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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

FOURTH MEETING WITH INTERNATIONAL ORGANIZATIONS

Geneva, October 9 and 10, 1989

COMMENTS FROM AIPPI

Document prepared by the Office of the Union

The annex to this document contains the comments from the International Association for the Protection of Industrial Property (AIPPI) on the revision of the Convention. They were transmitted to the Office of the Union by letter of September 21, 1989.

[Annex follows]

**Position to the International Association
for the Protection of Industrial Property (AIPPI)
for revision of the UPOV-Treaty
(UPOV-document IOM/IV/2 of 22.06.1989)**

(Editorship: Dr. E. Freiherr von Pechmann, Munich)

The AIPPI which is a scientific Association with more than 6'000 members worldwide, has given itself the task to promote the protection of industrial property through studies and consultation. It has also in light of the large economic as well as dietary political relevance which the development of improved plant breeding has received, occupied itself intensively for many decades with the problems of legal protection for new plant breeds. It greets the initiative of the Council UPOV to improve the already existing protection of plant breeds by means of a repeated revision of the UPOV-Treaty. As can be taken from the draft of the new edition of the treaty, as presented by the Association's office, the goals of the revision are:

- a) to strengthen the rights of the breeder;
- b) to increase the practical scope of application and
- c) to clarify a number of regulations.

The AIPPI allows itself, after conferring with its commission responsible for such matters, to make the following comments to a number of important suggested changes of the draft as presented:

To Art. 1:

The Executive Committee of the AIPPI has in its Resolution of Rio de Janeiro in the year 1985 to Question 82 as well as in the Resolution of Sydney in the year 1988 to Question 93 already clearly expressed, that the AIPPI is of the opinion, that the current prohibition of double protection according to Art. 2 of the Treaty, especially in light of newly developed methods for breeding which have been devised since the creation of the Treaty in the year 1961, cannot be seen anymore as up-to-date and therefore this provision should be deleted. It is in the meantime also softened by the newly introduced Art. 37 and is no longer binding on all members of the UPOV.

Although in the draft revision this prohibition was removed from Art. 2, it was nevertheless reintroduced in newer more precise form as sentence 2 of Art. 1 para. 2. The AIPPI is further of the opinion, that both legal systems, varieties patents and patents for the protection of inventors of new plant breeds, should and can exist next to one another. As already known, both systems have particular advantages. It should be left to the inventor or breeder to decide which form of protection they wish to choose for their innovation. Many years of practice in the countries which give patent protection for new breeds of plants has demonstrated, that also the patent system is appropriate for providing protection of patents in this area. Also the fact that those union-states that apply Art. 37 have experienced no difficult problems from a concurrent application of both systems to a large number of plant species, allows the claim that the possibility of protection opened by Art. 37 through both systems should be made generally binding on all member-states of the UPOV. Hereby a harmonization of the application of the treaty would be reached. Experience

in other protected areas shows that overlapping parallel protective law forms (for example patents - utility models) for the general populace has not lead to an uncertainty of the applicable protection for inventors. According to experience, the largest innovative incentive is given by providing strong protective rights, so that also in the area of plant breeding the public is also best served.

The second sentence in Art. 1 para. 2 of the draft revision should be deleted, especially in view of the high goal of the revision to improve the protection of the breeder. Instead it should be expressed, that by allowing the protection of a species, the rights of the contracting states to award patents for inventions of plant breeds, remains untouched.

To Art. 3:

The general introduction of national treatment is welcomed. The AIPPI has advocated such a policy for a long time in all areas of industrial legal protection in order to improve international cooperation.

To Art. 4:

The suggested expansion of the scope of application to all species of plants will strengthen the treaty. By cooperation between the responsible agencies (variety patent offices) of the contracting states and the assumption of test results, each type of protection in all member-states can be provided for. If there is a need for registration on the side of a breeder in a particular contracting state and protection for a new species of plant is desired there,

this protection should also be provided. Para. 2 does therefore not appear to be necessary.

To Art. 5:

The improvement of protection achieved with the new wording of para. 1 is welcomed, especially the inclusion of the harvest in the scope of protection, whereby the breeder is now better able to protect and realize the economic advantages of his invention. Therefore, the definition for the term "material" in Art. 2 must also include the number iv.

It is thankfully acknowledged, that it was also recognized at the UPOV, that a dependency regulation in the case of use of protected species for the breeding of new species and the industrial use of these breeds is justified and necessary. The increased costs of time and money connected with the development of new breeds, especially with the new breeding methods, justifies the introduction of a dependency regulation analogous to the patent law. Therefore, the alternative 1 in para. 3 is preferred, especially since it most closely reflects the goal of the revision that means the improvement of protection for breeders.

In the event that the alternative 1 cannot be put through, the alternative 3 is preferred over alternative 2, since unimportant changes in protected species is not worthy of advancement. The number of species would be unnecessarily enlarged and the clarity of the protection system would be reduced.

Since there are also cases in which a new breed is produced by the use of more than a single protected species the word "single" in para. 3 line 2 of the text should be deleted.

The fears, which were brought forth regarding the building of a so called dependency pyramid, should be unrealistic. In patent law it was demonstrated that in spite of the strong dependency principle such appearances in practice also in such intensely innovate areas as for example computer technics and polymer chemicals lead to no unresolvable problems.

Otherwise, the definition for the new species in para. 3 as "derived primarily from a protected species" will be unclear. It should be determinative here that they have substantial or the protected characteristics of the protected species.

The paragraph 4 is viewed as unnecessary and in opposition to the general trend towards harmonization. At least a test of the necessity of a reduction of the protective effect should not be left alone to the associated state, rather it should occur through the commission and be approved. A mere notification of the general secretary and a opinion by the commission concerning a restriction of the general breeding rights will not be able to prevent an arbitrary or national - egotistical treatment.

Para. 5 is definitely to be rejected. Because of basic legal political considerations, the repeal of existing, or previously issued industrial protective rights, by means of the registration of a species protection right, is to be rejected. This new provision would have the effect, that an older existing patent would be practically expropriated, since it could not be enforced against the owner of a species protection right as well as their licensee and all consumers; also, if the object or protected teaching of the patent is used during the production or propagation of the species or rather if the material being marketed falls within the scope of the protection of the patent claim.

Since according to Art. 13 para. 7 of the draft the propagation material of a protected species is to be designated by sale with a species designation, the new requirements of Art. 5, para. 5 would also have the result, that also older, a same, or similar registered trademark designating the species would be invalidated, since the use of the trademark with the identified or confuseable species designation by the offering for sale, marketing, import or export or use of the propagation material (see hereto para. 5 (i) in connection with para. 1 (i) (ii) and (iii) cannot be prohibited.

Such a grave encroachment on another existing legal system with the effect of automatic forced licencing on the industrial protection rights would violate the legal principles in many of the contracting states. This could jeopardize the ratification of the revised version of this treaty in those states. There has not even been a basic payment claim determined, as opposed to the dependant regulations of the older protection species (Art. 3). Should this be left up to the contracting states?

The AIPPI has previously fought energetically against tendency that further erode patent and trademark rights, which is why they advocate a substitutionless deletion of this unacceptable para. 5.

To Art. 7:

The proposed adoption in para. 4 of a preliminary protection for the patent rights, as already exists in many countries for the time prior to the granting of protective rights, is greeted and supported.

To Art. 8:

An extension of the minimum period of protection to 20 or 25 years appears sensible. In light of the different generation life of the plant types, extended protective effects for some of these types are justified. They should, however, be made uniformly compulsory for the contracting states.

To Art. 12:

The extension of the priority term to 24 months is justified in consideration of the length of time needed to develop a new plant species and will therefore be supported.

In para. 5 (c) not only the corresponding but also the designations which can be easily confused with designated species should be characterized as unsuitable.

Regarding the regulation in para. 7 the alternative 1 will be supported.

The existing para. 8 of Art. 13 should remain untouched. The additional use of a factory or trademark is in specific areas, especially with decorative plants, generally usual and has not lead to any difficulties or problems. There is therefore no recognizable reason, why this should be deleted.

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