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Subject: RE: PGR2024-00019
Date: Thursday, October 24, 2024 8:45:32 PM
Attachments: image001.png
image002.png
image003.png

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Director Vidal,

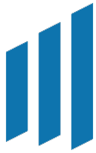
Petitioner provides this notification email in accordance with the Revised Interim Director Review Process, and hereby respectfully request Director Review of the denial of institution in the above captioned PGR (concurrently uploaded to P-TACTS). The denial presents an issue of first impression that impacts important issues of law and policy relative to plant utility patents.

Petitioner presented prior art teachings in its PGR petition that rendered obvious the plant variety claimed in U.S. Patent 11,659,803. Rather than consider that art by applying the same patentability analysis used in initial examination (concerning the phenotype of the variety as disclosed in the '803 Patent's specification), the Board found that it was excused because the Petitioner's ***section 103*** analysis had not sequenced the genotype of the seed deposit PO had made to satisfy ***section 112*** and which PO itself acknowledges to be a non-limiting "exemplary embodiment." That is, the Board created a new patentability test only applied post-grant in which seed deposit genotype analysis is required for the first time. The Board held that "Petitioner's lack of evidence in the prior art regarding 1PFLQ21's genotype" excused it from further analysis, reasoning that "[b]y depositing the seeds" PO had made such "genetic sequence…available." To overcome this new presumption potential challengers must access seed deposits and perform seed analysis that would wrongly subject potential challengers to the risk of patent infringement merely in seeking to overcome the Board's heightened new standard. *Corteva Agriscience LLC v. Inari Agric., Inc.*, No. CV 23-1059, 2024 WL 3653040, at *11 (D. Del. Aug. 2, 2024)

The agency has no power to legislate a new post-grant patentability analysis at all let alone one unique to a technology. Left to stand, this decision improperly adds a new presumption of patentability that is unique to plant utility patents at a time when both the agency and USDA have recognized significant abuses in the plant patent space. Requiring the public to analyze seed deposits as a threshold prerequisite for a viable patentability challenge "unnecessarily reduce[s] competition in seed…markets beyond that reasonably contemplated by the Patent Act"—notwithstanding Executive Order 14036's mandate that the PTO and USDA collaborate to ensure that the patent system does ***not*** unnecessarily reduce such competition. 86 Fed. Reg. 36987, 36993 (July 14, 2021). This decision creates yet another obstacle for American farmers. Indeed, rather than serving as an alternative to litigation, this decision forces litigation liability onto any member of the public seeking to challenge such patents before the PTAB.

Respectfully Submitted.

Scott McKeown
Lead Counsel
Inari Agriculture



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