



TC/38/11

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**INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS**  
GENEVA

**TECHNICAL COMMITTEE**

**Thirty-Eighth Session**  
**Geneva, April 15 to 17, 2002**

ADVICE FROM THE ADMINISTRATIVE AND LEGAL COMMITTEE

*Document prepared by the Office of the Union*

1. This document contains advice from the Administrative and Legal Committee (hereinafter referred to as “the CAJ”) concerning matters referred to it by the Technical Committee (hereinafter referred to as “the Committee”), or of direct relevance for the work of the Committee.

*Status of information provided in the Technical Questionnaire*

2. At its thirty-seventh session, held in Geneva from April 2 to 4, 2001, the Committee requested advice from the CAJ on the status of the information provided in the Technical Questionnaire (TQ) in relation to the application and decided to incorporate that advice into the appropriate TGP document(s) (see document TC/37/8, paragraph 117).

3. The CAJ discussed this matter at its forty-fourth session, held in Geneva on October 22 and 23, 2001, on the basis of document CAJ/44/6. It concluded, as a summary of the discussions, that the status of the information provided in the Technical Questionnaire would depend on the law of the States or members of the Union, and that this conclusion would be transmitted to the Committee (see document CAJ/44/9 Prov., paragraph 52).

*4. The Committee is invited to note that the draft TG template proposed in document TC/38/8, Annex I, (section 10, Technical Questionnaire) makes provision for each*

*member of the Union to clarify the way in which the information provided in the TQ will be treated.*

*Characteristics examined by patented methods*

5. At its thirty-seventh session, held in Geneva from April 2 to 4, 2001, the Committee agreed that the CAJ should be asked to consider if the inclusion of characteristics, whose examination required the use of processes covered by patent, should be excluded from the Test Guidelines (see document TC/37/8, paragraph 131).

6. The CAJ discussed this matter at its forty-fourth session, held in Geneva on October 22 and 23, 2001, on the basis of document CAJ/44/5. The CAJ agreed on the following recommended approach (see document CAJ/44/9 Prov., paragraph 41):

Recommendation on Patented Methods in the UPOV Test Guidelines

In line with the experience of other intergovernmental organizations, the following course of action, on how to deal with a patented method for assessing the state of expression of a characteristic that may be included in the UPOV Test Guidelines, is recommended:

(a) The TWPs are invited to disclose any known information on existing patents, or patent applications pending, that may relate to the assessment of the expression of one or several characteristics in the Test Guidelines under discussion. It is suggested that the information on known patents should include the name and contact details of the patent holder, patent registration number, and countries where the patent has been granted (or patent applications pending, if applicable).

(b) Once the information on existing patents (or patent applications pending, if applicable) has been disclosed, the experts of the TWP concerned should assess the importance of the patented method concerning the assessment of the expression of a characteristic and the suitability of alternative, non-patented methods, if available. The TWP should then decide whether it would be better to revisit the issue at a later stage or if it would be appropriate to contact the patent holder to find a suitable arrangement for utilization of the patented method. The TWP may decide to seek the advice of the Technical Committee and, if appropriate, the Technical Committee may also seek the advice of the Administrative and Legal Committee.

(c) If a decision to contact the patent holder is taken, three situations may arise:

(i) the patent holder waives his/her rights for the particular use of the patented method concerning the assessment of the expression of a characteristic for DUS testing and development of variety descriptions;

(ii) the patent holder is willing to negotiate licenses with other parties on a non-discriminatory basis and on reasonable terms and conditions;

(iii) the patent holder is not willing to cooperate with the solutions in (i) or (ii).

(d) If the first situation is applicable, a footnote in the corresponding characteristic(s) of the Test Guidelines should indicate that the method for assessing the expression of this characteristic is protected by patent, but that the patent holder has

waived his/her rights for the purpose of DUS testing and development of variety descriptions. The members of the TWP may decide, considering the importance of the characteristic, if it will be appropriate to select it as an asterisked characteristic.

(e) If the second situation is applicable, it is recommended that the characteristic(s) concerned will not be selected as an asterisked characteristic as it will not satisfy the requirement for accessibility that enables harmonization of variety description using asterisked characteristics. The members of the TWP may decide whether interested parties would like to retain the characteristic related to the method protected by patent as a standard Test Guidelines characteristic. Interested parties may decide to start negotiations with the patent holder for licenses on a non-discriminatory basis and on reasonable terms and conditions. Such negotiations are left to the interested parties and would take place outside UPOV. An appropriate note indicating that the method concerning the assessment of the expression of the characteristic is protected by patent and that the patent holder provides for licenses on a non-discriminatory basis and on reasonable terms and conditions should be provided.

(f) If the third situation is applicable, it is recommended that the characteristic(s) concerned with the method protected by patent will not be selected as an asterisked characteristic. The experts of the relevant TWP may decide, in light of the information available, e.g. experience of a member of the Union that has used the characteristic to develop a variety description, whether the characteristic should or should not be selected as a standard Test Guidelines characteristic. An appropriate note indicating that the method concerning the assessment of the expression of the characteristic is protected by patent should be provided.

*7. The Committee is invited to agree to the incorporation of this recommendation in the relevant section(s) of document TGP/7 "Development of Test Guidelines."*

#### *Plant variety identification*

8. At its forty-third session, held in Geneva on April 5, 2001, the CAJ discussed the possibility of considering plant variety identification within the terms of reference of the *Ad hoc* Subgroup of Technical and Legal Experts on Biochemical and Molecular Techniques (document CAJ/43/8, paragraphs 53 to 58). The Vice Secretary-General clarified that the extension of the terms of reference of the *ad hoc* subgroup would go beyond the responsibility of UPOV. However, the CAJ agreed to the Chairman's proposal to include the item of plant variety identification on the agenda of the CAJ for future consideration. In accordance with this proposal, the matter was discussed at its forty-fourth session, held in Geneva on October 22 and 23, 2001, on the basis of document CAJ/44/8. On the basis of the discussions, the Chair summarized that the general consensus of the CAJ was that it was not appropriate, at this time, for UPOV to make recommendations on variety identification (see document CAJ/44/9 Prov., paragraphs 65 to 68).

*9. The Committee is invited to note the opinion of the CAJ.*

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