

From: Judith de Roos [mailto:UXXfYgg`fYXUWhYX]  
Sent: Tuesday, March 27, 2012 9:46 AM  
To: ai\_a\_implementation  
Subject: First-Inventor-to-File (Before Proposed Rules)

Dear Sir, Madam,

Plantum is the Dutch association for companies active in plant breeding, propagation, production and the trade of both seeds, bulbs, tubers, cuttings and young plants and represents. Plantum has approximately 400 members in both the horticultural as agricultural sector.

Breeders of vegetatively reproducible species (with the exception of tubers) can protect their plant varieties by a Plant Patent as stipulated in U.S.C. Title 35, Chapter 15. The Dutch breeding companies account for approximately 30% of the Plant Patent applications from non-US residents. The implementation of the Leahy-Smith America Invents Act is therefore of great importance to our breeders. The interpretation of the new Section 102 has our particular attention.

Need for a clear interpretation of the new Section 102  
First of all there is an urgent need for a clarification as regards the interpretation of article 102 (a) and (b). As the Leahy-Smith America Invents Act will be of effect from March 16th 2013, this means that in regard to article 102 (b) (1) which provides for exceptions for disclosures made one year or less before the effective filing date, it seems that all acts performed after March 16th 2012 can already damage the novelty period of future applications that are to be filed after March 16th 2013. Nonetheless, at this moment our breeders do not have legal certainty about the impact that their current actions might have on the novelty of future applications.

Under the current Section 102 (b) the novelty period is damaged if the invention was patented or described in a printed publication or in public use or on sale, more than one year prior to the date of the application.

Under the new Section 102 (a) the same novelty damaging acts are stipulated, but with the addition of the act of making the invention "otherwise available to the public". It seems therefore that the scope of the acts that can be considered as damaging the novelty has been broadened. We would like to obtain guidance as to the exact meaning of this last criterion as well as to the total scope of acts that can be considered as novelty damaging.

The new Section 102 also makes a deviation between the acts that can as such be considered as novelty damaging under sub (a) and the

exception to that general rule for the "disclosures" made 1 year or less before the effective filing date under sub (b). We would like to get confirmed that the "disclosures" mentioned under sub (b) are actually all acts covered under sub (a) and that therefore there is under the new Section 102 still the Grace period of one year in place for all acts with the variety which are performed by or with the consent of the breeder.

Most of all our breeders would like to have a clear and unambiguous explanation of the new legislation on the points mentioned above. Nevertheless, we would like to make use of this opportunity to express a few wishes in regard to the novelty provision.

#### Specific wishes of plant breeders

For breeders of sexually reproducible species the United States offers protection to new plant varieties through the Plant Variety Protection Act of 1970 in which the International UPOV Convention version of 1991 has been implemented. Breeders of asexually reproducible species (with the exception of tubers) can only protect their new plant varieties through the Plant Patent system in U.S.C. Title 35, Chapter 15 as the PVP Act is explicitly excluding asexually reproducible species (with the exception of tubers). There are some considerable differences between both systems, also in respect to the novelty.

As for the novelty of plant varieties we would like to note that the publication of a written description of the variety will not enable the public in any way to make use of that plant variety. A plant variety can never be reconstructed without the availability of the plant material. It is therefore, that the concept of novelty that is enshrined in the UPOV Convention of 1991, stipulates that the material has not been sold or otherwise disposed of to others for purposes of exploitation of the variety. Furthermore the novelty period in the PVP-system is four years for all acts with the plant material outside the territory of the application. The reason for this lies in the fact that plant varieties are living material that interact with their environment. The value of a variety can only be assessed after it has been in commercial production with some growers and introduced to the market, which takes several years. Breeders in Europe logically want to do this in their own region after which those varieties that prove to be of commercial value are protected and marketed in all other countries.

Because the Plant Patent Act is integrated in U.S.C. Title 35 Chapter 15, we realise that it is difficult to deviate the novelty requirements for Plant Patents from all other Patents in order to bring them more in line with the provisions of the UPOV 1991 Convention. Still, we hope that when implementing the Leahy-Smith America Invents Act, the specific interests and needs of the applicants of Plant Patents will be taken into account.

Respectfully submitted,

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