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agreed by the Council of UPOV, only documents that have been adopted by the Council of UPOV and that have not been superseded can represent UPOV policies or guidance.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

UPOV

CAJ/XVII/2
ORIGINAL: French
DATE: March 24, 1986

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Seventeenth Session
Geneva, April 16 and 17, 1986

BIOTECHNOLOGIES AND PLANT VARIETY PROTECTION

- - - - -

EVALUATION OF THE RESULTS OF THE DISCUSSIONS IN OTHER FORA

Document prepared by the Office of the Union

INTRODUCTION

1. The draft agenda for this session of the Administrative and Legal Committee provides under item 5(i) for an "evaluation of the results of the UPOV/WIPO information meeting of January 10, 1986."

2. That meeting followed the second Meeting with International Organizations organized by UPOV on October 15 and 16, 1985, the agenda of which provided for a discussion on the "appropriate protection of the results of biotechnological developments by industrial patents and/or plant breeders' rights." It preceded the second session of the Committee of Experts on Biotechnological Inventions and Industrial Property organized by WIPO from February 3 to 7, 1986.

3. For this reason, the report given below will be on the second Meeting with International Organizations (a draft record thereof being reproduced in document IOM/II/8 Prov.). The report on the information meeting will be limited to items that are new in relation to what was said in October 1985. Finally, concerning the second session of the WIPO Committee of Experts on Biotechnological Inventions and Industrial Property, the members of the Administrative and Legal Committee will be referred to document BioT/CE/II/3.

SECOND MEETING WITH INTERNATIONAL ORGANIZATIONS

General

4. The discussions on the "appropriate protection of the results of biotechnological developments by industrial patents and/or plant breeders' rights" were very long and dense. They took place in the afternoon of October 15 and in the morning of October 16, 1985, under the direction of Mr. S. D. Schlosser (United States of America), Chairman of the Biotechnology Subgroup.

5. The discussions mainly focused on the protection by patents. Many problems were raised in respect of the patent route; very few of them received a satisfactory answer, that was favorable to that route. It is true, however, that the purpose of the discussions was not to find such answers.

6. In contrast, the main principles of the UPOV Convention were not brought into question, except by a fraction of the participants as regards Article 5(3), i.e. the free use of a protected variety in plant breeding work. In fact, the criticism of Article 5(3) was an argument, not against plant variety protection, but for the introduction of the industrial patent alongside of that protection. The latter was found to be of vital importance by plant breeders for themselves.

7. The discussions showed that views were not final at organization level. But there were convergent personal opinions within each organization and across organizations, with two well-individualized focal points:

i) the plant breeding circles : AIPH, ASSINSEL, CIOPORA and COMASSO;

ii) the patent and (secondary) industries circles: AIPPI and ICC.

The positions of these circles (or expressed by representatives of these circles) will be analyzed below. It should be noted in this respect that certain views had a rather sharp national character.

8. The President of the Biotechnology Subgroup recalled several times that circumstances in the United States of America were very special.

Views Expressed by the Plant Breeding Circles

9. It is appropriate to distinguish between ASSINSEL and COMASSO on the one hand and CIOPORA on the other. The distinction corresponds roughly to that between staple crops and ornamental plants and that between sexually reproduced plants and vegetatively propagated plants. The views expressed by AIPH correspond to those put forward by the speakers of the plant breeding circles.

10. Views expressed by the breeders of sexually reproduced plants.- Interest focused on breeding processes on the one hand and artificial genes on the other. Generally speaking, breeders do not deny to inventors in those fields the right to equitable protection.

11. Concerning breeding processes, the President of ASSINSEL considered that they should be patentable if the patentability conditions were met. This statement may give rise to various interpretations for it remains to determine

when those conditions are met. He added that that view raised the problem of what constituted the direct product of the process. In that respect, there was no opinion common to the ASSINSEL members.

12. Concerning artificial genes, the President of ASSINSEL considered that they were patentable as chemical compounds, but that that view again raised the problem of the scope of the protection conferred by the patent.

13. According to some breeders, in particular from the United Kingdom, the problem arising in the future was to "manage the interface," i.e. the relations between genetic engineering and 'traditional' plant breeding enterprises. It will be noted that this observation is true whether there is a patent or not.

14. The same breeders reached the conclusion that there possibly should be another protection system, differing from both the patent and the plant breeder's right.

15. A breeder from the Federal Republic of Germany, seating with ASSINSEL, stated, in summary, that the approach to the situation should be more realistic. What may appear to be a 'revolution' today was in fact only an evolution and may become routine tomorrow. This had already happened to micropropagation over a period of ten years. Commonplaces should also be discarded. For instance, the size of today's investments should not determine the size of the scope of protection. The two things were independent and should remain so. In fact, investments by breeders in 'traditional' plant breeding programs were also very high.

16. In addition, it should be recognized that genetic engineering too could only build on what already existed, i.e. on varieties from 'traditional' breeders. In other terms, if one claimed a strong protection for the results of genetic engineering, which would be to the detriment of the 'traditional' breeder (for instance by abolishing the freedom of plant breeding written down in Article 5(3) of the Convention), then the latter would be in the right to claim the same protection for himself. The situation may also be analyzed in terms of equity: why should different protections be provided for the same result obtained through, on the one hand, 'traditional' means and, on the other, genetic engineering?

17. Finally, still according to that breeder, political circumstances should not be ignored. In that respect the UPOV Convention was the optimal compromise between the interests of the breeders and public interest. One should stick to that compromise and use it in the best possible way.

18. The Secretary-General of COMASSO concurred with the latter view: he noted that the demands of the circles favorable to an extension of the patent field were based on hypotheses, in particular on that of the reproducibility of the 'invention.' In his opinion, those hypotheses were far from being true, and perhaps far from becoming reality. He consequently warned against this type of demands based on mere hypotheses.

19. Views expressed by breeders of vegetatively propagated plants.- These views were put forward by the Secretary-General of CIOPORA.

20. The latter spoke very positively of plant variety protection. This fact should be underlined for itself, but also because CIOPORA has always been very

critical, for instance concerning the scope of protection, the minimum distances between varieties (problem of the mutations) or the variety denominations. In addition, breeders from CIOPORA used patents in the past, when this was possible, and are therefore familiar with that system. They also have good relations with patent attorneys whose services they regularly use. Finally, they make use of so-called 'new' techniques, in particular of micropropagation.

21. The Secretary-General of CIOPORA recalled that the authors of the Convention, in particular M. Bustarret, considered the field of application of the Convention to be very large, and to correspond to the whole plant kingdom, including bacteria. Nevertheless, it should be recognized that the Convention could not be provide protection for intermediate results of genetic engineering work. People were therefore looking to the patent. Concerning the commercial exploitation of those results, it should be made clear that the positions of principle might be very different, and even totally opposed, according to whether one was a buyer or seller of technology. Caution was therefore required. CIOPORA tried to follow objectively the evolution of the situation.

22. But in the course of the subsequent meetings, the Secretary-General of CIOPORA did not take positions that were as favorable to plant variety protection under the UPOV Convention.

Views Expressed by the Patent and Industry Circles

23. The representative of ICC stated that the importance of the investments in research and development made a stronger protection necessary. It should be noted that this position is general in nature and therefore applies to genetic engineering as well as to 'traditional' plant breeding. Such stronger protection could be afforded by leaving the choice of the protection system. The representative of ICC admitted, however, that the choice was dependent on the reproducibility condition and that, in that respect, genetic engineering enjoyed a definite advantage.

24. The representative of AIPPI stated that according to his organization the exclusion of plant varieties, animal varieties and essentially biological processes for the production of plants or animals was no more justified. All biotechnological inventions should be patentable if the patentability conditions were satisfied. In practice, this meant that varieties created by 'traditional' breeding would be protected by a plant variety protection certificate and varieties created by genetic engineering by a patent (and possibly also by a plant variety protection certificate). According to the representative of AIPPI, that position resulted mainly from the fact that Article 5(3) of the UPOV Convention exaggerately restricted the right granted to the breeder.

UPOV/WIPO INFORMATION MEETING OF JANUARY 10, 1986

General

25. Origin of the meeting.- Information on the origin of the information meeting will be found in paragraphs 4 and 60 to 64 of document CAJ/XVI/8 Prov.

26. Documents for the meeting.- In addition to documents BioT/CE/II/2 (prepared by the International Bureau of WIPO) and UPOV/INF/11, the meeting had the following questions before it:

"1. Is the present protection of biotechnological inventions by industrial property sufficient and, if not, where are the shortcomings in such protection?

a. In which respect is the protection according to the UPOV Convention not sufficient for plant varieties created wholly or partly by biotechnological methods?

b. In which other areas does the lack or the express exclusion of industrial property protection for plant varieties, animal varieties and essentially biological processes, leave the originators of biological inventions without sufficient protection?

"2. Will biotechnology in future facilitate description or disclosure by other means of biotechnological inventions, in particular plant varieties, animal varieties, and biological processes?

27. In fact, the documents submitted as background for the discussions played a minor role only in the interventions of the representatives of interested circles. But document UPOV/INF/11, as well as some documents of the Administrative and Legal Committee, were the subject of a series of observations from a Government delegate representing a patent office. The representative of CIOPORA also stated that document UPOV/INF/11 was "a document for self-defense, but [was] not necessarily justified."

28. Summary of the discussions.- In summary, the discussions of the information meeting overlapped those of the second Meeting with International Organizations and of the second session of the WIPO Committee of Experts. They touched two distinct subjects.

29. The governmental representatives mainly put forward arguments of legal policy. In that respect, reference will be made in particular to paragraph 64 of document Biot/CE/II/3 which summarizes the present position of the governmental experts from the patent field on the issue.

30. The representatives of the organizations for their part mainly discussed the systems of protection which should be available for plant varieties and processes in the field of plant breeding. In fact, despite the hands held out from time to time by delegates from one of the 'camps' to the other, the discussions were rather a confrontation of the following points of view:

i) The specific features of plant breeding should be taken into account and the integrity of the protection system specially conceived for that field and embodied in the UPOV Convention should be preserved;

ii) There is no reason for excluding biotechnological inventions from patent protection from the moment when they meet the general patentability conditions.

FUTURE WORK OF THE ADMINISTRATIVE AND LEGAL COMMITTEE

31. In the opinion of the Office of the Union, it emerges from the discussions which took place in the three meetings mentioned above that, for UPOV in general and the Administrative and Legal Committee in particular, future work could concern two areas:

i) the improvement of the protection under the UPOV Convention;

ii) the definition of the dependence relationships between inventions (including plant varieties) and between titles of protection.

The question of the extension of protection to all botanical genera and species, which was amply discussed by the Administrative and Legal Committee at its previous sessions, will be mentioned here for recollection only.

Improvement of the Protection Under the UPOV Convention

32. Several speakers from the plant breeding circles referred to the shortcomings in the scope of the protection conferred in the member States. The Committee is to consider this issue under item 7 of the draft agenda, in particular on the basis of document CAJ/XVI/3. The latter summarizes the various problems which have been raised.

33. It will be underlined in this respect that in both the information meeting of January 10, 1986, and the session of the WIPO Committee of Experts held from February 3 to 7, 1986, the representative of CIOPORA made statements to the effect that the final position of that organization with respect to the form of protection which should be offered in future would depend on the speed at which the scope of the protection conferred under the UPOV Convention would be extended. He observed, however, at both occasions, that the scope of protection under French plant variety protection legislation gave full satisfaction to the breeders member of CIOPORA.

Definition of the Dependence Relationships Between Inventions (Including Plant Varieties) and Between Titles of Protection

34. This issue is rather complex since it is based on a number of assumptions which remain to be verified (and possibly to become reality). In simple terms, it consists in reopening the discussion on Article 5(3) of the Convention, both on its principle and on its application, to determine whether it should be confirmed or amended.

35. The need for reopening the discussion already derives from the question of mutations, which has already been raised and discussed at several occasions (but was not so during the meetings under study here). This question adds to the dissatisfaction expressed by the representatives of the patent and industries circles about article 5(3) of the Convention (see for instance paragraph 24 above): the problem, put in general terms (in fact it is not limited to the results of genetic engineering), is that whoever realises a scientific and technical breakthrough, for instance by introducing a new characteristic into a species, must suffer that others may freely exploit the breakthrough.

36. The problem becomes more complicated when the industrial patent is involved. In part, the issue is then to determine how the patent is to be applied in relation to article 5(3) of the Convention. It appears that some wish--and others oppose that wish--that 'generic' patents be granted for plants incorporating some particular characteristic. The issue is then whether and how those plants may be used as initial sources of variation in plant breeding work. The same question arises when a gene is patented.

37. In this connection, the representative of CIOPORA stated at several occasions that, according to an opinion of his organization that was not yet

final, the protection under the patent should extend to all plants (whether in the form of varieties or not) incorporating that gene. Protection would in fact be illusory if such were not the case. But it may be necessary, according to him, to limit the rights, in particular when the patent for the gene or any other invention would block an important area of research.

38. The representative of AIPPI observed that the question of non-volontary licenses was a very sensitive subject for industrial property circles. That remark, and other considerations such as the consequences of the exhaustion of the rights under the patents, could perhaps lead the UPOV circles to investigate whether it would not be appropriate to provide for possible protection of genes in the framework of UPOV. It should be noted that for the time being, it would be premature to examine that question.

[End of document]