



CAJ-AG/13/8/5

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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

Geneva

ADMINISTRATIVE AND LEGAL COMMITTEE ADVISORY GROUP

Eighth Session Geneva, October 25, 2013

MATTERS CONCERNING NULLITY OF THE BREEDER'S RIGHT

Document prepared by the Office of the Union

Disclaimer: this document does not represent UPOV policies or guidance

1. The Administrative and Legal Committee Advisory Group (CAJ-AG), at its seventh session, held in Geneva, on October 29 and 30, 2012, considered that it would be appropriate to develop further guidance in a separate document for the matters covered in document CAJ-AG/11/6/4 "Matters Arising after the Grant of a Breeder's Right" concerning nullity of the breeder's right (see CAJ-AG/12/7/7 "Report", paragraph 90).

BACKGROUND

2. The provisions on the nullity of the breeder's right contained in Article 21 of the 1991 Act of the UPOV Convention and Article 10 (1) and (4) of the 1978 Act of the UPOV Convention are reproduced below:

<p>1991 Act of the UPOV Convention</p> <p>Article 21</p> <p>Nullity of the Breeder's Right</p> <p>(1) <i>[Reasons of nullity]</i> Each Contracting Party shall declare a breeder's right granted by it null and void when it is established</p> <p>(i) that the conditions laid down in Articles 6 or 7 were not complied with at the time of the grant of the breeder's right,</p> <p>(ii) that, where the grant of the breeder's right has been essentially based upon information and documents furnished by the breeder, the conditions laid down in Articles 8 or 9 were not complied with at the time of the grant of the breeder's right,^[1] or</p> <p>(iii) that the breeder's right has been granted to a person who is not entitled to it, unless it is transferred to the person who is so entitled.^[2]</p> <p>(2) <i>[Exclusion of other reasons]</i> No breeder's right shall be declared null and void for reasons other than those referred to in paragraph (1).</p>
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¹ There is no corresponding provision to Article 21(1)(ii) of the 1991 Act in the 1978 Act.

² There is no corresponding provision to Article 21(1)(iii) of the 1991 Act in the 1978 Act.

3. Guidance on nullity of the breeder's right is currently provided in document UPOV/EXN/NUL/1 "Explanatory Notes on Nullity of the Breeder's Right under the UPOV Convention".

MATTERS FOR CONSIDERATION

Overview

4. The CAJ-AG, at its seventh session, considered that it would be appropriate to develop further guidance in a separate document for the matters covered in document CAJ-AG/11/6/4 "Matters Arising after the Grant of a Breeder's Right" concerning nullity of the breeder's right (see CAJ-AG/12/7/7 "Report", paragraph 90).

5. Matters with regard to nullity were presented in the following parts of document CAJ-AG/11/6/4:

(a) Annex I, Appendix 3 (Contribution from the European Union) (reproduced as Annex I to this document);

(b) Annex I, Appendix 6 (Contribution from South Africa) (reproduced as Annex II to this document);
and

(c) Annex II (Contribution from South Africa) (reproduced as Annex III to this document)

6. The following matters, reproduced from document CAJ/60/8 "Matters arising after the grant of a breeders' right", paragraph 8, were also presented in document CAJ-AG/11/6/4:

"a) Matters concerning distinctness

Example:

– after the grant of the breeder's right, a claim is made that the protected variety was not distinct from a variety whose existence was a matter of common knowledge at the time of the filing of the application."

7. The matters above are considered in the following paragraphs.

Responsible authority

8. The CAJ-AG may wish to consider the development of guidance to explain that it is a matter for the member of the Union concerned to decide which authority is competent to decide on nullity of breeders' rights (see Annex I to this document).

9. The CAJ-AG is invited to consider the development of guidance to explain that it is a matter for the member of the Union concerned to decide which authority is competent to decide on nullity of breeders' rights.

Initiation of nullity proceedings

10. The CAJ-AG may wish to consider the development of guidance to explain that nullity proceedings may be initiated by a request from a third party or *ex officio* by the competent authority of the member of the Union concerned (see Annex I to this document).

11. The CAJ-AG is invited to consider the development of guidance to explain that nullity proceedings may be initiated by a request from a third party or ex officio by the competent authority of the member of the Union concerned.

Distinctness

12. Paragraph 6 of this document (reproduced from document CAJ/60/8, paragraph 8) refers to nullity on the basis that the protected variety was not distinct from a variety whose existence was a matter of common knowledge at the time of the filing of the application. Annex I to this document proposes that “[i]f the Distinctness requirement is being questioned, it is important that the examination authority keeps track of the reference varieties used in the original DUS test”.

13. The CAJ-AG may wish to consider the development of guidance to explain the importance of the authority maintaining information on all varieties considered in the examination of distinctness of a candidate variety. In that regard the CAJ-AG may wish to:

(a) consider that matter in relation to document CAJ-AG/13/8/7 “Matters concerning Variety Descriptions”; and

(b) propose to the Administrative and Legal Committee (CAJ) to invite the Technical Committee (TC) to pursue this matter in the first instance.

14. *The CAJ-AG is invited to:*

(a) consider the development of guidance to explain the importance of the authority maintaining information on all varieties considered in the examination of distinctness of a candidate variety;

(b) consider that matter in relation to document CAJ-AG/13/8/7 “Matters concerning Variety Descriptions”; and

(c) propose to the Administrative and Legal Committee (CAJ) to invite the Technical Committee (TC) to pursue this matter in the first instance.

Effect of Nullity

15. Annexes II and III to this document refer to an example of a case in South Africa in which a decision to declare a breeder’s right null and void resulted in a requirement for the “PBR holder” to pay back “illegal royalties”. The CAJ-AG may wish to consider the development of guidance to explain that such measures might result from a decision on nullity.

16. The CAJ-AG is invited to consider the development of guidance to explain measures that might result from a decision on nullity, as set out in paragraph 15 of this document.

[Annexes follow]

ANNEX I

CONTRIBUTION FROM THE EUROPEAN UNION

To the attention of Mr. Rolf Jördens
Vice Secretary-General of UPOV

Union internationale pour la protection des obtentions végétales (UPOV)
34, chemin des Colombettes
CH-1211 Genève 20

Dear Mr. Jördens,

Please find the following answer prepared by the Community Plant Variety Office to the UPOV Circular E-1168 of December, 23, 2009 on matters arising after the grants of the breeder's right:

- In UPOV documents UPOV/EXN/NUL/1 and UPOV/EXN/CAN/1 certain aspects of Nullity & Cancellation are dealt with. The Explanatory Notes on Variety Denominations under the UPOV Convention provide also guidance on situations in which the variety denomination might be cancelled.
- The proposed document on examples on matters arising after the grant of the breeders right might include:

Nullity

- It may be stated that it is under UPOV members' law to decide which authority is competent to decide on nullity
- It may be stated that nullity proceedings may be initiated by a request from a third party or *ex officio* by the UPOV members' competent authority
- If the Distinctness requirement is being questioned, it is important that the examination authority keeps track of the reference varieties used in the original DUS test

[...]

Jacques Gennatas
Adviser to the Deputy Director-General
European Commission
DG Health and Consumers

[Annex II follows]

ANNEX II

CONTRIBUTION FROM SOUTH AFRICA

EXAMPLES ON MATTERS ARISING AFTER THE GRANT OF
THE BREEDER'S RIGHT

1. NULLITY

A petition to declare Phasion, a Canna variety null and void was received by the PBR Office on 3 July 2002. The grounds for the request were that the South African PBR holder was not entitled to the Rights, and that the variety did not fulfill the novelty criterion on the filing date.

The case was heard by the High Court of South Africa. Based on all documentary proof and photos submitted, the Court ruled that the granted PBR be declared 'Null & Void'. The 'PBR holder' was found guilty of fraud and he had to pay back thousands of rands in return of illegal royalties claimed.

[Annex III follows]

CONTRIBUTION FROM SOUTH AFRICA

MATTERS ARISING AFTER THE GRANT OF A PLANT BREEDER'S RIGHT

REF: CAJ-AG/10/5/6

CONTRIBUTION FROM SOUTH AFRICA received on December 20, 2010

NULLITY

In relation to the guidance provided in document *UPOV/EXL/NUL/1*; it is not clear what the implications of declaring a plant breeder's right "null and void" might be. Questions we receive in our country regarding declaring a plant breeders' right null and void include:

- must an applicant of such a right be reimbursed all the monies paid by him upon application for that Plant Breeders' Right?
- must all the royalties claimed by the applicant concerned be returned to those affected?

[End of Annex III and of document]