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UPOV

CAJ/30/6
ORIGINAL: French
DATE: September 18, 1992

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Thirtieth Session

Geneva, April 8 and 9, 1992

REPORT

adopted by the Committee

Opening of the Session

1. The Administrative and Legal Committee (hereinafter referred to as "the Committee") held its thirtieth session on April 8, 1992, under the chairmanship of Mr. J.-F. Prevel (France). The list of participants is given at Annex I hereto.

2. The session was opened by the Chairman, who welcomed the participants.

Adoption of the Agenda

3. The agenda was adopted as given in document CAJ/30/1, subject to the replacement in item 3 of the reference to document CAJ/29/6 by a reference to document CAJ/30/5.

Guidelines Relating to Essentially Derived Varieties

General

4. Discussions were based on documents CAJ/29/2, CAJ/29/7, paragraphs 4 to 14, and CAJ/30/5. The Committee also briefly discussed a letter from the Secretary General of the International Community of Breeders of Asexually Reproduced Ornamental and Fruit-Tree Varieties (CIOPORA), dated April 4, 1992, that had been received by the Office of the Union on the day preceding the session. The letter is reproduced at Annex II hereto.

Documents CAJ/29/2 and CAJ/29/7

5. **Nature and Role of the Guidelines.**- The Committee approached that question on the basis of paragraph 7 of document CAJ/29/7 (report on its twenty-ninth session).

6. The majority of delegations that spoke on that matter held the following views:

(i) It was not necessary to draw up guidelines for lawmakers, except possibly with regard to the burden of proof, since laws should remain sufficiently general to admit adjustment to future developments.

(ii) The guidelines were mainly aimed at breeders, who were required to manage between themselves the economic relationships resulting from extension of the protection of one variety to the essentially derived varieties.

(iii) The guidelines were therefore also aimed, for example in the form of an expert opinion, at those authorities that would be responsible for settling disputes between breeders on the essentially derived nature or not of a variety.

The delegation of Japan would have preferred guidelines aimed at the lawmakers.

7. The importance of closely concerted action with the breeders' organizations was stressed by several delegations in view of the part to be played by the breeders.

8. Several delegations pointed to the limitations suffered by the guidelines: examination of examples showed that they could go no further than generalities and, moreover, detail was likely to impede the capacity for adapting to circumstances. The Delegations of Germany and of Denmark proposed that there should be a simple collection of examples that reflected the outcome of discussions. The Delegation of France held that to pursue examples would rapidly lead to a dead end.

9. **Arrangements for Settling Disputes and the Role of the Plant Variety Protection Authorities.**- The Delegation of the Netherlands wished for a discussion on those items. It was emphasized that disputes would arise above all in the form of infringement proceedings. The above-mentioned delegation drew attention to the advantages of having an arbitration procedure.

10. It was pointed out that the administration of the provisions on essentially derived varieties had to be separate from the plant variety protection authorities and from the examination of distinctness, homogeneity and stability of varieties (which did not, however, prevent examination also serving as a basis for determining the essentially derived nature of a variety). It was also emphasized that the officials of those authorities could be called upon to contribute to settling a dispute as experts designated by a court. The Delegation of the Netherlands explained that, in its country, the settlement of litigation of that type could be entrusted to the authority itself since the expert knowledge was to be found concentrated in that authority. Indeed, it recommended that solution. The Delegation of France was able to entertain the hypothesis of arbitration by the authority outside its official function; it drew attention to the fact that the parties could wish to submit to other arbitration, particularly where a patent was also involved. Several delegations noted that a dispute could frequently concern related matters--for

example, the amount of remuneration or the contractual clauses--and that the authorities should not be required to take a decision on such matters.

11. **Paragraph 7 of Document CAJ/29/2.**- The Delegation of Japan returned to the question whether the provisions in Article 14(5) of the 1991 Act could be interpreted in such a way that, in a chain of essentially derived varieties of which the initial variety was not (or no longer) protected, the rights afforded by those provisions would apply to the first protected essentially derived variety. It asked the Committee to confirm that that interpretation was not permitted. The Committee confirmed it. The Committee also noted that the preliminary observations made by CIOPORA, reproduced at Annex II hereto, also addressed this issue. The Delegation of France pointed out that the aim of the authors of the provisions concerned had been precisely to prevent derived rights being perpetuated by transfer from one link in the chain to the next.

12. **Paragraph 8 of Document CAJ/29/2.**- All the delegations that spoke with regard to that paragraph were opposed to the description given for the "percentage of derivation." The 50% boundary was not particularly telling and was likely to lead to serious technical error on the part of a non-specialist. To lay down a figure was also extremely hazardous where its basis was not known (all genetic material or the coding parts only) and where there was a genetic heritage common to all the varieties.

13. **Paragraph 9 of Document CAJ/29/2.**- The Delegation of the United Kingdom pointed out the danger of analyzing every phrase, since that would raise more problems than it solved. Such was the case for the explanations as to the concept of "characteristics."

14. **Paragraph 12 of Document CAJ/29/2.**- The Delegation of Japan said that not only did account have to be taken of the number of differences, but also of their significance. That point was not considered further.

15. The Delegation of the Netherlands proposed that "there is some inconsistency" be replaced by a more neutral expression.

16. **Paragraphs 15 to 18 of Document CAJ/29/2.** In a written contribution distributed during the session, the Delegation of Japan proposed that the holder of the breeder's right in a variety claimed to be the initial variety would only have to prove that sufficient resemblance existed and, since it would be too difficult for him to prove the parentage relationship, that the second breeder would have had the possibility of access to that variety. The Delegation of the Netherlands was able to accept that proposal. Those of the United States of America and of France noted that the proposed system was not very far removed from the traditional system with regard to the burden of proof. Furthermore, they were concerned at the implicit assumption that certain varieties were not available for plant breeding purposes despite the fact that the Convention contained a "breeder's exemption."

17. The Delegation of Japan also proposed to add a provision under which a protected variety was presumed not to be essentially derived in the absence of proof to the contrary. The Delegation of France emphasized that the existence of a breeder's right permitted only the presumption that its subject matter was distinct, homogeneous and stable, and that it had been new at the date of the application. It was therefore not able to support the proposal. The Delegation of the United States of America observed that a defendant was at liberty to oppose the request by submitting that the variety claimed to be the initial variety was itself essentially derived. That was but the normal course of the court procedure in that type of litigation and of the rules on the burden of proof. Generally, one had to assume that the owner of a right, here

the plaintiff, had sufficient knowledge of the right to exercise it correctly, as also of the genealogy of his variety and the legal implications thereof.

18. The Delegation of Denmark expressed a general reservation on the reversal of the burden of proof, in view of legal tradition in Denmark.

19. **Paragraphs 19 and 20 of Document CAJ/29/2.**- The Delegation of the United Kingdom noted that the difference between the initial variety and the essentially derived variety could be just in one single characteristic and that its checking could require a complex test, for example at molecular level; it wondered whether it was truly necessary to have recourse to such a test. The Delegations of Germany and of France replied that no given test or type of test could be excluded in principle from the examination of distinctness.

20. The Delegation of Germany suggested, in that respect, that the technical questionnaires be amended to enable the breeder to state the derivation method and also the tests by which the differences could be identified. The Delegation of France did not wish that those questionnaires should in fact become declarations of dependence; in its view, they already enabled all the useful information to be provided.

21. The Delegation of the United States of America observed that any limitation of the tests used by the examination authorities would act in favor of the breeder of the initial variety. It was also noted that the use of molecular tests would require homogeneity at the molecular level concerned, that such homogeneity would be difficult to obtain and that the practical value of such tests was lessened as a result.

22. **Paragraph 21 of Document CAJ/29/2.**- The Committee wanted that paragraph to be redrafted in order to avoid the problem of percentages.

23. **Paragraphs 22 and 23 of Document CAJ/29/2.**- The Committee decided that the matter dealt with in those paragraphs should not be contained in the document to be submitted to the meeting with international organizations. It was nevertheless agreed that it would be useful to have information on the solutions that would be adopted by the States for implementing the new provisions involved.

24. With regard to the option set out in paragraph 22(i), (full "retroactiveness"), opinions varied on its compatibility with Article 40 of the 1991 Act (Preservation of Existing Rights) and, more generally, its relevance. It was emphasized in that respect that breeders' rights did not afford a right to act, but simply a right to prohibit; on the basis of that concept, there would be no conflict with Article 40.

25. With regard to the option set out in paragraph 22(ii) (application of the new provisions to essentially derived varieties for which protection is requested after entry into force of the provisions), it was emphasized that other acts could be taken as the reference, for instance creation or marketing; the filing of an application for protection was moreover an act of reference that would make it possible to escape the new provisions, since it would suffice not to apply for protection.

26. With regard to the option set out in paragraph 22(iii) (no "retroactiveness": the new provisions apply only to initial varieties for which protection is sought or obtained after their entry into force), it was noted that it

penalized breeders who would have applied for or obtained protection under the existing law and that it could therefore disturb the operation of the protection system during the transitional phase.

27. **Document to be Submitted to the Sixth Meeting with International Organizations.**- The Committee agreed that document CAJ/29/2, without Part VII, should be the basis for the document to be submitted to the sixth meeting with international organizations, it being understood that such document would not be a draft for the guidelines referred to in the Resolution on Article 14(5) adopted by the Diplomatic Conference. It was emphasized, in particular, that the guidelines should not enter into the detail given in paragraphs 6 et seq of document CAJ/29/2.

Draft Position Paper From ASSINSEL (Document CAJ/30/5)

28. The Committee ascertained that the draft document contained views that were very close to its own and noted that fact with interest.

Preliminary Observations by CIOPORA (Annex II hereto)

29. It was noted that the observations were of a fundamental nature and called into question, in part, the provisions contained in the 1991 Act. Since they did not contribute to the formulation of practical guidelines for the administration of arrangements based on the concept of essentially derived varieties, the Committee did not examine them further.

30. The Delegation of France, however, noted that the observations drew a parallel between dependency under patent law and "dependency" based on Article 14(5) of the 1991 Act. Although such a parallel made it possible to reach certain conclusions that were correct, it was nevertheless true that the legal and technical bases of the two principles were altogether different.

Definition of the Variety and Use of Multivariate Analysis

31. Discussions were based on document CAJ/30/2.

32. The Committee held that no provision in the 1991 Act opposed the pooling of two or more series of data, each relating to one characteristic, by means of a multivariate analysis and that it was for the experts to say whether such analysis should be used for distinctness examination. It was also noted that there was confusion, in the above-mentioned document, with regard to the analysis methods involved, between the pooling of statistical data and the combination of such data to constitute a complex characteristic (length/width ratio, for example).

Conditions for the Examination of a Variety Carried Out by the Breeder

33. Discussions were based on document CAJ/30/3.

34. The Committee noted that it was not always possible or necessary to require the deposit of a sample. It was therefore agreed to recommend the following text for subparagraph (b) of the 1976 declaration, the relevance of which should be confirmed by the Council:

"(b) the applicant, if requested to do so, deposits in a designated place, and within a time limit set by the authority, a sample of the propagating material representing the variety."

Fees in Relation to Cooperation in Examination

35. Discussions were based on document CAJ/30/4.

36. The following elements emerged from the discussions:

(i) It was not possible to harmonize fees, particularly in view of the facts referred to in paragraph 3 of the above-mentioned document. Consequently, operative paragraph 3 of the Recommendation on Fees in Relation to Cooperation in Examination had become pointless.

(ii) Opinions were divided on the usefulness of separating the charges connected with cooperation in examination from the national fee scales (that is to say to permit those charges to be set at a level differing from that of the corresponding examination fee). The majority was in favor of separation and of the setting of the charges at bilateral or multilateral level by the States party to the cooperation agreements. The Delegation of Japan preferred charges to be set at UPOV level and therefore reserved its position.

(iii) Opinions were divided as to the usefulness of increasing the 350 Swiss franc charge levied where examination results were taken over. The majority was in favor of its maintenance.

37. In view of the above, the Committee agreed to propose to the Council that it repeal the Recommendation on Fees in Relation to Cooperation in Examination, the Model Agreement for International Cooperation in the Testing of Varieties being revised with a view to incorporating those elements still relevant from the Recommendation and to setting out the basis for determining the charges referred to in paragraph 36(ii) above.

Change in the Law of Germany

38. The Delegation of Germany announced that the first Amending Law (of March 27, 1992) to the Plant Variety Protection Law had entered into force on April 8, 1992, the day of the Committee's session. The effects of that Law were as follows:

(i) The list of species was deleted and protection was henceforth available for all plant varieties.

(ii) The requirement for reciprocity had been deleted.

(iii) In the case of varieties of trees and of plants normally used as fruit or ornamental plants, protection had been extended as follows:

(a) to all propagating material produced for commercial purposes (there was therefore no longer a "farmer's privilege");

(b) to plants and parts of plants obtained from propagating material produced without the consent of the breeder and marketed or imported with a view to marketing.

Retirement

39. The Committee was informed that Mr. John Roberts (United Kingdom) was soon to retire and that he was participating for the last time in a session of the Committee. The Committee thanked Mr. Roberts for his activities on behalf of UPOV and wished him a long and happy retirement.

40. This report has been adopted by correspondence.

[Annexes follow]

ANNEXE I/ANNEX I/ANLAGE I

LISTE DES PARTICIPANTS*/LIST OF PARTICIPANTS*/TEILNEHMERLISTE*

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* Dans l'ordre alphabétique des noms français des Etats/In the alphabetical order of the names in French of the States/In alphabetischer Reihenfolge der Namen der Staaten in französisch

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Jean-François PREVEL, Président

V. BUREAU DE L'UPOV/OFFICE OF UPOV/BUERO DER UPOV

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André HEITZ, Director-Counsellor
Max-Heinrich THIELE-WITTIG, Senior Counsellor
Makoto TABATA, Senior Program Officer

[L'annexe II suit/
Annex II follows/
Anlage II folgt]

CIOPORA

COMMUNAUTÉ INTERNATIONALE DES OBTENTEURS DE PLANTES ORNEMENTALES ET FRUITIÈRES DE REPRODUCTION ASEXUÉE

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TEL. 93 95 81 80 - FAX 93 90 04 09

April 4, 1992

Mr. Barry GREENGRASS
Vice-Secretary General
UPOV
Chemin des Colombettes
GENEVA

Re.: "Essentially derived varieties" under the 1991 UPOV Convention

Dear Mr Greengrass,

Early this year you asked me whether CIOPORA had made any comments or published any position paper on the above-mentioned subject and I replied in the negative explaining that this matter would be one of the items under discussion at our next International Symposium which is to be held in Munich on September 17 and 18, 1992.

However, during our recent Board Meeting in Barcelona on March 27, 1992, we had the opportunity to discuss this matter and, in order to give you a few hints on the present views of our members, I send you enclosed a résumé of the provisional remarks and thoughts expressed during our meeting and on which concurrence of opinions was reached. Of course the enclosed does not represent any official position of our association since it has not yet been the subject of a discussion of our Annual General Meeting. And as you probably know, our association is not a federation of national associations but, instead, is composed of individual members having one vote each so that any official position has to be ratified by the AGM.

In order to be able to continue and make progress in our study of this difficult problem we shall equally appreciate being regularly copied of any UPOV documents that your Office may publish as well as of any survey, articles or even case law that you might be informed of.

Sincerely yours,

R. Royon
Secretary General

CIOPORA
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CIOP/rr

April 1, 1992

Provisional Thoughts and Comments of CIOPORA on the problem of "dependency" and "essentially derived varieties" under the new March 1991 Act of the UPOV Convention (article 14.5)

I

First of all CIOPORA wishes to reiterate its views that paragraph (ii) of article 14 (5)(a) has nothing to do with "dependency" and should have been incorporated into another part of article 14 or, better still, of article 7 of the Convention. Indeed, this paragraph is related both to

- the problem of "minimum distances" (nonobviousness or inventive step) between varieties of common knowledge and varieties which do not meet the protection requirements; and

- the problem of infringement of "parasitic" varieties where the varieties of common knowledge are protected varieties.

CIOPORA considers it essential that, whether under the present Convention or under the Revised UPOV Convention, harmonized rules of minimum distances in DUS tests be organized in order to eliminate such parasitic varieties from the very stage of examination because they are <u>within</u> the perimeter of minimum distances!. Otherwise, as a pending case is now demonstrating in Israel, the whole system of protection of breeders' rights under the UPOV Convention would be deprived of any interest for breeders.

The following thoughts on Dependency will, as a consequence of the preceding remarks, be limited to varieties falling under article 14(5)(a)(i) ["*essentially derived varieties*"], since 14(5)(a)(iii) is a case of "dependency" already covered by the present (1961 and 1978) Convention.

II

1 - CIOPORA basically considers that, although the concept of "Dependency" under the new article 14(5)(a)(ii) of the 1991 UPOV Convention has been poorly worded (see CIOPORA's comments on UPOV document DC/91/3 of November 9, 1990 and notably on the words "essentially", "predominantly" and "conform"), one should not repeat the mistake of the 1979 "Guidelines on Denominations" and run the risk of weakening the concept of Dependency such as defined in the Convention by more restrictive Guidelines.

2 - CIOPORA considers that, in view of the increasing problems of interface between traditional breeding and genetic engineering, and since genetic information will be basically protected by patents, Dependency shall necessarily have to be organized by national legislation and interpreted by the Courts in a similar way, whether it applies to

. plant varieties, protected by breeders' rights certificates, plant patents or utility patents, or to

. inventions relating to biotechnology, protected by patents.

3 - Whether in the case of plant varieties or of industrial inventions, Dependency must be considered as a specific case of infringement between an initial and already "protected" variety or invention and a subsequent variety or invention which, although it is "distinct enough" to be "protectable" by a patent or a breeders' rights certificate, is still too "close" to the initial product and consequently falls within the scope of rights conferred on the initial product.

CIOPORA again insists that while patentability or "protectability" by breeders' rights of a variety has to be assessed by differences (PROVIDED such differences do represent a certain "inventive step" or certain "minimum distances" with existing varieties), infringement has to be appraised by the similarities with or resemblance to already protected varieties.

Dependency should therefore exist where the "essential characteristics" of a protected variety are reproduced in another subsequent variety.

4 - Where A is protected and A^{**} is essentially derived from A^{*} which, itself, is essentially derived from A, CIOPORA considers that A^{**} must be dependent upon A if, like A^{*}, it reproduces the essential characteristics of A (this is normally the case with mutations). CIOPORA interpretes article 14(5)(b)(i) as meaning exactly this.

Where A is no longer protected but A* is still protected, CIOPORA wonders whether it is right to exclude dependency in such a case [last part of 14(5)(a)(i)]. Indeed, when wording the 1991 Convention, one should have more carefully considered the following:

(a) The purpose of the new provisions of the 1991 UPOV Convention is to better protect the research efforts of the breeder of the initial variety and to avoid that mere "finders" should freely and easily cash in on such efforts.

(b) In the present stage of technology, it may be impossible to prove whether A** is essentially derived from A* or from A.

(c) In many instances, the breeder of the initial variety will himself find or provoke mutations on his own initial variety. And, since an initial variety A may be rapidly evicted from the market by one of such mutations, it may therefore become too expensive for the breeder to continue to maintain its title of protection on A whereas he will continue to protect the mutation (A* for instance).

(d) And in the case of "plant varieties", what is protected in an essentially derived variety A* is not the distinct characteristic *per se* (*) but the variety itself, taken as a whole.

Therefore, if A is no longer protected but A* is protected (or controlled) by the breeder of the original variety A and if A** is essentially derived from A* "while retaining the essential characteristics of A", it may be wrong to exempt the finder of A** from dependency.

5 - Like in dependency for industrial products, where a title of protection (patent or breeders' rights certificate) for an essentially derived variety is dependent upon a former title of protection granted on the initial variety, the breeder of the initial variety or holder of the "controlling" title should be able to oppose the commercial exploitation of the second title because it infringes on his prior rights.

As far as ornamental and fruit tree plant varieties are concerned, there should be no compulsory licensing since public interest is hardly concerned by such plants and one should leave it to private contractual law provisions in license agreements and to the competent jurisdictions to take care of the conflicts that may arise in such situations of dependency.

6 - Dependency in the field of plant varieties does not offer any specific originality compared with patented industrial inventions. It may only occur more often especially in the case of mutations.

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