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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Eighteenth Session
Geneva, November 18 and 19, 1986

MINIMUM DISTANCES BETWEEN VARIETIES

Document prepared by the Office of the Union

INTRODUCTION

1. At the sixteenth session of the Administrative and Legal Committee, the Office of the Union reported on discussions which had taken place at the Second Meeting with International Organizations, held on October 15 and 16, 1985. On the question of minimum distances between varieties, restricting itself to the administrative and legal points of view, it noted the following:

(i) One participant (from the ASSINSEL delegation) had pleaded in favor of having decisions on whether to grant protection based on a weighing of similarities and differences. The main argument was that the present system, in which protection was granted as soon as a clear difference for at least one important characteristic could be observed, facilitated the activities of both infringers and plagiarists. (Paragraph 14 of document IOM/II/8, reproduced herein at Annex I).

(ii) The Secretary General of CIOPORA said that courts had little experience in regard to plant variety protection and that it would be useful if UPOV would define a "perimeter of protection" (paragraph 21 of document IOM/II/8).

(iii) There had been a somewhat confused discussion on the notion of "important characteristic." The AIPPI representative suggested that it should be interpreted as "economically important" (paragraph 19 of document IOM/II/8). The discussion also attached on the question of introducing into the conditions for protection the consideration of value for cultivation and use.

(iv) In that respect, the representative of the Federal Republic of Germany asked if other organizations could agree to the notion being limited solely to "economically important" characteristics, with all its consequences (paragraph 23 of document IOM/II/8).

(v) Lastly, the Secretary General of FIS stated that the alternative was to have freedom of breeding in virtue of Article 5(3) of the Convention with the possibility of small distances and thus similar varieties, or not to have it, as in the patent system (paragraph 28 of document IOM/II/8).

2. Following a discussion based on the proposal contained in subparagraph (i) above, the Committee decided that the Office of the Union should prepare for its present session a document setting out the problem and summarizing the decisions taken by UPOV and the criticism made, for example, by organizations. According to the Committee, UPOV should have available a document which presented the legal and scientific facts on which its working procedure was based. The other questions raised in the preceding paragraph should also be covered in the same document.

SCIENTIFIC AND LEGAL BASES

The Convention and its texts of application

3. For the matter under study here, the main legal basis is Article 6(1)(a) of the UPOV Convention, which states:

> "(1) The breeder shall benefit from the protection provided for in this Convention when the following conditions are satisfied:
>
> "(a) Whatever may be the origin, artificial or natural, of the initial variation from which it has resulted, the variety must be clearly distinguishable by one or more important characteristics from any other variety whose existence is a matter of common knowledge at the time when protection is applied for. Common knowledge may be established by reference to various factors such as: cultivation or marketing already in progress, entry in an official register of varieties already made or in the course of being made, inclusion in a reference collection, or precise description in a publication. The characteristics which permit a variety to be defined and distinguished must be capable of precise recognition and description."

4. As its principle, the above provision states the scientific, technical and practical notion of distinctness, which is one of the criteria for the definition of a variety. It contains two expressions which require interpretation: "clearly distinguishable" and "one or more important characteristics."

5. In order to make clear how the concepts of "clearly distinguishable" and "important characteristic" are to be applied in practice UPOV publishes, for each species or group of species, Guidelines for the Conduct of Tests for Distinctness, Homogeneity and Stability of new varieties of plants ("Test Guidelines"), general information being given in a General Introduction (document TG/1/2).

Concerted Interpretations

(i) At the Stage of Procedure for Granting Protection

6. The concept of "clearly distinguishable".- The General Introduction to the Test Guidelines clearly defines the circumstances in which two varieties are "clearly distinguishable," taking into account in particular the nature (qualitative or quantitative) of the characteristic in question. The rules established by UPOV for plant variety protection purposes--and accepted by other administrations for other purposes--allow little room for controversy:

(i) In the case of qualitative characteristics, distinctness, where it exists, is necessarily clear. For example, a variety of peas is either round or wrinkled.

(ii) In the case of quantitative characteristics, recourse is had to statistical methods which make it possible to establish whether a difference is significant or not. A difference noted in a trial is significant at a threshold of 1% (the threshold established by UPOV in its General Introduction) if it has a 99% probability of corresponding to a real difference, in the form of a difference between the two varieties studied, and a 1% probability of being due to chance (for example, the result of biased sampling).

7. The appropriateness of using a given trial design or statistical method can however be discussed. In that respect, the Technical Working Party on Automation and Computer Programs is reviewing the principle by which a variety is considered to be distinguishable from another where the difference:

(i) has been determined at least in one testing place;

(ii) is clear (significant in the case of quantitative characteristics--see paragraph 6(ii) above); and

(iii) remains consistent (occurs with the same sign in two consecutive, or in two out of three, growing seasons).

From criteria (ii) and (iii) above it can be seen that an independent statistical analysis is carried out for each growing season of tests. According to the above-mentioned Working Party, these analyses should eventually be replaced by a single analysis of the statistical data gathered throughout the testing period ("over-years analysis"). In short, this method should make more equitable treatment possible, particularly for new varieties which have shown differences in the same direction over three growing seasons but have not attained the threshold required in at least two of those seasons.

8. The concept of "important characteristic".- The concept of "important characteristic" poses greater problems. It has been retained, for want of anything better, in order to avoid a legal regime under which a difference in any characteristic would justify recognition of the existence of a new (different) variety and the consequent granting of protection. In this respect the Committee of Experts which prepared the Draft Convention presented to the Diplomatic Conference from 1957 to 1961 made the following comment at its first session in 1958 (page 34 of the Records of the Diplomatic Conferences of 1957-1961; 1972):

> "... the concept of "important characteristics" has been used, despite its lack of precision, because it would seem not to be

possible to protect a variety which presents only minimum differences in relation to a preexisting variety. It is recognized that the importance of a characteristic can vary according to the species concerned: the color of the flower is more "important" for a rose than for a potato."

9. By resorting to comparison, the Committee of Experts admitted that there is no clear criterion making it possible to create two categories of characteristics (those which are "important" and those which are not). The General Introduction to the Test Guidelines does likewise when it states (paragraph 7):

"The characteristics listed in the Test Guidelines are those which are considered to be important for distinguishing one variety from another and which are therefore also important for the examination of homogeneity and stability. They are not necessarily qualities which give an idea of a certain value that the variety may possess. The characteristics must be capable of precise recognition and description. The Tables of Characteristics are not exhaustive but may be enlarged by further characteristics if this proves to be useful."

10. Ultimately, it is up to the experts on the species in question to define empirically what the important characteristics are. However, empiricism does not mean that decisions taken on the matter are arbitrary or inconsistent. In effect, these characteristics must correspond to a certain number of necessary but insufficient conditions. In the work which the Administrative and Legal Committee carried out at its twelfth session, the result of which is given at Annex II, it established the following five conditions:

(i) The characteristic must be adapted to the needs of distinctness testing, that is to say meet the requirements of Article 6(1)(a) of the Convention (it must be important, it must enable a variety to be defined and distinguished, and must be capable of precise recognition and description);

(ii) The characteristic must be known to science, to the plant variety protection office and to plant breeding circles;

(iii) The characteristic must be reliable;

(iv) The characteristic must be usable under reasonable economic conditions;

(v) The characteristic must give a result within a reasonable period of time (compatible with the aims pursued by plant variety protection).

(ii) At the stage of exercise of the rights conferred by the title of protection

11. This issue concerns both the stage at which the existence of a new (different) variety is recognized and protection granted for it and the stage at which varieties are exploited and, where they are protected, infringement is sanctioned. Indeed, if reference is made to Article 5(1) of the Convention, it will be noted that the right granted relates to a certain material--in principle reproductive or vegetative propagating material--of the variety. The question is therefore to determine what material belongs, or still belongs, to a protected variety.

12. In that respect the Administrative and Legal Committee concluded, in the course of the work referred to in paragraph 10 above, that the expression "reproductive or vegetative propagating material of the variety" mentioned in Article 5(1) of the Convention covers:

(i) Material corresponding to the variety description and deriving from the material of the breeder (the owner of the plant breeder's right);

(ii) Material which cannot be distinguished from the above and which originates from a "parallel breeder";

(iii) Material which is not sufficiently distinguishable from the breeder's material to make it a distinct variety [which, typically, shows a clear difference in a non-important characteristic, an unclear difference in an important characteristic or an unclear difference in a non-important characteristic].

However, according to the Committee, this expression does not cover material which is clearly distinct in one or several important characteristics from the material of the breeder but which has been developed in all evidence in order to by-pass a breeder's right and constitutes a slavish imitation of the protected variety.

13. It will be noted that, according to the Committee, the concept of variety --in terms of the concepts of clear distinctness and important characteristic-- is the same both for the procedure for granting protection and for the definition and exercise of the rights granted. In the patent field, a doctrine has become established, under which the scope of protection is defined by the courts in infringement suits and is in general not linked with the opinion on that scope that presided over the decision of the patent office at the granting stage. In the field of plant variety protection, however, sufficient recourse has not been had to courts--nor have all the legal means been used (infringement, unfair competition, etc.)--to establish a body of case law and doctrine based on case law enabling precise determination of what the actual situation is.

PLAGIARISM OF A PROTECTED VARIETY

The Situation Today

14. The problem mentioned in paragraph 1(i) above is in fact that of minimum distances between varieties but presented from an angle different to the one from which UPOV usually approaches it. In fact, the speaker has presented the point of view of a firm having achieved a technical breakthrough with one variety (a non-protected variety in the case in point!) which, according to that firm, is being slavishly imitated by competitors. UPOV, for its part, is interested in the matter mainly from the scientific and technical point of view.

15. Paragraph 12, and in particular its last sentence, shows that part of the criticism is appropriate. In the present situation, UPOV accepts that the plant variety protection system permits slavish imitation of a protected variety to the extent that there is at least one clear difference in one important characteristic. This point of view is in no way reprehensible: the

"ground rules" for plant variety protection are in perfect harmony with scientific and technical ground rules, which are precisely that a clear difference in an important characteristic gives rise to a distinct variety. Moreover, these are also ground rules in other areas of intellectual property.

16. As the scientific and technical ground rules are invariable, the question arises, in the final analysis, of whether those elements of the rules liable to interpretation are correctly interpreted--bearing in mind the circumstances. This question in turn requires details of the circumstances. We will restrict ourselves here to pointing out that the situation varies from one species to another in function of scientific, technical, economic, legal, etc. data. For example, deliberate plagiarism is unlikely, almost impossible, for vegetatively propagated plants, at least in a general fashion, because the biology of the species concerned prevents it. It can occur however by exploitation of an accidental mutation which is slightly distinct from the parent variety (a problem which has already been extensively discussed). In the case of certain species, particularly forage plants, use has to be made of a very limited number of characteristics, which means that the concept of plagiarism has little meaning. However, this concept seems to be very important in the case of maize, which there can be little doubt is a very competitive sector where any innovation gives rise to imitation by other breeding firms as a means of survival (at least momentarily until they themselves achieve some innovation).

17. In such a situation, the innovating firm complains about plagiarism--and advocates larger distances--while the others concerned claim, on the contrary, that their work is creative (it is not in any case always unnecessary from the point of view of genetic diversity) and advocate smaller distances. Under these conditions it is inevitable that the plant variety protection system, like other legal systems relating to varieties, is at the same time criticized and drawn in one direction or another according to the respective weight of the economic forces concerned.

18. One of these forces having called upon UPOV, it is appropriate to reconsider the situation, i.e. the options taken under any form whatsoever (for example, by a positive decision or by the weight of use, on a scientific or empirical basis) in the interpretation of the concepts of clear distinctness or important characteristic.

The Concept of Important Characteristic

(i) The Different Types of Characteristics

19. It must be noted that no text previously quoted, nor any text prepared by UPOV, defines what is to be understood by important characteristic. In the conditions it has established, the Administrative and Legal Committee has limited itself to a reference to Article 6(1)(a) of the Convention (see paragraph 10 above) whereas the Technical Committee has specified the scope--in actual fact legal--of the lists of characteristics contained in the Test Guidelines by stating that these characteristics are important in the meaning of Article 6(1)(a) of the Convention (see paragraph 9 above). It remains therefore to analyse these lists in order to extrapolate the general principles. Such an analysis leads to the classification of the characteristics used into three main theoretical categories:

(i) Important characteristics from the point of view of the final use of the variety (functional characteristics);

(ii) Non-functional characteristics, albeit in correlation with a functional characteristic, normally not examined;

(iii) Non-functional characteristics.

20. Functional characteristics.- Generally speaking, it can be said that all characteristics of this type which also meet the conditions set out in paragraph 10(i) to (v) above are used to examine distinctness. This is a matter of fact corresponding to an imperative which is scientific and technical as much as it is legal. Conversely, characteristics of this type which do not meet one or more of the above-mentioned conditions are not included in the Test Guidelines. They are, however, not excluded a priori from the examination and may serve to establish distinctness if no other routinely used characteristic serves to do so (see paragraph 9 above).

21. Non-functional characteristics in correlation with a functional characteristic, normally not examined.- The correlation may be made by various means, sometimes not even elucidated. One of them resides in the fact that the genes coding for the two characteristics in question are neighboring, so that they are usually transmitted en bloc and the presence of one makes it possible to predict the presence of the other. The correlation therefore justifies the recourse to such non-functional characteristics.

22. Non-functional characteristics.- In a large number of species, the important characteristics from the point of view of the final use of the variety are few. Moreover they are often inconvenient to use. In order not to obstruct or seriously hamper plant breeding, recourse must therefore be had to characteristics without practical importance in order to establish distinctness for the purposes of granting protection. Moreover, it must be realized that the examination also serves the purpose of establishing a description of the variety, thereby enabling:

(i) the breeder to exercise and defend his rights;

(ii) the public to be informed of the identity of the variety in question (and even, where it has the means, to identify it) so that it can respect the right granted to the breeder and at the same time be armed against possible abuse of rights by the latter;

(iii) competent authorities to examine new varieties in comparison with the variety in question.

23. It is obvious that to this end unimportant characteristics can prove to be extremely useful, even indispensable. It would therefore be wrong not to use them. However, it is precisely at this stage that the problem of minimum distances between varieties, or plagiarism, arises in the following form: should a characteristic of this type serve as a basis on which to grant protection? In other words, should the principles underlying the Test Guidelines, particularly those mentioned in paragraph 9 above, be revised?

(ii) Outline for a New Philosophy

24. Logic provides a negative reply to the first of the above questions. Such a characteristic should not serve as a basis on which to grant protection. In such a case, the purpose of each characteristic must be stated in the Test Guidelines.

25. A special problem arises in the case where new material is distinct from material of a pre-existing variety by several characteristics which are not determinant for protection, even though there might be evidence of "originality" (and a welcome genetic diversification) of the new material. Here again logic provides the reply--positive in this instance--to the question of whether protection should be granted. In such a case it would certainly be desirable to quantify in the Test Guidelines the level of "originality" required, in order to establish clear ground rules, known to everybody and therefore likely to be uniformly applied. For example, each characteristic could be given a numerical value (high for functional characteristics or characteristics in correlation with such a characteristic and low for other characteristics) with protection being granted only if the new material obtains a minimum of points.

(iii) Problems to Be Resolved

26. As for any innovation, the new philosophy outlined above must be submitted to a feasibility study. The following questions in particular arise:

(i) Do present circumstances and/or future prospects (genetic engineering in particular) make a new basis for decision desirable and/or necessary for certain species or for the vegetable kingdom as a whole?

(ii) Is this new basis for decision technically feasible?

(iii) Is this new basis for decision legally feasible, bearing in mind the content of Article 6(1)(a) of the Convention?

27. In relation to the last question, it should be noted that member States are already applying a flexible interpretation to the concept of important characteristic and that flexibility is included in the General Introduction. Further characteristics (which are not included in the Test Guidelines) may be used "if this proves to be useful" (see paragraph 9 above). On frequent occasions, experts of member States have also made statements from which it may be understood that they were disposed to seek such characteristics in a particular case if they were convinced that the material presented really corresponded to a new variety.

The Concept of Clear Difference

28. The concept of clear difference only has a bearing in relation to a quantitative characteristic, as has been seen in paragraph 6 above. It has also been seen that clear is understood in a neutral reference system from the point of view of the final use of the variety, with recourse, where necessary, to statistical methods. The problem which therefore arises resides in the relationship between clear from the objective (statistical) point of view and clear from the point of view of final use of a variety.

29. The latter parameter is obviously meaningless in the case of a non-functional characteristic, which may therefore be excluded from the reasoning set out below. In fact, however clear it may be, a difference having a bearing on such a characteristic can have no incidence on the final use of the variety because of the very nature of the characteristic. This case is therefore more appropriately resolved within the concept of important characteristic.

30. A variety is undeniably new (and therefore protectable) when the difference is clear both from the objective (statistical) point of view and from the point of view of the final use of the variety. At the same time, a variety is undeniably not new where the difference is not clear from either point of view.

31. Under present UPOV criteria--which, it should be recalled, are accepted in professional circles and other governmental bodies--a variety is also new (and protectable) if the difference is clear from the objective (statistical) point of view but not from the point of view of final use of the variety. The question that arises at this stage is whether the minimum distance between varieties has not been fixed at too low a level, since this rule makes it possible, in theory, for varieties with very similar aptitudes to coexist and thus allows cases of plagiarism and parasitism.

32. To avoid this type of situation it is necessary to raise the level of clearness required for the purposes of taking a decision on the existence of a new variety to the level of clearness required from the point of view of the final use (it being naturally understood that protection would be granted both in a case where the new variety is considered an improvement and in a case where it constitutes a regression). This exercise, if accepted in principle, should be carried out separately for each characteristic and each species, bearing in mind the specific nature in each case.

33. As in the case of the concept of important characteristic, a modification of the rule governing clearness raises particularly the following questions:

(i) Do present circumstances and/or future prospects (genetic engineering in particular) make a new basis for decision desirable and/or necessary?

(ii) Is this new basis for decision technically feasible?

(iii) Is this new basis for decision legally feasible, bearing in mind the content of Article 6(1)(a) of the Convention?

34. The Office of the Union believes that there are very specific cases for which modification deserves to be carefully considered. These cases concern mutations of ornamental plants which are slightly different to the parent variety, for example, by the color of the flower. It also believes that in many cases the definition of a minimum level of clearness from the point of view of final use of the variety poses considerable problems of appreciation. To illustrate the extent of the difficulty, it can be said that a white flower and a slightly grey flower can be considered as being clearly different commercially because the difference is related to the concept of improvement (or regression), which is not so in the case, for example, of two shades of yellow.

35. Finally, a case might be envisaged where there is a clear difference from the point of view of final use of the variety but not from the statistical point of view. This case will not be considered in detail here because it does not appear to be of importance.

OTHER QUESTIONS RAISED AT THE SECOND MEETING WITH INTERNATIONAL ORGANIZATIONS

Perimeter of Protection (see paragraph 1(ii) above)

36. The opinion of the Administrative and Legal Committee, mentioned in paragraph 12 above, "could be considered an opinion of experts, which was not of

course binding in any way on the administrative and judicial authorities" (see paragraph 4 of document C/XVIII/9). This opinion has been submitted to the Council, which has taken note of it, but has not received wide publicity. The question which arises is therefore whether it would not be appropriate to make it known, with the above reservation and possibly after revision. In order to permit a considered decision on the part of the Committee, the opinion in its entirety is reproduced at Annex II to this document.

Interpretation of the Concept of Important Characteristic in the Sense of "Economically Important" (see paragraph 1(iii) and (iv) above)

37. Paragraphs 19-23 above answer this question.

Incidence of Article 5(3) of the Convention on Distances Between Varieties (see paragraph 1(v) above)

38. In the opinion of the Office of the Union the two questions are completely independent. In relation to the situation which would result from the possible application of the patent system, it can be assumed that, contrary to the opinion expressed by the Secretary General of FIS, minimum distances between "varieties" (or plant materials) would not so much be increased as decreased. In fact, the patent system does not recognize the concept of important characteristic and it might not be possible to apply the concept of inventive activity or only to apply it with difficulty or imperfectly in order to overcome this deficiency.

[Annexes follow]

ANNEX I

EXTRACT FROM THE RECORD
OF THE MEETING WITH THE INTERNATIONAL ORGANIZATIONS

14. Mr. Donnenwirth (ASSINSEL) noted that the interpretation of novelty given by UPOV enabled protection to be given as soon as a difference was observed in respect of one characteristic, however small it might be, once it enabled the distinction to be made. That favored both the infringer and the plagiarist breeder. It seemed to him that 1% of difference could give an infringer a 99% chance of being recognized as the true inventor, whereas 99% similarity in fact only gave the protected breeder a 1% probability of the rival variety being declared identical with his own. He agreed that he had possibly exaggerated that feature intentionally, but that if one thought of the question, there was truly nothing in the concept of distinctness, as set out by UPOV, to prevent such a thing happening. Rather than to look for differences, which would always be found, it was preferable, in his opinion, that decisions to grant protection to plant varieties should be based on the assessment of the balance between similarities and differences where those were credible and justified their existence. Otherwise, the declarations of good intentions in the UPOV Convention were likely to remain a dead letter. Mr. Donnenwirth indeed felt that if one gave way to facility, that was to say if there was a decline in the best material, the progress expected by agriculture would be slow to appear since the maintenance of genetic variability resulting from the creative activities of breeders would have been completely obscured. By setting the boundary at its proper level, breeders would be given an incentive to undertake a true research and creation effort that would necessarily imply maintenance of genetic variability and would thus ensure genetic progress.

[Annex II follows]

ANNEX II

LEGAL ASPECTS OF THE QUESTION OF MINIMUM DISTANCES BETWEEN VARIETIES*

Conclusions adopted by the Administrative and Legal Committee at its twelfth session and noted by the Council at its eighteenth ordinary session

I. DISTINCTNESS

Article 6 (1) (a) of the UPOV Convention:

"Whatever may be the origin, artificial or natural, of the initial variation from which it has resulted, the variety must be clearly distinguishable by one or more important characteristics from any other variety whose existence is a matter of common knowledge at the time when protection is applied for. Common knowledge may be established by reference to various factors such as: cultivation or marketing already in progress, entry in an official register of varieties already made or in the course of being made, inclusion in a reference collection, or precise description in a publication. The characteristics which permit a variety to be defined and distinguished must be capable of precise recognition and description."

1. When is a variety "another variety" in the meaning of the above provision? Does a variety that is identical or almost identical with the variety the subject of an application for protection, but that has been bred independently by someone else ("parallel breeder"), belong to the variety the subject of an application for protection or is it "another variety"?

In Article 6, variety is taken to mean the plant material, bred by the applicant for protection, on which the application is based. Identical or almost identical material produced by another breeder--independently of the applicant--certainly constitutes material of the same variety in a botanical sense but nevertheless represents an "other variety" for the purposes of Article 6(1)(a) of the Convention. If the "existence" of the material representing the "other variety" is already "common knowledge" at the time protection is applied for, the application must be refused for lack of distinctness. Similarly, the notion of "variety" is also to be interpreted in the same way in the other subparagraphs of Article 6: the question whether the "variety" has already been offered for sale or marketed, and whether it is homogeneous and stable, is examined solely on the basis of the plant material bred by the applicant for protection.

2. What conditions must be fulfilled by the "other variety"? Must the "other variety" with which the variety the subject of an application for protection has to be compared when the latter is tested for distinctness be a "finished" variety, that means a variety that is sufficiently homogeneous, or can it be a plant population that does not--yet--fulfill the requirements for homogeneity (a so-called "quasi-variety", as for instance are most of the varieties distributed by CIMMYT)?

The "other variety" must not necessarily be "finished," that is to say meet the standards set for the protection of new plant varieties in the member State of the Union concerned (these standards are often identical with those set in other fields of law such as the regulations on production and trade in seed and seedlings). In the case of the "other variety," this must be material which already fulfills the usual criteria accepted by the trade for the notion of variety; in particular, the variety must at least be able to be described as such.

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* According to the Administrative and Legal Committee, these conclusions can be considered an opinion of experts, which is not of course binding in any way on the administrative and judicial authorities.

3. What conditions must be fulfilled by the "other variety" for it to be able to be considered as a matter of common knowledge on the basis of a "precise description in a publication"? Is a description by the breeder, published or submitted to the plant variety protection office, sufficient? In the case of a hybrid variety, is it sufficient to indicate the formula if the parent lines are a matter of common knowledge, or are there additional conditions that have to be fulfilled? If so, what are they (must it be certain that the "other variety" does not only exist on paper)?

The Convention requires the "existence" of the other variety to be a matter of common knowledge. Unless a sample of the variety in question may be made available to the plant variety protection office, a breeder's description published or handed to that office or a statement of the formula for a hybrid are not sufficient to make the existence of the variety in question a matter of common knowledge.

4. What conditions have to be fulfilled by a characteristic for it to be used in testing for distinctness?

(a) Should the decision be taken species by species, account being taken of the development of plant breeding? If not, what common rules can be established?

(b) Should characteristics be considered that are not "capable of precise recognition" without means that are not normally available to:

(i) breeders

(ii) plant variety protection authorities?

(c) Before taking into account a new characteristic (i.e. a characteristic that is not yet included in the list of characteristics), must it be assured that to do so will not lead to a disturbance of the system of plant variety protection for the species in question, for instance by encouraging grants of plant breeders' rights that would prejudice rights already granted? What criteria are to be taken into account?

(a) The decision can only be taken on a species-by-species basis.

(b) Generally speaking, a characteristic may be used once the following conditions are met:

(i) It must be adapted to the needs of distinctness testing, that is to say meet the requirements of Article 6(1)(a) of the Convention (it must be important, it must enable the varieties to be defined and distinguished, and must be capable of being precisely recognized and described);

(ii) It must be known to science, to the plant variety protection office and to plant breeding circles;

(iii) It must be reliable;

(iv) It must be usable under reasonable economic conditions;

(v) It must give a result within a reasonable period of time (compatible with the aims pursued by plant variety protection).

(c) As a principle, no breeder holding protection of a variety may claim that the list of characters examined for the purpose of distinctness be frozen at that used in deciding on the grant of his title.

II. NOVELTY

Article 6 (1)(b) of the UPOV Convention:

"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 rootstocks, 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."

1. What is covered by the expression "the variety" in the meaning of the above provision? Is it detrimental to novelty in the meaning of the above provision if material that is identical with the variety, but that has been developed independently by someone other than the breeder/applicant ("a parallel breeder"), is offered for sale or marketed (please note the connection with question I.1 above)? If the answer to this question is positive, whose agreement must have been given for the activity to be detrimental to novelty; that of the breeder of the variety the subject of an application for protection or that of the "parallel breeder"?

The fact that, at the time of filing an application for protection, someone else has already offered for sale or marketed material he has bred himself and which is identical to the material on which the application for protection is based has to be examined from the point of view of distinctness under Article 6(1)(a) of the Convention and not from that of novelty under subparagraph (b). If, as should be the rule, the "existence" of someone else's material has become "common knowledge" through offering for sale or marketing, the application that is later than that event and is based on identical material must be refused for lack of distinctness in relation to the "other variety."

The second question above does not apply.

2. Is offering for sale or marketing detrimental to novelty if it takes place at a time at which the variety is not yet "finished" and is thus still a "quasi variety" (see question I.2 above), not yet completely fulfilling the conditions for homogeneity?

Yes, where the material offered for sale or marketed can be defined as a variety. An important consequence of this event is the fact that the breeder who has marketed the material during the time between filing the application for protection and the refusal of the application for lack of homogeneity, foregoes the possibility of protection of the variety derived from such material by "purification."

3. Is the offering for sale or marketing of a hybrid variety detrimental at the same time to the novelty of the parent lines?

No. The case in which possession of lines is transferred (for example, under a growing contract) must be analyzed from the point of view of offering for sale or marketing of such lines.

III. SCOPE OF PROTECTION

Article 5(1) of the UPOV Convention:

"The effect of the right granted to the breeder is that his prior authorisation shall be required for
- the production for purposes of commercial marketing
- the offering for sale
- the marketing

of the reproductive or vegetative propagating material, as such, of the variety.

Vegetative propagating material shall be deemed to include whole plants. The right of the breeder shall extend to ornamental plants or parts thereof normally marketed for purposes other than propagation when they are used commercially as propagating material in the production of ornamental plants or cut flowers."

1. What is meant by "propagating material of the variety" in this context?

(a) Only material corresponding to the variety description and deriving from material of the breeder (the owner of the plant breeder's right)?

(b) Also material which cannot be distinguished from that referred to in (a) above, and which originates from a "parallel breeder"?

(c) Also material that may only be distinguished from material of the breeder to such a small extent that it cannot constitute another, distinct, variety?

(d) Also material that is clearly distinguishable by one or more important characteristics from material of the breeder, but that has been developed manifestly to by-pass a breeders' right and that constitutes a slavish imitation of the protected variety?

The term "propagating material of the variety" covers the material referred to in items (a), (b) and (c) above. It does not cover the material referred to in item (d).

[End of Annex and of document]