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UPOV

IRC/III/4
ORIGINAL: French
DATE: January 21, 1976

NTERNATIONAL 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 20, 1976

COMMENTS BY PARTICIPANTS

Comments and proposals of CIOPORA

1. The International Community of Breeders of Asexually Reproduced Ornamentals (CIOPORA) transmitted on January 10, 1976, the letter and the comments and proposals that are attached as Annex I to this document, in preparation for the third session of the Committee of Experts on the Interpretation and Revision of the Convention.

2. Reference is made in the comments and proposals to a previous letter dated August 30, 1974--reproduced in the Annex to document NM/I/4--and to a letter dated April 5, 1974. These letters (and their enclosures) are attached as Annexes II and III, respectively, to this document.

[Annexes follow]

ANNEX I

Letter from the Secretary General of CIOPORA
to the Secretary-General of UPOV,
dated January 10, 1976

With reference to your circular letter No. U 233/08.2, by which you kindly communicated to us the agenda for the session of February 17 to 20, 1976, we have the honor to send you herewith some suggestions concerning the items on which our Organization wishes to see a revision of the Convention of 1961.

For the sake of greater efficiency, we limited ourselves to the questions we consider to be most essential and most urgent.

Comments and proposals of CIOPORA

Article 2(1), second sentence

The possibility (mainly asked for by the United States of America) of protecting the same botanical species under both forms of protection (patent and special title of protection) does not seem, in CIOPORA's view, to be of major interest at the national level.

It would be advisable, however, to examine the interest of such a proposal with regard to the future introduction of a supranational protection title (similar to the European Patent) which would allow the automatic grant of breeders' rights,on the basis of a single application, in several countries that protect new plant varieties either by plant breeders' certificates or by patents or by both forms of protection.

Article 5 - Definition and Content of the Right of the Breeder

The protection provided for in Article 5 of the Convention applies only, in principle, to the reproductive or vegetative propagating material, as such, of the new variety.

It is only by way of alternative--in other words as an optional possibility--that paragraph (4) of the same Article provides that signatory States may grant a right capable of extending to the marketed product.

Up to now, namely 15 years after the signature of the Convention, only France and Italy have made use of this possibility (for roses and carnations and for ornamental plants respectively).

The limitation of the mandatory minimum scope of protection to the propagating material is partly explained by the fact that it was advisable to open the Convention to the maximum number of species and the maximum number of States. Fifteen years ago the protection of new plant varieties was still a mystery to many people and the arguments in favor of the extension of protection to the "finished article" in the case of ornamental plants were often not fully understood.

The fact remains, however, that the authors of the Convention were intent on affording all breeders such protection as allowed them to exercise effectively their right of control over their varieties. Now, unfortunately, CIOPORA has observed that, in the member States which have incorporated only paragraph (1) of Article 5 in their national legislation--and which therefore have not made use of the possibility provided for in paragraph (4)--the breeders of vegetatively propagated ornamental plants are often given illusory protection only:

- Cut flowers (which do not constitute propagating material as such) of a protected variety can be freely introduced and commercialized on the territory of such a member State if, having come from a country that does not grant protection, they are sold in that form and are not used for propagation purposes.

Such a situation is intolerable for both the breeder and his licensees in the importing country, who thus have to contend with unfair competition and cannot enjoy the untroubled exercise of the right granted or assigned.

- Furthermore, it is debatable whether, in a member State, the growing of plants for the production and sale of cut flowers of a protected variety can be efficiently controlled by the breeder of that variety where the plants have not been propagated on the territory of the respective State, but imported from another country where the variety is not protected.

Since this situation is obviously contrary to the intentions of the authors of the Convention and to the spirit of the Convention itself, CIOPORA reiterates the wishes that it has been expressing since 1960 and asks that the last sentence of Article 5, paragraph (1) be drafted as follows:

"With respect to vegetatively propagated ornamental plants, the right of the breeder shall extend to plants and parts of plants (cut flowers ...) even if the latter are produced, offered for sale or marketed for purposes other than propagation."

CIOPORA proposes to complete that amendment with the following change at the end of the first sentence of Article 5, paragraph (4):

"..... a more extensive right than that defined in paragraph (1) of this Article, capable in particular, of extending, in the same way as for vegetatively propagated ornamental plants, to the marketed product."

CIOPORA wishes to point out that the provision mentioned in item 6 of document IRC/III/2 would be insufficient and would not allow the above-mentioned shortcomings to be remedied, as it takes account of neither "culture" nor "commercialization," but only of "reproduction" or "multiplication."

Article 6 - Preliminary Examination

On the whole CIOPORA maintains, with respect to preliminary examination, the arguments put forward in its letter of August 30, 1974*, which was reproduced by UPOV in document NM/I/4 of October 15, 1974.

CIOPORA welcomes and endorses the suggestions in items 7, 10 and 11 of document IRC/III/2, which aim at a limitation of the cases in which the breeder risks losing his entitlement to protection because of disclosure.

Article 13

CIOPORA asks that the term "denomination" may be replaced, in conformity with German law, by the expression "designation," which is more consistent with the role and the function assigned by the Convention to that "denomination."

CIOPORA proposes the deletion of the second paragraph of Article 13(3), as well as of the end of its first paragraph beginning with "unless he undertakes to renounce...." Paragraph (3) would thus end at "....liable to cause confusion with such a mark."

CIOPORA also calls the attention of UPOV to its letter of April 5, 1974**, on the subject of the Guidelines for Variety Denominations. Although the Guidelines only have the effect of mere recommendations, they contain provisions capable of orienting the interpretation of the Convention. Incidentally the requests for amendment of the said Guidelines that have been made by CIOPORA have acquired increased importance since the Federal Republic of Germany voted the Amendment of December 31, 1974 (Article 8), of the Law on the Protection of Plant Varieties.

[Annex II follows]

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* See Annex II to this document.

** See Annex III to this document.

LETTER FROM THE SECRETARY GENERAL OF CIOPORA
TO THE SECRETARY GENERAL OF UPOV, DATED AUGUST 30, 1974*

As I mentioned to you at our last meeting in your Office, our Association was very appreciative of the proposal you made in your letter of April 9, 1974, to the effect that we should submit to you our comments and suggestions, if any, on those of the draft Guidelines for the Conduct of Tests which relate to species of interest to our Association.

As agreed, our Association has investigated the problem of prior examination in general and I enclose herewith a memorandum containing a certain number of general considerations deriving from recent experience of examination as provided for in Article 7 of the 1961 Convention.

We should be obliged if you would forward this document to the Council of UPOV and to the Working Group responsible for the drafting and revision of the Guidelines for the Conduct of the Prior Examination.

We earnestly hope that, in accordance with your proposal, communication may soon be established between our Association and the bodies referred to, in such a way that the desired improvements may be brought about in examination procedures and the issue of titles of protection. We thank you in advance for whatever action you take to this end.

In addition, our Association will not fail to submit more specific suggestions to you with regard to the examination of each of the species in which it is interested, as the respective draft Guidelines become available.

* forms part of UPOV document NM/I/4 of October 15, 1974

M E M O R A N D U M

on the prior examination provided for in Article 7 of the Paris Convention establishing the Union for the Protection of New Varieties of Plants of December 2, 1961

I.

C.I.O.P.O.R.A.,

Considering Articles 7 and 30(2) of the Convention establishing the Union for the Protection of New Varieties of Plants and the Recommendation annexed to the said Convention concerning the organization of prior examination at the international level,

Considering the recommendations made to States members of the Union by the Council of the said Union at the close of its seventh session, held from October 10 to 12, 1973,

Recalling also the advice and recommendations already given by it in the past (observations of October 1961 on the Preliminary Draft Convention of August 1961, on the Protection of New Varieties of Plants, International Symposia on the Protection of New Plant Varieties in Paris in April 1967 and in Amsterdam in April 1972),

Referring to the letter sent to it by the Secretariat General of UPOV on April 9, 1974,

submits to the Council of the International Union for the Protection of New Varieties of Plants the following Memorandum, the purpose of which is to review the present operation of prior examination with respect to vegetatively reproduced ornamental plants, and to suggest such improvements as are desired by the profession at the present time.

II.

It is important to bear in mind that the International Conference on the Protection of New Varieties of Plants, which resulted in the 1961 Paris Convention, was convened from 1957 to 1961 at the instigation of the breeders of plants which did not qualify for protection by patent,

that is, mainly, seed-reproduced plants for alimentary purposes.

For the majority of these plants provision was already made, in legislation on the commercialization of seeds and plants, for prior examination of the performance and the cultivation value of new cultivars.

Moreover, the novelty characteristics of this type of plant are often of a physiological nature (better performance, higher precocity rating, etc.), and generally can only be verified after a thorough test growing. The same applies to homogeneity and stability characteristics.

There is no doubt that this fact had a considerable influence on the decision taken by the writers of the Convention to introduce prior examination.

On the other hand, new varieties of vegetatively reproduced ornamental plants by definition present no major difficulty with respect to homogeneity and stability. As for their novelty characteristics, these are generally morphological and can therefore be determined more easily and rapidly. This no doubt explains how, in the United States of America, protection by "plant patent" of vegetatively reproduced plants has existed for 40 years without prior examination and has given satisfaction to breeders and users alike.

III.

C.I.O.P.O.R.A. concludes from the foregoing that the prior examination of vegetatively reproduced ornamental plants should be designed on the basis of norms and criteria radically different from those used for other categories of plants. This view is moreover quite in accordance with the 1961 Convention, which provides in Article 7(1) that "examination shall be adapted to each botanical genus or species having regard to its normal manner of reproduction or multiplication."

C.I.O.P.O.R.A. also considers that such a distinction is not only necessary but urgent, for, while prior examination is the keystone of plant variety protection as conceived by the new Convention, it could equally become a stumbling-block if care is not taken.

1. Prior examination limits the number of countries able to accede to the 1961 Paris Convention, which obliges any State contemplating accession to be in a position to put its provisions into effect immediately, and therefore to carry out the examination prescribed by Article 7.

It is now clear that a number of countries have not, and for a long time will not have, sufficient capital, the necessary installations or competent technicians to devise and operate a prior examination service.

2. Prior examination limits the number of species likely to enjoy protection under national laws enacted in accordance with the provisions of the Convention: The Federal Republic of Germany,for instance, justified its refusal to extend protection to carnations by the lack of ad hoc installations for the prior examination of varieties of this species.

3. Prior examination is likely to become more and more uncertain and less and less reliable owing to the growing number of varieties of every species being put on the market, and of commercial dealings between countries. There was a time when the cultivars of a given species, marketed in a given country, were for the most part produced by breeders who were nationals of that country. Nowadays the origin of the cultivars varies more and more, and they can come from the United States, the Soviet Union, Japan, Australia or New Zealand. Thus it becomes practically impossible for an expert to know all the cultivars in existence at any one time, or even all the "well-known varieties." Thus prior examination becomes progressively longer and more difficult.

4. Being difficult, prior examination is of course also costly (in France a new plant variety certificate costs three times as much as a patent). This high cost limits the number of varieties in respect of which breeders decide to file an application for protection, and the vicious circle is completed by the examining bodies, which are thus obliged to charge high fees for reasons of economic viability.

A more accurate idea of the foregoing may be had by consulting the Register of New Varieties (vegetatively reproduced species) maintained by the French Association of Breeders of New Horticultural varieties (SNPNH): at the time of the entry into force of the French Law for the Protection of New Plant Varieties, 850 recent varieties had already been recorded in the SNPNH Register and were therefore eligible for the application of the provisions of Article 36 of the French Law; this option was exercised for only 32 varieties, however. Moreover, by April 1974, some 200 new varieties had been entered in the Register since the entry into force of the French Law whereas, during the same period, applications for new plant variety certificates had been filed in respect of only 40 varieties. Finally, bearing in mind that the Register in question does not cover all the varieties put on the market (many breeders are not members of the Association), it may be concluded from the above figures that there is a somewhat disquieting lack of interest in the protection afforded by the Convention.

On the basis of a survey of its own, C.I.O.P.O.R.A. is in a position to state that the main cause for this is the cost of protection, which is considered too high by a large number of breeders of ornamental plants. These breeders seek to make their research work profitable in roundabout ways (sale of propagating material at high prices, gentlemen's agreements). Another cause is undoubtedly the difficulties which are being encountered by breeders (particularly in the United Kingdom and Denmark) in the application of the UPOV Guidelines for Variety Denominations.

5. Since it is a long process, prior examination is likely to delay the marketing of new varieties or unduly prolong the period (prior to publication of the issue of the title of protection) during which the breeder, while enjoying preliminary protection, can only report or proceed against action prejudicial to his rights after notification of a certified copy of the application.

IV.

One cannot but conclude from all the foregoing that prior examination, as provided for at the present time, suffers from a number of limitations of a human, technical and financial nature, and that steps should be taken to investigate and apply promptly any measures which would permit, if not its elimination, at least its simplification within limits compatible with the texts of the Convention currently in force.

C.I.O.P.O.R.A. was pleased to note that the Council of the International Union had instituted a certain number of measures to rectify the situation, particularly at its October 1973 session, such as the possibility for each member State to issue the title of protection on the basis of the results of a prior examination carried out previously in another State.

C.I.O.P.O.R.A. nevertheless considers it necessary to go much further towards a simplification of the prior examination, and therefore takes the liberty of suggesting the following measures:

Short-term measures

1. It is desirable that, for each species which allows this in terms of technical considerations, only one State of the Union be responsible for prior examinations in respect of that species, in order to avoid the costly proliferation of reference collections and examination services. The results of the examination should be recognized automatically by the State making use of them except where the breeder or any other interested party has made an objection. It is also desirable that the country responsible for the examination of a given species be selected on the basis of its climatic and technical facilities in relation to the species concerned: it would be unfortunate if examination were entrusted to a country which would need a period of two years whereas another country could do the same work in a shorter time.

2. Where several countries of the Union have comparable prior examination facilities for a given species, the results of the first examination must prevail, under the same conditions as above, as far as the authorities of the other States are concerned. The party filing the application must of course have the right to choose freely the country in which he wishes to have the prior examination of his variety carried out.

3. Where, as indicated above, examination is carried out in one State of the Union only, it is neither reasonable nor justified, in the opinion of C.I.O.P.O.R.A., to expect other countries using the examination results to do more than cover the administrative costs occasioned by the transmittal of those results. The essential purpose of international cooperation, that is, the reduction of the cost of protection both for breeders and for the official bodies responsible, must be taken into account at all times. In this connection C.I.O.P.O.R.A. would also like to have examination fees standardized on the basis of the lowest rates currently applied.

4. As soon as one country of the Union protects a given species and therefore has established the appropriate prior examination services, that species should immediately and automatically be entered in the list of species to which all the other countries undertake to apply the provisions of the Convention.

5. Even where prior examination is carried out in one country only, C.I.O.P.O.R.A. proposes the appointment, for each ornamental species concerned, of a permanent working group composed of international experts. The experts, selected and designated by the Council on the basis of their competence, would be responsible for assisting the services of the country entrusted with the examination of the species concerned, and would travel on request. They would keep up to date the Guidelines for the conduct of tests on each species involved.

6. In view of the fact that the establishment of a comprehensive reference collection is practically impossible for obvious technical and financial reasons, C.I.O.P.O.R.A. considers it desirable to establish and keep up to date, for each species, a list of varieties maintained in public or private reference collections already in existence, in order that use may be made of these collections whenever necessary.

Medium-term measures

Even though the measures outlined above are likely to bring about a considerable simplification of the existing prior examination system, there is reason to wonder whether one should not consider still more radical and pragmatic solutions.

New Zealand recently drafted a law on the protection of new plant varieties which provides that examination may be carried out on the basis of reference plants kept by the applicant himself. Similarly, in the United States of America, the Plant Variety Protection Act of January 1, 1971, which introduces protection for categories of plants not eligible for protection under the 1930 Plant Patent Act and which is nevertheless extensively based on the 1961 Convention, does not provide for prior examination as foreseen by the Convention.

In view of the foregoing, C.I.O.P.O.R.A. requests that the Council and the representative professional organizations contact the competent authorities of these countries, in order to ascertain the reasons underlying the adoption of such provisions, to compare experience acquired in the field of examination and to make an objective review of the advantages and drawbacks of the two systems.

C.I.O.P.O.R.A. remains at the entire disposal of the Council of the Union for detailed discussion of each of the points mentioned in this Memorandum.

[Annex III follows]

ANNEX III

Letter from the Secretary General of CIOPORA to the Secretary-General of UPOV, dated April 5, 1974

At its last session, the Steering Committee of our Assocation thoroughly studied the "Guidelines for Variety Denominations" adopted by the Council of UPOV on October 12, 1973, which you have kindly transmitted to us.

We were extremely disappointed to note that the new text of the Guidelines did not take into account:

(a) either the official observations transmitted by CIOPORA to the Council of UPOV on April 8, 1972;

(b) or the view unanimously expressed during the consultation of December 6, 1972, by the most representative professional organizations of breeders and users (ASSINSEL, FIS, CIOPORA), as well as by the international authorities most competent in this matter (AIPPI, ICC);

(c) or our abundant correspondence, especially our letter of July 11, 1973, following the article published by the Vice-Secretary General of UPOV on the subject.

These rules not only ignore our observations, they are also even more restrictive than the "provisional" rules of October 28 and 29, 1970: in particular, the denomination must, from now on, be easy to pronounce and "easy to remember."

In other respects, the new Guidelines do nothing about the inextricable situation to which we drew your attention (our letters of February 10, 1970, and July 28, 1970) and which, through the combined effect of the provisions of the Convention (Article 12(5)) and of British legislation (Section Va) may last as long as the latter continues to be applied in contempt of Article 13(9) of the Convention.

Our Steering Committee fails to understand the reasons which led the Working Group on Variety Denominations to disregard professional practices that have been in force for 20 years, and to ignore the views of the most eminent jurists in this matter. Breeders and horticulturists, who are at present facing particularly severe difficulties, can neither understand nor accept that, in the absence of juridical or economical justification, new administrative obstacles should be put in the way of the exercise of their activity.

There is reason to fear that such rules, if maintained, would lead breeders to forgo the new protection afforded by the Convention of 1961, especially since a certain number of them are finding the cost of that protection hard to bear, having regard to the low profitability of certain varieties.

In view of the foregoing, our Committee asks the Council of UPOV to agree to review the Guidelines, and to this end, we take the liberty of attaching to this letter the comments and amendment proposals suggested by our Association.

We remain at your entire disposal should you consider it useful to arrange a new meeting with the representatives of our Association.

COMMENTS AND AMENDMENT PROPOSALS CONCERNING
THE GUIDELINES FOR VARIETY DENOMINATIONS
ADOPTED BY THE COUNCIL ON OCTOBER 12, 1973

Enclosure attached to letter of April 5, 1974

Article 1

Comments: The end of the second paragraph seems to be in contradiction to the principle laid down in paragraph (1). The denomination must allow the new variety to be identified, that is to be recognized with regard to its "civil status," whatever the country in which it is marketed. Thus, in the view of CIOPORA, only a system of code denominations allows linguistic difficulties to be overcome.

Article 2

Comments: There is nothing in the wording of Article 13 of the Convention of 1961 that admits of a demand that the denomination be used in relations other than those between the breeder and the licensee. Paragraph (7) of Article 13 speaks only of the sale of "reproductive or vegetative propagating material." For those countries, still few in number, in which the breeder's right is extended to the final product, the sole purpose of the use of the denomination must be the control of the genuineness of the variety: it should not have a commercial or advertising function.

Proposed amendment: Delete "a purchaser of average attentiveness."

Article 3

Comments: CIOPORA has already, on many occasions, expressed its position on this point, and explained the multiple advantages of the nomenclature system that has now been used for 20 years by its members. It still maintains this point of view. Furthermore, CIOPORA considers it exaggerated to require that the denomination be both "easy to pronounce and to remember": this would amount to a confusion of the role of the denomination with that of the mark. The latter, and only the latter, must be easy to pronounce and to remember in order to be effective, because it constitutes the pole of attraction for the consumer. Therefore, for one and the same variety, the mark must vary according to the different linguistic or marketing problems of different countries. As to the denomination, it has only to allow the variety to be identified, in the same way as a fingerprint "identifies," and so it must be identical in all UPOV member States, an obligation which is liable to be practically impossible if both of the characteristics mentioned above are required of it.

Proposed amendments:

(1) Delete "easy to pronounce and to remember."

(2) No change

(3) No change

(4) Delete "where a variety is exclusively used for the production of propagating material of other varieties."

Proposed wording: "The denomination may also be formed by combining letters and figures, or syllables and figures, provided that, in the opinion of the competent authorities, such combinations correspond to an established custom for the species concerned in several member States."

Articles 4, 5, 6, 7, 8 and 9

No comments.

Article 10

Comments: In the nomenclature system recommended by CIOPORA, such a provision has little relevance for our members.

[End of document]