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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Thirty-third Session

Geneva, October 27, 1993

NOVELTY

Document prepared by the Office of the Union

Introduction

1. At its thirty-second session, the Administrative and Legal Committee decided to place on the agenda of the present session the question whether the 1991 Diplomatic Conference had the intention of introducing changes into the provision which establishes the novelty condition (see paragraph 36 of document CAJ/32/10-TC/29/9).

2. This document compares the provisions in question (Article 6(1)(b) of the 1978 Act and Article 6(1) of the 1991 Act). It is not concerned with the transitional limitation of the requirement of novelty which can be applied to varieties of recent creation (Article 38 of the 1978 Act and Article 6(2) of the 1991 Act) nor with the question of territories in the case of the member States of certain intergovernmental organizations (Article 6(3) of the 1991 Act).

The Legal Basis

3. Article 6(1)(b) of the 1978 Act reads as follows:

> "b) At the date on which the application for protection in a member State of the Union is filed, the variety
>
> "(i) must not--or, where the law of that State so provides, must not for longer than one year--have been offered for sale or marketed, with the agreement of the breeder, in the territory of that State, and

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

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

4. Article 6(1) of the 1991 Act reads as follows:

"(1) [Criteria] The variety shall be deemed to be new if, at the date of filing of the application for a breeder's right, propagating or harvested material of the variety has not been sold or otherwise disposed of to others, by or with the consent of the breeder, for purposes of exploitation of the variety

"(i) in the territory of the Contracting Party in which the application has been filed earlier than one year before that date and

"(ii) in a territory other than that of the Contracting Party in which the application has been filed earlier than four years or, in the case of trees or of vines, earlier than six years before the said date."

5. The novelty condition has the following constituent elements:

- a specified varietal material
- may not have been the subject of specified acts
- for specified purposes
- before specified dates.

The Origin of Article 6(1) of the 1991 Act

6. The initial work on the revision of the Convention was based upon a novelty rule according to which a variety ought not to be exploited commercially before certain dates (see, for example, document CAJ/XXII/2--a preparatory document for the April 1988 session). For a long time discussion concerned whether a requirement for the agreement of the breeder should be added to the rule, or alternatively a provision specifying that the abusive acts of third parties could not be held against the breeder; the issue of the burden of proof also arose in relation to allegations that an act destructive of novelty had been carried out without the agreement of the breeder. Alternatives were proposed for the first time in document CAJ/XXIV/2 (a preparatory document for the April 1989 session); these still appeared in document CAJ/27/2, which was submitted to the session of the Committee held from June 25 to 29, 1990.

7. The outline of the text finally adopted by the Diplomatic Conference emerged in the course of the forementioned session; the report on the discussions (paragraphs 40 to 47 of document CAJ/27/8) is reproduced in the

Annex. It should be noted that the Committee met once again in October 1990 but on that occasion it only made modifications to the detail of the text which was finally adopted by the Council in October 1990 as the Basic Proposal for the Diplomatic Conference.

The Plant Material

8. The 1978 Act is very general and simply refers to the "variety"; the 1991 Act specifies that novelty is established by reference to propagating material and harvested material of the variety.

9. The Diplomatic Conference decided to exclude the product directly obtained from harvested material when assessing novelty. Accordingly, a variety that has been exploited commercially during periods greater than those provided for by the 1991 Act remains protectable if the material to which the public had access was a transformed product (for example, ground pepper) and only this product (the sale of pepper seed, on the other hand, would be destructive of novelty).

The Acts

10. The 1978 Act makes reference to offer for sale or marketing, while the 1991 Act refers to sale or disposal to others in some other manner.

11. A simple offer for sale--even if on a large scale, for example, in the form of an item in a catalogue or an advertisement--cannot be held against the breeder under the new text. The new text was initially based upon the wish of the Delegation of Germany which sought to base the condition of novelty not "on the commercial exploitation of the variety but rather on the fact that plants or certain parts of plants had or had not been remitted to others together with the right of disposition, i.e. that the variety [had or had not] become freely available to those persons" (see paragraph 27 of document CAJ/26/1, report of the April 1990 session).

12. The 1978 Act specifies that trials with a variety not involving an offer for sale or marketing, or the fact that a variety becomes known to the public as a result of acts other than an offer for sale or marketing, do not affect its novelty. These provisions are of an explanatory nature; they have no equivalent in the 1991 Act.

The Purposes

13. The idea of purpose was introduced into the 1991 Act. The 1978 Act, based upon the notion of marketing, had no need of it, although it was generally considered that certain transactions which might be regarded as "marketing" ought not to be taken into account within the framework of the novelty examination; this applies particularly to seed multiplication contracts entered into as a step preceding the launch of the variety.

14. It was this point of view which led the Office of the Union to insert: "for the purposes of exploitation" in document IOM/5/2 (prepared for the meetings of October 1990) in order to restrict the scope of: "sold or otherwise disposed of to others." At the fifth Meeting with International Organizations (October 1990), ASSINSEL proposed the inclusion of a provision worded as follows:

"The making available of a variety by the applicant under a contract by which the applicant maintains his property right in the variety, particularly for the purposes of trial, propagation, production of hybrid seed, processing and storage, shall not be understood as exploitation within the meaning of subparagraphs (i) and (ii)."

(See paragraph 109 of document IOM/5/12).

15. In the course of the twenty-eighth session of the Committee (October 1990), the expression "for the purposes of exploitation" was supplemented with "of the variety," which lead to the text finally adopted; this decision followed upon interventions from several delegations who underlined that "the sale of by-products from a breeding program and from trials should not prejudice novelty" (see paragraph 19 of document CAJ/28/6).

16. The question of exceptions was also raised during the Diplomatic Conference (see paragraphs 375, 380.1, 380.2 and 395 to 399 of the Summary Minutes of the Plenary Sessions of the Diplomatic Conference), and at the thirty-first and thirty-second sessions of the Committee (October 1992 and April 1993), on the basis of document CAJ/31/4; the report of the discussions appears at paragraphs 13 to 15 of document CAJ/31/5 and paragraphs 35 and 36 of document CAJ/32/10-TC/29/9.

17. In the course of the discussions, opinions differed on the question whether it is better to include provisions in national law in order to secure that the 1991 Act is applied at the national level in accordance with the spirit which inspired its drafting, or to leave this to jurisprudence. The Committee may wish to reconsider this question.

18. It would seem to be important, in fact, to determine whether (specific) seed multiplication contracts entered into as a step preceding the launch of the variety could be considered as a result of legal analysis to fall outside the notion of selling or otherwise disposing to others for the purposes of the exploitation of the variety. The notion of "others" could also perhaps call for definition in certain cases, particularly when transactions take place between enterprises within a single group.

The Dates

19. Being concerned to harmonize national laws, as a token of greater security for users, the Diplomatic Conference made compulsory the "period of grace" of one year for relevant acts of exploitation carried out in the territory where the application is filed.

[Annex follows]

ANNEX

EXTRACT FROM DOCUMENT CAJ/27/8

(Report on the June 1990 Session of the Committee)

Paragraph (3) - Novelty

40. Five separate questions were examined on the basis of the Draft and of the proposals submitted during the session by the Delegations of the Federal Republic of Germany, the Netherlands and Switzerland and by the Office of the Union.

41. The first question was whether novelty was to be assessed by reference to commercial exploitation (as in the Draft) or to sale or to any other act of making available certain material to others (solution recommended by the Delegation of the Federal Republic of Germany). That latter solution was chosen by the Committee. No conclusions were drawn as to whether an offer for sale was also to be taken into consideration.

42. The second question dealt with the material to be taken into consideration. It gave rise to a general question in response to which the Delegation of Italy reserved its stance. The other delegations agreed that the material should comprise not only the propagating material, but also the harvested material. As for the product directly obtained from the harvested material, six delegations (France, Japan, Netherlands, New Zealand, Switzerland, United Kingdom) spoke in favor of its inclusion; the other eight (Australia, Belgium, Denmark, Federal Republic of Germany, Hungary, Ireland, Sweden, United States of America) were in favor of insertion of the wording in square brackets. The representative of the EC was in favor of insertion, but without square brackets, where the product involved was specific to the variety. In conclusion, it was agreed to mention the product obtained directly from the harvested material in square brackets in the next Draft and to state in a footnote that a large minority was already in favor of a provision that would also be based on such product.

43. The third question dealt with the breeder's agreement. It also gave rise to a general question in response to which the Delegation of Italy reserved its stance. With the exception of the Delegation of New Zealand (and of the representative of the EC), the delegations that voted were in favor of inserting the words "with the agreement of the breeder" in the provision setting out the novelty condition (sub-paragraph (a) in the Draft). Consequently, sub-paragraph (b), which was simply explanatory, would be deleted.

44. The fourth question concerned inclusion of a reference to woody sarmentous plants other than grapevine. As the result of a general question, on which the Delegation of Italy abstained, nine delegations spoke in favor of its inclusion and five others of its inclusion in square brackets. It was agreed that the next Draft would contain the expression without square brackets.

45. The fifth question concerned the period for marketing abroad ("period of grace"). It was agreed that, if necessary, the delegations and representatives concerned would propose a solution to possible problems raised by the existence of a unified market in Europe.

46. The text adopted by the Committee was therefore based on the following reasoning:

"The variety shall be deemed new if the reproductive or propagating material of the variety, the harvested material or the product directly obtained from harvested material has not been sold or otherwise made available to others by the breeder or with his consent..."

47. The Committee took cognizance of document CAJ/27/6. The Delegation of France commented that if a hybrid was represented by its components and the formula associating them, then the sale or making available to third parties of hybrid seed should be equivalent to sale or making available to third parties of the components. Moreover, it interpreted the wording chosen by the Committee for Article 8(3) as meaning that the making available of seed of a component to third parties for the purposes of producing hybrid seed was liable to affect the novelty of that component, whatever the nature of the contract.

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