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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

COMMITTEE OF EXPERTS ON
THE INTERPRETATION AND REVISION OF THE CONVENTION

Sixth Session

Geneva, September 20 to 23, 1977

PROPOSALS CONCERNING ARTICLES 1 TO 14, 34A, 35, 36 AND 36A

Memorandum prepared by the Office of the Union

INTRODUCTION

1. This document contains the present text of the so-called substantive articles of the Convention (Articles 1 to 14, 35 and 36), the drafts of the revised texts of the same articles and of two new articles (34A and 36A) and a draft commentary on the draft articles. The draft commentary is drafted in the style proposed to be used in the document which would be presented to the Diplomatic Conference. In a few instances, the draft texts are also accompanied by observations which are directed to the Committee of Experts; whether and if so to what extent such observations could become part of the commentary directed to the Diplomatic Conference depends on the reaction of the Committee of Experts to the said observations.
2. Copies of the provisions of the United States laws referred to in this document may be obtained from the Office of the Union on request. They are generally available only in English.
3. The drafts of the revisions are generally based on the tentative decisions arrived at by the Committee of Experts in its last sessions. In a few cases, a departure from such decisions was made; attention to such cases is drawn at the appropriate places in this document. In some cases, no tentative decisions were made by the Committee of Experts although decisions seem to be necessary; this document tries to cover also these cases since the aim is to draw attention to all questions which will require solution by the Diplomatic Conference.
4. The draft proposals concerning the revision of the Articles of the Convention not covered in this document as well as other points to be submitted to the Diplomatic Conference, in particular the draft Rules of Procedure of that Conference, will be treated in additional documents expected to be issued in August 1977.

Comments on Article 4

Ad paragraph (1): No amendment is proposed in this paragraph.

Ad paragraph (2): No amendment is proposed in this paragraph.

Ad paragraph (3): In the present text, this paragraph obliges member States to apply the Convention progressively to thirteen genera and species listed in the Annex to the Convention. It is proposed to delete this Annex as well as the reference to it in the paragraph under consideration for the following reasons: the list of genera and species in the Annex was fixed mainly with regard to the situation prevailing in countries of the temperate climatic zone; it would be unreasonable to require that countries belonging to other climatic zones apply the Convention to the same genera or species (i.e., those listed); in order to allow all States to join the Union, it would therefore be necessary either to amend the said list or to delete it; as it would be hardly possible to agree on a list suitable for all countries, the only practical solution is to abandon it completely.

Once the list is deleted, each member State will have the free choice of the genera and species which it will make eligible for protection in order to fulfil its obligation under the Convention. Such relative facility justifies an increase in the minimum numbers of genera or species to which member States have to apply the Convention within certain periods. The proposed amendment would increase the minimum number (to be obtained within eight years) from 13 to 24.

Ad paragraph (4) (new): Certain States, particularly States having a relatively small territory or States with relatively unfavorable economic or ecological conditions, wishing to join the Union, might not be able to fulfil the obligations provided for in paragraph (3). It is therefore proposed that the Council be authorized to reduce, for the purposes of such States, the said minimum numbers of genera or species to be protected or to extend the periods within which such States would have to apply the Convention to them. The majority which is necessary for a Council decision of this kind is prescribed in Article 22. The wording of the proposed new paragraph in question is similar to that of Article 26(5) as contained in Article II of the Additional Act.

Ad paragraph (5) (new): This new paragraph has been introduced for the purposes of States, which, after having ratified or acceded to the Convention, find unexpected difficulties to comply with the obligation provided for in paragraph (3) within the prescribed periods. This can, for instance, happen when in a given State the parliamentary approval for the extension of the list of genera and species eligible for protection cannot be obtained in time. The present paragraph would authorize the Council to extend, in such case, the periods set forth in paragraph (3).

Ad paragraph (6) (new): This paragraph, as proposed, is similar to the first part of paragraph (4) of the present text, except that it refers to any genus or species rather than to genera or species "not included in the list." This difference is a consequence of the proposed suppression (see paragraph (3)) of the list of genera and species appearing in the Annex of the present text.

The proposed text would omit the provisions contained, in the present text, in the second part of paragraph (4) and in paragraph (5).

The second part of paragraph (4) in the present text is omitted since, as far as nationals, etc., of other member States of UPOV are concerned, the national treatment applies (unless the retaliation referred to above is applicable and is applied) automatically, that is, does not require an extension (as provided in the present text), and, as far as nationals, etc., of member States of the Paris Union (not members of UPOV) are concerned, there is nothing in the UPOV Convention which would prevent a member State of UPOV to protect them or, for that matter, the nationals of any State. In other words, the provision seems to be superfluous.

[Present Text]

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) 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 to 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.

[New Text]

Article 4

Botanical Genera and Species Which Must
or May Be Protected; Reciprocity

- (1) [No change]
- (2) [No change]
- (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) Subsequently, each member State shall apply the said provisions to additional 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 eight genera or species in all;
 - (iii) within eight years, to at least two four genera or species in all.
- (4) At the request of any State intending to ratify or accede to this Convention, the Council may, in order to take account of special economic or ecological conditions prevailing in that State, decide, for the purposes of that State, to reduce the minimum numbers referred to in paragraph (3), or to extend the periods referred to in that paragraph, or to do both. The instrument of ratification or accession shall refer to the decision of the Council.
- (5) At the request of any member State, the Council may, in order to take account of difficulties encountered by such State in fulfilment of the obligations under paragraph (4), decide, for the purposes of that State, to extend the periods referred to in paragraph (4).
- (6) Any member State of the Union providing for the protection of a genus or species shall be entitled to limit the benefit of such protection to the nationals of those member States of the Union which provide for protection of the same genus or species and to natural and legal persons resident or having their headquarters in such States.

0022

[Comments on Article 4, continued]

Paragraph (5) of the present text is omitted because, in some situations, it may create uncertainty and, in others, it seems to be superfluous. The paragraph could be understood as meaning that a member State of UPOV which is not a member State of the Paris Union could apply Articles 2 and 3 of the Paris Convention; it could furthermore be understood as meaning that Articles 2 and 3 of the Paris Convention supersede the UPOV Convention; both understandings, however, seem to be contrary to the intentions of the drafters of the original UPOV Convention. Finally, the paragraph would seem to be superfluous since, if a country is a member of both UPOV and the Paris Union, it can--as a matter of fact, it must--apply Articles 2 and 3 of the Paris Convention and it can and must do so without having to make the declaration referred to in that paragraph.

[Article 4, continued]

[Present Text]

(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.

[New Text]

[There would be no provision in the new text corresponding to paragraph (5) in the present text.]

0024

Comments on Article 5

Ad paragraph (1): It is proposed to omit the words "new plant" and the word "new," when they appear before the word "variety." For explanations, see the Observation under Article 1(1).

It is proposed to add the words "reproductive and" in the second sentence so that that sentence would read "Reproductive and vegetative propagating material shall be deemed to include whole plants." Without the new words, there might be some doubt whether the sale of plantlets falls under the scope of protection provided for in paragraph (1). Glasshouse growers buy more and more plantlets already rooted in peat pots from specialized enterprises. Such enterprises could produce such plantlets in great quantity with the help of buying only a small quantity of necessary seed. The question whether such a way of proceeding is admissible without the authorization of the breeder depends on what is understood by the term "vegetative" propagating material. The present text says that "vegetative" propagating material includes whole plants. One could argue that, a contrario, generatively produced whole plants, for instance plantlets grown from seeds, are not to be deemed to be propagating material. Such interpretation was not intended by the drafters of the original Convention. Its danger would be eliminated by an express statement that the propagating material in question may be not only vegetative but also reproductive.

OBSERVATIONS

It has been proposed, especially by breeders of ornamental plants, to make it obligatory for member States to protect, as far as ornamental plants were concerned, the marketed--the final--product; this would mean, in particular, extending the scope of protection to cut flowers. It has been pointed out that as long as a national law does not go beyond the minimum scope of protection provided for in Article 5(1) in its present text, breeders cannot prevent that third persons multiply propagating material in a non-member State where no protection exists, produce cut flowers there, and import such flowers in great quantities into member States. In such a case, the breeder would receive royalties only for the small amount of material used as initial propagating material by the third person. In accordance with the outcome of the preparatory discussions it is, however, not proposed to extend the mandatory minimum scope of protection to the marketed product, because it is probable that in some member States--and some prospective future member States--the group of users of protected varieties would so strongly oppose any such an extension of the minimum protection that the acceptance of the revised text could be put in serious jeopardy. Under these conditions, it seems preferable, at least at the present time, to leave any extension of the protection to the marketed product to the discretion of the national laws. Such discretion would have the advantage that any member State could decide for which genera and species such extension was desirable.

The same approach is proposed, for the same reasons, as far as two less far-reaching proposals are concerned, namely (i) to state in paragraph (1) that the minimum scope of protection is to cover any commercial multiplication of a protected variety (i.e., also such multiplication which is performed for other purposes than the commercial marketing of the propagating material as such) and (ii) to extend, for ornamental plants, the minimum scope of protection to the cultivation of plants of the protected variety (i.e., also to the commercial use of ornamental plants of a protected variety for the production of cut flowers) in any case and not only in the case mentioned in the last sentence of paragraph (1). Both proposals refer to very special situations which best are dealt with, if necessary in a coordinated way, by the national legislators of member States. As to the first case, it should be mentioned that it was a subject of the discussion already in the course of the elaboration of the Convention before 1961 (Acts of the International Conferences for the Protection of New Plant Varieties 1957 to 1961, 1972, UPOV Publication No. 316, page 44).

No amendment is furthermore held to be necessary in order to enable the United States of America, should this State want to become a member of UPOV, to maintain the so-called "farmers' privilege" in its national legislation. The United States of America exempt from the scope of protection, though under certain rather limited conditions, sales by farmers of seed, produced by them on their own premises, to other farmers. In accordance with the outcome of the preparatory discussions it can be stated that such exceptional activity--performed within the narrow restrictions as they are imposed in the United States--can be considered as not falling

[Present Text]

Article 5

[Rights Protected; Scope of Protection]

(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 material, 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 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.

[New Text]

Article 5

Rights Protected; Scope of Protection

(1) The effect of the right granted to the breeder of a 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 material, as such, of the variety, and for the offering for sale or marketing of such material. Reproductive and 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) [No change]

(3) [No change, except omit the word "new," in all cases in which it appears.]

(4) [No change]

[Comments on Article 5, continued]

under the term "commercial marketing" and thus not infringing the rights of the breeder. It is furthermore noted that the drafters themselves of the original Convention thought it not to be necessary to adopt a clear prohibition of this type of sales in view of the fact that no real problem existed and that it was not intended to cover by plant breeders rights transactions of seed which only constituted an exceptional service (see Acts of International Conferences for the Protection of New Plant Varieties 1957 to 1961, 1972, UPOV Publication No. 316, page 44).

Ad paragraph (2): No amendment is proposed **to** this paragraph.

Ad paragraph (3): The only amendment proposed is to omit the word "new" (three times). For explanations, see the Observation under Article 1(1).

Ad paragraph (4): No amendment is proposed to this paragraph.

Comments on Article 6

Ad paragraph (1), introductory lines: It is proposed to omit the word "new."
For explanations, see the Observation under Article 1(1).

Ad paragraph (1)(a): In the first sentence, it is proposed to replace the words "the new" by "any" and, in the third sentence, to omit the word "new." For explanations, see the Observation under Article 1(1).

OBSERVATION

No amendments are proposed as to the standard for judging distinctness and as to the word "important" in the expression "important characteristics." In the preparatory discussions, no practical differences were seen in the standard applied for judging distinctness in the member States of UPOV according to this subparagraph and in the non-member States mainly interested in an accession to the Convention, in particular the United States of America. Also, it was generally found that the definition given in the General Introduction to the Guidelines for the Examination of Distinctness, Homogeneity and Stability of New Varieties of Plants (document TG/1/1) was sufficient to clarify the meaning of the expression "important characteristics."

Ad paragraph (1)(b): In at least one non-member State of UPOV, the United States of America, breeders are granted a period of one year, expiring on the date of the filing of the application for protection in that country, in which they can use and sell the variety without thereby causing prejudice to their right to obtain protection. Other non-member States plan to follow this example. The period of one year, called "period of grace," is insofar favorable to breeders as it allows them a certain time in which to test the economic value of the variety and its suitability for being protected in the country in question before taking a decision whether it is worth applying for protection there. The period of grace being a well-established tradition of most patent laws, some non-member States would encounter unsurmountable difficulties to accede to the Convention if the Convention would not permit them to maintain--or to introduce--such period. It is therefore proposed to amend the wording of subparagraph (b) so that it allows member States to grant a period of grace for up to one year.

In addition, it is proposed that the period of four years expiring at the filing date of the application, during which the variety may have been offered for sale or marketed in a State other than the State in which the application is filed, be extended to a period of six years in the case of certain groups of plants which are usually slow-growing and for which Article 8 of the present text already envisages a longer minimum period of protection.

The order of the two sentences has been changed so that the basic rule appears first and the rule of interpretation is stated afterwards.

OBSERVATIONS

No proposals for amendments are made to cover the case that propagating material is released for purposes of experimentation. The preparatory discussions have led to the conclusion that the release of propagating material solely for purposes of experimentation is to a sufficient extent permissible under the Convention and is practiced, to a smaller or larger degree, in all present member States. It has been confirmed that it was up to each member State to define in which cases the turning over, for experimental use, of propagating material of a variety to another person was to be considered as "offer for sale or marketing of the variety," and thus prejudicial to the novelty of the variety under paragraph (1)(b), and in which cases such action was not prejudicial. In addition, there were, during the preparatory discussions, concordant or nearly concordant views held among member and most non-member States on any practical example which had been considered in this respect. The discussions had eventually also shown that it was hardly possible to agree on an amended version of the text which would give a clear answer for all possible situations that could arise in connection with experimental use. It therefore seems to be neither necessary nor even advisable to try to work out a special rule for the use of propagating material for purposes of experimentation and its effect on novelty.

[Present Text]

Article 6

[Conditions Required for Protection]

(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 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 another 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.

[New Text]

Article 6

Conditions Required for Protection

(1) The breeder of a 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, any 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 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 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) At the time of the application for protection in a member State of the Union, the 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 in the territory of any other State for longer than six years in the case of vines, fruit trees and their rootstocks, forest trees and ornamental trees and similar plants, or for longer than four years in the case of all other plants. 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.

(c) [No change, except omit the word "new."]

(d) [No change, except omit the word "new."]

(e) [No change, except omit the word "new."]

[Comments on Article 6, continued]

The Delegation of the United States of America has drawn the attention of the UPOV member States to Section 102(d) of its Patent Act which contains a provision which does not seem to be compatible with Article 6 of the UPOV Convention. It appears to be advisable to check the whole concept of novelty in the legislation of the United States of America and compare it with the mandatory rules of Article 6 of the Convention. The different problems are treated in the paragraphs (a) to (d) below.

(a) Offering for Sale or Marketing Abroad. Neither of the two US Acts contains a rule according to which the offering for sale or marketing abroad is detrimental to novelty. This would, however, be necessary in order to comply with Article 6(1)(b), second subparagraph, of the Convention. The Delegation of the United States of America has declared its intention to introduce such requirement if necessary.

(b) Description in a Publication. Under Section 102(b) of the US Patent Act, the invention [the new variety] must not have been described in a printed publication in the United States or in another country more than one year prior to the date of application for patent in the United States of America. This provision is, subject to the proposed introduction of the period of grace, sufficiently compatible with the Convention if applied to a publication of another variety, i.e., a variety which--though not being the same variety as the one for which an application has been filed--is not clearly distinguishable from that variety by at least one important characteristic: for according to Article 6(1)(a), a variety has to be distinguishable from any other variety whose existence is a matter of common knowledge and common knowledge may be established, among others, by a precise description in a publication.

Section 102(b) of the US Patent Act, however, may give rise to difficulties where the breeder's variety itself has been published more than one year prior to the application for patent in the United States of America. Such publication would be a bar to protection in the United States of America, while under Article 6 of the Convention only the prior offering for sale or marketing of the variety itself, and not its publication alone, would prevent the breeder from obtaining protection. Since, according to the second paragraph of that Article, member States are not permitted to make the grant of plant variety protection subject to any condition not mentioned in the Convention, an inconsistency seems to exist here between a provision of the US Patent Act and a basic rule of the Convention.

The Delegation of the United States of America should be asked whether the US Patent Act could, as far as this problem is concerned, be amended to conform to the Convention. This could be justified by the following considerations:

Section 102(b) of the US Patent Act is a provision well suited for industrial inventions. Publications of industrial inventions--in particular a publication of the description of such invention which observes the rule contained in most patent laws that the invention is described in a manner sufficiently complete for a person skilled in the art to use it--convey the main contents of it to the general public. This is not the case as far as plant varieties are concerned. A description of a plant variety will as a rule not enable other persons to produce plants of that variety. Such other persons, even when skilled in the art of plant breeding, will need the necessary propagating material. Such material is usually conveyed to the public when the variety is commercialized. It is therefore reasonable that under the Convention only certain acts of commercialization, and not publication alone, of the variety be a bar to protection.

(c) Application for protection and protection abroad. Under Section 102(d) of the US Patent Act the breeder of a new variety may be barred from protection by a plant patent if his variety was first patented (in his favor or in favor of his successor in title) prior to the date of the application in the United States of America and on the basis of an application filed abroad more than twelve months before the US filing date.

[Article 6, continued]

(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.

(2) [No change, except omit the word "new."]

[Comments on Article 6, continued]

This provision seems to be in conflict with Article 6 of the Convention since the prior filing or prior patenting abroad is in no case a reason for denying the novelty of the variety under Article 6(1) of the Convention. Thus, no member State of the Union may make the grant of the protection dependent from the fact that the variety was not already subject of a foreign filing or patented abroad at any time. The requirements of Section 102(d) of the US Patent Act can also not be treated as a mere "formality," the fulfillment of which member States can always demand under Article 6(2) of the Convention; it is a normal and typical substantive rule. Finally, it seems to be beyond any doubt that Section 102(d) of the US Patent Act, though using the term "patented," has to be interpreted in the sense that "patented" means also "protected by a special title of protection."

Two possible solutions exist: Amending the US legislation or the Convention. Amending the US legislation--in the sense that patenting abroad is not prejudicial to novelty--would not entail considerable practical changes since the case that a variety will be filed in that country after protection has already been granted for it in another country will be relatively rare. The other solution--amending the Convention--could be achieved by providing for an exception in the final Articles permitting States to maintain their existing rules according to which filing patent applications or patenting abroad is prejudicial to novelty. Such provision could read as follows: "If, at the date of entry into force of this Convention in respect of a member State of the Union, the law of this State provides that the prior protection of the variety in a foreign country or the prior filing of an application for protection in such country is a bar to protection, such State may, notwithstanding the provisions of Articles 6 and 11, continue the application of such law."

No amendment seems to be necessary as far as Section 42(a)(2) of the US Plant Variety Protection Act is concerned. This provision contains a rule according to which the variety must not have been the subject of an application filed abroad by the owner of the variety more than one year before the US filing date. However, the Secretary of the Department of Agriculture has the possibility to extend this one-year period for a reasonable period of time according to Section 42(b). In the US Plant Variety Protection Act, the problem can therefore be solved in a pragmatic way which is, however, not quite compatible with the idea underlying Section 42(a)(2) of the Act. Also some doubts might be raised as to the meaning of the word "reasonable" in paragraph (b) of Section 42 of the Act.

(d) First Filing in Breeding State. Sections 184 and 185 of the US Patent Act provide that patent applications in respect of an invention made in the United States of America shall not be filed abroad prior to six months after filing in the United States except where expressly permitted by the US Commissioner of Patents and Trademarks. Persons violating that rule shall not receive protection and a patent issued to a person having violated that rule shall be invalid. This rule would not be compatible with the Convention since it makes the granting of protection dependent from a requirement not provided for in the Convention (see Articles 6(2) and 10(2)) and since it restricts the freedom of the breeder to choose the member State in which the first application is filed (see Article 11).

One solution could consist of the US Commissioner of Patents and Trademarks issuing, in advance, to breeders of asexually reproduced plants in the United States of America a general license permitting them to file first applications for obtaining protection for their plant varieties abroad, according to the first sentence of Section 184 of the US Patent Act. The question might, however, be asked whether it would not be preferable to exclude expressly, in the US Patent Act, the application of the provisions of Sections 184 and 185 to plant patents and plant patent applications.

[Comments on Article 6, continued]

Ad paragraph (1)(c), (d) and (e): The only amendment proposed in each of these subparagraphs is to omit the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (2): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

0036

Comments on Article 7

Ad paragraphs (1) to (3): The only amendment proposed is to omit the words "new plant" in paragraphs (1) and (3). For explanations, see the Observation under Article 1(1).

It is recalled that during the preparatory discussions a statement was agreed upon which was noted with approval by the Council at its tenth ordinary session. This statement reads as follows:

"(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."

[Present Text]

Article 7

[Official Examination of New Varieties;
Provisional Protection]

- (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.
- (3) During the period between the filing of the application for protection of a new plant variety and the decision thereon, any member State of the Union may take measures to protect the breeder or his successor in title against wrongful acts by third parties.

[New Text]

Article 7

Official Examination of Varieties;
Provisional Protection

- (1) [No change, except omit the words "new plant."]
- (2) [No change]
- (3) [No change, except omit the words "new plant."]

Comments on Article 8

It is proposed that this Article be redrafted so as to consist of only one paragraph which would, however, include the main contents of paragraphs (1) and (2) of the present text. It seems to be unnecessary to state expressly (as does paragraph (3) of the present text) that member States may fix different periods of protection for different classes of plants since no provision of the Convention obliges the member States to fix the same period for all classes of plants.

[Present Text]

Article 8

[Period of Protection]

(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.

(3) Each member State of the Union may adopt longer periods than those indicated above and may fix different periods for some classes of plants, in order to take account, in particular, of the requirements of regulations concerning the production and marketing of seeds and propagating material.

[New Text]

Article 8

Period of Protection

The right conferred on the breeder or his successor in title shall be granted for a limited period. This period may not be less than fifteen years, computed from the date of issue of the title of protection. For vines, fruit trees and their rootstocks, forest trees, ornamental trees and similar plants, the minimum period shall be not less than eighteen years computed from the said date.

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Comments on Article 9

It is proposed that the two paragraphs of the present text be numbered and that the words "new varieties" be replaced by "the variety." As far as the deletion of the word "new" is concerned, see the Observation under Article 1(1). The use of the singular and the definite article would improve the text since the existing wording could be interpreted as covering only restrictions made in order to ensure the widespread distribution of new varieties in general rather than such distribution of a specific variety.

[Present Text]

Article 9

[Restrictions in the Exercise
of Rights Protected]

The free exercise of the exclusive right accorded to the breeder or his successor in title may not be restricted otherwise than for reasons of public interest.

When any such restriction is made in order to ensure the widespread distribution of new varieties, the member State of the Union concerned shall take all measures necessary to ensure that the breeder or his successor in title receives equitable remuneration.

[New Text]

Article 9

Restrictions in the Exercise
of Rights Protected

(1) [No change, except that the paragraph should receive a number, namely "(1)."]

(2) When any such restriction is made in order to ensure the widespread distribution of the variety, the member State of the Union concerned shall take all measures necessary to ensure that the breeder or his successor in title receives equitable remuneration.

Comments on Article 10

Ad paragraph (1): No amendment is proposed in this paragraph.

Ad paragraph (2): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (3): The only amendment proposed is to omit, in subparagraph (a), the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (4): No amendment is proposed to this paragraph.

[Present Text]

Article 10

[Nullity and Forfeiture
of the Rights Protected]

(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.

(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.

[New Text]

Article 10

Nullity and Forfeiture
of the Rights Protected

(1) [No change]

(2) [No change, except omit the word "new."]

(3) [No change, except omit the word "new."]

(4) [No change]

Comments on Article 11

Ad paragraph (1): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (2): No amendment is proposed in this paragraph.

Ad paragraph (3): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

[Present Text]

Article 11

[Free Choice of the Member State in Which the
First Application is Filed; Application in
Other Member States; Independence of
Protection in Different Member States]

- (1) The breeder or his successor in title may choose the member State of the Union in which he wishes to make his first application for protection of his right in respect of a new variety.
- (2) The breeder or his successor in title may apply to other member States of the Union for protection of his right without waiting for the issue to him of a title of protection by the member State of the Union in which he made his first application.
- (3) The protection applied for in different member States of the Union by natural or legal persons entitled to benefit under this Convention shall be independent of the protection obtained for the same new variety in other States whether or not such States are members of the Union.

[New Text]

Article 11

Free Choice of the Member State in Which the
First Application is Filed; Application in
Other Member States; Independence of
Protection in Different Member States

- (1) [No change, except omit the word "new."]
- (2) [No change]
- (3) [No change, except omit the word "new."]

Comments on Article 12

Ad paragraph (1): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (2): The only amendment proposed in the English version is to omit the word "new"; for explanations, see the Observation under Article 1(1). In the French and German versions, it is proposed that the words "de l'obtention" and "der Züchtung" be replaced by the words "de la variété" and "der Sorte," respectively.

Ad paragraph (3): It is proposed to add to this paragraph a sentence (starting with the word "Nevertheless"). The new sentence would allow member States to shorten, in two cases, the four-year period which is normally granted to applicants benefiting from the right of priority for furnishing any "additional document" (that is, other than the certified copy of the priority application) and "material" (that is, a sample of the variety) to the office with which the subsequent application is filed.

The first case in which this four-year period could be shortened is the case where the priority application has been rejected or withdrawn. In this case, it is almost certain that the authority with which the priority application has been filed will destroy all or most documents or material, received from the applicant, some time after that rejection or withdrawal has taken place. Such destruction means that neither the office with which the subsequent application has been filed nor courts or private parties in the country of the subsequent application can rely, as on a possible source of evidence, on the files, the growing fields, the reference collections or the sample collections of the office with which the priority application has been filed, should the validity of the priority claim be under dispute. Under such circumstances, the office of the subsequent filing should be given a chance to ask for samples of the propagating material immediately because the sooner the applicant is obliged to furnish them the more likely it is that they will be the same as those which were given to the office with which the priority application was filed.

The second case is the case where the office with which the subsequent application has been filed does not perform official growing tests. It can be assumed that such office will normally only demand small quantities of propagating material for recording purposes (as for instance demanded by paragraph (1)(b) of the statement agreed upon to Article 7), quantities which the applicant will easily be able and prepared to deposit much sooner than at the expiration of the four-year period. It also can be expected that these States do not demand the transmission of a great amount of additional documentation. It finally must be taken into account that in these States the official authority entrusts its tasks to perform growing tests to the applicant. In a system of this kind, it should be ensured that the official authority receives the result of these tests as soon as possible and not only after the four-year time limit.

[Present Text]

Article 12

[Right of Priority]

(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.

(2) To benefit from the provisions of the preceding paragraph, the further filing must include an application for protection of the new variety, a claim in respect of the priority of the first application and, within a period of three months, a copy of the documents which constitute that application, certified to be a true copy by the authority which received it.

(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.

(4) Such matters as the filing of another application or the publication or use of the subject of the application, occurring within the period provided for in paragraph (1), shall not constitute grounds for objection to an application filed in accordance with the foregoing conditions. Such matters may not give rise to any right in favour of a third party or to any right of personal possession.

[New Text]

Article 12

Right of Priority

(1) [No change, except omit the word "new."]

(2) [No change, except omit the word "new."]

(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. Nevertheless, that State may require the additional documents and material to be furnished, within an adequate period specified by its laws and regulations, in cases where:

(i) the application whose priority is claimed is rejected or withdrawn;

(ii) the examination of the variety pursuant to the application for protection in that State does not comprise official growing tests.

(4) [No change]

Comments on Article 13

Ad paragraph (1): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (2): It is proposed to delete the word "new"; for explanations, see the Observations under Article 1(1). Furthermore, it is proposed that the expression "existing varieties" be put into the singular in view of the fact that any given denomination normally designates only one--and not several--varieties. Finally, it is proposed to combine both subparagraphs in one paragraph.

It is to be noted that the rule contained in this paragraph and according to which a denomination "may not consist solely of figures" may suffer an exception, namely, where the proposed new Article 36A (see there) applies.

Ad paragraph (3) in the present text (paragraph (4) in the new text): It is proposed that this paragraph be amended in two respects.

According to the present text, any applicant who wishes to use as a denomination a sign which is one of his trade marks, is obliged to undertake to renounce his right to the trade mark and--when he does not comply with this obligation--he may not, as from the time of the registration of the denomination, continue to assert his right to the trade mark, in respect of products identical or similar to the plant variety. It is proposed that the applicant should not be compelled to renounce the right to his trade mark, but that he be only prevented to assert it in respect of the above-mentioned products. The proposed solution would simplify the procedure before the plant variety rights offices of member States since such offices would no longer be required to demand the applicant to renounce his right in a trade mark and the applicant would no longer be required to attach such a declaration of renunciation to his application. At the same time, the proposed amendment would lead to a harmonization of the procedure before the various offices since, at present, different undertakings are demanded from the breeders in the various member States under those provisions of the national laws which implement the renunciation procedure.*

The other proposed amendment would consist in the following. The present text provides, in effect, that the applicant who continues to use the denomination as a trade mark cannot assert his right to the trade mark (as far as certain products are concerned) in any member State; the proposed new text would limit the application of this sanction to those member States, in which the genus or species to which the variety in question belongs is eligible for protection. The reason for such an amendment lies in the belief that it seems not to be justified to deprive the applicant of the rights and advantages conferred upon him by a trade mark in member States in which he is not in the position to enjoy plant variety protection because such protection is simply not available, as the national laws do not offer the possibility of protection to the genus or species in question. In such States, because of the lack of plant variety protection, breeders can neither control the sale of propagating material of their varieties nor enforce the payment of royalties for their use; they should, in such States, at least not be deprived to exercise any rights they may derive from their trade marks when their varieties are sold under such marks.

*OBSERVATION: This proposal is different from the draft amendment agreed upon by the Committee of Experts in its fifth session. That draft amendment consisted of replacing "to renounce his right" by "not to continue to assert his right." However, it would seem preferable to do away altogether with the requirement to file an express undertaking since such a requirement only burdens the procedure both for the applicant and the offices. The legal effect of the provision would nevertheless remain unchanged: the right to the trade mark cannot be asserted.

[Present Text]

Article 13

[Denomination of New Varieties of Plants]

- (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 the 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.

[New Text]

Article 13

Denomination of Varieties of Plants

- (1) [No change, except omit the word "new."]

- (2) Such denomination must enable the 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 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, an existing variety of the same or a closely related botanical species.

- (4) If the breeder or his successor in title submits as the denomination of the variety either a designation in respect of which he enjoys the protection 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, 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, in any member State of the Union applying the provisions of the Convention to the genus or species to which the variety belongs.

- (3) [Same as paragraph (4) of the present text, except omit the word "new."]

- (5) A variety must be submitted in member States of the Union under the same denomination except in a member State in which this denomination will be unsuitable. 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.

[Comments on Article 13, continued]

It is proposed to interchange paragraphs (3) and (4) in the new text in view of the fact that the case treated in paragraph (3) of the present text would no longer be a reason for a national authority to refuse registering a proposed denomination.

Ad paragraph (4) in the present text (paragraph (3) in the new text): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (5): It is proposed to omit the word "new"; for explanations, see the Observation under Article 1(1).

It is proposed to add to the first sentence "except in a member State in which this denomination will be unsuitable." This amendment would give the breeder the possibility to depart from the general rule according to which the denomination must be the same in all member States. A denomination in a given member State could be "unsuitable," for example, if, in the language of that State, the word from which the denomination consists, would have an offensive meaning.

Ad paragraph (6), first subparagraph, in the present text (paragraph (6) in the new text): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (6), second subparagraph, in the present text (paragraph (7) in the new text): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (7) in the present text (paragraph (8) in the new text): For reasons similar to those stated in connection with the proposed new text for paragraph (4), it is proposed to restrict the application of this paragraph to member States in which the genus or species to which the variety in question belongs is eligible for protection. This result is achieved by inserting words to the said effect.

Ad paragraph (8) in the present text (paragraph (9) in the new text): It is proposed to delete the word "new"; for explanations, see the Observation made under Article 1(1).

Two changes are proposed to subparagraph (b) of this paragraph. First, it is suggested to delete the first sentence according to which the denomination of the new variety shall be regarded as a generic name for that variety. This statement would not be compatible with the proposed new paragraph (3) according to which a breeder can enjoy trade mark protection in a member State for a denomination which is registered in another member State of the Union as variety denomination, provided that the variety belongs to a genus or species not eligible for protection in the first mentioned member State. Second, the subparagraph, as amended, should ensure that in member States, in which the genus or species to which a variety belongs is not eligible for protection, the breeder himself or the successor in title can still obtain trade mark protection for the variety denomination which is registered for that variety in another member State of the Union. Only persons other than the breeder or his successor in title are barred from obtaining trade mark protection in any member State for such denomination for the products mentioned in this paragraph.

Ad paragraph (9) in the present text (paragraph (10) in the new text): The only amendment proposed is to omit the word "new." For explanations, see the Observation under Article 1(1).

Ad paragraph (10) in the present text (paragraph (11) in the new text): It is proposed to omit the word "new"; for explanations, see the Observation under Article 1(1). Furthermore, "paragraph (7)" has to be replaced by "paragraph (8)" and the words "if need be" have to be deleted as superfluous.

[Article 13, continued]

(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 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 a 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 identical to or liable to cause confusion with such denomination, in respect of identical or similar products within the meaning of trade mark law.

(6) [Same as the first subparagraph of paragraph (6) of the present text, except omit the word "new."]

(7) [Same as the second subparagraph of paragraph (6) of the present text, except omit the word "new."]

(8) Any person who, in a member State of the Union applying the provisions of the Convention to the genus or species to which the variety belongs, offers for sale or markets reproductive or vegetative propagating material of the variety shall be obliged to use the denomination of that variety, even after the expiration of the protection of that variety, in so far as, in accordance with the provisions of paragraph (11), prior rights do not prevent such use.

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

(b) subject to the provisions of paragraph (11), no person other than the breeder or his successor in title may, in any member State of the Union, apply for the registration of, or obtain protection as a trade mark for, a designation identical to or liable to cause confusion with the denomination of the variety, in respect of identical or similar products within the meaning of trade mark law. The breeder or the successor in title may not apply for such registration in States applying the provisions of the Convention to the genus or species to which the variety belongs.

[Article 13, continued]

(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.

(10) [Same as paragraph (9) of the present text, except omit the word "new."]

(11) [Same as paragraph (10) of the present text, except omit (twice) the word "new," change "(7)" to "(8)" and delete "if need be."]

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Comments on Article 14

Ad paragraph (1): No amendment is proposed in this paragraph.

Ad paragraph (2): No amendment is proposed in this paragraph.

[Present Text]

Article 14

[Protection Independent of Measures Regulating
Production, Certification and Marketing]

(1) The right accorded to the breeder in pursuance of the provisions of this Convention shall be independent of the measures taken by each member State of the Union to regulate the production, certification and marketing of seeds and propagating material.

(2) However, such measures shall, as far as possible, avoid hindering the application of the provisions of this Convention.

[New Text]

Article 14

Protection Independent of Measures Regulating
Production, Certification and Marketing

(1) [No change]

(2) [No change]

Comments on Article 34A

This new Article would constitute a limited exception to the rule contained in the second sentence of Article 2(1).

Ad paragraph (1): In the United States of America, two forms of plant breeders' rights are granted according to two different laws by two different authorities: special titles of plant protection are granted by the Plant Variety Protection Office for sexually reproduced plants on the basis of the Plant Variety Protection Act, whereas plant patents are granted by the Patent and Trademark Office for vegetatively reproduced plants on the basis of the Patent Act. These two forms of protection are the result of historical developments. It would be hardly possible to change this system, which is working satisfactorily. Its maintenance would cause no appreciable inconvenience for other member States of UPOV should the United States of America itself become such a member State. The proposed new provision would open the possibility for the United States of America to become a member State of UPOV without the need of changing its national law on this respect.

Ad paragraph (2): This paragraph would allow the withdrawal of the notification provided for in paragraph (1).

[Present Text]

[New Text]

Article 34A

Exceptional Rules for the Protection
Under Two Forms

[There is no Article 34A in the present text.]

(1) Notwithstanding the provisions of paragraph (1) of Article 2, any State which, at the date of opening for signature of this Act, provides for protection under different forms for sexually reproduced and for vegetatively propagated varieties, may continue to do so if, at the time of signing this Act or of depositing its instrument of ratification of or accession to this Act, it notifies the Secretary-General of the Union of this Act.

(2) The said State may, at any time, notify the Secretary-General of the withdrawal of the notification it has made under paragraph (1). Such withdrawal shall take effect on the date which the State shall indicate in its notification of withdrawal.

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Comments on Article 35

This Article is intended to protect the interests of a breeder who has started the commercialization of a variety before knowing that such commercialization may destroy the novelty of the variety since he did not know in advance when the provision of the Convention will be applicable to the genus and species to which such variety belongs. The present text makes an exception as to varieties (of recent creation) existing at the date of entry into force of the Convention in respect of the interested State; the proposed new text would make the exception as to varieties (of recent creation) existing at the date at which such State applies for the first time the provisions of the Convention to the genus or species to which the variety in question belongs. That date will be the date of entry into force of the Convention if the genus or species is among those which the State protects when it becomes a member of the Union; it will be a later date if the genus or species is one to which the State extends protection later.

[Present Text]

Article 35

[Transitional Limitation of the
Requirement of Novelty]

Notwithstanding the provisions of Article 6, any member State of the Union may, without thereby creating an obligation for other member States of the Union, limit the requirement of novelty laid down in that Article, with regard to varieties of recent creation existing at the date of entry into force of this Convention in respect of such State.

[New Text]

Article 35

Transitional Limitation of the
Requirement of Novelty

Notwithstanding the provisions of Article 6, any member State of the Union may, without thereby creating an obligation for other member States of the Union, limit the requirement of novelty laid down in that Article, with regard to varieties of recent creation existing at the date at which such State applies the provisions of this Convention for the first time to the genus or species to which such varieties belong.

Comments on Article 36

Ad paragraph (1) of the present text: That paragraph was intended to remedy a particular situation which was feared to arise at the time of the entry into force of the Convention in a given State. The provisions of Article 36 have a close relationship to paragraphs (3) and (7) of Article 13. It is proposed that those paragraphs be changed. As a result of such change, at least paragraph (1) of the present Article 36 appears to become superfluous. It is therefore proposed that it be deleted.

Ad paragraph (2) of the present text and the only paragraph of the new text: The changes proposed in this paragraph partly follow from the deletion of paragraph (1) of the present text. Furthermore, the changes parallel the changes proposed in Article 35.

[Present Text]

Article 36

[Transitional Rules Concerning the
Relationship Between Variety
Denominations and Trade Marks]

(1) If, at the date of entry into force of this Convention in respect of a member State of the Union, the breeder of a new variety protected in that State, or his successor in title, enjoys in that State the protection of the denomination of that variety as a trade mark for identical or similar products within the meaning of trade mark law, he may either renounce the protection in respect of the trade mark or submit a new denomination. If a new denomination has not been submitted within a period of six months, the breeder or his successor in title may not continue to assert his right to the trade mark for the above-mentioned products.

(2) If a new denomination is registered for the variety, the breeder or his successor in title may not prohibit the use of the previous denomination by persons obliged to use it before the entry into force of this Convention, until a period of one year has expired from the publication of the registration of the new denomination.

[New Text]

Article 36

Transitional Rule Concerning the Use
of a Former Denomination

[There would be no provision in the new text corresponding to paragraph (1) of the present text.]

If, at the date at which a member State applies for the first time the provisions of this Convention to a genus or species to which a variety belongs, a new denomination is registered for that variety, the breeder or his successor in title may not prohibit the use of the previous denomination by persons who were obliged to use it before the said date, until a period of one year has expired from the publication of the registration of the new denomination.

Comments on Article 36A

This new Article would constitute a limited exception to that rule contained in Article 13(2) which provides that no denomination may "consist solely of figures."

Ad paragraph (1): In a number of States which are interested in joining the Union, breeders are allowed to designate their varieties by a series of figures. Such denominations have become customary in those States, at least with respect to certain genera or species, and any prohibition to continue such practice would probably constitute, for those States, an unsurmountable obstacle to joining the Union. It is therefore proposed that such States be permitted to derogate from the provisions of Article 13(2).

The proposed permission would be as restricted as possible. The admission of numerical denominations must be established practice and not merely sporadic or exceptional. Such practice must be determined at the date of opening of the revised Act for signature. This date has been preferred to the date of ratification or accession by a State in order to avoid that numerical denominations be made established practice between the date of opening for signature of the revised Act and the date of ratification or accession.

Ad paragraph (2): This paragraph would allow the withdrawal of the notification provided for in paragraph (1).

[Present Text]

[New Text]

Article 36A

Exceptional Rules for the Use of
Denominations Consisting Solely of Figures

[There is no Article 36A in the present
text]

(1) Notwithstanding the provisions of paragraph (2) of Article 13, any State which, at the date of opening for signature of this Act, has the established practice of admitting variety denominations consisting solely of figures, may continue such practice in respect of all or certain genera and species if, at the time of signing this Act or of depositing its instrument of ratification or accession to this Act, it notifies the Secretary-General of the Union of its intention to do so and, unless it intends to do so in respect of all genera or species, of the genera and species in respect of which it intends to continue the said practice.

(2) The said State may, at any time, notify the Secretary-General of the withdrawal of the notification it has made under paragraph (1). Such withdrawal shall take effect on the date which the State shall indicate in its notification of withdrawal.

[End of document]