



CAJ/44/9

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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS
GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Forty-Fourth Session
Geneva, October 22 and 23, 2001

REPORT

adopted by the Committee

Opening of the Session

1. The Administrative and Legal Committee (hereinafter referred to as "the Committee") held its forty-fourth session in Geneva on October 22 and 23, 2001, under the chairmanship of Mr. John Carvill (Ireland).
2. The list of participants is given in the Annex to this report.
3. This session was opened by the Chairman, who welcomed the participants. He extended a special welcome to the Delegations of Croatia and Nicaragua which had become members of the Union since the preceding session of the Committee. The Chairman also extended his congratulations to the Delegation of Finland which had recently acceded to the 1991 Act of the UPOV Convention.

Adoption of the Agenda

4. The representative of the International Community of Breeders of Asexually Reproduced Ornamental and Fruit Tree Varieties (CIOPORA) made the following statement in relation to paragraph 76 of the previously adopted Report of the forty-third session of the Committee (document CAJ/43/8):

“TherepresentativeofCIOPORAconsidersthatthemarketingofanF₁hybridshouldnot necessarilymaketheparentlinespublic,however,once,thehybridisnolongerprotected, thenweareconfrontedwithtwopossibilities:eithertheparentlinesarenotprotected,in that case, those who want to freely commercialize the hybrid should have access to the parentlinessincethevarietyisfreeforuse;ortheparentlinesareprotectedorhavebeen protectedatalaterstage,inthatparticular case,specialaccessshouldbepermittedtothe parent lines, just for the specific manufacture of the hybrid, but not for any other purpose.”

5. TheCommitteeadoptedtheagendaasgivenindocumentCAJ/44/1.

TheNotionofBreederandCommon Knowledge

6. DiscussionswerebasedondocumentCAJ/44/2.

7. The Vice Secretary -General indicated that a small number of suggestions for improvementshavebeenincorporatedintherevisedversion.Inparticular,hementionedthat a new paragraph 1 had been added. This contained a proposed mission statement which would be discussed in the Consultative Committee on October 24, 2001 (see document CC/62/2).

8. The Delegation of Germany indicated the need to remove the “,” af ter the word “improved”orevenhedeletionoftheword“improved”intheGerman textofparagraph 1. It was also suggested that “for example” should be added in the second sentence of paragraph 2 just before the term “clone.” This addition would clarif y that the terms in bracketsdonotconstituteanexhaustivelist.

9. The Delegation of Belgium requested that the term “donc” in the second sentence of paragraph 24beremoved.ThischangeonlyaffectedtheFrenchtext.

10. TheDeleg ationofFrancewassatisfiedwiththenewversionofthedocument,however, it expressed concern in relation to the reference to the revised “General Introduction to the Examination of Distinctness, Uniformity and Stability and the Development of Harmoniz ed Descriptions of New Varieties of Plants”(document TG/1/3),in paragraph 22,in particular in section 5.2.2,the terms “Living plant material must be in existence”for a variety to be taken into account for distinctness. The Delegation explained that, in some cases, protection has been rejected on the basis of documents which have provided proof that the varieties have existedinthepastalthoughlivingmaterialofthosevarietieswasnolongeravailable.Minor drafting changes in the French version of document CAJ/44/2 were made by the Delegation, in particular, in paragraph 2, the term “hybride complexe” was changed to “hybride multiple.” In paragraph 16, line seven of the French text needed to be redrafted in conformity with the English text.

11. The Delegation of Norway approved the document as a UPOV position paper, to be taken into consideration in various forums regarding plant genetic resource issues. It concluded that thenotionofbreeders supportstheUPOV system of plant variety protection. In particular with regard to the Convention on Biological Diversity (CBD), the Delegation felt it was important that the UPOV Convention and the CBD were implemented in a mutually supportiveway.

12. The Delegation of Spain expressed general concern about the differences in translation of terms between the English versions and the Spanish versions of UPOV documents.

13. The Delegation of Chile expressed its satisfaction with the clarity and the contents of the document.

14. The representative of the European Community expressed its satisfaction with the document.

15. Several delegations and representatives of organizations, and the Secretariat held a discussion on the difficulties, in practice, of applying the requirement for "living material must be in existence." For the purpose of this document, it was decided to remove the reference to the General Introduction in paragraph 22 and the Committee agreed to return to this matter when considering the revised General Introduction.

16. After a brief discussion and following a proposal by the Secretariat, the first sentence of paragraph 19 was amended and approved by the Committee in the four UPOV languages as follows:

Paragraph 19

Where the application satisfies the requirements for protection, the breeder's right shall be granted, irrespective of the mode of creation of the variety.

Paragraphe 19

Quand la demande satisfait aux conditions requises pour bénéficier de la protection, le droit d'obtenteur est octroyé, indépendamment de la manière dont la variété a été créée.

Absatz 19

Erfüllt ein Antrag die Schutzvoraussetzungen, wird das Züchterrecht erteilt, ungeachtet der Art und Weise der Schaffung der Sorte.

Párrafo 19

Cuando la solicitud reúne los requisitos para la protección, se concederá el derecho de obtentor, cualquiera que sea el modo de creación de la variedad.

17. The Committee approved, as amended by the changes indicated in paragraphs 8, 9, 10, 15 and 16, the position paper on "The Notion of Breeder and Common Knowledge in the Plant Variety Protection System Based upon the UPOV Convention."

18. This position paper will be submitted, in the next April session, to the Consultative Committee, with the proposal that it recommends the Council to adopt this document as a UPOV position which, in particular, should be used in various fora concerned with plant genetic resource issues.

Variety Denominations

19. Discussions were based on document CAJ/44/3.

20. The Delegation of France noted the need to establish the UPOV *ad hoc* Working Group on Variety Denominations (hereinafter referred to as “the *ad hoc* Working Group”) and expressed its wish to participate. It explained that, as a member of the European Union, France applies both the UPOV Convention and the European Community Regulations on variety denominations. The Delegation further proposed a minor drafting change in the first line of paragraph 11(iv) of the French text only, the term “directives” to be changed to the terms “lignes directrices.”

21. The representative of the European Community informed the Committee that 15 Member States of the Community Plant Variety Office (CPVO) apply the same rules on variety denominations. He also informed the Committee of the recent creation of the CPVO Working Group on Variety Denominations, to which a UPOV representative had been invited to participate in an observer capacity. The representative further expressed an interest in participating in the UPOV *ad hoc* Working Group on Variety Denominations, and in coordinating the efforts of both Working Groups.

22. The Delegation of Spain also expressed its interest in contributing to the work of the *ad hoc* Working Group, and in the elaboration of clear recommendations that would reduce different interpretations.

23. The Delegation of Chile recommended that the terms of reference of the *ad hoc* Working Group in the first line of paragraph 11(ii) should be changed by the substitution of the term “trademark” with the terms “intellectual property,” which would allow coverage of a broad range of situations.

24. The Committee agreed with the amendments, made by the Delegations of France and Chile, to the terms of reference of the *ad hoc* Working Group.

25. Several members and observers, covering different regions and alphabets, expressed an interest in participating in the *ad hoc* Working Group: Argentina, Belgium, Chile, China, Colombia, Croatia, France, Japan, New Zealand, Spain, as members of the Union, the European Community and two non-governmental organizations, the International Association of Plant Breeders for the Protection of Plant Varieties (ASSINSEL) and CIOPORA, as observers.

Publication of Variety Descriptions

26. Discussions were based on documents CAJ/44/4 and CAJ/44/4Add.

27. The representative of ASSINSEL was in favor of the publication *in extenso* of the official descriptions which form the basis for the grant of a breeder's right certificate. He noted several advantages: publication should be sufficient to render the variety a matter of common knowledge, even when the variety was not available to the public, for example, in the case with inbred lines; publication would also give some substance to the opposition procedures which exist in some countries. With regard to the content of the descriptions, he added that ASSINSEL would favor a unified format like the one provided by the UPOV Test Guidelines; the information should be accessible "on-line" at a reasonable cost, to cover the additional administrative costs, and also, it should allow searches on different criteria, such as varietal characteristics or names of the varieties. In order to reduce costs and provide an effective system, it suggested consideration be given to the SINGER database (System -Wide Information Network for Genetic Resources). The representative of ASSINSEL encouraged UPOV and the International Plant Genetic Resources Institute (IPGR I) to work as closely as possible to harmonize UPOV and IPGR I descriptors.

28. The Delegation of the Republic of Korea expressed its support for the project.

29. The Delegation of Argentina welcomed the proposal and considered that national laws dealing with confidentiality issues should be taken into account.

30. The representative of CIOPORA expressed its support for the project in order to achieve harmonized variety descriptions, however, noted that due care should be taken in relation to cost considerations.

31. The Delegation of Mexico noted the efficiency benefits resulting from the exchange of information concerning variety descriptions. It gave support for the work plan and its agreement to the priorities and technical, administrative and legal considerations.

32. The Delegation of France proposed that paragraph 22 of document CAJ/44/4 should be amended by the incorporation of a reference to the methods developed in response to the results of the questionnaire envisaged in paragraph 39 of document CAJ/44/4 (as modified in paragraph 8 of document CAJ/44/4 Add.).

33. The Committee endorsed the work plan including the model study proposed by the *ad hoc* Working Group on Publication of Variety Descriptions.

Inclusion of Patented Methods in UPOV Test Guidelines

34. Discussions were based on document CAJ/44/5.

35. The representative of ASSINSEL was satisfied with the document and with the clear way it identified the issue of patented methods. He further suggested, in relation to the second situation in paragraph 20, that the Office of the Union play a role in negotiating licenses with the patent holder, in order to obtain similar conditions for all interested parties.

36. In response to the suggestion made by the representative of ASSINSEL, the Office of the Union clarified that, due to the international status of UPOV as an intergovernmental organization, the Office of the Union should avoid litigious situations which could have a negative impact on UPOV's privileges and immunities. The context of the licenses and the interpretation of "reasonable terms" could vary from case to case and it should be the sole

responsibility of the interested parties. Without jeopardizing the impartiality of UPOV, the Office of the Union would be happy to facilitate relevant information and to provide assistance to the interested parties.

37. The representative of the European Community noted with interest the contents of the document and suggested simplifying paragraph 16, leaving the indication that the Technical Working Parties (TWPs) are invited to disclose any known information on existing patents or patent applications.

38. The Delegation of Australia was satisfied with the document and proposed recommendation on patented methods in the UPOV Test Guidelines. In relation to paragraph 21, the Delegation indicated that, in the event that the patent holder would not agree to waive his rights or grant non-discriminatory access, Australia would be very reluctant to support the inclusion of the patented method to determine each characteristic as a standard Test Guidelines characteristic. The Delegation took the opportunity to clarify that the patented method referred to the method for assessing the state of expression of a characteristic. The Delegation felt that, as a general principle, one should avoid the inclusion of methods in the Technical Guidelines which are only available to some members of the Union.

39. The Delegation of France was in favor of discussing this topic and was satisfied with the document, but indicated that, wherever possible, solutions should be found without using patented methods.

40. The Vice Secretary-General agreed with the comment made by the Delegation of France, but observed the need to respond to technical progress and to be able to assess cases where a patented method could bring clear time and cost advantages. The Vice Secretary-General further recommended amendment of paragraph 17 in order to clarify that the TWPs should also assess the suitability of alternative non-patented methods if available. In addition to the possibility that the TWPs may decide to seek the advice of the Technical Committee as provided in paragraph 17, it would also be appropriate for the Technical Committee to seek the opinion of this Committee.

41. The Committee agreed on an approach regarding the inclusion of patented methods in UPOV Test Guidelines and decided to transmit this recommended approach, as modified by the Committee, to the Technical Committee in order to assist TWPs that may face this issue. This recommendation is reproduced below:

Recommendation on Patented Methods in the UPOV Test Guidelines

In line with the experience of other intergovernmental organizations, the following course of action, on how to deal with a patented method for assessing the state of expression of a characteristic that may be included in the UPOV Test Guidelines, is recommended:

(a) The TWPs are invited to disclose any known information on existing patents, or patent applications pending, that may relate to the assessment of the expression of one or several characteristics in the Test Guidelines under discussion. It is suggested that the information on known patents should include 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).

(b) Once the information on existing patents (or patent applications pending, if applicable) has been disclosed, the experts of the TWP concerned should assess the importance of the patented method concerning the assessment of the expression of a characteristic and the suitability of alternative, non-patented methods, if available. The TWP should then decide whether it would be better to revisit the issue at a later stage or if it would be appropriate to contact the patent holder to find a suitable arrangement for utilization of the patented method. The TWP may decide to seek the advice of the Technical Committee and, if appropriate, the Technical Committee may also seek the advice of the Administrative and Legal Committee.

(c) If a decision to contact the patent holder is taken, three situations may arise:

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

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

(iii) the patent holder is not willing to cooperate with the solutions in (i) or (ii).

(d) If the first situation is applicable, a footnote in the corresponding characteristic(s) of the Test Guidelines should indicate that the method for assessing the expression of this characteristic is protected by patent, but that 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.

(e) 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 satisfy the requirement for accessibility that enables harmonization of variety description using asterisked characteristics. The members of the TWP may decide whether interested parties would like to retain the characteristic related to the method 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 would take place outside UPOV. An appropriate note indicating that the method concerning the assessment of the expression of 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 provided.

(f) If the third situation is applicable, it is recommended that the characteristic(s) concerned with the method protected by patent will not be selected as an asterisked characteristic. The experts of the relevant TWP may decide, in light of the information available, e.g. experience of a member of the Union that has used the characteristic to develop a variety description, whether the characteristic should or should not be selected as a standard Test Guidelines characteristic. An appropriate note indicating that the method concerning the assessment of the expression of the characteristic is protected by patents should be provided.

Status of Information Included in the Technical Questionnaire of Test Guidelines

42. Discussions were based on document CAJ/44/6.
43. The Delegation of Germany indicated that the status of the Technical Questionnaire was subject to national legislation. For example, it considered that, in Germany, the information provided in the Technical Questionnaire was not part of the application. In this respect, the status of the Technical Questionnaire may vary from country to country. The same comment applied to what different countries considered to be bad faith.
44. The Delegation of Australia suggested that the word “is,” in the second line of paragraph 7, should be replaced by the words “maybe.”
45. The Delegation of Austria indicated that their national legislation provided for a mechanism of rectification of errors when the information provided in their own Technical Questionnaire was insufficient, misleading or obviously erroneous. If the rectification was not made by the applicant within the time limit, then the application was rejected. If the error was found after the right was granted, it would trigger the mechanism of declaration of nullity.
46. The Delegation of France agreed with the comments provided by the Delegations of Germany and Austria. The status of the Technical Questionnaire was subject to national law, in this regard French Law was in line with the conclusions in paragraph 21(i). The French administration could determine if there was a substantial error. French Administrative Law provided a mechanism for correction of errors. The Delegation further noted that it was very difficult to prove that an error had been made in bad faith.
47. The representative of the European Community noted that the technical description was part of the application and the Technical Questionnaire was intended to provide a broad description of the variety. In examining the application, the procedure was not concerned with the intention of the applicant, but rather with the seriousness of the error. Non-serious errors could be rectified within a given period and the initial filing date would be kept. Serious errors would not be given a filing date at all. If the error was found later in the examination process, as indicated in paragraph 15, the consequences could vary from case to case depending on the relevance of the error. The CPVO system was in line with paragraph 21(iv) and, as provided in Article 21(1)(ii) and (iii) of the 1991 Act of the UPOV Convention, those types of errors would lead to the nullity declaration or to the transfer of the right to the person entitled.
48. The representative of ASSINSEL noted that a distinction should be made between the role of the Technical Questionnaire in countries in which the Government conducts all aspects of the examination, and the role of the detailed variety description in countries, like Canada and the United States of America, in which at least part of the examination is conducted by the applicant.
49. The Delegation of New Zealand agreed with the distinction made by the representative of ASSINSEL and confirmed that, in their system, it was rare that final decisions could be based on information provided in the UPOV type of Technical Questionnaire, but rather decisions were based on the detailed descriptions and the data prepared from the comparative growing trials.

50. The Delegation of Japan agreed that it was difficult to establish bad faith.
51. The Delegation of the Netherlands explained that their system had a requirement for material to be submitted within two weeks. In cases where submission would be later than this, it was necessary to submit a Technical Questionnaire and a picture of the plant. With the exception of minor mistakes, if the material deviated from the Technical Questionnaire or the picture, the application would be rejected.
52. The Committee concluded, as a summary of the discussions, that the status of the information provided in the Technical Questionnaire would depend on the law of the States or members of the Union, and that this conclusion would be transmitted to the Technical Committee.

Breeder's Exemption in Relation to Parent Lines

53. Discussions were based on document CAJ/44/7.
54. The Vice Secretary -General introduced the document and provided a modified version of paragraph 3. It was clarified that the breeders submitted the material of parent lines of hybrid varieties for examination purposes, as provided in Article 12 of the 1991 Act of the UPOV Convention, and the Convention did not provide for the authority to make that material available to any third party for breeding purposes.
55. The Delegations of Argentina, Austria, France, Germany and the representatives of the European Community, ASSINSEL and CIOPORA welcomed the rectification made in paragraph 3.
56. The Delegation of France further noted that the protection of parent lines would render those varieties a matter of common knowledge and that this would create difficulties for the examination of other candidate varieties if the parent lines were only known by the breeder and the authority.
57. The representative of ASSINSEL proposed that, following the rectification of paragraph 3, paragraph 9(i) should be modified accordingly. He also noted that the material supplied belonged to the breeder.
58. The Delegation of Australia noted that Article 12 of the 1991 Act of the UPOV Convention clearly indicated that the material was submitted only for examination purposes and did not make reference to other uses.
59. The Delegation of France explained that the authority had the right to use the material but only for official purposes.
60. The representative of the European Community clarified that the authority was not free to deliver samples of the material to third parties in relation to the breeder's exemption, as that activity fell outside the competence of the testing authority.
61. The Delegation of Spain indicated that the samples of material were submitted for testing purposes and that ownership was not transmitted to the authority. It added further that

the submission of material was also relevant for verifying the maintenance of the variety in accordance with Article 22(1)(b)(i) of the 1991 Act of the UPOV Convention.

62. The Delegation of Austria supported the comments made by the Delegation of Spain.

63. The Delegation of Sweden, supported by the Delegation of the Netherlands, proposed that discussions should lead to the elaboration of a new document.

64. The Chair summarized the general debate concluding that the breeder submitted material for examination purposes, that parent lines which were protected varieties were considered to be a matter of common knowledge and that the different issues raised concerning the use of the material submitted for examination would be incorporated into a new document.

Plant Variety Identification

65. Discussions were based on document CAJ/44/8.

66. Several delegations and the representatives of the European Community and ASSINSEL considered that it fell outside the competence of UPOV to make recommendations on variety identification. However, the Delegation of Chile wondered which would be the competent international body for studying biochemical and molecular techniques.

67. In response to the concern raised by the Delegation of Chile, the Vice Secretary-General clarified that the work carried out by the Working Group on Biochemical and Molecular Techniques and DNA Profiling in Particular (BMT) on molecular markers and the assessment of their suitability for examination of distinctness, uniformity and stability (DUS) would continue.

68. The Chair summarized that the general consensus of the Committee was that it was not appropriate, at this time, for UPOV to make recommendations on variety identification.

Program for the Forty-Fifth Session

69. The program for the forty-fifth session would include the following items:

1. Report on the thirty-eighth session of the Technical Committee;
2. Revised General Introduction to the Examination of Distinctness, Uniformity and Stability and the Development of Harmonized Descriptions of New Varieties of Plants;
3. Publication of variety descriptions;

4. A new item and document concerning issues on the use of material submitted for DUS examination;
5. Variety denominations.

70. The present report has been adopted by correspondence.

[Annex follows]

ANNEXE/ANNEX/ANLAGE/ANEXO

LISTE DES PARTICIPANTS/LIST OF PARTICIPANTS/
TEILNEHMERLISTE/LISTA DE PARTICIPANTES

(dans l'ordre alphabétique des noms français des États/
in the alphabetical order of the names in French of the States/
in alphabetischer Reihenfolge der französischen Namen der Staaten/
por orden alfabético de los nombres en francés de los Estados)

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