



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agreed by the Council of UPOV, only documents that have been adopted by the Council of UPOV and that have not been superseded can represent UPOV policies or guidance.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

IOM/III/3

ORIGINAL: English

DATE: July 9, 1987

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

**THIRD MEETING
WITH INTERNATIONAL ORGANIZATIONS****Geneva, October 21 and 22, 1987****PROPOSALS OF INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS
FOR REVISION OF THE CONVENTION**compiled by the Office of the Union

The present document sets out, for each Article of the Convention for which proposals have been received from international non-governmental organizations, the proposals that have been made in relation to that Article.

TABLE OF CONTENTS

	page
Abbreviations	3
Article 2	4
Article 3	6
Article 4	7
Article 5	9
Article 6	12
Article 7	14
Article 8	16
Article 9	17
Article 10	18
Article 11	19
Article 12	20
Article 13	21
General Proposals	23

ABBREVIATIONS

The abbreviations used in this document have the following meanings:

- AIPH: International Association of Horticultural Producers.
- AIPPI: International Association for the Protection of Industrial Property.
- CIOPORA: International Community of Breeders of Asexually Reproduced Ornamental and Fruit Tree Varieties.
- COMASSO: Association of Plant Breeders of the European Economic Community.
- FIS: International Federation of the Seed Trade.
- ICC: International Chamber of Commerce.

Article 2AIPH

Article 2.1. We are not prepared to see any change in this article.

AIPPI

Although protection of plant varieties under laws conforming to the UPOV Convention presents a valuable system of protection and should continue, it is essential that techniques newly applied and products obtained thereby in the field of the development of new plants, and capable of meeting the patentability requirements, should become generally eligible for patent protection, and therefore, prohibition of double protection should not be maintained or provided for.

CIOPORA

- Paragraph (1)

Considering that one of the UPOV member States (the United States of America) already allows protection of one and the same plant species in more than one form.

Considering also that the level of protection afforded to breeders under the laws on patents is in general higher and therefore more satisfactory than that afforded by plant breeders' rights,

CIOPORA proposes that the prohibition of the possibility of obtaining dual protection, which seems to result from the provisions of this paragraph, be expressly deleted.

- Paragraph (2)

CIOPORA proposes the deletion of this paragraph.

COMASSO

On the basic question of the alternatives of patent protection and plant breeders' rights protection for genetic engineering and its products, it should be underlined that our members have different opinions, ranging from the removal of the prohibition of dual protection, in so far as it could be laid down in Article 2 of the UPOV Convention, via a wish for differentiated treatment for products of genetic engineering, to the maintenance of the present provisions. However, it may well be that the need for patent protection would be reduced by a strengthening of plant variety protection.

The limitation laid down in Article 2(2) of the UPOV Convention should be deleted as irrelevant, since the merit of a variety, in terms of protection, should not depend on the propagation method.

FIS

This is still a very open question, and opinions vary as to whether the choice between plant breeders' rights (hereinafter referred to as "PBRs") and patents should be exclusive or whether a free choice between the two forms of protection could be contemplated.

A possible solution could be to substantially strengthen the protection offered by PBRs in order to make them attractive for biotechnology.

There seems to be agreement on the fact that paragraph (2) of this Article should be deleted, as the right to protection should not depend on the propagation system.

ICC

It is suggested that the prohibition on double protection of varieties (both by a special title and by a patent) be deleted. This proposal commands wide though not universal support among those whom ICC has consulted. It has been suggested that the term "patent" in Article 2(1) means "plant patent" (e.g. of the type provided in the USA) rather than a utility patent. Normally, however, the provision is interpreted as forbidding utility patents for protectable plant varieties, sometimes even as forbidding any patents whatever covering plants. As countries are naturally anxious to be quite sure that their laws conform to this Article, it is a real obstacle to the grant of any patents on plants. For example, it has clearly shaped the law of the European Patent Convention. For all the reasons set out in ICC's position paper, ICC believes it most important that plant patents should be permitted without restriction, and hence strongly recommends the deletion of this clause. Double protection already exists in patents, designs, trademarks, copyright. The ICC has not seen any convincing reasons why patent protection should not exist for plant varieties, too.

Furthermore ICC recommends inclusion in this Article of a clause providing that the breeder shall have the freedom to choose the way in which he seeks to protect his new variety: whether by a patent, plant variety right, or both. Furthermore, paragraph 2 of Article 2 should be eliminated. There is a clear need for protection of all plant varieties, regardless of their method of production or end-use: in particular, no sufficient reason can be seen for discriminating against plants which reproduce in a particular way.

Article 3CIOFORA

CIOFORA wishes to see the principle of national treatment become the rule in all UPOV member States.

COMASSO

The reciprocity under Article 3 of the UPOV Convention is an obstacle to the widespread recognition of protection based on the Convention and to efforts to make it more attractive; it should therefore be deleted.

FIS

With a view to effectively opening up the Convention and the protection offered by it, it is suggested that the principle of reciprocity should be abandoned.

Paragraph (2) is unrealistic and should be deleted.

ICC

The principle of national treatment, whereby each country treats residents of other member countries of the Convention in just the same way as its own residents, is seen as very important. It is also considered sufficient. The reciprocity provisions of paragraph 3, whereby one country is entitled to withhold from the citizens of another protection which the second country does not grant, is retrogressive. Indeed (as discussed in connection with Article 4 below) it is the exact opposite of what is required. Paragraph 3 of Article 3 should be deleted.

Article 4

AIPH

Article 4.3. This article must provide protection to all genera and species:

- a). in which there is breeding in the state concerned;
- b). in which there is significant production or trade in the state concerned;
- c). for which protection is already available in another member State of the Union.

Article 4.4. This article can be abrogated because of our amendment to article 4.3.

CIOPORA

Taking into account the time that has elapsed since the member States became party to the Convention,

Taking into account the possibilities offered by bilateral or multilateral arrangements for the exchange of examination results,

CIOPORA considers that every member State of the Union should be obliged to extend protection, within a maximum of three years from the date of entry into force of the Convention on its territory, to any species already protected in another member State.

CIOPORA wishes to have paragraphs (4) and (5) of Article 4 deleted.

COMASSO

The provisions of Article 4 of the UPOV Convention (genera and species which must or may be protected) should be amended to make the extension of protection to a particular species automatic in all member States once one of them has provided for such extension. Progress achieved in international cooperation in examination has made the cost argument irrelevant.

FIS

First of all, it is suggested that the number of species covered (paragraphs (2) and (3)) should be substantially increased in order to stimulate the introduction of PBRs.

In addition, the idea has been raised that, given the progress made in international cooperation in examination, it should be possible to offer automatic protection in all member States for genera that can be protected in any one of them.

ICC

It is important to strengthen the provisions of this Article.

Numerous inconveniences arise from the fact that species for which variety protection is available differ considerably as between member countries of the Convention. Protection should be both wider and more uniform. One way of doing this, which it is suggested is worth further careful study, is to oblige each member country to provide protection for every genus which is protectable in another country. While at first sight this proposal might be seen as imposing considerable burdens on member countries, it is believed that these are supportable. The proposal does not oblige each country to have an examination system for each genus. Rather, it would encourage countries to rely on the examination systems of other countries. Thus by international cooperation wider protection would be obtainable, and unnecessary costs and wasteful duplication of work avoided.

Article 5

AIPH

Article 5.1. The meaning of the last two sentences of this article is more accurately expressed as follows: "Propagating material shall be deemed to include whole plants, parts thereof and tissue culture, when they are used as propagating material in the production of plants."

Article 5.2. We would prefer the following text: "The authorization given by the breeder may be made subject to such conditions as he may specify, but these conditions shall be limited to the production and sale of the reproductive material of the new plant variety." Our organization is of the opinion that this supplement is more appropriate to the framework of the Convention.

CIOPORA

- Paragraph (1)

CIOPORA considers the present wording of Article 5 difficult to improve owing to its shortcomings in both substance and form; CIOPORA therefore suggests that the wording of the Article should be reconsidered in its entirety.

CIOPORA requests that protection of the breeder's rights relate basically to any form of commercial exploitation of plants or parts of plants of his variety and, in particular, as in the field of patents, to their production, use for industrial purposes, offering for sale or marketing, introduction on the territory of the country in which the variety is protected or stocking with a view to industrial use or marketing.

- Paragraph (3)

The phrase "for the marketing of such varieties" could usefully be deleted. It adds nothing to the lawmaker's initial intention to allow full scope for research. Moreover its deletion would enable the notions of "minimum distances" and infringement to be strengthened. The right conferred on the breeder must enable him to prevent any marketing of infringing varieties, in particular varieties which, even if they are not slavish imitations of his variety, cannot be sufficiently distinguished from it and still remain within the bounds of protection defined by the "minimum distances."

COMASSO

The content and scope of protection under Article 5(1) of the UPOV Convention need to be extended to allow for structural developments and developments in the rapid propagation methods.

Our reflections concern the effect of rights on commercial exploitation, i.e. the extension of the notion of exploitation to production with a view to commercial use, as well as the extension of protection to the varietal material, i.e. the material which may be regenerated from whole plants, or the end product where it does not belong to the food sector.

The issue of the farmers' privilege should be considered realistically; if maintained at all, this exemption should be limited to family farms, households, etc.

The principle of the freedom of plant breeding, as such, laid down in Article 5(3) of the UPOV Convention is considered inviolable. On the other hand, our internal discussions have related to the possible deletion of the phrase "or for the marketing of such varieties" in the first sentence of the Article. The purpose of the deletion would not be to introduce a dependency principle, but this undoubtedly requires a new definition of the distinctness criteria.

FIS

First of all, the definition of the protected subject matter should be extended to include everything that enables whole plants to be regenerated. This conception is required by the new propagation techniques.

The acts and commercial activities subject to authorization by the breeder should include:

- propagation with a view to commercial production of plants or parts thereof;
- use of plants or parts thereof with a view to production of material (for instance perennial basic products);
- transport, importation (including from countries where the variety is not protected), exportation, stocking for commercial purposes.

The farmers' privilege would remain limited to family farms and households. It would only be tolerated as regional usage.

Finally, in view of the developments in multiplication techniques, it would be appropriate to delete the limitation to ornamental plants and cut flowers appearing in the second half of paragraph (1).

With regard to further plant breeding work, the principle of free access to varieties (even those containing patented genes) seems to be generally recognized.

However, access to varieties at commercial utilization level is still a debated point, reflecting the positions taken regarding the type of protection to be granted, notably to varieties developed by biotechnological means.

A suggestion to reconcile the various points of view might be the following: if a royalty is to be paid for the commercial utilization of

varieties containing patented genes, the varieties that host those genes and have been created by "conventional" plant breeding should in return be given adequate financial compensation.

ICC

Here again the ICC proposes a major recasting of this article. As it stands at present, the Convention prescribes a uniform but low level of protection of breeders' rights. However, the level of protection may be raised in exceptional cases. The ICC feels that this order of priorities should be reversed. The Convention should provide for a uniform high level of protection, subject to derogations for special reasons or in particular circumstances.

Experience has shown without doubt that to limit the rights of the breeder to the propagating material of his variety is inadequate. This permits the breeder to be exploited by those who buy a very small quantity of his new variety, multiply it, and harvest and sell the product. This is seen, for example, with fruit. An orchard grower can buy one specimen of a new apple variety, multiply it in his orchard, and in due course sell many tons of the new variety without paying anything further to its originator. With increasing industrial concentration, examples of this kind will increase. Further, the problem will be increased by biotechnology. In due course, plants will be adapted to produce special chemicals (oils, rubbers, drugs). Concerns would then be able to buy a single specimen of the genetically modified plant, multiply it, and thereafter plant it, crop it and process it to extract the chemical in question for sale, all without further payments to the grower. This is clearly unacceptable. Problems have likewise arisen with imports, for example of cut flowers. In some countries, local legislation has dealt with some of these problems, but a uniform treatment would be much better.

Accordingly, the ICC proposes that the Convention should state that the breeder receives the exclusive right to exploit his variety commercially. This general principle may be subject to justified exceptions. The breeder would be in a much better position to recover the value of his efforts through specialized licensing arrangements, which would probably increase commercialization of his variety.

Article 5.2 should be maintained, but it should be made clear that the breeder is not obliged to authorize exploitation of his new variety. If he wishes, he should be able to retain a monopoly.

It is seen as important to retain Article 5.3. The public interest in the creation of new varieties absolutely requires that research with protected varieties is not inhibited. However, the rights of the owner of the variety should be strengthened by deleting the words "or for the commercialization of such varieties" at the end of the first sentence. Sometimes (perhaps through error) a second variety receives a grant of rights when it differs only insignificantly from the variety from which it is derived. This amendment could enable the breeder of the earlier variety to assert his rights in such circumstances.

Article 6AIPH

Article 6.1(a). We prefer the text of this article as it was originally, namely with the following last sentence: "A new variety may be defined and distinguished by morphological or physiological characteristics. In all cases such characteristics must be capable of precise description and recognition." In our view, it is the task for the authorities responsible for granting breeders' rights to decide if a new variety is sufficiently distinguishable from the existing range, based on one or more important characteristics. During this examination it is necessary to pay attention to the principle that the variety must demonstrate originality. If this approach is maintained, the granting of breeders' rights to varieties which differ only minimally from the existing ones is avoided. The same criterion should also be applied to the granting of breeders' rights to mutants. A clear distinction should be preserved between varieties including mutants; distances between them should not, therefore, be too small. This is desirable in order to maintain existing breeders' rights and also to facilitate identification of varieties by those who use them. We therefore regret the amendment made to Article 6(1)(a) in the revision of the Convention in 1978; specific reference to morphological and physiological characteristics made the Convention more effective in this area.

Article 6.1(c), Article 6.1(d). Mutants occur more frequently in varieties which are insufficiently homogeneous and stable. For the granting of breeders' rights, varieties must be thoroughly examined with respect to these requirements, the more so because insufficient homogeneity and stability detected subsequently are no grounds for nullity. Insufficient homogeneity and stability should be a base for nullity.

CIOPORA- General remark

It is essential that the criteria for sufficient "minimum distances" be defined species by species, and that the "important" characteristics used for assessing the distinctness of a variety give the variety, once protected, a sufficient area of protection in relation to other "characteristics" that are only slightly different and in any event of no concern (for the species in question) to the customers of the varieties concerned.

- Paragraph (1)(a)

Should "precise description in a publication" be considered sufficient disclosure?

- Paragraph (1)(b)

The word "trials" should be replaced by "any use."

- Paragraph (2)

CIOPORA requests that the formalities for the grant of protection be harmonized, in particular through the use of identical forms in all countries.

COMASSO

On the conditions required for protection (Article 6 of the UPOV Convention), an in-depth study is necessary, for example on a new definition of "important characteristics" or of the requirement of worldwide novelty.

FIS

Progress in biotechnology requires on the one hand a redefinition of the important characteristics on which distinctness from other varieties is based and of the minimum distances that should separate varieties. On the other hand, the array of tests for assessing distinctness should be extended, and new techniques such as eletrophoresis should be taken into consideration.

With regard to the period before the filing of the application during which the variety may be offered for sale or marketed, there should be a greater differentiation according to species. Some countries wish to have the period extended to six years in the case of cereals.

Article 7AIPH

Article 7.1. Member States should enter into bilateral agreements in order to reduce costs because of a more efficient and less expensive testing system. Such a system should include testing by breeders themselves at their own premises.

Article 7.3. In our opinion this period should form part of the period of protection granted under the Convention.

CIOPORA

CIOPORA wishes generally to draw attention to and reiterate its general remarks already submitted to UPOV on prior examination as conceived in the UPOV system and on its drawbacks for breeders (see document CIOP/IOM/3 of September 16, 1985).

- Paragraph (3)

CIOPORA requests that "any member State of the Union may provide" be replaced by "any member State of the Union shall provide."

COMASSO

Provisional protection under Article 7(3) of the UPOV Convention should be made mandatory; alternatively protection should take effect from the date of filing.

FIS

As with patents, there should be (provisional) protection as from the date of filing of the application.

Harmonization of the examination criteria for hybrid varieties and of the examination procedures used in member States has also been requested.

Finally, competent authorities should have the right to request only the elements necessary for the determination of the characteristics of the variety, and nothing else (paragraph (2)).

ICC

The ICC believes that compulsory examination of new varieties for distinctiveness, uniformity and stability is causing problems, and suggests it be reconsidered. The cost of testing is escalating, which is undesirable whether these costs fall on governments or breeders. They are time-consuming and delay grant. Even so, the results are by no means assured. If it is considered desirable to retain some kind of examination perhaps the Convention should make clearer that the authorities are not necessarily required to carry out growing tests.

Article 8CIOFORA

It is indispensable that the duration of protection be harmonized in all member States. It should be calculated from the date of filing of the application.

COMASSO

The duration of protection (Article 8 of the UPOV Convention) should be harmonized upwards, for instance on the basis of the relevant provisions of the law of the Federal Republic of Germany; the minimum duration of protection should be discarded.

FIS

There is a unanimous desire for extension of the duration of protection, with a new minimum to be set at no less than 20 years.

ICC

Two changes are proposed. Firstly, the term of protection should begin with the date of application. Protection is often most important to the breeder at this time. This would however mean that the right would expire earlier, and for this reason (as well as others) the period of minimum protection should be extended, say to 25 years. If an adequate minimum term of protection is fixed in this way, no particular reason is seen to retain the possibility of different terms for different classes of plant.

Article 9

AIPH

Our organization recommends a revision of Article 9 of the Convention. We therefore suggest the insertion of a text based on the United Kingdom legislation:

"(1) Subject to the provisions of this section, if any person applies to the Controller and satisfies him that the holder of any plant breeders' rights has unreasonably refused to grant a licence to the applicant, or, in granting or offering to grant a licence, has imposed or put forward unreasonable terms, the Controller shall, unless it appears to him that there is good reason for refusing the application, grant to the applicant in the form of a compulsory licence any such rights as respects the plant variety as might have been granted to the applicant by the holder of the plant breeders' rights.

(2) In entertaining applications and settling the terms of compulsory licences under this section the Controller shall endeavour to secure that the plant variety is available to the public at reasonable prices, that it is widely distributed, that it is maintained in quality and that there is reasonable remuneration for the holder of the plant breeders' rights."

We therefore feel that, if the Convention is revised, a new article which embodies this approach should be included.

COMASSO

The equating of the public interest, in terms of Article 9 of the UPOV Convention, with measures to ensure the widespread distribution of the variety is unsound. There is no reason for limiting to that case only the measures necessary to ensure that the breeder receives equitable remuneration. Article 9(2) should be deleted.

FIS

Paragraph (2) should be deleted.

ICC

A suggested minor amendment is to delete the words "in order to ensure the widespread distribution of new varieties" in the second paragraph. This is for two reasons. Firstly, it is not necessarily accepted that the widespread distribution of new varieties is sufficient to justify restriction of the breeders' right. Further, in all cases where the right is restricted the breeder should be treated equitably.

0054

IOM/III/3
page 18

Article 10

AIPH

We propose to add an article 10.3(c) as follows: "he does not keep his varieties homogeneous or stable."

Article 11

AIPH

We suggest to make the following system: "An application in a member State for protection under the terms of this Convention shall be deemed to constitute an application for such protection in all other member States in which the variety involved is protectable."

FIS

One proposal aims to reverse the system so that dependence of protection becomes the rule, but at the discretion of the applicant. PBRs obtained in one State would then automatically apply in all the others if the applicant so requested. If not, the rule of independence would apply.

Article 12CIOPORA

CIOPORA requests extension of the priority period to two years.

COMASSO

The priority period laid down in Article 12 of the UPOV Convention should be extended to 18 months.

FIS

The priority period could be extended to 18 months.

ICC

As is well known, the development of plant varieties is a long drawn out process. The ICC suggests that the period of priority could be extended to up to 18 months or two years.

Article 13

AIPH

Article 13.8. On the question of variety denominations we emphasize that a clear distinction must exist between these variety denominations, being part of the breeders' right on the one hand and a trademark or trade name on the other. We recognize that, in accordance with Article 13(8) of the Convention, the breeder is entitled to add a trademark to the variety denominations. In horticultural trade, however, there is often confusion as to whether the name is a variety denomination or a trademark. In these cases the requirement, also mentioned in Article 13(8), that variety denominations are easily recognizable, has not been fulfilled. These problems occur both during the period of breeders' right and after the termination of that period. It is not acceptable that the holder of such a right should convey the impression, by use of a trademark, that the protection continues to apply after the right has in fact expired.

We suggest to add an Article 13.9 with following text: "Under no circumstances shall the use of trademarks confer rights to the breeders over or above those rights provided under the terms of this Convention."

CIOPORA

- Paragraph (2)

CIOPORA requests the deletion of the second sentence "It may not consist solely of figures...".

- CIOPORA uses this occasion to draw attention to its own and other organizations' requests for the total deletion, or amendment according to the wishes of breeders, of the UPOV Recommendations of 1985 on Variety Denominations (see document CIOP/IOM/7 of September 16, 1985, and the statements of CIOPORA during the UPOV meeting on April 18, 1986). This is a matter of urgency, and should be dealt with without waiting for the next revision of the Convention.

COMASSO

The principle written into Article 13 of the UPOV Convention according to which the variety denomination is a generic designation should be deleted to enable breeders to use other forms of protection in non-member States of UPOV.

The prohibition on denominations consisting solely of figures should be removed.

In any event, any recommendations that interpret the provisions of the Convention more restrictively should be eliminated.

FIS

There have been many reactions in favor of complete revision of this provision or at least its adaptation to commercial realities. Inadequate restrictions should be deleted.

ICC

While the need for the very existence of this article in the Convention has been questioned, the ICC believes, on balance, that it should be maintained, but simplified. For example, why should not the variety denomination consist solely of figures? While this is not a matter directly concerned with amendments to the Convention, the ICC also suggests that the guidelines issued by UPOV on this topic are less helpful than they could be, and should be redrawn.

General Proposals

International Commission for the Nomenclature of Cultivated Plants

It is proposed to replace following expressions at each place of the text where they are used:

"genus and species" by "taxon" (e.g. art. 2(2))

"genera and species" by "taxa" (e.g. art. 4 heading, (1), (2))

"genus or species" by "taxon" (e.g. art. 3(3))

"genera or species" by "taxa" (e.g. art. 4(3)(b)(i), (ii), (iii), art. 5(4))

Explanation:

1. In many national legislations the eligibility for protection is not only restricted to genera and species but may also contain other taxonomic groups as orders, families, sections, parts of genera or species.¹

2. For "genus" and "species" there are no unanimously followed definitions available. The term "taxon" however is defined in the three UPOV languages in the International Code of Botanical Nomenclature (Adopted by the Thirteenth International Botanical Congress, Sydney, August 1981), E.G. Voss c.s., 1983.

In this code art. 1 reads:

1.1. Taxonomic groups of any rank will, in this Code, be referred to as taxa (singular: taxon).

[End of document]