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Subject: RE: PGR2024-00020
Date: Thursday, October 24, 2024 8:47:11 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 11,666,020. But these positions were never considered as Patent Owner leveraged a clear mistake made during prosecution. That is, prior to issuance, the examiner mistakenly permitted the Patent Owner to deny a Rule 105 request for necessary examination information (i.e., the identification of an undisclosed parent) as “proprietary” despite well-established examination guidelines to the contrary. (Ex. 1033). And then when faced with the instant PGR petition, Patent Owner insisted that the claimed variety’s lineage made it **impossible** to establish obviousness given that “one-half of the parentage of 1PFHC43 is nowhere in the prior art.” The Board applied the same reasoning in rejecting the petition explaining that petitioner had “only identified one parent.”

Nowhere did the Board address the necessary implications of its flawed logic—that is, allowing plant breeders to obtain utility patent protection as a matter of right merely by combining prior art patents with trade secrets. The decision permits plant breeders in essence to **register** for utility patent protection merely by combining trade secrets (withheld from the PTO) with indisputable prior art—regardless of whether such work was inventive. If left to stand, this decision will be liberally cited going forward whenever patent examiners seek such necessary lineage information (the agency is entitled to). Indeed, such practices as this have compelled the USDA’s urgent recommendation to the agency earlier this month (October 8, 2024), to consider requiring disclosure of “breeding histories or pedigrees back to known and **publicly available parents**” as part of the original disclosure “for utility patents pertaining to plant varieties and traits.” In this instance the PTO **already** asked for the necessary information and was denied. As examiners look to the PTAB for guidance on such topics, it is imperative to U.S. farmers that this decision be reversed

Respectfully Submitted.

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PGR2024-00020
Ex. 3100



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