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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Twenty-fourth Session
Geneva, April 10 to 13, 1989

REVISION OF THE CONVENTION

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PROPOSALS AND COMMENTS FROM CIOPORA

Document prepared by the Office of the Union

1. The annex to this document contains the proposals and comments from the International Community of Breeders of Asexually Reproduced Ornamental and Fruit-Tree Varieties (CIOPORA) on the proposals for the revision of the Convention that had been set out in document CAJ/XXIII/2 of July 13, 1988. The proposals and comments were received by the Office of the Union on March 15, 1989.

2. The proposals and comments have been annotated by the Office of the Union to facilitate reference to document CAJ/XXIV/2.

[Annex follows]

ANNEX

REVISION OF THE UPOV CONVENTION

PROPOSALS AND COMMENTS OF C.I.O.P.O.R.A.

RELATING TO UPOV DOCUMENT CAJ XXIII/2 of July 13, 1988

GENERAL COMMENT

CIOPORA would like to acknowledge and welcome the efforts made by the Administrative and Legal Committee of UPOV in trying to improve the contents of the right granted to Breeders under the present UPOV Convention. For the first time, a number of the claims presented by CIOPORA over the past 28 years have been either taken into consideration or at least addressed by the Committee.

However, because the Revision which is now under consideration is bound to govern breeders' rights for a fairly long period and because the problems relating to the protection of new plant varieties are incessantly and rapidly diversifying because of the impact of biotechnology, CIOPORA expresses the hope that the provisions of the UPOV Convention which, in the past and until now, have been giving rise to many criticisms on the part of breeders will be deleted or amended in such a way that the Revised UPOV Convention may live up to the expectations of breeders and fare harmoniously with the constant changes in Plant Technologies.

INTRODUCTION

* Objectives of the Revision of the UPOV Convention

CIOPORA agrees with the objectives enumerated under paragraph 3.[1]

* Paragraph 5 : other issues[2]

5 (i): CIOPORA has always considered that there was no justification for a specific title; hence its position and recommendations on Article 2(1) of the UPOV Convention. Protection of Plant Varieties should be possible either by plant breeders'rights certificates or by plant patents or by standard utility patents.

5 (ii): In view of the already wide range of problems that have to be solved for plant varieties, CIOPORA considers that it would be unwise to extend the UPOV system to animal breeds.

5 (iii): CIOPORA considers that the object of protection in the case of genetic engineering and more generally of biotechnological research is quite different to the object of protection for a plant variety.

Whereas it should be possible to protect a plant variety either by a product patent or by a breeders' rights certificate, only a standard patent can be the appropriate vehicle for the proper protection of genetic information (necessity of generic claims). CIOPORA refers in that respect to the work of the Committee of Experts on Biotechnological Inventions and of Industrial Property convened under the aegis of WIPO (Document BIOT/CE/IV/ 4 of October 28, 1988).

CIOPORA stresses that present efforts should therefore concentrate on the improvement of the existing UPOV system. The contemplated extensions to animal breeds and to subject matter of genetic information would only

- confuse the present issues on plant varieties
- delay the urgently and much awaited improvements of the UPOV Convention.

ARTICLE 1 / ARTICLE 2

* Article 2 (1) of the present Convention

In view of the existing case law in a number of Countries, which recognizes the patentability of plant varieties;

In view of the rapid progress of new technologies for the identification and accurate description of plant varieties;

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[1] Paragraph 4 in document CAJ/XXIV/2.

[2] Paragraph 6 in document CAJ/XXIV/2; item (iii) no longer appears in the said paragraph.

In view of the general trend, both in relevant international organizations and at the level of national Governments, towards patentability of "living matter";

CIOPORA considers that the present text of the second sentence of Article 2(1), which precludes the possibility, for Member Countries of UPOV, of protecting varieties belonging to a given species either by a patent or by a plant breeders' rights title, is no longer consistent with the developments of technology and case law nor with the requirements of breeders.

CIOPORA therefore recommends that Article 2(1) of the present Convention be modified accordingly. This means that the second sentence ("Nevertheless ... species") should be deleted.

Incidentally, CIOPORA considers that the term "double protection" used in the comments of Document XXIII/2 is not right. What breeders require is the option to choose the most adequate form of protection for a given "variety" but not a "double" protection (i.e. two different titles for one and the same "variety").

* Article 2 (2) of the present Convention

CIOPORA strongly supports the deletion of this paragraph (see Article 4).

* Article 1 (revised)

In view of the above-mentioned proposed modifications, CIOPORA takes the liberty of suggesting to merge Article 1 (present) and Article 2 (present) into the following Article 1 (revised):

Article 1
Constitution of a Union - Purpose of the Convention

" *(1) The States parties to this Convention (hereinafter referred to as "The Member States of the Union") constitute a Union for the Protection of New Varieties of Plants.*

(2) The seat of the Union and its permanent organs shall be at Geneva.

(3) The purpose of this Convention is to recognize and to ensure a right to the breeder of a new plant variety or to his successor in title (both hereinafter referred to as "the breeder").

(4) Each Member State of the Union may recognize the right of the breeder provided for in this Convention by the grant either of a "sui generis" title of protection or of a patent. "

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ARTICLE 37 (present)

In view of its recommendation to suppress the second sentence of Article 2(1) (present), CIOPORA considers that Article 37 (present) should be deleted or amended accordingly.

ARTICLE 2 (new) - Definitions

CIOPORA considers that it is advisable that the UPOV Convention should try to give accurate definitions for a number of basic terms which repeatably appear in the text of the Convention in order

- to make the text of the Convention more concise and precise
- to ensure uniformity of interpretation in various countries.

As regards the definition of species the Administrative and Legal Committee should take into consideration the likely more frequent occurence, in the future, of intergeneric hybrids.

ARTICLE 3 (new)

No comment.

ARTICLE 4 (new)

* Article 4 (1)

No comment except that species or botanical species should be defined (see above comments on Article 2 (new).

* Article 4 (2) [3]

CIOPORA considers that the limitations brought by this paragraph should be deleted for the following reasons :

- Ecological constraints can be taken care of under other legislations, the specific purpose of which is the protection of environment.
- The criterium of "important exploitation" is too subjective and "anti-

[3] The comments relate to Alternative 1.

innovative". The public authorities are not, and should not be placed, in a position to decide unilaterally whether a "species" is expected to acquire importance. Even if a species is unimportant a particularly outstanding variety belonging to that species may be valuable enough for the market. Anyhow it is the breeder himself who assumes all the risks of protecting a variety and his freedom to make research in any given direction should not be restricted.

- The examination constraints can be solved by bilateral or, better still, by multilateral cooperation and by an ajustment of the regulations on examination. CIOPORA refers again to its proposal of 1974 whereby any species should be eligible for protection as soon as the conditions for its technical examination have been established in any UPOV Member State. CIOPORA would like to remark that if, as proposed above under Article 1.4 (revised), the option were given to Member States and to breeders to protect a variety either by a "sui generis" title or by a patent, this would also contribute to the application of protection to the widest possible range of species, including intergeneric hybrids.

ARTICLE 5 (new)

* Articles 5 (1) and 5 (2) (new)

Scope of rights

CIOPORA appreciates the commendable efforts of the Committee to improve the scope of the right granted to the breeder under the UPOV Convention and understands the idea underlying the basic difference of treatment proposed for :

- the "reproduction" of the variety on the one hand,
- the "offer for sale, sale, use, import or stocking" of the variety on the other hand.

However this makes the text complicated. In view of the difficulties that might be raised as to the interpretation of the unclearly delineated term "material" it is submitted that a product patent-like definition of the scope of rights, coupled with the use of more traditional terms (like "plants and parts of plants"), would be preferable.

Indeed "any commercial exploitation of the variety", subject of course to the limitations under the second sentence of Article 5 (3) of the present Convention, should be under the control of the breeder like in the following proposal :

" *The breeder of a variety protected in accordance with the provisions of this Convention shall enjoy the exclusive right of (or shall have the right to exclude others from) reproducing the variety, using the variety for commercial purposes, offering for sale, putting on the market, importing or stocking for any such purposes reproductive material, plants or parts of plants of the variety* "

Exhaustion of rights

If such a principle is to be incorporated at all in an international Convention, CIOPORA considers that it could appear as a second paragraph of Article 5(1)(new), defining the scope of the right granted to the breeder. However,it is proposed that any relevant text should specify that

" *the exhaustion shall apply only to such limited field-of-use applications for which the breeder may have licensed the reproduction, sale or use of his variety* "

Indeed, the language used in paragraph 5(2)(b)[4] of Document CAJ XXIII/2 is not adapted to a vast number of cases where the breeder does not sell plants but licenses his variety for such or such specified field of use. Such a situation is neither adequately nor totally covered by : "or material "derived" from the said material ... was put on the market".

In the same train of thoughts, CIOPORA wishes that Article 5 (2) (present) be maintained in whatever form consistent with the final approach (positive exclusive right or right of exclusion) that will be adopted for Article 5 (1).

* Article 5 (3)[5] of Document CAJ XXIII/2

In view of the above-mentioned suggested modification of Article 5(1), CIOPORA proposes the following wording:

" *The right granted in accordance with the provisions of this Convention does not extend to*

(i) acts done for domestic and non-commercial purposes;

(ii) acts done for experimental purposes or for the creation of new varieties. "

* Article 5 (4) (new)

CIOPORA proposes to delete this Article because it gives too much freedom to Member States to restrict the Convention and is anyway redundant with Article 9.

* Article 5 (5) (new)[6]

For breeders it is essential that their varieties be protected against "would-be" new varieties which can be distinguished only by minor, trivial characteristics, with no other economic purpose than that of living as parasites on well-known, already protected varieties.

The text proposed by 5 (5) of Document CAJ XXIII/2 does not address the case where dependence may exist even where a variety is not "derived" from a protected

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[4] Paragraph (2)(i) in document CAJ/XXIV/2.
[5] Paragraph (2)(ii) to (iv) in document CAJ/XXIV/2.
[6] Paragraph (3), alternative 2, in document CAJ/XXIV/2.

variety.

Also in many cases the point at issue for the breeder is not whether he may be entitled to a remuneration but rather whether he can oppose the sale of a variety which, because it is too close to his already protected variey, constitutes an infringement.

Consequently CIOPORA considers that dependency should be organized within the framework of a system of "minimum distances" (the equivalent of nonobviousness in patent laws). In patent language, dependence is determined on the basis of the interpretation of the claims. In order to build up a consistent dependency principle for plant varieties it is necessary that protection under the UPOV Convention should extend to a certain *"perimeter"* "around" the variety and not only to the variety as strictly defined by its description.

This should enable breeders to take legal action not only against slavish reproductions ("contrefaçon à l'identique") of their varieties but also against varieties (whether mutations or not) which, although representing a minor variation from a protected variety, have the same function and are within the said perimeter of protection.

* Article 5 (6) (new)[7]

The UPOV Convention should not encroach on other legislations and CIOPORA proposes to erase this paragraph.

ARTICLE 6

CIOPORA has not been in a position to make detailed and final comments on the provisions of Article 6(new) as proposed in CAJ XXIII/6.

However a few general remarks can be made:

- one may wonder whether "distinct" should not be replaced with "unobvious" or "new" in order to take into account the concept of minimum distances; and "novel" with "not disclosed".

- a precise description in a publication should not be regarded as a disclosure or as making the variety a matter of common knowledge. Only the actual supply of plant reproduction material should be

- the language : "... with the agreement of the breeder ..." appearing in Article 6 (1) (b) (i) of the present Convention should be maintained. What's more, in order to avoid any ambiguity, it would be advisable to stress: "... *with the* express *agreement of the breeder* ..."

- stability may take some time to be verified. This concept might be treated under Article 10 (forfeiture of the right).

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[7] Paragraph (5) in document CAJ/XXIV/2.

- it might be simpler to provide that the variety must be

  " *clearly distinguishable from etc...* "

  and drop "by one or more etc...", leaving it to the national legislator, and to the Courts in case of litigation, to define the limits between varieties.

  The UPOV Convention is worded too much like a "Model Law".

  Whereas breeders regard it as essential that the scope of rights should be defined in a binding way at UPOV level, it may be advisable to leave it up to the national legislations of the Member States to organize the details of the conditions for the grant of rights even if the UPOV should continue its much valued work on descriptions and definition of minimum distances.

ARTICLE 7

The new wording proposed by the Administrative and Legal Committee represents an improvement of the present text.

* Article 7 (3)

In CIOPORA's opinion, Article 7 (3) should make a reference to Article 4 and to the obligation, as proposed by CIOPORA, for any Member State to protect any species for which the conditions for its technical examination have been established in another UPOV Member State.

* Article 7 (4)

CIOPORA welcomes the efforts made by the Administrative and Legal Committee for the improvement of the present situation.

However, CIOPORA is not in favour of the system of "protective direction" (re.: UK law on Plant Breeders' Rights) for the safeguard of the rights of the breeder during the period between the filing of the application and the grant of title. CIOPORA insists that although the grant of title gives the breeder's right its final validity, the application itself should at least have the following legal effects:

- it should be the starting point of the exclusive right of the breeder,
- it should be possible for the breeder to assign or license his rights on the basis of the application.
- it should be possible for the breeder to institute legal proceedings against infringements on the basis of a published or notified application.

ARTICLE 8 - Duration of the right

CIOPORA is not in favour of different periods of protection depending on which species the right applies to.

Although the general trend is towards a quicker turnover of new varieties and therefore a shorter average commercial life of varieties, some exceptional varieties may last for a very long time.

It is preferable that a uniform maximum protection be fixed for all species.

Considering the above comments on Article 7(4)(new) it might be advisable to compute the duration of the right from the date of filing of the application if the period of protection is increased.

ARTICLE 9 (new)

The text proposed by the Administrative and Legal Committee in Document CAJ XXIII/2 is an improvement over the existing text of the Convention. This is welcomed by CIOPORA.

ARTICLE 12

* Article 12 (1)

CIOPORA considers that the 2-year (24 monthy) period of priority would be a necessary improvement, more important to breeders than the one-year grace period (or preclusive period) provided for in Article 6 (1) (d) (new).

* Article 12 (3)

The 4-year period should be maintained.

ARTICLE 13

In the second proposal of Article 13 appearing on Document CAJ XXIII/2[8] there are a fair number of provisions which are objected to by CIOPORA.

Therefore, in order to avoid creating difficulties over what has already been a "hot" issue over the past 25 years CIOPORA proposes that the text of Article 13 on Variety Denomination should :

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[8] Now the only proposal in document CAJ/XXIV/2.

- either be left with its present wording,

- or be simplified in accordance with the most recent changes of the relevant provisions of the Swiss law on Plant Breeder' Rights, which are totally acceptable to CIOPORA and which are reproduced hereafter :

" *(1) A variety shall be given a denomination.*

(2) Such denomination shall not :

(a) be liable to mislead or to cause confusion with another denomination which has already been filed or registered in a Member State for a variety of the same or a botanically related species;

(b) be contrary to public order or morality nor infringe national laws or international conventions.

(3) If the same variety has already been the subject of an application or a registration in another Member State, the same denomination shall be used unless it is improper for linguistic or other reasons.

(4) In addition to the denomination, a trademark differing from the denomination may be used in connection with the variety.

(5) If, for a particular variety the breeder announces a denomination that is identical or liable to be confused with the trademark for which he has obtained registration in respect of that variety or another variety of the same or a botanically related species, he can no longer, from the time when he obtains protection in a Member State, avail himself, within the limits of the protection resulting from the variety denomination, of the rights deriving from the trademark.

(6) Anyone offering for sale or marketing propagating material on a commercial basis shall use the denomination of the variety, even after the termination of protection.

(7) The rights of third parties shall remain unaffected. "

CIOPORA expresses the hope that the above comments will be taken into consideration by the Administrative and Legal Committee of UPOV in its preparation of future documents concerning the Revision of the UPOV Convention.

[End of document]