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IRC/ III/13
ORIGINAL: English
DATE: February 21, 1976

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

COMMITTEE OF EXPERTS ON THE INTERPRETATION AND REVISION OF THE CONVENTION

Third Session

Geneva, February 17 to 19, 1976

DRAFT REPORT

(Second part: Discussions in the Absence of Observer Delegations)

prepared by the Office of the Union

1. On February 19, 1976, the representatives of member States in the Committee of Experts for the Interpretation and Revision of the Convention (hereinafter referred to as "the Committee") continued their discussion in private. All the representatives of member States listed in the Annex to document IRC/III/12 took part in this discussion.

Program for the Fourth Session of the Committee

2. The Chairman pointed out that the first item on the agenda of the fourth session of the Committee would be the adoption of the report on the third session. In addition, the questions on the interpretation and revision of the Convention which were dealt with at the third session should be discussed with a view to preparing final recommendations for presentation to the Council at its session from October 13 to 15, 1976. The Office of the Union was asked to prepare a document listing the various items. The document should contain, where possible, proposals for amendments to the Convention, together with alternative proposals, but not more than three for each item.

3. The Vice Secretary-General pointed out that, according to Article 27 of the Convention, the next revision conference was to be held in the coming year unless the Council decided otherwise. He asked the Committee for its opinion as to whether the revision conference could be held as soon as in 1977. The Committee took the view that revision of the Convention was urgent with respect to at least one item, namely the deletion of the Annex. The convening of a revision conference as early as in 1977 should therefore not be ruled out for the time being. The question had to be discussed at the fourth session of the Committee and at the tenth session of the Council.

4. Mr. Laclavière (France), President of the Council, pointed out that the convening of a diplomatic conference in 1977 called for special provisions in the 1977 budget. He asked the Office of the Union to inform the members of the Consultative Committee on the cost of a diplomatic conference as soon as possible. In the light of this information, the question whether a revision conference should be held in 1977 could be prediscussed at the forthcoming thirteenth session of the Consultative Committee.

5. It was also mentioned that, as decided by the Council, a joint meeting with the Working Group on Variety Denominations was to take place during the fourth session of the Committee and that a preparatory document should be established by the Office of the Union for that part of the session.

Interpretation of Article 7 of the Convention (Examination)

6. The Committee agreed on a statement for presentation to the United States Delegation attending the third session of the Committee as a possible interpretation of Article 7(1) of the Convention. The statement is attached as Annex 1 to this report. It was pointed out that the statement had to be approved by the Council at its tenth session. Mr. Laclavière (France), President of the Council, indicated that a preliminary decision on the statement could be taken after a further discussion during the thirteenth session of the Consultative Committee, and that the United States authorities could be informed of that preliminary decision.

[After the closing of the session, the statement was presented to the United States Delegation, which promised to submit it to the competent bodies in the United States of America and expressed the wish to be informed on the final position of UPOV as early as possible]

Mission of the UPOV Delegation to the United States of America

7. The Vice Secretary-General distributed a letter from the United States Commissioner of Patents and Trademarks, dated February 10, 1976, containing comments on the internal report on the mission of the UPOV delegation to North America (UPOV/Inf/III/Rev 2). The letter is attached as Annex II.

Planned Visit of a Delegation of the United States of America to the UPOV member States

8. In informal discussions with the United States Delegation attending the third session of the Committee, the Office of the Union had distributed several draft proposals for an itinerary for the visit of a delegation from the United States of America to the UPOV member States. The United States Delegation promised to inform the Office of the Union in writing on the wishes of the competent bodies of its country.

[Two Annexes follow]

ANNEX I

STATEMENT CONCERNING ARTICLE 7

The following statement has been drafted as a possible interpretation of Article 7(1) of the Convention, although it has not yet been accepted by the UPOV Council.

It is clear that it is the responsibility of the member States to ensure that the examination required by Article 7(1) includes a growing test, and the authorities in the present UPOV member States normally conduct these tests themselves; however, it is considered that, if the competent authority were to require these tests to be conducted by the applicant, this could be considered to be in keeping with the provisions of Article 7(1) provided that:

(a) the growing tests are conducted according to guidelines established by the authority, and that they continue until a decision on the application has been issued;

(b) the applicant is required to deposit in a designated place, at the time of filing his application, a sample of the propagating material representing the variety;

(c) the applicant is required to give access to the growing tests mentioned under (a) to persons properly authorized by the competent authority.

[Annex II follows]

IRC/III/13

ANNEX II

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address Only: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

February 10, 1976

Dr. Heribert Mast
Vice Secretary General
International Union for the Protection
of New Plant Varieties
Geneva, Switzerland

Dear Dr. Mast:

Thank you for forwarding to the Patent and Trademark Office the Report on the Mission of the UPOV delegation to North America. The Report makes it apparent that the delegation thoroughly appreciates our laws and practices for the protection of new plant varieties. We did notice, however, a few statements that could be misunderstood. I am taking the liberty, therefore, of offering the following comments.

Paragraph 21 of the Report suggests that the proscription of the patent laws against any applicant adding new matter to his application does not apply to applications for plant patents. As a general rule, it may be true that an applicant may perfect the description of his plant variety. However, he cannot substitute the description of a different plant or substitute information which contradicts any scientific or technical information provided in the application as filed.

Paragraph 22 states that the examiner consults experts in our Department of Agriculture only about their knowledge of agricultural varieties. In fact, these experts are consulted whenever there is any doubt about the novelty of any variety, agricultural or otherwise, for which a patent is sought. Also, the examiner is authorized to solicit affidavits from agricultural or horticultural experts other than the applicant, which he does in doubtful cases.

The final phrase of paragraph 22 refers to unregistered varieties. We are not sure what this means.

Turning to the second sentence of paragraph 23, we wish to point out that this six-month period is not a consequence of any backlog. It is a normal operating period during

which papers are handled and clerical procedures performed. This six-month period will be reduced some in the future as the Patent and Trademark Office approaches its long-range goal of an eighteen-month pendency period for patent applications.

Paragraph 24 suggests that the examiner is free to consult any sources of information he wishes, including the results of tests conducted by foreign governments. Actually, the examiner's freedom is not so unlimited. For example, a plant publicly unknown in the United States, and never described in a publication, cannot be relied upon under our laws in judging the novelty of a new variety. To the extent that the testing procedures of foreign examining offices utilize such information, their test results would have no legal effect here.

Paragraph 24 could be misleading in suggesting that we sometimes fail to perform needed tests. The examiner is authorized to request plant specimens, and have them grown in greenhouses (glasshouses) or in the open. Such tests are not routinely carried out for asexually reproduced varieties. They are performed, however, when their results would be useful in judging novelty.

Paragraph 25 concerns the effect of changes within our professional staff. When an examiner (in any technological area) leaves the Office, there is, of course, the need to replace him with another examiner. Sometimes, this second examiner possesses less immediate knowledge of the particular technology. Additional supervision of the second examiner might be required for a while, and there might be a temporary increase in the time needed for the proper examination of an application. But the overall integrity of the examination process and the validity of new patents does not decrease. The Patent and Trademark Office takes great pains to assure that changes in personnel do not affect the quality of examination or the validity of issued patents.

Paragraph 26 suggests that a plant for which a patent is sought may or may not be useful, and that the presence or absence of usefulness plays no part in determining whether or not a patent will be granted. The usefulness of a novel variety is usually taken for granted. Certainly, its economic value is not a requirement for patenting. We have never faced the question, however, of the usefulness

of a plant with serious undesirable characteristics and no known desirable characteristics. Perhaps such a plant would be judged as failing to satisfy the "usefulness" requirement.

The last sentence of paragraph 28 is not clear to us. Each of our patents contains a complete botanical description of the protected variety and a colored illustration. We are not sure what is meant by "bibliographical data". If this term refers to a listing of the publications relied upon by the examiner, it is also included in the published patent. The publicly-available patent file also contains additional information or data taken into consideration by the examiner.

Paragraph 29 suggests that applications from smaller or lesser-known firms or amateur breeders may be checked more carefully than those received from large, well-known nurseries or professional breeders. This is not the case. All applications are examined under exactly the same standards. Each application is carefully scrutinized for deficiencies, and our examination procedures are applied uniformly. Our system cannot be characterized as favoring large-scale, commercial firms to the detriment of smaller ones.

Paragraph 30, along with several other paragraphs, states that the examination of plant patent applications is conducted on the basis of a photograph. This is also not true. Our examination utilizes the drawing (often a photograph) provided by the applicant, together with his botanical description, his statement of the origin and parentage of the plant, and his further statement of where (geographic) and in what manner (cutting, grafting, etc.) the plant has been asexually reproduced. When the plant originates as a newly-found seedling, the application must explain the location and character of the area where the seedling was discovered. In addition, the examiner evaluates the report received from the Department of Agriculture. All of these factors go into determining the novelty of a plant variety.

The last sentence of paragraph 32 states that a judicial decision on patent validity in our courts affects only the parties involved. Decisions were so limited at one time, but have been expanded by recent judicial decisions. Now, patents found invalid in litigation over validity or infringement cannot ordinarily be relitigated. A holding

of invalidity attaches (with some possible special exceptions) to the patent and binds the patent owner in suits against other possible infringers. Although no plant patents have been litigated since the development of this legal doctrine, we are certain that it will apply equally to them.

Of course, a holding of validity has effect only between the litigating parties, and cannot prejudice the rights of later accused infringers. They are always offered an opportunity to establish the invalidity of the patent that they are accused of infringing.

Paragraph 40 states that no applications for poplars have been filed so far. Actually, a number of poplar trees have been patented, although no applications for poplars have been received in recent years.

We do not completely understand the last two sentences of paragraph 40. There is no requirement in our laws that a tree be at least five years old before an application for it can be submitted to the Patent and Trademark Office. Nor are we sure what is meant by the statement that the further development of a five-year old (or older) tree could be anticipated.

I trust these remarks are helpful. Of course, we would be pleased to answer any questions you may have about them, or about other aspects of our system. Would you be kind enough to see that our remarks are forwarded to those who have received copies of the Report of the UPOV Mission to North America.

Sincerely,

C. Marshall Dann

C. Marshall Dann
Commissioner of Patents
and Trademarks

[End of Annex II and of document]