress of science and useful arts, by securing for a limited time to inventors, the exclusive right to their respective discoveries. However, the laws of many countries *outside the United States* provide that an application for Plant Breeders’ Rights of a plant variety must be filed *within one year of the first sale of the variety in that country or four years or, in the case of trees or of vines, six years from the date of first sale outside of that country*.

This discrepancy between the timing for filing of a U.S. plant patent versus the timing for filing a Plant Breeders’ Rights application can potentially cause major financial concerns for the breeder of the new plant variety. For example, for many plant breeders developing new plants outside the United States, there is a need to fully test and validate the viability of a plant before actually investing their time and money into introducing, marketing and selling a new plant variety in their country or internationally. It is not uncommon to hear about plant breeders spending 7 to 10 years developing a new plant, shrub or tree outside of the United States. As these breeders develop the new plant, the breeder also spends a massive amount of money testing the viability of the plant in their specific country to determine if there may be a valid market for the plant. In some cases, the breeder does not have the additional resources available to

test the plants in their country of origin, as well as in the United States. This may put the plant breeder in a difficult situation. If the breeder sells the new plant variety outside the United States, then the breeder must file a U.S. plant patent application within one year of that first sale of the plant anywhere outside the United States. The plant breeder may have little or no information available at the time of first sale outside the United States to determine if the plant will succeed in the United States commercial market, but unfortunately U.S. plant patent laws require that the plant breeder make this costly and potentially risky decision within this stringent time frame.

Thus, if the breeder proceeds with a U.S. plant patent and the testing of the new plant in the United States is not successful, then the breeder may have wasted thousands of dollars on the U.S. plant patent with no returned financial or intellectual property value. If the breeder decides not to proceed with a U.S. plant patent, then they potentially risk the new plant variety becoming a commercial success in the United States without intellectual property protection of a U.S. plant patent.

This is a decision that a plant breeder should not have to make in this limited time frame, and is a decision which many countries outside the United States allow a breeder more time to make. The U.S. plant patent laws should be changed to allow a plant breeder a time frame of four years or, in the case of trees or of vines, six years from the first date of sale outside of the United States to make a decision as to whether they want to proceed with filing a U.S. plant patent application. Additionally, the one year rule for filing a U.S. plant patent application should be limited to disclosures and sales that take place in the United States and not anywhere in the world.

These changes in the timing of filing a U.S. plant patent application would allow plant breeders and owners more time to test and analyze a new plant before deciding whether they wish to pursue a U.S. plant patent application. In the end, these changes may actually increase the number of U.S. plant patent applications filed because it would provide breeders more time to trial and strategize their potential pursuit of intellectual property protection.

The intent of the AIA was to bring U.S. patent laws more in harmony with the patent laws of the rest of the world. However, the AIA failed to address U.S. plant patents and moreover, failed to bring U.S. plant patent laws more in line with the plant protection laws of the rest of the world, specifically with the Plant Breeders' Rights laws that are predominantly used outside the United States. Changing the U.S. plant patent novelty requirements to conform with the novelty laws of the rest of the world will not harm the original intent for the promotion of the progress of science and will allow a breeder to gain valuable information regarding the potential commercial success of their plant. Increasing a breeder's comfort level in their novel plant, as well as their comfort in filing a new U.S. plant patent application will only further increase the number of U.S. plant patents filed – a win-win for both the breeder and the United States Patent and Trademark Office.

## **About the Writers**

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