



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agreed by the Council of UPOV, only documents that have been adopted by the Council of UPOV and that have not been superseded can represent UPOV policies or guidance.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

IRC/v/2 013
ORIGINAL: English
DATE: December 14, 1976

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

COMMITTEE OF EXPERTS ON
THE INTERPRETATION AND REVISION OF THE CONVENTION

Fifth Session
Geneva, March 8 to 10, 1977

PROPOSALS FOR THE REVISION OF THE CONVENTION

Document prepared by the Office of the Union

SUMMARY

This document, which is intended as a working paper for the fifth session of the Committee of Experts on the Interpretation and Revision of the Convention, sums up the state of the discussions on questions which concern the protection of new varieties of plants as provided in the UPOV Convention and which will form the subject of the next Diplomatic Conference, scheduled for October 1978. It contains proposals for some amendments. It does not deal with questions falling under general treaty law.

INTRODUCTION

1. The Committee of Experts on the Interpretation and Revision of the Convention (hereinafter referred to as "the Committee") has in former sessions discussed a number of proposals for a more flexible interpretation or a revision of the UPOV Convention (hereinafter referred to as "the Convention"). Surveys of the various proposals have been made in documents IRC/I/3*, IRC/II/3*, IRC/III/3, and IRC/IV/2* and 3*, while the main questions were listed in document IRC/III/2. During its third session, in February 1976, the Committee discussed these proposals with observers from non-member States and international non-governmental organizations (see document IRC/III/14 containing the draft report on the first part of that session, which was unanimously adopted by the Committee at its fourth session).
2. The present document surveys the state of the discussions covering the major questions to be dealt with by the next revision conference and contains a number of proposals prepared by the Office of the Union at the request of the Committee. Questions which fall under general treaty law rather than under the rules concerning the protection of new plant varieties are excluded.

PART I

PROVISION OF TWO FORMS OF PROTECTION
(SPECIAL TITLE OF PROTECTION AND PATENT)Article 2(1)**The Problem

3. Article 2(1) reads as follows:

"2(1) Each member State of the Union may recognise the right of the breeder provided for in this Convention by the grant either of a special title of protection or of a patent. Nevertheless, a member State of the Union whose national law admits of protection under both these forms may provide only one of them for one and the same botanical genus or species.

4. In other words, Article 2(1) of the Convention allows individual member States to recognize the breeders' rights by the grant either of a special title of protection or of a patent. It permits States to grant both forms of protection, but it excludes the possibility of doing so in the case of the same botanical genus or species.
5. These rules reflect the situation in the original member States of the Convention at the time the Convention was drafted. While one of those States aimed at protecting plant varieties by patents after due adaptation of its patent law, others favored a system according to which plant varieties were protected under a special title of protection. These conflicting intentions resulted in the text which appears in the first sentence of Article 2(1) and which permits member States to choose between the two systems: the grant of plant patents or the grant of special titles of protection. The second sentence of Article 2(1) was added to solve an additional problem for States which planned to introduce, and later did introduce, protection under a special title. Those States intended to extend the protection progressively, species by species; since in most of them breeders were able, to a limited extent, to benefit from the normal patent protection in the case of some crops, care had to be taken that on the one hand the protection by means of patents was not abandoned too early (in other words, before the new type of protection could be extended to the species in question) and that on the other hand breeders could not still obtain patent protection for varieties of a given species once the new legislative system had been extended to that species. That was the reason for which the grant of patents and special titles of protection for varieties of the same botanical genus or species was expressly excluded.

* Restricted distribution.

** The Articles referred to are Articles of the Convention.

6. This set of rules, however far-sighted it was in covering all the possibilities existing in the original member States, might lead to difficulties for other States where developments had been different, for instance in the United States of America, where vegetatively propagated plants can be protected by the grant of plant patents while sexually reproduced plants can be protected by the grant of a special title of protection. In such States, problems might arise when both sexual reproduction and vegetative propagation are possible and economically feasible for a given species so that some varieties of the species are vegetatively propagated--and thereby eligible for protection by means of plant patents--while other varieties of the same species are sexually reproduced--and thereby eligible for protection by means of a special title of protection; even a single variety might be both vegetatively propagated and generatively reproduced. As a practical example, the case of plums can be cited, where all fruit-bearing varieties are vegetatively propagated (by grafts) while some rootstocks are produced from seed and others by vegetative propagation. Admittedly, such cases are rare at present, but they might increase with the progress of science and technology: new methods of vegetative propagation are and will be developed in the case of species which are now reproduced exclusively from seed (or methods for such vegetative propagation which are already known may become more economic in the future) or vice versa. As an example, the development of clones of conifers in forestry can be cited.

State of the Discussions

7. The Committee agreed that Article 2(1) should be amended to remove the difficulties arising for States wishing to accede to the Convention. Two proposals were under discussion, one aimed at deleting the second sentence of Article 2(1) completely, another intended to replace in the same sentence the words "botanical genus or species" by "variety," which would mean that member States would be precluded merely from providing both forms of protection for the same variety. The Committee showed a certain preference for the second proposal but decided to re-discuss the matter during its fifth session. The main objection against deleting the second sentence of Article 2(1) was the consideration that the first sentence of Article 2(1) by itself did not clearly specify that States were permitted at all to grant protection under two different systems. In the course of the Committee's fourth session, a third proposal was made to the effect that only newly acceding States whose laws were not in conformity with Article 2(1) should be allowed to maintain their legal systems.

Proposals

8. If the Committee shows a preference for precluding in Article 2(1) merely the protection of one and the same variety under both possible forms of protection, the paragraph in question could be phrased as follows:

"Article 2

"(1) Each member state of the Union may recognise the right of the breeder provided for in the Convention by the grant of a special title of protection or of a patent or of both, it being understood that any given variety may be protected by the grant of either a patent or a special title of protection."

9. If the proposal to delete the second sentence of Article 2(1) and leave it to the member States to solve the problems of a possible conflict between two different forms of protection for the same varieties under their national laws were to be adopted, Article 2(1) would have to be reworded to make it clear that member States are not prevented from providing, under certain conditions, for the protection of plant varieties under both systems. The following text is proposed to cover this eventuality:

"Article 2

"(1) Each member State of the Union may recognize the right of the breeder provided for in this Convention by the grant of a special title of protection or of a patent or of both."

10. If it is intended to restrict the right to protect varieties of the same species under both forms of protection to those States whose national laws at the date on which they join the Union provide for different forms of protection according to the mode of reproduction or propagation of the plants, a new Article would have to be inserted between Articles 34 and 35 of the Convention, which could be worded as follows:

2016

"Article 34a

"Notwithstanding the provisions of paragraph (1) of Article 2, any member State of the Union whose national law, at the date of the entry into force of this Convention in respect of that State, provides for protection under different forms for sexually reproduced and for vegetatively propagated plant varieties even if they form part of one and the same genus or species may continue to apply such provision."

PART II

DEFINITION OF VARIETY

Article 2(2)

The Problem

11. Article 2(2) reads as follows:

"(2) For the purposes of this Convention, the word "variety" applies to any cultivar, clone, line, stock or hybrid which is capable of cultivation and which satisfies the provisions of subparagraphs (1)(c) and (d) of Article 6."

12. The inclusion of a definition of the variety was justified at the time of drafting the Convention by the fact that lines and stocks were not generally regarded as varieties and the purpose was to make it clear that such types of varieties could also be protected.

13. The present wording of Article 2(2) raises some problems:

(i) it is possibly incomplete since multiclones and multilines, which are of increasing importance, might be regarded as varieties;

(ii) it is incorrect since at least in English and French the terms "cultivar" are considered synonyms of "variety" and "variété" and not special types of variety such as clones, lines, stocks or hybrids;

(iii) it is redundant in its reference to the concepts of homogeneity and stability;

(iv) read in connection with the introductory sentence of Article 6(1), the wording of the provision in question seems to make it mandatory to protect any hybrid, thereby forming an obstacle for States that object to the protection of hybrids.

Proposals

14. Several proposals for remedying the situation were discussed. The proposal merely to agree to interpret Article 2(2) and 6(1) as meaning that member States were not obliged to extend the protection to hybrid varieties was, at least for the moment, discarded since one delegation had serious doubts whether such an interpretation was compatible with the Convention.

15. A further proposal to delete the definition of the term "variety" in Article 2(2) was discussed at length and it was observed that other basic terms like "species" or "genus" were not defined either. The Committee showed some reluctance to follow that proposal since it thought that Article 2(2) at least provided some guidance for new member States and prevented an unduly narrow interpretation of the term "variety." As to the value of this paragraph as guidance for new member States, it could be argued, however, that the same guidance could also be found in the national laws and the practice of the present member States. It was then generally agreed to amend Article 2(2) and reference was made to the International Code of Nomenclature of Cultivated Plants. It was finally decided to consider an amended version of the paragraph under discussion during the Committee's fifth session on the basis of one or more proposals prepared by the Office of the Union.

16. The following proposals are now being made:

First Proposal

Delete Article 2(2).

Second Proposal

Reword Article 2(2) to read as follows:

"(2) For the purposes of this Convention, the word "variety" applies to any assemblage of plants which is capable of cultivation and which satisfies the provisions of subparagraphs (1)(c) and (d) of Article 6. It may in particular be applied by the member States of the Union to clones, lines, stocks or hybrids."

Third Proposal

Reword Article 2(2) to read as follows:

"(2) For the purposes of this Convention, the word "variety" shall be understood in the broadest sense and may in particular be applied by the member States of the Union to any clone, line, stock or hybrid which is capable of cultivation."

17. With regard to the first proposal, it is recalled that the main purpose of Article 2(2), which is to prevent an unduly narrow interpretation of the term "variety," is not achieved but this may no longer be necessary.

18. As to the second proposal, it can be argued that the provisions of Article 6(1)(c) and (d) are referred to in order to define the term "variety" in Article 2, while the same provisions are used in Article 6 to define the cases in which a "new variety" is protectable. It is furthermore possible that the reference to Article 6(1)(c) and (d) is too narrow since it does not cover distinctness.

19. In respect of the third proposal, it can be stated that it is less specific than the second proposal.

PART III

ANNEX TO THE CONVENTION; APPLICATION OF THE CONVENTION TO
A MINIMUM NUMBER OF GENERA OR SPECIES; NATIONAL TREATMENT AND RECIPROCITY

(Article 4(3) to (5) and Annex)

The Problem

20. Article 4 reads as follows:

"(1) This Convention may be applied to all botanical genera and species.

"(2) The member States of the Union undertake to adopt all measures necessary for the progressive application of the provisions of this Convention to the largest possible number of botanical genera and species.

"(3) Each member State of the Union shall, on the entry into force of this Convention in its territory, apply the provisions of the Convention to at least five of the genera named in the list annexed to the Convention.

"Each member State further undertakes to apply the said provisions to the other genera in the list, within the following periods from the date of the entry into force of the Convention in its territory:

"(a) within three years, to at least two genera;

"(b) within six years, to at least four genera;

"(c) within eight years, to all the genera named in the list.

"(4) Any member State of the Union protecting a genus or species not included in the list shall be entitled either to limit the benefit of such protection to the nationals of member States of the Union protecting the same genus or species and to natural and legal persons resident or having their headquarters in any of those States, or to extend the benefit of such protection to the nationals of other member States of the Union or of member States of the Paris Union for the Protection of Industrial Property and to natural and legal persons resident or having their headquarters in any of those States.

"(5) Any member State of the Union may, on signing this Convention or on depositing its instrument of ratification or accession, declare that, with regard to the protection of new varieties of plants, it will apply Articles 2 and 3 of the Paris Convention for the Protection of Industrial Property."

21. As to the requirements of Article 4(3)--that member States must apply the Convention, gradually and within certain time limits, to at least the species enumerated in the list attached in the Annex to the Convention--it is generally recognized that this list is important in parts of Europe and in other regions with similar climatic conditions, but of less relevance in States with different climatic conditions. The latter States would find it very difficult to undertake to make all the species listed in the Annex eligible for protection. It has also been noted that States might be prevented for other reasons from extending the protection under the Convention to certain of the listed species. The list of species in the Annex to the Convention has proved to be one of the major obstacles to the accession of further States to UPOV. After discarding the proposals to amend the list to make it acceptable to all States, the Committee decided to delete it.

22. The decision to delete the list in the Annex to the Convention has made other decisions on Article 4 necessary.

23. The first question that had to be considered was whether the minimum number of genera or species which the member States must protect within given time limits should be maintained and, if so, whether they should remain the same. The Committee decided on the following compromise: each member State would have to apply the Convention, upon its entry into force in its territory, to five genera or species; within three years after its entry into force, it would have to apply the Convention to a total of ten genera or species, within six years to a total of 18 genera or species and within eight years to a total of 24 genera or species.

24. The Committee was aware that the increase in the minimum numbers of genera and species could present difficulties for certain States, particularly States with a relatively small territory or States in which only a few crops were grown as a consequence of the economic or ecological conditions prevailing there. It was therefore decided to give the Council of UPOV the authority to reduce the minimum numbers of genera or species to which the Convention was applied within certain periods, or to extend those periods, at the request of any State at the time when it acceded to the Convention. Later on, when a State had already ratified or acceded to the Convention and had thereby undertaken to meet its obligations under Article 4(3), the Council should be authorized, according to the Committee's decision, to extend those periods of time--but not to reduce the minimum numbers of genera and species--whenever that State encountered special difficulties in its progressive application of the Convention.

25. The Committee finally had to consider the consequences which the above changes would have on Article 4(4) in relation to Article 3. At present, member States must ensure that the nationals and residents of the other member States enjoy, in so far as recognition and protection of breeders' rights are concerned, the same treatment as is accorded by their laws to their own nationals (Article 3 "national treatment principle"). This principle has to be applied without limitation as far as the genera and species included in the present Annex to the Convention are concerned. As to any other genus or species, member States are, however, entitled to limit the benefit of protection to nationals or residents of those other member States in which their own nationals enjoy protection for the same genus or species (Article 4(4) "reciprocity principle"). A question that has been raised is whether, in view of the deletion of the list in the Annex to the Convention, the Convention should require member States to grant national treatment, without limitation as to

the genus or species concerned, to nationals and residents of all the other member States, or whether, on the contrary, the possibility of limiting the benefit of national treatment to cases where reciprocity exists should be extended to all genera and species. The Committee expressed itself in favor of the second alternative, which would mean extending the reciprocity principle, particularly since it doubted whether the governments and parliaments of all the present member States would be prepared to agree to abandon the existing limitations of the national treatment principle.

26. The Committee furthermore decided to maintain the possibility provided in Article 4(4) of extending the benefit of protection to nationals of member States of the Paris Union for the Protection of Industrial Property and to residents of those States. The same decision was made in the case of paragraph (5) of Article 4.

Proposals

27. In view of the foregoing decisions, the following wording is proposed for Article 4:

"Article 4

"[Botanical Genera and Species Which Must or May Be Protected; Reciprocity; Possibility of Declaring that Articles 2 and 3 of the Paris Convention for the Protection of Industrial Property Are Applicable]"

"(1) This Convention may be applied to all botanical genera and species.

"(2) The member States of the Union undertake to adopt all measures necessary for the progressive application of the provisions of this Convention to the largest possible number of botanical genera and species.

"(3) (a) Each member State of the Union shall, on the entry into force of the Convention in its territory, apply the provisions of the Convention to at least five genera or species.

"(b) Each member State further undertakes to apply the said provisions to other genera or species, within the following periods from the date of the entry into force of the Convention in its territory:

"(i) within three years, to at least ten genera or species in all;

"(ii) within six years, to at least eighteen genera or species in all;

"(iii) within eight years, to at least twenty-four genera or species in all.

"(4) At the request of a State applying for accession to the Convention in accordance with Article 32, the Council may, in order to take account of special economic or ecological conditions prevailing in that State, decide, by the majority required and with the quorum provided in Article 32(3) for decisions on applications from non-member States, to reduce the minimum numbers of genera or species, set forth in paragraph (3), to which such State shall apply the Convention, or to extend the periods within which the Convention shall be applied to such minimum numbers of genera or species.

"(5) At the request of any member State, the Council may, in order to take account of special difficulties encountered by such State in the fulfilment of the obligations under paragraph (3), decide to extend the periods, set forth in paragraph (3), within which such State shall apply the Convention to the minimum numbers of genera or species.

"(6) Any member State of the Union protecting a genus or species shall be entitled to limit the benefit of such protection to the nationals of member States of the Union protecting the same genus or species and to natural and legal persons resident or having their headquarters in any of those States, or to extend the benefit of such protection to the nationals of other member States of the Union or of the member States of the Paris Union for the Protection of Industrial Property and to natural and legal persons resident or having their headquarters in any of those States.

0020

"(7) Any member State of the Union may, on signing this Convention or on depositing its instrument of ratification or accession, declare that, with regard to the protection of new varieties of plants, it will apply Articles 2 and 3 of the Paris Convention for the Protection of Industrial Property."

28. The extension of the possibility of limiting the benefit of national treatment makes it necessary to amend the second sentence of Article 33(1), which could then read as follows:

"(1) In addition it shall specify whether it intends to avail itself of the option of limitation available under paragraph (6) of that Article."

PART IV

SCOPE OF PROTECTION

Article 5

The Problem

29. Article 5 reads as follows:

"(1) The effect of the right granted to the breeder of a new plant variety or his successor in title is that his prior authorisation shall be required for the production, for purposes of commercial marketing, of the reproductive or vegetative propagating materials, as such, of the new variety, and for the offering for sale or marketing of such material. Vegetative propagating material shall be deemed to include whole plants. The breeder's right shall extend to ornamental plants or parts thereof normally marketed for purposes other than propagation when they are used commercially as propagating material in the production of ornamental plants or cut flowers.

"(2) The authorisation given by the breeder or his successor in title may be made subject to such conditions as he may specify.

"(3) Authorisation by the breeder or his successor in title shall not be required either for the utilisation of the new variety as an initial source of variation for the purpose of creating other new varieties or for the marketing of such varieties. Such authorisation shall be required, however, when the repeated use of the new variety is necessary for the commercial production of another variety.

"(4) Any member State of the Union may, either under its own law or by means of special agreements under Article 29, grant to breeders, in respect of certain botanical genera or species, a more extensive right than that set out in paragraph (1) of this Article, extending in particular to the marketed product. A member State of the Union which grants such a right may limit the benefit of it to the nationals of member States of the Union which grant an identical right and to natural and legal persons resident or having their headquarters in any of those States."

30. The Convention provides in Article 5(1) for a minimum scope of protection which all member States are required to grant to owners of breeders' rights. Each member State is, however, entitled under Article 5(4) to grant more extensive rights than those specified in Article 5(1).

31. In its previous sessions, the Committee discussed several proposals pertaining to the scope of protection. They are recapitulated below:

32. "Farmers' Privilege." Under Section 113 of the Plant Variety Protection Act of the United States of America, a person whose primary occupation is the growing of crops for purposes other than reproduction may sell seed which he has produced to other persons so engaged. The Committee took the view that it lay within the competence of each member State to interpret Article 5(1) and determine the scope of the protection it afforded, and that the interpretation of this provision had to be based on the authentic French text, as explained in the "Actes

des Conférences internationales pour la protection des obtentions végétales, 1957-1961, 1972."* It saw no objection to interpreting Article 5(1) as meaning that member States are not obliged to extend the scope of protection to sales of seed between farmers.

33. Protection of the Marketed Product. It had been proposed that the minimum scope of protection under Article 5(1) be extended to the marketed product--at least in respect of vegetatively reproduced ornamentals--and mainly to cut flowers. The reason given for this proposal was that, in a State which granted the minimum scope of protection, the owner of a protected variety could not prevent the import of cut flowers grown in a State which granted no protection and in which he could not obtain royalties for the multiplication of the variety. It had been reported that this was a problem that was becoming acute since it was generally very profitable to grow the final product--particularly cut flowers--of a great number of ornamental plants in countries where the climate and other conditions were favorable. The Committee considered, however, that any extension of the scope of protection might render the ratification of the revised text by the present member States and the accession of future member States more difficult, or even impossible, and should therefore be avoided. In this context, it was mentioned that the Plant Varieties Protection Bill submitted to the Belgian Parliament had provided for the possibility of extending protection for certain species to the final product but that the Belgian Parliament had eliminated that possibility.

34. Sale of Plantlets. For similar reasons, the Committee did not approve a proposal to make it clear in the Convention that the production and sale of plantlets produced from the seed of a protected variety fell within the scope of protection, which could have been achieved by introducing into the Convention a broad definition of the term "propagating material." The Committee felt that, should a national law be too narrow to be interpreted as meaning that plantlets of the above-mentioned kind were to be considered propagating material, it would be better to amend the national law than Article 5(1) of the Convention. Here, again, the Committee feared that an extension of Article 5(1) would jeopardize speedy ratification of the revised version of the Convention and accession by some non-member States. The Committee proposed, however, that the Diplomatic Conference adopt a recommendation inviting member States to ensure that the scope of protection comprises the sale of plantlets.

35. Commercial Multiplication. In earlier sessions a question that had been asked was whether it was permissible under the present wording of the Convention to buy small quantities of seed of a protected variety, multiply it, or have it multiplied under contract, and use the multiplied material, or have it used under contract, for growing crops for the production of plants to be processed and used for consumption. The breeder would in such cases receive royalties only for the initial small quantity of seed, while huge profits might be made by the multiplying firm. The Committee considered that an extension of the scope of protection to cover such cases should also be provided, if necessary, under the national law. In this context, it should be noted that, at the time of drafting the text of the provision, the words "à des fins d'écoulement commercial" ("for the purposes of commercial marketing") had been chosen in order to cover this and other similar cases¹.

PART V

CONDITIONS REQUIRED FOR PROTECTION

Article 6

The Problems

36. Article 6 reads as follows:

"(1) The breeder of a new variety or his successor in title shall benefit from the protection provided for in this Convention when the following conditions are satisfied:

"(a) Whatever may be the origin, artificial or natural, of the initial variation from which it has resulted, the new variety must be clearly distinguishable by one or more important characteristics from any other variety whose existence is a matter of common knowledge at the time when protection is

* See Annex I.

022

applied for. Common knowledge may be established by reference to various factors such as: cultivation or marketing already in progress, entry in an official register of varieties already made or in the course of being made, inclusion in a reference collection or a precise description in a publication.

"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.

"(b) The fact that a variety has been entered in trials, or has been submitted for registration or entered in an official register, shall not prejudice the breeder of such variety or his successor in title.

"At the time of the application for protection in a member State of the Union, the new variety must not have been offered for sale or marketed, with the agreement of the breeder or his successor in title, in the territory of that State, or for longer than four years in the territory of any other State.

"(c) The new variety must be sufficiently homogeneous, having regard to the particular features of its sexual reproduction or vegetative propagation.

"(d) The new variety must be stable in its essential characteristics, that is to say, it must remain true to its description after repeated reproduction or propagation or, where the breeder has defined a particular cycle of reproduction or multiplication, at the end of each cycle.

"(e) The new variety shall be given a denomination in accordance with the provisions of Article 13.

"(2) Provided that the breeder or his successor in title shall have complied with the formalities provided for by the national law of each country, including the payment of fees, the grant of protection in respect of a new variety may not be made subject to conditions other than those set forth above."

37. World Novelty Principle. After a thorough study of the practice in both member States and other States for the examination of distinctness of varieties, the Committee noted that standards were generally very similar and considered that it was not necessary to amend Article 6(1)(a). In particular, it did not adopt the proposal of one delegation to amend the provision by stating that the new variety must be distinct from any other variety whose existence was a matter of common knowledge "in the State where the application concerning the new variety was filed."

38. Expression "Important Characteristics". After having carefully studied a number of proposals in this connection and after having agreed that the definition given in the General Introduction to the Guidelines (UPOV/TG/1/1) was sufficient to clarify its meaning, the Committee decided that there was no need to amend the expression "important characteristics" contained in Article 6(1)(a).

39. Sale of Propagating Material for Purposes of Experimentation. The Committee examined the question whether experimentation with a view to assessing the characteristics of a variety (for example, milling, baking, canning and processing properties in general) which coincidentally involved the release of propagating material would prejudice the novelty of the variety. It took the view that such release was not commercial in nature and therefore not prejudicial to novelty as long as the material was not sold as a variety or under the variety denomination and as long as sales were not intended to assess the commercial attractiveness to the customer. It saw no need to clarify Article 6 on this point.

40. Period of Grace. In the United States of America, breeders are granted a period of one year expiring on the filing date of the application (the so-called "period of grace") during which they may sell the variety, without prejudice to

its novelty*. The Committee considered that, in the United States of America and other States, the period of grace was a well-established tradition which could hardly be abandoned. It took the view that the Convention should be amended to allow newly acceding States to maintain such a period in their national laws. While the majority of the experts favored a solution according to which this privilege was restricted to States which, when ratifying the Convention or when acceding to it, already provided for a period of grace, one delegation was of the opinion that other member States should also be given the possibility of introducing such a period at any time if they wished to do so. Two proposals for amendment are made in paragraph 42 of this document.

41. Commercialization in States Other than the State in which the Application is Filed. The Committee examined whether the four-year period referred to in Article 6(1)(b) should be extended--to six years, according to one proposal; to eight years, according to another proposal--in the case of slow-growing species such as trees and vine. After one delegation had observed that such an extension was insufficient in any case, the Committee agreed that the problem should be presented to the international professional organizations, and said that it would be ready to examine any realistic proposal.

* Section 102 of the Patent Act (applicable to asexually reproduced plants) reads as follows:

"Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless -

.....

"(b) the invention was patented or described in a printed publication in this or a foreign country or in a public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or"

Section 42 of the Plant Variety Protection Act (applicable to sexually reproduced plants) reads as follows:

"Right to Plant Variety Protection; Plant Varieties Protectable.

(a) The breeder of any novel variety of sexually reproduced plant (other than fungi, bacteria, or first generation hybrids) who has so reproduced the variety, or his successor in interest, shall be entitled to plant variety protection therefor, subject to the conditions and requirements of this title unless one of the following bars exists:

(1) Before the date of determination thereof by the breeder or more than one year before the effective filing date of the application therefor, the variety was (A) a public variety in this country or (B) effectively available to workers in this country and adequately described by a publication reasonably deemed a part of the public technical knowledge in this country which description must include a disclosure of the principal characteristics by which the variety is distinguished.

(2) An application for protection of the variety based on the same breeder's acts, was filed in a foreign country by the owner or his privies more than one year before the effective filing date of the application filed in the United States.

(3) Another is entitled to an earlier date of determination for the same variety and such other (A) has a certificate of plant variety protection hereunder or (B) has been engaged in a continuing program of development and testing to commercialization or, (C) has within six months after such earlier date of determination adequately described the variety by a publication reasonably deemed a part of the public technical knowledge in this country which description must include a disclosure of the principal characteristics by which the variety is distinguished.

(b) The Secretary may, by regulation, extend for a reasonable period of time the one year time period provided in subsection (a) for filing applications, and may in that event provide for at least commensurate reduction of the term of protection."

Proposals

42. Period of Grace. The following provision is proposed should it be decided that the Convention will allow newly acceding States to maintain a period of grace in their national laws:

"Article 35a
"[Period of Grace]

"Notwithstanding the provisions of Article 6, any member State of the Union under whose law, at the time of depositing its instrument of ratification of or accession to this Convention, the breeder is allowed a period during which the variety may be offered for sale or marketed in the territory of that State without prejudicing the right of the breeder or his successor in title to apply for protection for the said variety in that State may, without thereby creating an obligation for other member States of the Union, continue to allow such period, provided that its duration shall not exceed one year."

43. The following amendment to the second subparagraph of Article 6(1)(b) is proposed should it be decided that all member States will have the possibility of granting a period of grace at any time:

"At the time of the application for protection in a member State of the Union, the new variety must not--or, where the law of that State so provides, must not for longer than one year--have been offered for sale or marketed with the agreement of the breeder or his successor in title, in the territory of that State, or for longer than four years in the territory of any other State."

44. Commercialization in States other than the States in which the Application is Filed. If the Committee takes the view that the four-year period should be extended as described in paragraph 41 above, the following wording of the second subparagraph of Article 6(1)(b) is proposed for consideration:

"At the time of the application for protection in a member State of the Union, the new variety must not have been offered for sale or marketed, with the agreement of the breeder or his successor in title, in the territory of that State, or in the territory of any other State for longer than [six] years in the case of plants such as vines, fruit trees and their rootstocks, forest trees and ornamental trees, or for longer than four years in the case of all other plants."

PART VI

EXAMINATION OF NEW VARIETIES

Article 7(1) and (2)

45. Article 7(1) and (2) reads as follows:

"(1) Protection shall be granted only after examination of the new plant variety in the light of the criteria defined in Article 6. Such examination shall be adapted to each botanical genus or species having regard to its normal manner of reproduction or multiplication.

"(2) For the purposes of such examination, the competent authorities of each country may require the breeder or his successor in title to furnish all the necessary information, documents, propagating material or seeds."

46. The Committee studied the question of the conditions under which the examination for distinctness, homogeneity and stability could be performed by other than official authorities. It adopted a statement concerning the minimum requirements which such examination should fulfill. The statement, which has already been noted with approval by the Council at its tenth ordinary session, is reproduced in Annex II to this document.

47. In this context, the Committee also took the view that a system of deferred examination was fully compatible with the present wording of the Convention.

PART VII

PERIOD OF PROTECTION

Article 8(1) and (2)

48. Article 8(1) and (2) reads as follows:

"(1) The right conferred on the breeder of a new plant variety or his successor in title shall be granted for a limited period. This period may not be less than fifteen years. For plants such as vines, fruit trees and their rootstocks, forest trees and ornamental trees, the minimum period shall be eighteen years.

"(2) The period of protection in a member State of the Union shall run from the date of the issue of the title of protection."

49. In the United States of America, the present periods of protection under patent law and under the Plant Variety Protection Act are 17 years counted from the date of the grant of the title of protection. The possibility is envisaged, however, of amending the patent law and providing for a term of 20 years computed from the date of filing. Taking into account the duration of the examination, the effective period of protection counted from the date of the grant of the patent would in practically all cases be longer than the 18 years required in the Convention for certain species such as vines and trees (Article 8(1)). The Delegates of the United States of America noted at the third session of the Committee that their country's Plant Variety Protection Act would not meet the requirements of Article 8(1) as far as sexually reproduced trees were concerned.

50. The Committee concluded from the authentic French text of Article 8(2) ("La durée de la protection ... s'entend à partir de ...") that the provision could be interpreted as not prohibiting the computation of the period of protection from the date of the filing of the application, provided that the effective duration of the protection, as computed from the date of the grant of the title of protection, complied with the minimum periods provided for in paragraph (1) of Article 8.

PART VIII

NULLITY AND FORFEITURE OF THE RIGHTS PROTECTED

Article 10

51. Article 10 reads as follows:

"(1) The right of the breeder shall be declared null and void, in accordance with the provisions of the national law of each member State of the Union, if it is established that the conditions laid down in subparagraphs (a) and (b) of paragraph (1) of Article 6 were not effectively complied with at the time when the title of protection was issued.

"(2) The breeder or his successor in title shall forfeit his right when he is no longer in a position to provide the competent authority with reproductive or propagating material capable of producing the new variety with its morphological and physiological characteristics as defined when the right was granted.

0026

"(3) The right of the breeder or his successor in title may become forfeit if:

"(a) after being requested to do so and within a prescribed period, he does not provide the competent authority with the reproductive or propagating material, the documents and the information deemed necessary for checking the new variety, or he does not allow inspection of the measures which have been taken for the maintenance of the variety; or

"(b) he has failed to pay within the prescribed period such fees as may be payable to keep his rights in force.

"(4) The right of the breeder may not be annulled and the right of the breeder or his successor in title may not become forfeit except on the grounds set out in this Article."

52. Several proposals for adding further grounds for nullity and forfeiture of the rights protected have been considered by the Committee.

53. Application in a Foreign State. Under Section 184 of the Patent Act of the United States of America, a person may not, without authorization by the Commissioner of Patents and Trademarks, file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States of America an application for a patent in respect of an invention [or of a new variety] made [bred] in that country. Under Section 185, a patent issued to a person having infringed that obligation is invalid. This rule, which has no counterpart in the Plant Variety Protection Act, is designed as a safeguard to national security. Since national security is unlikely to be endangered by the filing of an application for plant variety protection, the Committee has agreed to discuss with the representatives of the United States of America whether the Commissioner of Patents and Trademarks was in a position to issue a general authorization permitting breeders to file a first application for plant variety protection abroad. As was pointed out, it was most unlikely that a breeder in the United States would file an application for a US-bred variety abroad before applying for protection at home. The problem raised by the United States Delegation was therefore only of theoretical importance.

54. Cases of Fraud and Business Restriction. The authorities of the United States of America had further indicated that the courts of that country were entitled to annul patent rights when those rights were obtained by fraud or used to suppress competition unduly. Though there was no jurisprudence in this matter, there was little doubt that the courts would claim the same power in cases of rights granted under the Plant Variety Protection Act. Neither case seems to require an amendment of Article 10. In the case of a right obtained by fraud it is not the "right of the breeder" which is annulled. Cases in which the anti-trust legislation is involved can, in the Committee's view, be settled under Article 9.

55. Non-Compliance with the Conditions of a Compulsory License or of Provisional Protection. The delegation of one member State proposed that non-compliance with the conditions of a compulsory license or of provisional protection be added as grounds for annulment or forfeiture of plant breeders' rights. It was observed, however, that penalizing a breeder who refused to comply with the conditions of a compulsory license--that is to say, in most cases, refusal to deliver seed or vegetative propagating material to the licensee--by depriving him of his right would most probably not achieve its aim.

56. Fraudulent Sales of Propagating Material. The question whether it should be a ground for annulment or forfeiture under Article 10(3) if a breeder, or another person with his consent, intentionally sells propagating material which he fraudulently implies is the variety for which he was granted a right was already discussed with the observer delegations during the Committee's third session (see document IRC/III/14, paragraphs 61 to 63). On that occasion, objections were raised to making such an amendment. It was felt that other means were available to repress such activities and that the sanction of annulment was not needed. It was finally agreed to rediscuss the matter in later sessions.

57. General Admission of New Grounds for Annulment or Forfeiture. In view of the number of grounds for annulment or forfeiture proposed for inclusion in Article 10, it was suggested that Article 10(4) be deleted and member States be generally permitted to introduce into their laws grounds not mentioned in the Convention for annulment or forfeiture. The Committee felt unable to agree to such a suggestion since it was considered a step backwards which would deprive breeders of a basic guarantee which they presently enjoyed.

Proposal

58. In view of the outcome of the above discussions, a drafting proposal is put forward by the Office of the Union only for the case referred to in paragraph 56. The proposal could be implemented by inserting the following additional subparagraph (b) in Article 10(3) (the present subparagraph (b) becoming subparagraph (c)):

"(3) The right of the breeder or his successor in title may become forfeit if:

.....

"(b) he, or a third person with his consent, intentionally [and repeatedly] offers for sale or markets [considerable amounts of] reproductive or vegetative propagating material, purporting to be of the new variety, which is not capable of producing the new variety with its morphological and physiological characteristics as defined when the right was granted;"

PART IX

VALIDITY OF PRIORITY CLAIM

Article 12(1) and (3)

The Problem

59. Article 12(1) and (3) reads as follows:

"(1) Any breeder or his successor in title who has duly filed an application for protection of a new variety in one of the member States of the Union shall, for the purposes of filing in the other member States of the Union, enjoy a right of priority for a period of twelve months. This period shall run from the date of filing of the first application. The day of filing shall not be included in such period.

.....

"(3) The breeder or his successor in title shall be allowed a period of four years after the expiration of the period of priority in which to furnish, to the member State of the Union with which he has filed an application for protection in accordance with the terms of paragraph (2), the additional documents and material required by the laws and regulations of that State."

60. The one-year period under Article 12(1) and the four-year period under Article 12(3) might be misused by a breeder at the expense of his competitors working in the same field. A breeder could file his first application in a member State at a time when the variety was not sufficiently homogeneous and subsequently file applications in other member States claiming the priority of the first application. When submitting the required material in the States of the subsequent filing--for which the Convention grants him a period which can be of up to 5 years counted from the date of the first filing--the breeder can submit samples of the variety after having improved its homogeneity in the meantime. By claiming the priority of his first application he can obtain an unjustified advantage over breeders who have bred the same variety but have waited until the variety was sufficiently homogeneous to fulfill the requirements of the Convention before filing an application. Under the present wording of the Convention, the fact that the first application of the breeder who is acting unfairly will probably be rejected, if not withdrawn voluntarily, does not have any effect on the validity of the subsequent filings in other member States. On the contrary, it will even be difficult, it not impossible, to prove that the priority claim was unjustified since, in view of the rejection or withdrawal of the first application, the authority with which it was filed will have discarded the material submitted to it at the time of the first filing.

0028

61. The Committee considered that it would be impossible and unwise to change the present rule stating that the invalidity of the first application has no influence on the subsequent applications for which the priority of the first application was claimed. However, it realized that the Offices with which the subsequent applications were filed should be in a position to check whether the material submitted to them corresponded to the material submitted to the Office of the first filing also in cases where the first applications had been rejected or withdrawn. It was therefore agreed that the Convention should authorize the Offices of member States to request that a sample of the propagating material be immediately furnished to them when a breeder had claimed the priority of an application in another member State and that application had been rejected or withdrawn. The Committee underlined, however, that such a rule should not normally shorten the periods provided for under Article 12(1) and (3). The Offices of the subsequent filing should not be entitled to begin the examination against the wish of the breeder before the expiration of those two periods, which could be as long as five years.

Proposal

62. The following sentence, to be added to Article 12(3), is proposed for consideration:

"...Nevertheless, that State may require the additional documents and material to be furnished, within a period specified by that State, in cases where the application whose priority is claimed has been rejected or withdrawn."

PART X

VARIETY DENOMINATION

Article 13

The Problems

63. Article 13 reads as follows:

"(1) A new variety shall be given a denomination.

"(2) Such denomination must enable the new variety to be identified; in particular, it may not consist solely of figures.

The denomination must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the new variety or the identity of the breeder. In particular, it must be different from every denomination which designates, in any member State of the Union, existing varieties of the same or a closely related botanical species.

"(3) The breeder or his successor in title may not submit as the denomination of a new variety either a designation in respect of which he enjoys protection, in a member State of the Union, accorded to trade marks, and which applies to products which are identical or similar within the meaning of trade mark law, or a designation liable to cause confusion with such a mark, unless he undertakes to renounce his right to the mark as from the registration of the denomination of the new variety.

If the breeder or his successor in title nevertheless submits such a denomination, he may not, as from the time when it is registered, continue to assert his right to the trade mark in respect of the above-mentioned products.

"(4) The denomination of the new variety shall be submitted by the breeder or his successor in title to the authority referred to in Article 30. If it is found that such denomination does not satisfy the requirements of the preceding paragraphs, the authority shall refuse to register it and shall

require the breeder or his successor in title to propose another denomination within a prescribed period. The denomination shall be registered at the same time as the title of protection is issued in accordance with the provisions of Article 7.

"(5) A new variety must be submitted in member States of the Union under the same denomination. The competent authority for the issue of the title of protection in each member State of the Union shall register the denomination so submitted, unless it considers that denomination unsuitable in that State. In this case, it may require the breeder or his successor in title to submit a translation of the original denomination or another suitable denomination.

"(6) When the denomination of a new variety is submitted to the competent authority of a member State of the Union, the latter shall communicate it to the Office of the Union referred to in Article 15, which shall notify it to the competent authorities of the other member States of the Union. Any member State of the Union may address its objections, if any, through the said Office, to the State which communicated the denomination.

The competent authority of each member State of the Union shall notify each registration of the denomination of a new variety and each refusal of registration to the Office of the Union, which shall inform the competent authorities of the other member States of the Union. Registrations shall also be communicated by the Office to the member States of the Paris Union for the Protection of Industrial Property.

"(7) Any person in a member State of the Union who offers for sale or markets reproductive or vegetative propagating material of a new variety shall be obliged to use the denomination of that new variety, even after the expiration of the protection of that variety, in so far as, in accordance with the provisions of paragraph (10), prior rights do not prevent such use.

"(8) From the date of issue of a title of protection to a breeder or his successor in title in a member State of the Union:

"(a) the denomination of the new variety may not be used, in any member State of the Union, as the denomination of another variety of the same or closely related botanical species;

"(b) the denomination of the new variety shall be regarded as the generic name for that variety. Consequently, subject to the provisions of paragraph (10), no person may, in any member State of the Union, apply for the registration of, or obtain protection as a trade mark for, a denomination, in respect of identical or similar products within the meaning of trade mark law."

"(9) It shall be permitted, in respect of the same product, to add a trade mark to the denomination of the new variety.

"(10) Prior rights of third parties in respect of signs used to distinguish their products or enterprises shall not be affected. If, by reason of a prior right, the use of the denomination of a new variety is forbidden to a person who, in accordance with the provisions of paragraph (7), is obliged to use it, the competent authority shall, if need be, require the breeder or his successor in title to submit another denomination for the new variety."

64. During the Meeting of Member and Non-Member States in October 1974 and in earlier sessions of the Committee, as well as on other occasions, a number of proposals were made for amending Article 13. These proposals are listed below.

(i) Canada proposed in the Meeting of Member and Non-Member States that the present constraints with respect to denominations should be abandoned and that combinations of words or series of letters with numbers should be permitted.

(ii) The United States of America proposed that the selection and approval of variety denominations, and the details of their policies should be left to the national laws of Member States and, on the other hand, that the role of UPOV in informing States of the appropriation of variety denominations in order to ensure that variety denominations are generic in nature, and cannot be appropriated as trademarks, should be maintained and possibly enhanced.

(iii) CIOPORA proposed that the word "denomination" should be replaced by "designation" where it appeared in the Convention. This was said to be more consistent with the role and the function assigned by the Convention to the name of the variety.

(iv) CIOPORA also proposed that the final part of the first subparagraph of Article 13(3) beginning with the words "unless he undertakes to renounce" and the second subparagraph be deleted.

65. The proposals made by Canada and by the United States of America in the Meeting of Member and Non-Member States seem to indicate that both States advocate the complete deletion of the provisions of Article 13 except for those rules which ensure that member States are better informed on variety denominations already registered or filed in other member States. During the mission of the UPOV Delegation to the United States of America and Canada in 1975, and in the course of later discussions, the impression was gained, however, that neither State had the intention of proposing any amendment to Article 13 itself, but that both were solely referring to the Guidelines on Variety Denominations. As far as measures of mutual information on existing variety denominations and variety denominations filed for registration are concerned, it has to be noted that the system envisaged under the Convention has for the time being been replaced by the Provisions 1 Rules of Procedure on the Exchange of Variety Denominations (document UPOV/C/V/33).

66. Recently, the United States of America has proposed the deletion of the requirement in the first subparagraph of Article 13(2) that the variety denomination must consist solely of figures. This question needs further discussion.

67. After having examined the history of the word "denomination," as restated in the "Actes des Conférences internationales pour la protection des obtentions végétales 1957 - 1961, 1971," the Committee considered that the proposal of CIOPORA to replace the term "denomination" by "designation" should not be adopted. The "Records" show that:

(i) in the first drafts of the Convention, the term "name" was used (see pages 37, 39, 42, 45, 53 and 63 of the Records);

(ii) the term "designation" was then proposed by the Representatives of the Federal Republic of Germany (page 74 of the Records) and by CIOPORA (page 94 of the Records);

(iii) the Ad Hoc Committee for the drafting of Article 14 proposed the term "denomination" (page 123 of the Records), which was adopted in the final version of the Convention.

[Annexes follow]

THE SCOPE OF PROTECTION

(Extracts from the Actes des Conférences)*

1. In the first draft of the Convention, the scope of protection was defined as follows (see "Actes des Conférences," page 41):

"Article 3

(1) The effect of the right granted to the breeder of a new plant variety is that his prior authorization shall be required for the production for commercial purposes, the offering for sale and the marketing of the reproductive or vegetative propagating material, as such, of that new variety."

2. In the third meeting of a Committee of Experts, the following comments were made (see "Actes des Conférences," page 44):

"The expression 'à des fins commerciales' ['for commercial purposes'] does not seem sufficiently clear to certain experts: A pea-canner purchasing seed and multiplying it with a view to releasing the seed so produced to farmers whose crops he buys back should be obliged to pay royalties. To cover this particular case, and other similar cases, the experts would prefer using the phrase 'à des fins d'écoulement commercial' [translated as: 'for the purposes of commercial marketing'].

"The words 'mise en vente' ['offering for sale'] are also debatable. Taken literally, they would mean that the farmer who releases some seeds to his neighbor should pay a royalty. In fact, the problem will not arise in practice. What the experts intend to cover are the transactions for a consideration (or involving an exchange) in all cases where they do not constitute an exceptional service and whatever the legal status of the natural or legal person undertaking them.

"The Committee of Experts finally agrees upon the following wording for paragraph (1):

'The effect of the right granted to the breeder of a new plant variety is that his prior authorization shall be required for the production, for purposes of commercial marketing, of vegetative propagating material, as such, of the new variety, and for the offering for sale and marketing of such material'."

3. In the final version of that paragraph, which became paragraph (1) of Article 5, the words "or his successor in title" have been included after "breeder of a new plant variety" and "nouveau végétale" has been replaced by "variété nouvelle" (both translated into English as "new plant variety").

[Annex II follows]

* Actes des Conférences internationaux pour la Protection des Obtentions Végétales 1957 - 1961, 1972; UPOV Publication No. 316, 1974; published in French only.

0032

STATEMENT CONCERNING ARTICLE 7 FORMULATED BY THE
COMMITTEE OF EXPERTS ON THE INTERPRETATION AND REVISION
OF THE CONVENTION

(1) It is clear that it is the responsibility of the member States to ensure that the examination required by Article 7(1) of the UPOV Convention 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 is 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 given;

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

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

(2) A system of examination as described above is considered compatible with the UPOV Convention.

[End of Annex II and of document]