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agreed by the Council of UPOV, only documents that have been adopted by the Council of UPOV and that have not been superseded can represent UPOV policies or guidance.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

CAJ/29/3
ORIGINAL : French
DATE : October 8, 1991

UPOV

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Twenty-ninth Session

Geneva, October 21 and 22, 1991

EXAMINATION OF DISTINCTNESS UNDER
ARTICLE 7 OF THE 1991 ACT OF THE CONVENTION

Document prepared by the Office of the Union

INTRODUCTION

Basic Texts

1. Article 7 is worded as follows in the 1991 Act of the UPOV Convention (the underlined sentence encapsulates the subject addressed in this document):

"Article 7
"Distinctness

"The variety shall be deemed to be distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of the filing of the application. In particular, the filing of an application for the granting of a breeder's right or for the entering of another variety in an official register of varieties, in any country, shall be deemed to render the other variety a matter of common knowledge from the date of the application, provided that the application leads to the granting of a breeder's right or to the entering of the said other variety in the official register of varieties, as the case may be."

2. In the 1978 Act, the corresponding provision reads as follows (emphasis added):

> "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."

3. The above wording had been taken from the 1961 Act without change; that explains why the provision does not refer to the actual or pending grant of a title of protection: the founding fathers of the Convention took into consideration only the general situation obtaining at the time when they devised the distinctness rule (in April 1958, at the first meeting of the Committee of Experts), which was noteworthy for the lack of any protection system in a great many countries.

The Problem

4. At the Diplomatic Conference held from March 4 to 19, 1991, two Delegations, those of Japan and of the United States of America, submitted proposals for the amendment of the text quoted in paragraph 1 above, the effect of which would have been to set territorial limits on the presumption of common knowledge of a variety in respect of which the grant of a breeder's right or entry in an official register of varieties is applied for. According to those proposals, the presumption would have been valid only for the State (or intergovernmental organization) with which the application concerned had been filed.

5. In support of the proposals it was pointed out that the text of the Basic Proposal--which in fact was eventually adopted--stated a condition that was too strict for both breeders and offices. A breeder would have no knowledge of a variety for which an application had been filed in another country until such time as the breeder's right was granted, for instance, or at least until the application was published. As for offices, distinctness examination would be made difficult for them, and they would risk having to defer the grant of rights until all earlier applications had been dealt with.

6. The proposals were rejected by 13 votes to three, with three abstentions. It should be mentioned that three statements were made in the course of the discussions by international non-governmental organizations: CIOPORA and COMASSO endorsed the text eventually adopted, the latter arguing that a country-based common knowledge criterion would in certain cases make the grant of breeders' rights dependent on the efficiency of the offices concerned; AIPPI advocated the replacement of "in any country" with "in any Contracting Party," which amounted to a partial limitation of the presumption.

7. In the course of the discussion it was suggested that technical guidelines should be drawn up for use in relation to the Convention. No decision was taken on the subject by the Conference, but it transpires from the records that no delegation actually opposed the consideration of the matter within UPOV; indeed, in view of the misgivings caused by the text adopted, it does seem desirable to go into the matter in greater depth.

8. In a letter dated May 7, 1991, Mr. Y. Kobayashi, Director of the Seeds and Seedlings Division of the Ministry of Agriculture, Forestry and Fisheries of Japan, asked for the matter to be considered by the various organs of UPOV. This document is the response to that request.

SCOPE OF THE 1991 AMENDMENT IN LAW

9. The first question that arises is whether Article 7 of the 1991 Act creates a new situation as compared with the earlier Acts. The scope of the various Acts should therefore be determined.

1961 and 1978 Acts

10. The Annex to this document contains an extract from the report on the first meeting, held from April 22 to 25, 1958, of the Committee of Experts set up in connection with the 1957-1961 Diplomatic Conferences. It emerges from that report that the original intention had been to establish an "absolute" criterion: "the variety [had] to be distinguishable from any variety existing as such ... whose existence may be known and verified by various means, such as: entry ... already made or in the course of being made..." (Emphasis added).

11. The criterion also had to be uniform: "the word 'known' could be accepted if it were accompanied by explanatory comments: a known variety is a variety whose existence is a matter of common knowledge in any country."

12. It was nevertheless agreed that the concept of "novelty" (more correctly distinctness) could be either absolute or relative, and, albeit grudgingly, the founding fathers of the Convention accepted the coexistence of both concepts within the Union.

13. Two participants in the work done between 1957 and 1961, Schade and Pfanner (Internationaler Schutz von Pflanzenzüchtungen, GRUR, 1961, 1-14), commented as follows on the expression "common knowledge" (UPOV translation):

> "This expression which was eventually adopted requires some additional comment. One spoke first of existing varieties, but that was thought to be going too far: it could indeed cover a plant fortuitously discovered in virgin forest. It was then thought that one might use the word 'known,' but it also seemed too far-reaching. The next stage was 'well known,' and the final one 'common knowledge.' It nevertheless seemed desirable to the experts to illustrate the expression with examples, namely entry in an official register of varieties, presence on a comparative testing plot or precise description in a publication.
>
> "As the proposed wording does not contain any territorial limitation, it has to be deduced that what is meant is 'absolute novelty.' It is therefore immaterial whether the conditions specified, for instance entry in an official register, are met at the national level, in another member State or in a non-member State. The feeling was that, in the field of new plant varieties, novelty examination would cause far fewer difficulties than it does in the field of industrial inventions, owing to the fact that the novelty concept is somewhat restricted by the word 'common,' and that it would be easier to handle in practice". (Emphasis added)

14. At the time of the preparatory work on the 1978 Diplomatic Conference, a Committee of Experts had to entertain the proposal that the "universal scope criterion" be replaced by a criterion according to which protection could be refused only in so far as the variety was a matter of common knowledge, or

used or marketed on the territory of the State of the application. The proposal was not adopted on account of three arguments:

(i) a legal argument: the sentence quoted in paragraph 2 above embodies no obligation, being included merely by way of illustration;

(ii) a practical argument: examination undertaken according to the national criterion, as observed in the State that made the proposal, differs little from examination undertaken according to the universal criterion;

(iii) an argument of appropriateness: the universal criterion should be retained as a means of promoting international cooperation in examination (this argument was used again at the 1991 Conference).

1991 Act

15. The revision of the provision concerned grew out of the argument according to which "precise description in a publication" is not sufficient to make the existence of a variety a matter of common knowledge. The principle adopted in Article 7 was proposed from the outset of the revision work in April 1988 (see document CAJ/XXII/2), and eventually established itself without it ever having been stated that it was an innovation in relation to the 1961 and 1978 Acts.

16. In the final analysis, the 1991 Act clearly does not have the flexibility of its predecessor: the Contracting Parties under the 1991 Act will be obliged to introduce in their legislation the concept of the presumption of common knowledge in relation to a variety that is the subject of an application in any country, whereas that presumption is implicit in the 1961 and 1978 Acts--even though they also allowed a different interpretation: the basis for comparison is universal and not national, and then whatever the criterion adopted for determining common knowledge; it follows that, according to the spirit of those Acts, the criterion of "entry in the course of being made" (application pending) is to be handled in the same way regardless of whether a national or a foreign application is involved.

SCOPE OF THE AMENDMENT IN PRACTICE

17. Whatever the wording of the relevant provisions of their national legislation, all the member States now use a common knowledge criterion that is not subject to any territorial limitation. To the knowledge of the Office of the Union, the criterion has never presented a serious problem. In particular, the number of invalidations of breeders' rights under Article 10(1) of the 1961 or the 1978 Act is very small.

18. Because it is so explicit, the 1991 Act seems to introduce a difficulty in the management of the plant variety protection system. Indeed the main difficulty seems to stem from the concept of common knowledge as such: it is an absolute concept, in the sense that it does not specify the circle of persons for whom the existence of the variety must be a known fact, and it is a stringent one, in the sense that the only varieties that it excludes are those whose existence is an unknown fact or a known but confidential fact. Clearly the limits of common knowledge and confidentiality have to be ascertained, but that is a question outside the terms of reference of this document.

19. It is equally clear that one could not allow a conception according to which the existence of a variety would only be a matter of common knowledge --for the purposes of the protection system--if the office were informed of that existence and had a thorough knowledge of the variety. What that means in practice is that the result of the examination carried out by the office is necessarily a provisional one, subject to revision. This is precisely the reasoning that underlies the provision, in Article 21(1)(i) of the 1991 Act, for nullity for want of distinctness.

20. All things considered, however, the difficulty arising from the presumption of commmon knowledge is far smaller than that arising from common knowledge attributable for instance to "cultivation or marketing already in progress" or "inclusion in a reference collection":

(i) The filing of an application for protection, for instance, leads very quickly to the publication of summary information on the variety in the office's official journal; consequently, the presumption of common knowledge exists only for the often very short period prior to publication. In a liberal system (notably in the absence of catalogues of varieties approved for marketing and seed and seedling certification procedures), marketing can very easily escape the attention of offices.

(ii) The filing of an application establishes a definite date as from which there is common knowledge. That is not necessarily true of cultivation or marketing.

(iii) The filing of an application is bound--subject to the successful prosecution of the application--to result in a description of the variety. That is not true of cultivation or marketing either.

(iv) In the case of applications, the office has the enormous advantage of a source of reliable information at its disposal, namely the offices of other States in charge of the protection of new plant varieties or the keeping of official registers of varieties, and the further advantage of being able to take action within the UPOV framework to ensure the best possible management of the protection system. A number of offices, for instance, exchange lists of varieties under tests.

21. It should be noted that the Convention's distinctness criterion--to which the common knowledge concept and the presumption of common knowledge are both linked--is no more difficult to manage than the novelty and inventive step criteria of the patent system, for the purposes of which "state of the art" means everything that has been disclosed, anywhere in the world, by publication in material form. In that system, anticipation in the form of a typewritten thesis made available to the public in a library is sufficient to invalidate a patent. In the course of its examination, the patent office generally contents itself with consulting a search file consisting of published patent applications and patents and the best-known publications that the examiners can read.

22. In the plant variety protection field, the problem of a world distinctness criterion is mitigated in practice by considerations that have to do with agricultural science, economics and culture (in the sense of cultural traditions). With regard to a great many species, Japan, for instance, can reasonably expect its present or future range of varieties to be different from that in other States (with the possible exception of its closest neighbors), in which case it can reasonably base its protection system on examination in relation to those varieties alone whose existence is a matter of common knowledge in Japan.

OPTIMIZATION OF EXAMINATION RELIABILITY

General

23. The problem described above does however exist at regional level (notably in Europe), and at world level for certain species, especially ornamental and vegetable species (and, of those, especially varieties raised under glass). It is therefore important that the offices of member States should take the necessary action to optimize the reliability of the examination undertaken by each one of them, and thus the overall quality of protection systems.

24. Regardless of the type of examination carried out, the basis for comparison necessarily consists of varieties known to the examining office, to the exclusion of all others. This comparison takes place according to two main methods:

(i) the office undertakes growing trials (or has them undertaken by a service organization) in order to obtain a description of the variety to which the application relates;

(ii) the office requests such a description of the breeder.

In the first case the office at the same time carries out a growing trial for comparison with its own reference collection and with other varieties for which applications have been filed, and it is at the data analysis stage that account is taken of the varieties that it has not been possible to include in the trials; trial data are compared with those in the data base. In the latter case the office typically carries out only a comparison with a data base, the applicant being explicitly or implicitly required to undertake the direct comparisons.

25. Three levels may therefore be distinguished:

(i) Direct comparison. In all cases this has to establish clear distinctness for the application to be successful.

(ii) Comparison in a data base. This presupposes comparability of the data.

(iii) The principle, namely that the variety for which the application is filed has to be distinct from any variety whose existence is or is presumed to be a matter of common knowledge.

The Ideal Solution: Cooperation in Examination

26. Clearly, in a system of centralized examination, all the varieties for which applications for protection have been filed in States participating in the cooperation system are included--theoretically--in the same trial, in which case the comparisons are made direct, between varieties presumed to be known. That is the ideal solution.

27. The Administrative and Legal Committee might perhaps wish to consider whether it is appropriate to undertake activities with a view to:

(i) promoting the principle of cooperation in examination;

(ii) perfecting the existing cooperation system, where applicable;

(iii) developing other systems, such as examination common to several States, with growing sites distributed over several of them.

28. For a system to function perfectly, the administrative procedures need to be uniform enough for the varieties for which applications are filed to be put on trial, subject to climatic constraints among other things, in the chronological order of applications and for results to be available in the same order, subject to delays due to additional testing. It is strict procedure that allows a breeder's right to be granted in a variety after due account has been taken of varieties which--owing to earlier applications--are presumed to be a matter of common knowledge on the filing date of the application for that variety. They will indeed be known in detail at the time when the decision is taken--because a growing trial will have been carried out.

29. This question of harmonization of procedures arises also in relation to national growing trials and documentary examinations. The Committee may therefore wish to consider whether activities should be undertaken in that area with a view to the making of recommendations to member States.

A Costly Solution: Extended National Examination

30. In the absence of international cooperation in examination, a national office may be in search of a very high level of reliability in dealings with varieties presumed to be a matter of common knowledge. It then has to obtain samples of the varieties for growing in national trials. This situation raises a number of questions to which the Committee might wish to give more thought:

(i) Are there cases in which such a procedure is warranted or recommended, and if so what are those cases or what are their characteristic features?

(ii) In the knowledge that an office wishing to adopt this course can always approach breeders--who have an interest in helping examination to avoid problems later--is it possible to introduce a system for the exchange of samples between services? Should special provisions to that end be enacted in national legislation, and would it be appropriate to recommend such provisions?

(iii) Should an international instrument (administrative agreement or special arrangement) be established for the implementation of such a system?

31. The Model Form for the Application for Plant Breeders' Rights (Text 10 in the Collection of Important Texts and Documents) contains a passage worded as follows:

> "Authorization is hereby given to the Plant Breeders' Rights Office to exchange with the competent authorities of any UPOV member State all necessary information and material related to the variety, provided that the rights of the applicant are safeguarded."

According to the additional explanations, this statement concerns above all those States that participate in the system of international cooperation in examination. From the point of view of the breeder (applicant), its purpose is exclusively to facilitate the examination of his variety. It would therefore be appropriate to ascertain whether such a passage would be sufficient for the exchange of material to facilitate the examination of other varieties. In that respect account should be taken not only of legal but also of psychological aspects, as breeders might well object to their material being distributed to countries not party to the cooperation system.

A Rational Solution: Centralization or Exchange of Information

32. This solution consists in improving the reliability of the documentary examination. It therefore concerns both States that make that type of examination only and States that also undertake growing trials.

33. The principle is that the variety for which the application is filed "shall be deemed to be distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of the filing of the application." For the application of the principle, the other varieties need only be known to the service at the time when it takes its decision. The first level of knowledge stems from the publication--whether in the traditional form or in a more modern form using computer or information technology facilities--of fundamental data on the applications filed. At this level there arises the problem of the standardization of administrative procedures, already mentioned in paragraph 28 above: the publication of the data has to occur early enough (for instance at least quarterly) for the data to be accessible.

34. The Committee may wish to make recommendations on the frequency of publication, which in fact concerns the effective application of the provisions of Article 30(1)(iii) of the 1991 Act of the Convention (Article 30(1)(c) of the 1978 Act).

35. A second question has to do with the contents of publications. This will probably have to be discussed in a broader context in view of:

(i) the possible necessity of publishing detailed information on the breeding history of varieties and on their description, in order to facilitate the management--by users--of the dependency system;

(ii) modern data processing and communication technology.

Documents TC/27/7 and CAJ/29/4 should be consulted in this connection. Those documents confine themselves to questions of computerization. When the time comes, the question of international cooperation in publication, for instance in CD-ROM form, will have to be addressed.

36. More specifically with regard to distinctness examination, the most practical thing to do would be to centralize the detailed information (the untreated statistical data from growing trials carried out by breeders or offices) and also the processing of those data. Such centralization would appear to require an administrative agreement which the Committee could be entrusted with drafting if a number of States showed an interest in such a cooperation system (for all species or only some).

37. A less ambitious step would consist in exchanging either the untreated data or final descriptions (and perhaps also provisional descriptions) of varieties. For the purposes of examination, the most appropriate form is exchange via computers (on-line use or exchange of diskettes). Apart from the questions raised in document TC/27/7, this exchange raises questions of a financial nature, particularly regarding the present form, now well established, of cooperation in examination. The exchange could for instance be either free or paid for. In the latter case the cost could be the same as or less than the charge made by an examining State when it forwards a report already drawn up for its own purposes or for the purposes of another State. If it is less, one could consider charging an additional fee when the report is to be used in connection with the grant of a breeder's right for the variety described in it.

38. The use of descriptions published in a bulletin as at the Australian office is not recommended, as it is impractical. Except in the case of an entirely manual documentary examination, it presupposes the inputting of the data contained in those descriptions when they are already available in computerized form elsewhere.

An Imperative Solution: User Involvement

39. Any office responsible for the protection of plant breeders' rights must be concerned to manage the protection system in the best possible way. In the case of examination, the objective must not--and indeed cannot--be the total elimination of errors, but rather the acceptance of a margin of error compatible with financial constraints and efficiency for users and other beneficiaries of the system. As already mentioned, it may reasonably be assumed that in a great many cases the national range of varieties of one State is going to be different from that of another State. It is pointless to make comparisons between those ranges.

40. In that case--and in others too--one can rely on the users of the system to contribute to its efficiency by means of verification before or after the event (the grant of rights). That indeed is the main purpose of the descriptions published by the Australian office. Such a distribution of tasks should no doubt be contemplated on a broader scale for certain species, for instance Iris, of which there is on the one hand a very large range of varieties, which offices would probably have difficulty in accommodating, and on the other hand quite a large public of enlightened connoisseurs. This distribution again raises the question of international cooperation in publication, mentioned in paragraph 35 above.

CONCLUSIONS

41. The Office of the Union considers that Article 7 of the 1991 Act of the Convention does not seriously complicate the distinctness examination system. It presumably would not have been adopted by such a large majority had it entailed difficulties for the management of the protection system, apart from which the Article does not place member States under the obligation to amend their distinctness examination procedures.

42. On the other hand, analysis of the action that could be taken to optimize those procedures indicates that the following subjects should be considered in a broader context:

(i) possible recommendations on the content of revised legislation, notably concerning the exchange of samples;

(ii) possible recommendations on certain administrative procedures, with a view to their standardization;

(iii) further improvement of the system of cooperation in examination;

(iv) centralization, rationalization and cooperation in the field of data management;

(v) centralization, rationalization and cooperation in the field of information.

[Annex follows]

[Original: French]

ANNEX

EXCERPTS FROM THE RECORDS OF THE 1957-1961 DIPLOMATIC CONFERENCES

Report of the First Meeting of the Committee of Experts
(April 22-25, 1958)

...

(2) In relation to what will a variety be new? In relation to any variety anywhere in the world or only in relation to those known in the countries of the Union, or for that matter in the country in which the novel variety has been bred?

Ascertaining "absolute" novelty is difficult, above all for ornamental plants. However, for the various categories of plants, the different types of variety are grown in a fairly regional fashion. There are moreover inventories made by research establishments or professional organizations or on the initiative of the International Committee on Nomenclature.

At the level of industrial property, the novelty concept is variable, sometimes absolute, sometimes relative, indeed one could even, at a stretch, acknowledge the coexistence of both conceptions in the plant kingdom.

The main thing is to establish a principle whereby it may be said in relation to what a variety is new, and one that allows comparisons to be made with existing varieties.

In the Convention is seems difficult to speak of anything other than absolute novelty; of course the implementation of such a principle presupposes close collaboration between the countries party to the Convention and their protection services with a view to the harmonization of their working methods and their legislation.

According to the proposal of the Delegation of Italy, one could even consider the setting up of an international commission of advisory character. The difficulties will be encountered at the stage of application of the Convention and national legislation, owing to the use among other things of different terminology (example: Stresa Agreement on cheeses).

Should one speak of "known" varieties, but then what is the meaning of the word "known"? Should one speak of existing, certified or cultivated varieties? Whatever the term, it would give rise to protracted discussion. Indeed even the word "variety" is unsatisfactory and could be replaced by the word "cultivar."

The word "known" could be accepted if it were accompanied by explanatory comments: a known variety is a variety whose existence is a matter of common knowledge in any country.

[Annex to the report: recommendations]

...

For the breeder of a plant novelty (variety or cultivar) to secure the protection provided for in the Convention, it is necessary that the following conditions be met:

(a) it has to be possible to distinguish the new variety clearly, by one or more important characteristics, from any variety whose existence at the time when protection is applied for is a matter of common knowledge ("est notoire"), either in the country in which the new variety has been bred or in any other country.

...

Commentary:

...

3. The novelty concept adopted by the majority of the experts is that of "absolute" novelty. A new variety has to be distinguishable from any variety existing as such (that is, susceptible of precise description, sufficiently homogeneous and sufficiently stable), whose existence may be known and verified by various means, such as: entry in a catalogue, register or list of varieties already made or in the course of being made, growing in a reference collection or precise description in a publication.

[End of document]