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IOM/5/ 8
ORIGINAL : English
DATE : October 5, 1990

In English only

UPOV

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

FIFTH MEETING WITH INTERNATIONAL ORGANIZATIONS

Geneva, October 10 and 11, 1990

REVISION OF THE CONVENTION:

COMMENTS FROM CIOPORA

Document prepared by the Office of the Union

The annex to this document contains the comments from the International Community of Breeders of Asexually Reproduced Ornamental and Fruit-tree Varieties (CIOPORA) on the revision of the Convention. They were received by the Office of the Union on October 5, 1990.

[Annex follows]

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FIFTH UPOV MEETING

WITH INTERNATIONAL ORGANIZATIONS

COMMENTS AND COUNTER-PROPOSALS OF CIOPORA

RELATING TO DOCUMENT IOM/5/2 Rev. of August 22, 1990

UPOV Document	*Comments of CIOPORA*
Article 1 - Definitions (PROPOSED NEW TEXT) (v) "breeder's right" means the right of the breeder provided for in this Convention;	* CIOPORA has already underscored the confusion that may exist between the various meanings of the word "rights". CIOPORA is also adamant that the UPOV Convention should be as flexible as possible and keep the possibility, both for Governments and for breeders, to grant/resort to whichever means or vehicle of protection as they may find more convenient, namely "breeder's right certificate" or "plant patent" or "utility patent. Therefore it would be more apt to introduce the following concept and corresponding definition of "title of protection": *"title of protection" means a breeder's right certificate, a plant patent or a utility patent protecting a variety;* *"breeder's right" means the right defined in Article 12 and attached to a Title of protection granted by a Contracting Party under this Convention;*

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<u>Article 2 - Obligations of Contracting Parties</u>

(PROPOSED NEW TEXT)

(1) Subject to the provisions ... each Contracting Party shall grant and protect breeder's rights.

* Because of the above remarks on the definition of "breeder's right", CIOPORA suggests the following language:

(1) Subject to the provisions ... each Contracting Party shall recognize and protect the breeder's rights provided for in this Convention by the grant of a title of protection.

(2) (ii)

(2)
(ii) maintain ...the task of granting titles of protection or...
(iii)ensure ...
- applications for and grants of titles of protection.

* (2) (ii) is not quite clear and would require more detailed explanations from CAJ as to its purport.

Because of the desired flexibility it advocates, CIOPORA believes it would be essential that an existing patent office be able to act as such an authority where a government has decided to choose patents as a means of protection for some or all plant species.

(PRESENT TEXT)

(PROPOSED NEW TEXT)

Article 2 - Forms of Protection

* The note about the so-called "non-inclusion" is not addressing the real issue and is a case of Hobson's choice for the Contracting Parties.

If the choice is between the present wording of article 2(1) of the 1978 Act and the non-inclusion, CIOPORA is clearly in favor of the non-inclusion.

However, as already underscored by CIOPORA in many instances, breeders are not advocating the possible choice of patent protection as a means of **cumulative** protection where the subject-matter of protection is a **variety** per se but as a means of **alternative** protection. In short a variety **(and the UPOV Convention has the primary and sole purpose of protecting VARIETIES!) should** be protectable by one title of protection only, that is to say whether a sui generis plant breeders' rights certificate or a plant patent or a utility patent.

In return, a "utility" patent should also afford the possibility, for those (biotech research firms) who primarily wish to protect genetic information by various generic claims, to extend such claims to the variety or varieties into which such genetic information may be incorporated.

This is why CIOPORA considers that the would-be "choice" alluded to in the said Note (page 11, from: "It is to be noted ......) is not in fact a real and wide enough one.

A positive statement ,giving Contracting Parties this free choice, at variety level, between PVR protection and patent protection, would on the contrary be highly necessary and would avoid ambiguity.

<u>Article 4 - Genera and Species to be protected</u>

(PROPOSED NEW TEXT)

(1) (i) and (ii)

* The proposed new text of Article 4 represents an improvement over the present Convention. However it perpetuates the principle of "progressive" implementation of the Convention which, from the very beginning, has been the basic flaw of the UPOV Convention.

* Even the limited period of 10 years from the ratification of the new Convention is too long if one considers that the Convention already dates back to 1961.

* This is one more reason why CIOPORA insists that the optional choice of governments/breeders between *sui generis* rights (Plant Variety Rights or plant patents) and standard patents (utility patents) be definitely incorporated into the new Convention. In most patent legislations, patents should permit to protect <u>any</u> species.

* In (1) (ii) the period of 10 years should in any case be brought down to 3 years.

<u>Article 6 - First Application</u>

(PROPOSED NEW TEXT)

* For the reasons already explained under the article on definitions CIOPORA proposes :

(1) .....he wishes to file his first application for a <u>title of protection</u>.

(2) the term "breeder's right" should also be superseded by "title of protection".

* CIOPORA would be interested to know whether there any specific reasons, and if so which ones, why para.(3) of the corresponding Article 11 of the 1978 Convention has been deleted.
Does this deletion mean that the former provisions of Art. 11(1) "go without saying"?

Article 7 - Conditions for the grant of a breeder's right

(PROPOSED NEW TEXT)

* Again "***title of protection***" should supersede "breeder's right"

(2) [Newness]

* In (2) (i) and (ii) ".. with the consent of the breeder" should be replaced with "*.. **with the express consent of** ...*".
Indeed in case of litigation it should be up to the party who or which questions the validity of the title of protection to prove that the breeder has given such consent and NOT to the breeder to prove that he has not given such consent.

(3) [Distinctness]

* The combination of the mention of "entering in an official register" in paragraph (3) with paragraph (2) above (and the words "in particular" imply that there may be other circumstances where a variety may be "a matter of common knowledge" and yet be "new") implies that, contrary to the trend of most legislations on industrial property rights, the right conferred by a title of protection does not belong to "the first to apply" but to "the first to invent". It would therefore be desirable to know whether the CAJ of UPOV has had the deliberate and willful intention to adopt the "first to invent" principle and if so why.

Whenever a breeder wishes to secure a proprietary breeder's right under this Convention beyond a mere right of personal possession, it is submitted that he should file an application for the grant of a title of protection under this new Convention.

Article 8 - Right of Priority

(PROPOSED NEW TEXT)

(1) "...This period shall be computed from the date of filing of the first application"

* It might be advisable to specify what can be considered as a "first application" in the case where an application has been withdrawn then filed again at a later date. (see in that respect art. 4 para C4 of the Lisbon Act of the Paris Union Convention on the Protection of Industrial Property of 1883)

(3) ...period of two years...

* The present Convention (1978) provides for a "period of four (4) years. One does not understand why the new Convention should be less advantageous for the breeder. The four-year period cannot be reduced without serious justification.

(4)

* Is there any particular reason why the words "or to any right of personal possession" have been omitted ?

Article 9 - Examination and Provisional Protection

(PROPOSED NEW TEXT)

(1) (b)

* CIOPORA requests that "*concerning the variety*" be added after "material".

(2)

* The second sentence, which refers to a "minimum effect" ("at least") of the measures to be taken by Contracting Parties, is not satisfactory:

CIOPORA has long and often before underscored the many cases of infringement and parasitic activity that occur in the period between application and grant.

The problem is therefore not only that the breeder should receive an "equitable remuneration" but that he should be placed in a position to take legal action against, and if necessary receive damages retroactively for any infringement commited during the period comprised between the date of the notification, to the alleged infringer, of a certified copy of his application for rights and the date of grant of the title protection. This should belong to the minimum requirements of said measures.

The sentence in question must therefore be revised.

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Article 12 - Effects of the breeder's right

(PROPOSED NEW TEXT)

(1) (a) and (1) (b)

* As already stated in the course of the past International Organizations Meetings CIOPORA expresses its deep appreciation of the marked (and long-needed!) improvement of the scope of the breeder's right brought by the proposed Revised Convention. However the new text proposed in article 12 (1) (b) seems to raise some problem.

(1) (b)

* Apparently the new language adopted seems to make it impossible for a breeder, having granted an exclusive license for the production and sale of finished plants or parts of plants limited to the territory of country A, to oppose the sale of such material in country B where his variety is also protected and where he may have granted a separate exclusive license. Such a situation would be contrary to the principle of territoriality of the rights granted in each country and contrary also to the definition of the "exhaustion of rights principle" under paragraph (5), which principle is rightly limited to sales "in the territory of the Contracting Party concerned".

The principle of territoriality should indeed be overruled only where a specific and separate limitation to the exercise of the breeder's right (e.g. EEC regulations on competition) may apply. But the UPOV Convention should not pass legislation on such limitations.

Therefore no special, less favorable, treatment should be reserved for "harvested material" and CIOPORA insists that no difference be made between propagating material per se and harvested material as far as the definition of the scope of the breeder's right goes.

In view of the difficulty of finding an adequate formulation within the new language adopted in the proposed text of Art. 12 of IOM/5/2, CIOPORA again suggests to merge (1)(a) and (1)(b) into the following general definition of the scope of the breeder's right conferred by a title of protection:

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(1) (a)

" *The title of protection granted in accordance with the provisions of this Convention shall confer to its owner the right to exclude others from exploiting the variety and in particular:*
(i) from producing or reproducing the variety;
(ii) from using for commercial purposes, offering for sale or selling the variety or plant material thereof;
(iii) from importing or stocking the variety or plant material thereof;"
Such a wording would give more flexibility to the Contracting Parties that may have difficulties with (a)(v) ("exporting").

* CIOPORA considers it would be desirable to define "plant material" as follows:

" *The term "plant material" shall mean any plant or part of plant, whatever its botanical or commercial function may be. The term shall include in particular cut flowers, fruit and seeds."*

(1) (c)

* In view of the preceding remarks the following amendment is suggested:

(1) (b)

" *in respect of products directly obtained from plant material of the protected variety, the right of the breeder shall extend to any of the acts referred to in (a) above, provided that such products were obtained through the use of plant material and that such use was not authorized by the breeder;"*

(2) [essentially derived varieties]

* CIOPORA expresses its satisfaction with the introduction of the principle of "dependency" and of the principle of infringement of closely resembling varieties.

(2) (a) (iii)

* CIOPORA notes with pleasure that the suggestion of its comments of 25/9/89 on IOM/IV/2 (page 6) concerning the incorporation of this provision into the subparagraph on dependency has been retained.

(2) (b) (iii)

* It would be advisable to clarify the exact purport of the words "it conforms to the genotype.."

(4) [possible "farmer's privilege"]

* CIOPORA does not see any valid reason for introducing provisions on a so-called "farmer's privilege" which corresponds to a practice which is limited to a small number of plant species and which, incidentally, has, even for such species been condemned by some national courts as an infringement of the breeder's right.

* Furthermore, the term "farmer" being translated by "agriculteur", it is liable to include growers in the horticultural industry since in France a "horticulteur" is also an "agriculteur". This might therefore be construed to extend the concept or practice of the "farmer's privilege" to categories of growers or users of protected varieties which had always been specifically excluded from such a concept/practice so far. This would of course represent an unacceptable step backward in the UPOV Convention.

CIOPORA consequently submits that this entirely new provision be deleted from the proposed new Convention.

(5) [Exhaustion of right]

* Consistently with its above proposals of amendments, CIOPORA suggests that "material" be changed to "***plant material or products directly obtained from the plant material***".

Article 13 - Restrictions on the exercise of the breeder's right
(PROPOSED NEW TEXT)

(2)

* CIOPORA proposes to supersede paragraph (2) with:

" ***In such a case the breeder shall be fully compensated***"

Article 14 - Variety Denominations

(PROPOSED NEW TEXT)

* CIOPORA greatly appreciates that its remarks and observations concerning the former provisions of IOM/IV/2 have been taken into account. Similarly, it will be necessary to abolish the 1984 UPOV Guidelines on Denominations that were unanimously criticised by the interested parties.

The above represents the present comments by CIOPORA on IOM/5/2 Rev. and will be supplemented during the UPOV Meeting of October 10 and 11 in Geneva.

[End of document]