Disclaimer: unless otherwise agreed by the Council of UPOV, only documents that have been adopted by the Council of UPOV and that have not been superseded can represent UPOV policies or guidance.

This document has been scanned from a paper copy and may have some discrepancies from the original document.

———

Avertissement: sauf si le Conseil de l'UPOV en décide autrement, seuls les documents adoptés par le Conseil de l'UPOV n'ayant pas été remplacés peuvent représenter les principes ou les orientations de l'UPOV.

Ce document a été numérisé à partir d'une copie papier et peut contenir des différences avec le document original.

———

Allgemeiner Haftungsausschluß: Sofern nicht anders vom Rat der UPOV vereinbart, geben nur Dokumente, die vom Rat der UPOV angenommen und nicht ersetzt wurden, Grundsätze oder eine Anleitung der UPOV wieder.

Dieses Dokument wurde von einer Papierkopie gescannt und könnte Abweichungen vom Originaldokument aufweisen.

———

Descargo de responsabilidad: salvo que el Consejo de la UPOV decida de otro modo, solo se considerarán documentos de políticas u orientaciones de la UPOV los que hayan sido aprobados por el Consejo de la UPOV y no hayan sido reemplazados.

Este documento ha sido escaneado a partir de una copia en papel y puede que existan divergencias en relación con el documento original.

UPOV

C/XVIII/9
ORIGINAL: French
DATE: July 12, 1984

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

COUNCIL

Eighteenth Ordinary Session
Geneva, October 17 to 19, 1984

PROGRESS REPORT ON THE WORK OF THE ADMINISTRATIVE AND LEGAL COMMITTEE

prepared by the Office of the Union

1. Since the seventeenth ordinary session of the Council, the Administrative and Legal Committee (hereinafter referred to as "the Committee") has held two sessions: its twelfth, on November 7 and 8, 1983, and its thirteenth, on April 4 and 5, 1984.

2. The work of the Committee has mainly consisted in preparing, at its twelfth session, and following up, at its thirteenth session, the first meeting with international organizations, held on November 9 and 10, 1983. Three subjects had been entered on the agenda for that meeting:

(i) Minimum distances between varieties;
(ii) International cooperation;
(iii) UPOV recommendations on variety denominations.

These topics will serve as a basis for describing the work of the Committee.

Minimum Distances Between Varieties

3. The matter examined under this heading is the distance that ought to exist between, for example, a "variety" for which protection is requested and an already existing well-known variety, in terms of differences in one or more "important" characteristics, in order that protection may be granted to the former. It has recently taken on considerable importance as a result, in particular, of the acceleration in plant breeding work and the use of techniques for creating varieties such as the exploitation of natural or induced mutations and of back crosses (resulting in material being bred that differs only very slightly from other material) and from the progress achieved in examination techniques (enabling both a larger number of differences and finer differences to be found).

4. In preparation for the meeting with the international organizations, the Committee pursued at its twelfth session its examination of the legal aspects having a connection, whether close or not, with the problem of minimum distances between varieties. Their conclusions are reproduced in the annex to this document. The Committee held that those conclusions could be considered an expert opinion, which was not of course binding in any way on the administrative and judicial authorities. As far as the United States of America was concerned, the Committee noted that that country applied Article 37 of the 1978 Act of the Convention and that the legal situation could in some cases differ from that prevailing in the other member States.

5. The Committee examined with great care the question of offer for sale and marketing in relation with the novelty concept, particularly in the case of hybrids and their parent lines. The Committee noted a study submitted by the Office of the Union, it not having been possible to reach a consensus on the importance of that problem.

6. At its thirteenth session, the Committee carried out an evaluation of the results of the Meeting with International Organizations. In a general way, it felt that the discussions had not been particularly open and that it should therefore be proposed to the Council that future meetings of that type take the form of a discussion between representatives of the member States and of UPOV and representatives of the international organizations, and should no longer constitute a hearing. It also considered that, unless the Council should decide otherwise, the documentation relating to the 1983 meeting should only be given limited distribution to the authorities and to the participants at the meeting.

7. From an administrative and legal point of view, the Committee noted that problems could arise in respect of minimum distances between varieties, but that in any event those should be solved on a species-by-species basis. It concluded that there was basically no reason to modify or supplement the current interpretation given to the concepts used in the Convention to describe minimum distances, particularly the provision that "the variety must be clearly distinguishable by one or more important characteristics from any other variety whose existence is a matter of common knowledge at the time when protection is applied for." In particular, a characteristic was to be considered "important" once it was "important for distinguishing the variety" whether or not it was additionally a functional characteristic.

8. The Committee is to continue its examination of the conclusions to be drawn from the meeting with the international organizations on the basis of the discussions in the Technical Committee on a number of items that also fell within the purview of that Committee.

International Cooperation

9. From the meeting with the international organizations there emerged three series of questions examined by the Committee at its thirteenth session. The following conclusions were reached:

(i) International cooperation in the future. - Realistic thinking demanded that the current policy be continued, that is to say concluding bilateral agreements for cooperation in examination on the basis of a UPOV model agreement. The replacement of the network of bilateral agreements by a multilateral agreement would indeed encounter a number of problems resulting, in particular, from the differences existing between the current agreements. On the other hand, the introduction of centralized filing of applications should be envisaged as soon as possible. Moreover, the granting of a title of protection by one State for a number of States and the automatic acceptance of titles granted in another State appeared problematic and would not seem to offer any great additional advantages over centralized application and examination. Such possibilities could, however, prove of interest to a small country, such as Luxembourg, where they had in fact been proposed.

(ii) National legislation and cooperation in examination. - A general stance could not be taken at international level on whether a breeder had the right to request a purely national examination instead of an examination carried out by another State within the framework of cooperation. Indeed, the matter depended on national law, on the situation as regards examination (some States did not examine certain species or no longer did so) and possibly on the circumstances of the individual case. Moreover, the four-year period laid down by Article 12(3) of the Convention for supplying additional documents and material did not constitute a restraint on international cooperation. Indeed, it only applied where such documents or material were necessary and did not comprise a right for the breeder to have the decision postponed at his request.

(iii) Limited groups of States. - The question had been put, in particular, as a result of the expansion of the Union. UPOV now included States on the five continents, subject to climatic conditions that differed greatly, of which some were additionally members of regional economic unions. As a result, there were fields well suited to initiatives and activities pursued within restricted groups of member States. Three considerations had been advanced in that context:

(a) It was preferable that matters concerning plant variety protection be examined within the framework of UPOV even where those same problems also arose in other fields, as was the case for the examination of distinctness, homogeneity and stability (also carried out in respect of the entry in national catalogues of varieties authorized for marketing). UPOV was indeed better placed for consultations between all of the member States and coordination between them than were bodies that were either more restricted or had more general tasks.

(b) Nothing prevented the setting-up of limited groups of States having the same problems. On the contrary, Articles 29 and 30(ii) of the Convention foresaw the conclusion of special agreements for the protection of new varieties of plants and individual contracts with a view to the joint utilization of the services of the authorities entrusted with the examination of varieties. It was, however, essential that such groups should inform the other States of their intentions so as to enable them to participate in the best possible way if they so wished since it was much easier to amend a project than to change a decision or a final text if the need was then felt.

(c) It did not seem at all necessary to set up new limited groups. A better solution would be to draw up agendas for the session of bodies of the Union on which matters of special interest to certain States would be grouped together. This would enable the different States, particularly those distant from the headquarters of UPOV or from the venue for the meeting concerned, to decide more easily on the advisability of being represented at the meeting and, therefore, to participate more actively and more effectively in the work of the Union.

10. At its twelfth session, the Committee decided that UPOV would undertake a pilot project of centralized examination of proposed variety denominations. Various detail matters were settled at the thirteenth session. The project was to be carried out by the Office of the Federal Republic of Germany in respect of begonia elatior and by the United Kingdom Office for chrysanthemum. Once the project was operational, both of those Offices would carry out a complete examination of the denominations proposed by the other Offices participating in the project. Examination would concern all criteria of denomination suitability within the limits of the practical possibilities of the executing Office. For instance, it was not possible to check denominations against trademarks except by reference to the national file.

11. At its twelfth session, the Committee also noted the contents of the variety denomination data banks used in each member State as a comparison basis for the examination of proposed denominations. The majority of the Committee agreed that in the event of identity or similarity of two proposed denominations, priority should be given to the denomination with the earliest filing date (or the earliest utilization date, where relevant, for example, where the legislation of the State in question provided for a "period of grace" and where the breeder had availed himself of that period).

12. At its thirteenth session, the representatives of five member States, that is to say Denmark, France, the Federal Republic of Germany, the Netherlands and the United Kingdom, submitted draft improved versions of the UPOV Model Agreement for International Cooperation in the Testing of Varieties and the Model Form for the Application for Plant Breeders' Rights. The Office of the Union had added a similar draft in respect of the Model Form for the Application for a Variety Denomination. The Committee was in fact requested to review the proposed drafts and to submit the revised model agreement and forms to the Council for adoption. These texts are given in document C/XVIII/9 Add.

13. At its thirteenth session, the Committee also reviewed application by the member States of the UPOV Recommendation on Fees to be Paid in Relation to Cooperation in Examination.

UPOV Recommenations on Variety Denominations

14. At the Meeting with International Organizations, the opinions expressed by the breeders' organizations were not entirely new. However, it appeared that those organizations, or at least most of them, were not opposed to the principle of drafting recommendations but only criticized certain points in the text submitted to them, which were too inflexible in their view. Furthermore, the comments made by AIPH showed clearly that some form or other of recommendation was necessary in the interests of the users of varieties.

15. At its thirteenth session, the Committee agreed on the basis of its preceding considerations that of the various solutions available (maintaining the former Guidelines for Variety Denominations, application of the International Code of Nomenclature of Cultivated Plants, new recommendations), a text based on the Recommendations on Variety Denominations would be best able to reconcile the needs and interests of all parties. It entrusted a small drafting committee with the finalization of the Recommendations for submission to the Council for adoption. The Recommendations are contained in document C/XVIII/9, Add.2.

16. At the meeting with the international organizations, the question had been asked whether the system of references recommended by CIOPORA was acceptable for variety denominations. According to the documents received by UPOV in 1970, the system consisted in associating the first three letters of the breeder's name, in capitals, with arbitrary syllables, four or five numerals and the abbreviation of the name of the country of origin of the variety. At its thirteenth session, the Committee held that there was no need to examine that system but agreed to enter it on the agenda for its following session should the need be felt.

Biotechnology and Plant Variety Protection

17. At its thirteenth session, the Committee held an initial exchange of views, based on a study undertaken by the Office of the Union, on the implications of biotechnology, particularly plant genetic engineering, in respect of variety protection. The main purpose of the exchange of views was to prepare for the symposium that is to be held on October 17, 1984, in connection with this session of the Council.

Program of Future Work

18. Subject to the decisions of the Council, the program of future work will be as follows:

(i) The Committee will complete the work mentioned above where such is not already the case;

(ii) The Committee will monitor and evaluate the pilot projects set up in respect of centralized examination of variety denominations (see paragraph 12 above) and the simplified examination of mutants submitted by the breeder of the parent variety, which differ from that variety in one or more characteristics entered on an exhaustive list (system reported to the seventeenth session of the Council--see paragraph 9 of document C/XVIII/9);

(iii) The Committee will evaluate the results of the symposium held in connection with this session of Council;

(iv) The Committee will examine from an administrative and legal point of view the matter of cooperation in examination between States subject to greatly different climatic conditions (meaning that some varieties can have differing behavior in those States, corresponding to differing descriptions);

(v) The Committee will examine the harmonization of the lists of protected species.

19. The Council is requested:

(i) to take note of the work done by the Committee and of the results it has achieved;

(ii) to adopt the UPOV model Agreement for International Cooperation in the Testing of Varieties and the Model Forms for the Application for Plant Breeders' Rights and for the Application for a Variety Denomination, given in the annexes to document CAJ/XVIII/9 Add.;

(iii) to adopt the UPOV Recommendations on Variety Denominations given in Annex I to document CAJ/XVIII/9 Add.2;

(iv) to take the necessary decisions on the future work of the Committee.

[Annex follows]

C/XVIII/9

ANNEX

LEGAL ASPECTS OF THE QUESTION OF MINIMUM DISTANCES BETWEEN VARIETIES

Conclusions Reached of the Administrative and Legal Committee

I. DISTINCTNESS

Article 6 (1)(a) of the UPOV Convention:

"Whatever may be the origin, artificial or natural, of the initial variation from which it has resulted, the variety must be clearly distinguishable by one or more important characteristics from any other variety whose existence is a matter of common knowledge at the time when protection is applied for. Common knowledge may be established by reference to various factors such as: cultivation or marketing already in progress, entry in an official register of varieties already made or in the course of being made, inclusion in a reference collection, or precise description in a publication. The characteristics which permit a variety to be defined and distinguished must be capable of precise recognition and description."

1. When is a variety "another variety" in the meaning of the above provision? Does a variety that is identical or almost identical with the variety the subject of an application for protection, but that has been bred independently by someone else ("parallel breeder"), belong to the variety the subject of an application for protection or is it "another variety"?

In Article 6, variety is taken to mean the plant material, bred by the applicant for protection, on which the application is based. Identical or almost identical material produced by another breeder--independently of the applicant--certainly constitutes material of the same variety in a botanical sense but nevertheless represents an "other variety" for the purposes of Article 6(1)(a) of the Convention. If the "existence" of the material representing the "other variety" is already "common knowledge" at the time protection is applied for, the application must be refused for lack of distinctness. Similarly, the notion of "variety" is also to be interpreted in the same way in the other subparagraphs of Article 6: the question whether the "variety" has already been offered for sale or marketed, and whether it is homogeneous and stable, is examined solely on the basis of the plant material bred by the applicant for protection.

2. What conditions must be fulfilled by the "other variety"? Must the "other variety" with which the variety the subject of an application for protection has to be compared when the latter is tested for distinctness be a "finished" variety, that means a variety that is sufficiently homogeneous, or can it be a plant population that does not--yet--fulfill the requirements for homogeneity (a so-called "quasi-variety", as for instance are most of the varieties distributed by CIMMYT)?

The "other variety" must not necessarily be "finished," that is to say meet the standards set for the protection of new plant varieties in the member State of the Union concerned (these standards are often identical with those set in other fields of law such as the regulations on production and trade in seed and seedlings). In the case of the "other variety," this must be material which already fulfills the usual criteria accepted by the trade for the notion of variety; in particular, the variety must at least be able to be described as such.

3. What conditions must be fulfilled by the "other variety" for it to be able to be considered as a matter of common knowledge on the basis of a "precise description in a publication"? Is a description by the breeder, published or submitted to the plant variety protection office, sufficient? In the case of a hybrid variety, is it sufficient to indicate the formula if the parent lines are a matter of common knowledge, or are there additional conditions that have to be fulfilled? If so, what are they (must it be certain that the "other variety" does not only exist on paper)?

The Convention requires the "existence" of the other variety to be a matter of common knowledge. Unless a sample of the variety in question may be made available to the plant variety protection office, a breeder's description published or handed to that office or a statement of the formula for a hybrid are not sufficient to make the existence of the variety in question a matter of common knowledge.

4. What conditions have to be fulfilled by a characteristic for it to be used in testing for distinctness?

(a) Should the decision be taken species by species, account being taken of the development of plant breeding? If not, what common rules can be established?

(b) Should characteristics be considered that are not "capable of precise recognition" without means that are not normally available to:

(i) breeders

(ii) plant variety protection authorities?

(c) Before taking into account a new characteristic (i.e. a characteristic that is not yet included in the list of characteristics), must it be assured that to do so will not lead to a disturbance of the system of plant variety protection for the species in question, for instance by encouraging grants of plant breeders' rights that would prejudice rights already granted? What criteria are to be taken into account?

(a) The decision can only be taken on a species-by-species basis.

(b) Generally speaking, a characteristic may be used once the following conditions are met:

(i) It must be adapted to the needs of distinctness testing, that is to say meet the requirements of Article 6(1)(a) of the Convention (it must be important, it must enable the varieties to be defined and distinguished, and must be capable of being precisely recognized and described);

(ii) It must be known to science, to the plant variety protection office and to plant breeding circles;

(iii) It must be reliable;

(iv) It must be usable under reasonable economic conditions;

(v) It must give a result within a reasonable period of time (compatible with the aims pursued by plant variety protection).

(c) As a principle, no breeder holding protection of a variety may claim that the list of characters examined for the purpose of distinctness be frozen at that used in deciding on the grant of his title.

II. NOVELTY

Article 6 (1)(b) of the UPOV Convention:

"At the date on which the application for protection in a member State of the Union is filed, the variety

(i) must not - or, where the law of that State so provides, must not for longer than one year - have been offered for sale or marketed, with the agreement of the breeder, in the territory of that State, and

(ii) must not have been offered for sale or marketed, with the agreement of the breeder, in the territory of any other State for longer than six years in the case of vines, forest trees, fruit trees and ornamental trees, including, in each case, their rootstocks, or for longer than four years in the case of all other plants.

Trials of the variety not involving offering for sale or marketing shall not affect the right to protection. The fact that the variety has become a matter of common knowledge in ways other than through offering for sale or marketing shall also not affect the right of the breeder to protection."

1. What is covered by the expression "the variety" in the meaning of the above provision? Is it detrimental to novelty in the meaning of the above provision if material that is identical with the variety, but that has been developed independently by someone other than the breeder/applicant ("a parallel breeder"), is offered for sale or marketed (please note the connection with question I.1 above)? If the answer to this question is positive, whose agreement must have been given for the activity to be detrimental to novelty; that of the breeder of the variety the subject of an application for protection or that of the "parallel breeder"?

The fact that, at the time of filing an application for protection, someone else has already offered for sale or marketed material he has bred himself and which is identical to the material on which the application for protection is based has to be examined from the point of view of distinctness under Article 6(1)(a) of the Convention and not from that of novelty under subparagraph (b). If, as should be the rule, the "existence" of someone else's material has become "common knowledge" through offering for sale or marketing, the application that is later than that event and is based on identical material must be refused for lack of distinctness in relation to the "other variety."

The second question above does not apply.

2. Is offering for sale or marketing detrimental to novelty if it takes place at a time at which the variety is not yet "finished" and is thus still a "quasi variety" (see question I.2 above), not yet completely fulfilling the conditions for homogeneity?

Yes, where the material offered for sale or marketed can be defined as a variety. An important consequence of this event is the fact that the breeder who has marketed the material during the time between filing the application for protection and the refusal of the application for lack of homogeneity, foregoes the possibility of protection of the variety derived from such material by "purification."

3. Is the offering for sale or marketing of a hybrid variety detrimental at the same time to the novelty of the parent lines?

No. The case in which possession of lines is transferred (for example, under a growing contract) must be analyzed from the point of view of offering for sale or marketing of such lines.

III. SCOPE OF PROTECTION

Article 5(1) of the UPOV Convention:

"The effect of the right granted to the breeder is that his prior authorisation shall be required for
- the production for purposes of commercial marketing
- the offering for sale
- the marketing

of the reproductive or vegetative propagating material, as such, of the variety.

Vegetative propagating material shall be deemed to include whole plants. The right of the breeder shall extend to ornamental plants or parts thereof normally marketed for purposes other than propagation when they are used commercially as propagating material in the production of ornamental plants or cut flowers."

1. What is meant by "propagating material of the variety" in this context?

(a) Only material corresponding to the variety description and deriving from material of the breeder (the owner of the plant breeder's right)?

(b) Also material which cannot be distinguished from that referred to in (a) above, and which originates from a "parallel breeder"?

(c) Also material that may only be distinguished from material of the breeder to such a small extent that it cannot constitute another, distinct, variety?

(d) Also material that is clearly distinguishable by one or more important characteristics from material of the breeder, but that has been developed manifestly to by-pass a breeders' right and that constitutes a slavish imitation of the protected variety?

The term "propagating material of the variety" covers the material referred to in items (a), (b) and (c) above. It does not cover the material referred to in item (d).

[End of Annex and of document]