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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

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ADMINISTRATIVE AND LEGAL COMMITTEE**Forty-Fourth Session****Geneva, October 22 and 23, 2001****INCLUSION OF PATENTED METHODS IN THE UPOV TEST GUIDELINES***Document prepared by the Office of the Union***Introduction**

1. At its thirty-seventh session held in Geneva from April 2 to 4, 2001, the Technical Committee considered a matter raised by the Technical Working Party on Vegetables, regarding the use of bulk samples and methods protected by patents. After a brief discussion, the Technical Committee agreed to refer to the Administrative and Legal Committee the matter of whether the characteristics based on patented methods should be excluded from the Test Guidelines (see paragraphs 129 to 132 of the draft report of the session, document TC/37/8/ Prov.).
2. The Administrative and Legal Committee (hereinafter referred as “the Committee”), at its forty-third session in Geneva on April 5, 2001, decided to include in the present agenda of the Committee an item on the “Inclusion of patented methods in the UPOV Test Guidelines” (see paragraphs 6 and 86 of the draft report of the session, document CAJ/43/8 Prov.).
3. The present document is intended to provide some background information and a proposed recommendation to facilitate the deliberations among the members of the Committee in order to give advice to the Technical Committee on this particular topic.

Experience of Selected Intergovernmental Organizations

4. In recent years, the development of new technologies has had an important impact on the activities of intergovernmental organizations. In this new environment, intergovernmental organizations must ensure that, in developing their activities, they respect the rights of third parties.

5. Intergovernmental organizations which as part of their mandate, provide for technical, harmonized solutions are addressing the issue of how to deal with intellectual property rights, in particular patents, that may be involved in the development of technical standards or recommendations. For the purpose of the present document, the Office of the Union has summarized the experience of selected intergovernmental organizations in this area. Although the nature of technical standards or recommendations may differ from UPOV Test Guidelines, since these provide for a different category of characteristics, the objective in reaching harmonized acceptable tools applies to both. If the inclusion of patented methods in technical standards or in Test Guidelines hampers their use, their value may be limited.

6. Some organizations that have recently adopted policy solutions to deal with this problem include the International Telecommunications Union (ITU), the Universal Postal Union (UPU) and the International Civil Aviation Organization (ICAO).

7. ITU policy on approval of new and revised ITU Recommendations provides that ITU must ensure that the Recommendations, their application and use are accessible to everybody. ITU has adopted the approach of asking that any Member State or Sector Member aware of a patent held by itself or others, which may fully or partly cover elements of the draft ITU Recommendation, is requested to disclose such information. The Patent Policy of the Telecommunication Standardization Bureau provides for, once the information has been disclosed, the patent holder to be contacted in order to request him or her to waive his or her rights, or to negotiate a license under particular terms.

8. UPU policy is very similar to the one adopted by ITU and in this regard any party putting forward a standardization proposal should, from the outset, draw the attention of the UPU Technical Standards Board to any known patent or any known patent application.

9. ICAO also favors early disclosure of potential patents involved in the adoption of an ICAO standard. Then, the patent holder is requested to provide a written statement as to whether he/she is willing to waive his/her patent rights or license the patent.

UPOV Test Guidelines

10. The technical examination system, under the UPOV Convention, provides for a tool to enhance harmonized practices among Contracting Parties and, at the same time, offers a degree of flexibility to allow for particular circumstances.

11. The “DUS” testing is performed according to the UPOV Convention and developed by standardized principles recommended by UPOV in the “Revised General Introduction to the Examination of Distinctness, Uniformity and Stability and the Development of Harmonized Descriptions of New Varieties of Plants” (Document TG/1/3). In accordance with these basic principles individual guidelines have been developed for the Conduct of tests for Distinctness, Uniformity and Stability (Test Guidelines), in general, for an individual species. The Test

Guidelines are prepared by Technical Working Parties (TWP) and coordinated by the Technical Committee. The Test Guidelines constitute an essential tool for guidance and harmonization of the technical examination, but are not binding in nature.

12. In order to select the characteristics for DUS testing and for inclusion in particular Test Guidelines, the characteristics should meet certain criteria. To enable the appropriate use of characteristics in DUS testing, it is important to understand the way in which characteristics can be used. In this regard, the functional categories of characteristics provide for the following types: standard Test Guidelines characteristic, asterisked characteristic, grouping characteristic, and additional characteristic.

13. The tool to enhance harmonized variety descriptions among Contracting Parties is mainly accomplished by the selection of a core or essential characteristics known as the “asterisked” characteristics. These characteristics should always be examined for DUS testing and included in the variety description by all Contracting Parties (except when the state of expression of a preceding characteristic or regional environmental conditions render this inappropriate).

14. The Test Guidelines also permit a degree of flexibility to allow for particular circumstances. In the course of DUS testing, it may not always be appropriate to use all the characteristics listed in the individual Test Guidelines. Furthermore, the list of characteristics is not exhaustive, and further characteristics may be used by the examining authorities if they are considered useful or necessary.

Recommendation on Patented Methods in the UPOV Test Guidelines

15. In line with the experience of other intergovernmental organizations, the following course of action, on how to deal with patented methods related to characteristics that may be included in the UPOV Test Guidelines, is recommended.

16. The leading expert, within a TWP, putting forward a proposal of Test Guidelines for a particular genus or species, is invited to disclose any known information on existing patents or patent applications pending that may relate to one or several characteristics of the Test Guidelines under discussion. The interested experts and other experts of the TWP will assist the leading expert in this task. It is suggested that the information on known patents includes the name and contact details of the patent holder, patent registration number, and countries where the patent has been granted (or patent applications pending, if applicable).

17. Once the information has been disclosed on existing patents (or patent applications pending, if applicable), the experts of the TWP concerned may assess the importance of a characteristic protected by patent and then decide whether it would be better to revisit the issue at a later stage or it would be appropriate to contact the patent holder and find a suitable solution. The TWP may decide to seek the advice of the Technical Committee.

18. If the decision to contact the patent holder has been retained, three situations may arise:

(a) the patent holder waives his/her rights for the particular use of the patented method as a characteristic for DUS testing and development of variety descriptions;

(b) the patent holder is willing to negotiate licenses with other parties on a non-discriminatory basis and on reasonable terms and conditions;

(c) the patent holder is not willing to cooperate with the solutions in (a) or (b).

19. If the first situation is applicable, a footnote in the corresponding characteristic(s) of the Test Guidelines will indicate “characteristic protected by patent, the patent holder has waived his/her rights for the purpose of DUS testing and development of variety descriptions.” The members of the TWP may decide, considering the importance of the characteristic, if it will be appropriate to select it as an asterisked characteristic.

20. If the second situation is applicable, it is recommended that the characteristic(s) concerned will not be selected as an asterisked characteristic as it will not serve the purpose of accessibility and harmonization of the asterisked characteristics. The members of the TWP may decide whether interested parties would like to retain the characteristic protected by patent as a standard Test Guidelines characteristic. Interested parties may decide to start negotiations with the patent holder for licenses on a non-discriminatory basis and on reasonable terms and conditions. Such negotiations are left to the interested parties and shall take place outside UPOV. An indication that the characteristic is protected by patent and that the patent holder provides for licenses on a non-discriminatory basis and on reasonable terms and conditions should be available.

21. If the third situation is applicable, it is recommended that the characteristic(s) protected by patent will not be retained as asterisked characteristic. The experts of the TWP concerned may decide, in light of the information available, e.g. experience of a Contracting Party that has used the characteristic protected by patent to develop a variety description, whether the characteristic should or should not be retained as a standard Test Guidelines characteristic. An appropriate note indicating that the characteristic is protected by patent should be available.

Final Comment

22. The proposed Recommendation is intended to provide guidance to the TWP and the Technical Committee in developing new Test Guidelines. The suggested course of action offers a degree of flexibility allowing the TWP experts to assess the existence and the importance of a characteristic protected by patent and to determine the best way to proceed: to revisit the issue at a later stage or to contact the patent holder and find a suitable balance between the rights of the patent holder and the purpose of the Test Guidelines.

23. The Committee is invited to express its views on the Recommendation in paragraphs 15 to 21 on patented methods in the UPOV Test Guidelines proposed by the Office of the Union.

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