

Contrasting Utility Patents, Plant Patents, and PVP

Type of IP	Scope of Coverage	Exceptions to Coverage	Scope of Protection	Limits to Protection
Utility Patent	Any useful, novel, nonobvious invention (note: judicial exceptions under 35 U.S.C. § 101 not patentable subject matter)	Judicial exceptions: 1. laws of nature, 2. natural phenomena, 3. abstract ideas USPTO Guidelines are helpful	Exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States (20 years from filing date)	Broad protection
Plant Patent	Any distinct and new variety of plant that has been asexually reproduced	Tuber propagated plant Plants found in an uncultivated state	Exclude others from asexual reproduction (20 years from filing date)	Only protects against asexual reproduction
Plant Variety Protection (PVP) aka Plant Breeder's Rights	Any new, distinct, uniform, and stable ("DUS") plant	A plant that does not meeting the new and DUS criteria	Exclude others from selling, importing, etc. (20 years from certificate issuance, 25 years for vines and trees)	Research exemption allowing use for breeding to develop a new variety Farmer's exemption allowing saving of seed for replanting farmer's land

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Patent Basics

- Normal filing route (patents) = provisional patent application → international and/or U.S. utility patent application and/or foreign application
- Utility and plant patents provide exclusive rights for 20 years from the original non-provisional patent application filing date
 - claims can be pursued as long as there is a pending application in that patent family
 - one year term of provisional patent application not included in 20 years
- PVP provides exclusive rights for 20 years (or 25 years for trees and vines) from date of certificate issuance

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Where to File for IP Protection

- Where protection is available
 - where invention is patentable subject matter
 - where applicable grace period has not expired
- Where the invention will be sold
- Where the invention will be produced
- Where partners & investors want it protected
- Where you can afford it (costs add up quickly!)
- Where you can enforce it

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Where to File for IP Protection

United States:

- Offers the most options
 - Utility patents
 - Plant Patents
 - Plant Variety Protection
- Broad claim scope available with utility patents
 - plant varieties, methods of plant breeding, recombinant products and methods . . .
- Allows more than one type of IP for a single invention

Rest of the world:

- Two basic options
 - Utility patents
 - Plant Breeder's Rights (Plant Variety Rights, PVRs)
- More limited claim scope available with utility patents
 - varies considerably by country
- Generally only one type of IP for a single invention

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Example: Fruit Tree Rootstock Variety Protection

- **United States**

- The variety can be protected by PVPC based on seed propagation of the rootstock.
- The variety can be protected by a Plant Patent based on tissue culture propagation of the rootstock.
- The variety can also be protected by a Utility Patent.



- **Europe**

- The variety's protection is likely limited to Plant Breeder's Rights.
- Options are available in the EP, but the individual variety can't be claimed. See, e.g. G1/98 decision and Broccoli and Tomato cases I and II.



Source: USDA Invention Licensing and Plant Variety Protection, June Blalock and Marion Ravelonandro

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IP in the Field and Marketplace

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When are public use, sale, and/or offer for sale “prior art” to patent applications?

Pre-America Invents Act

- **Domestic** public use, sale, offer for sale **one year before** filing date of the patent application

America Invents Act

- **World-wide** public use, sale, offer for sale **before** filing date of the patent application



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When are public use, sale and/or offer for sale “prior art” to patent applications?

Our company demonstrated an invention at a tradeshow in Canada or sold the invention in Canada (or other foreign country) before a patent application was filed. Does the demonstration or sale affect our U.S. patent rights?

Yes, unless a patent application is filed within *one year* of the demonstration or sale, the subject matter of the demonstration or sale will be prior art. Note that this result is a change from the pre-AIA law under which a public use or sale of an invention has to occur in the United States to qualify as prior art.



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When are public use, sale and/or offer for sale “prior art” to Plant Variety Protection applications?

What if I've already sold seed of my variety but would still like to have it protected?

As long as you have not sold seed of the variety, offered or advertised it for sale for more than 1 year in the United States, prior to the date your application is filed at PVPO, your variety is still eligible for protection. You have more than one year of eligibility if the variety has only been sold in a foreign country. That time would be 4 years for most crops, and 6 years for a tree or vine.

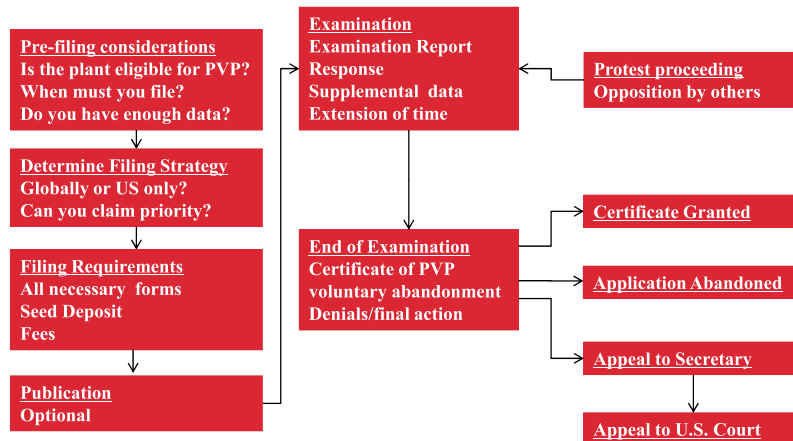
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PVP Basics in the U.S.

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US PVP Application – What to expect

PVP Act and Regulations and Rules of Practice



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US PVP Application – Several Things

- **Pre-filing Consideration**
 - Sexually (seed) reproduced, tuber propagated, and F1 hybrids
 - New, distinct, uniform, and stable
 - Has not been sold or otherwise disposed of to others for
 - ✓ more than 1 year in US
 - ✓ more than 4 years outside US
 - Description of plant (depending on variety): www.ams.usda.gov/services/plant-variety-protection/pvpo-c-forms
 - Proper "prior art" plant for comparison
- **Filing Strategy**
 - Global v. US
 - May claim priority
- **Filing Requirements**
 - All forms are available online (PVP Office)
 - Make seed deposit within 3 months from filing
 - \$4382 filing and examination fees
- **Examination**
 - Amendment is possible or even required
 - Could last several rounds
 - May need to perform additional field trial
 - Can request extension of time for good cause
 - Show: new, distinct, uniform, and stable
 - Data must be statistically significant
 - At least two independent trials
 - Molecular markers are acceptable (but must be associated to distinctive phenotype)
- **Certificate**
 - Protection for 20 years
 - Limited rights compared to patents
 - Can mark product with PVP certificate info.
- **Infringement**
 - Activities defined in Sec. 111(a) of PVP Act
 - Several exemptions apply (Sec. 111(c) to Sec. 115 of PVP Act)

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THANK YOU

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