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Subject: CIOPORA comments to the UPOV documents CAJ-AG/12/7/3 and UPOV/EXN/EDV/2/Draft 2
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Attachments: [Letter to UPOV CAJ-AG on Essentially Derived Varieties_04-10-2012.pdf](#)

Attn.

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OF PLANTS (UPOV)
Administrative and Legal Committee Advisory Group (CAJ-AG)
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Dear members of the UPOV CAJ-AG,

Please find attached the CIOPORA comments to the UPOV documents

CAJ-AG/12/7/3 and UPOV/EXN/EDV/2/Draft 2.

With kind regards,

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Secretary General

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Hamburg, 04 October 2012

**Explanatory notes on Essentially Derived Varieties under the UPOV Convention
CAJ-AG/12/7/3 and UPOV/EXN/EDV/2/Draft 1**

Dear members of the CAJ-AG,

CIOPORA is pleased to submit the following additional comments in regard to the documents
CAJ-AG/12/7/3 and UPOV/EXN/EDV/2/Draft 2.

A) Non-protected EDV falling under the scope of protection

- 1 CIOPORA suggests to adding to Section I, chapter (c) explanations about non-protected EDVs. Non-protected EDVs fall in the same way under the scope of protection of the initial variety than separately protected EDVs. The commercialization of non-protected EDVs requires the authorisation (only) of the title-holder of the initial variety.
- 2 Section I, chapter (c) is silent about this important fact and should be amended accordingly, including a figure. The short half-sentence on page 12, number 16 at the very end, does not cover the matter sufficiently.
- 3 Sufficient information about this aspect is important, because the EDV concept imposes obligations for the breeder of the EDV, propagators, growers and traders, who have to comply with these legal requirements¹. The risks of a negligent infringement of the PBR of an initial variety by commercialising a non-protected EDV is rather high, as currently non-protected EDVs are not registered.

B) Variety denomination of non-protected EDV

- 4 Based on the explanation before, it is also advisable to add some explanations about the variety denomination of a non-protected EDV.

¹ See also under number 15 below.

- 5 Article 20 (1) of the UPOV 1991 Act requires that varieties shall be designated by a denomination, and Article 20 (5) provides that a variety must be submitted to all contracting parties under the same denomination.
- 6 Article 20 (7) stipulates that any person who, within the territory of one of the Contracting Parties, offers for sale or markets propagating material of a variety protected within the said territory shall be obliged to use the denomination of that variety, even after the expiration of the breeder's right in that variety.
- 7 An EDV, being a separate variety, shall be designated by a variety denomination according to Article 20 (1) of the UPOV 1991 Act, too.
- 8 This is obvious and happens each time where the EDV is applied for separate PBR protection, because the approval of a suitable variety denomination is part of the granting process.
- 9 Also non-protected EDVs are separate varieties and shall be designated by a variety denomination, too. This follows from Article 20 (1), which does not limit the need to designate a variety by a denomination to protected varieties. It also follows from the general understanding of a variety denomination as the generic name of a variety.
- 10 As EDVs necessarily are distinct from the Initial Variety, they must not bear the same variety denomination than the initial variety. This applies both to protected and non-protected EDVs.
- 11 A variety, which is considered to be an EDV in a UPOV 1991 member state, may be considered to be an "ordinary" variety in a UPOV 1978 member state, where no EDV concept is included in the law. While in the UPOV 1991 member state the EDV may be not protected separately, it may be protected in the UPOV 1978 member state. In both countries the variety needs to have the same denomination, according to Article 20 (5).
- 12 The national PBR offices should be competent for the approval of a denomination of non-protected EDVs. The approval shall take place on the proposal of the title-holder of the initial variety, which in many cases is also the breeder of the non-protected EDV. The title-holder of the initial variety is – as far as his variety and a non-protected EDV thereof are concerned - the only person who has established contacts to the PBR office and who has the exclusive right over the non-protected EDV.
- 13 In regard to the suitability of the variety denomination the authorities should apply the same rules than for varieties, which are subject of a separate PBR application. It might be of advantage to develop guidance for variety denominations of EDV – whether protected or non-protected - particularly with regard to a link between the denomination of the EDV and the denomination of its Initial Variety.

C) Obligation to use the variety denomination

- 14 In order to avoid confusion and false marketing and in order to enable the title-holder of the Initial Variety to enforce his rights on the non-protected EDVs thereof it is necessary to oblige any person, who commercializes a (directly or indirectly) protected variety, to use the designated variety denomination. This shall apply also to EDV, irrespective whether such EDV is protected or not.
- 15 Reasons for obliging all parts of the trade chain to use a variety denomination are:

- a) The variety denomination is the generic name of the variety, which designates the variety and allows to identify it in the entire production and trade chain.
- b) The title holder of the initial variety must be able to identify the EDVs of his protected variety, in order to be able to control the commercialization of the EDVs.
- c) The propagator, the grower, the trade and the consumer have an interest to know which variety they are growing, trading, purchasing – also in case of an EDV.
- d) The propagator and grower are obliged to check if the variety which he grows is protected (or falls under the scope of protection) and if the propagating material complies with the law (“compliance check”)². This is possible only if the varieties are designated by a variety denomination.
- e) The trader is obliged to carefully check with its supplier (i.e. grower) whether such necessary compliance-check has been carried out. If he does not check with his supplier, he has to do the check himself. A trader must not put a product into circulation unless he can reasonably assume that the necessary check of IP compliance has been carried out at least once². This is possible only if the varieties are designated by a variety denomination.

D) Variety Description of a non-protected EDV

- 16 As a consequence of the mandatory separate and unique variety denomination for a non-protected EDV, such EDV also requires a description of the variety, using its relevant characteristics, by which it can be defined as a variety in terms of Article 1 (vi) of the UPOV 1991 Act. Without such a description the variety denomination cannot be designated to the EDV, because the variety has no profile.
- 17 Such variety description shall be made by competent DUS examination offices, following a similar procedure than for examinations in the course of granting PBR.

E) Register of non-protected EDV

- 18 As soon as the variety description has been made and the variety denomination has been approved, the non-protected EDV should be included into a separate register, to be managed by the respective PBR offices.
- 19 The EDV shall stay in the register as long as its Initial Variety is protected in the territory concerned. The variety denomination and the variety description of the EDV as well as the variety denomination of its Initial Variety shall be published in the register.
- 20 Such register will allow all parties in the industry to check whether a variety is covered by PBR protection.

F) Clarity about what is an EDV is urgently required

- 21 All remarks under numbers 1 to 20 above depend on a clear determination of which variety is an EDV. Without clarity in this point the concept of EDV cannot unfold its full potential and continues to be a source of disputes.

² Such obligations are immanent in all IP laws. They have been expressly written down in regard to Plant Breeders' Rights by the German Federal Supreme Court in the case “Melanie” (decision of 14 February 2006, X ZR 93/04).

- 22 In the CIOPORA Conference on “*Patents and modern PBR in horticultural breeding*”, which was held on 20 September 2012 in Venlo, NL, it was consensus among the participants that true innovations must be better protected. A clear and sufficiently broad EDV concept was mentioned as one of the tools to achieve this goal. The example given by an apple breeder was an eye-opener in this regard: In order to develop a new innovative apple variety it needs more than 20 years breeding- and evaluation-work. Mutants of such a new variety can be developed very rapidly after its introduction and can lead to a significant loss in the market position of the original variety. The PBR has to protect the innovative breeder against such undesirable development. The auditorium was concerned about the UPOV system not providing sufficient protection for innovations.
- 23 Innovation is the motor of any business. In the area of plant breeding the “original genotypes” provide the level of innovation which is the motor for the entire business. Therefore, the promotion of innovation necessitates the primary protection of these “original genotypes”. Depending on the development stage of species it is extremely difficult and cost- and labour intensive to create real innovations in these species. These investments must be protected by granting a solid protection.
- 24 In order to enable innovators to sustainably continue their business, they deserve a true and effective “exclusive right” for their innovation. Granting such an exclusive right is the key task of any Intellectual Property regime, also of the UPOV PBR regime. The breeders’ exemption poses a unique limitation to such exclusive right, as it allows third parties to immediately take advantage of the innovation. CIOPORA is in favour of granting unlimited access to the germplasm for further breeding and research. However, it requires a corrective as regards the commercialisation of the breeding result. The EDV concept is designed as such corrective, and its significance must not be diminished by a limitation of its scope.
- 25 The opportunity to introduce non-protected EDV into the market, which have the same protection than protected varieties, can have significant advantages for the breeders concerned. Inter alia it can save a significant amount of money in the breeding industry, which is urgently required particularly in so called small commercial crops. However, pre-condition for the EDV concept to unfold its full effect is that the concept is clear and that every breeder knows with security whether a variety is an EDV or not.

G Relationship between Article 14 (5) (b) (i) and (iii) of the UPOV 1991 Act

- 26 The draft 2 of the EXN on EDV needs to be amended by a clarification of the relationship between Article 14 (5) (b) (i) and (iii) of the UPOV 1991 Act of this point.
- 27 In this regard CIOPORA makes reference to its previous comments.

With kind regards,

CIOPORA



Dr. Edgar Krieger
Secretary General