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PRESENTATION ON COURT DECISION ON ESSENTIALLY DERIVED VARIETIES IN ISRAEL

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Protection of Breeders' Right



- (a) Subject to the provisions of this Chapter and of chapter Seven, **utilization** of a registered variety requires authorization obtained from the holder of a breeders' right to that variety.

- (b) The holder of a breeders' right may prevent any other person from **utilizing** – without his authorization or unlawfully – the variety in respect of which the right is registered (hereafter: protected variety); an aforesaid utilization constitutes infringement.

Definition of Utilization

"Utilization", for purposes of a variety –

- (1) its cultivation or propagation;
- (2) its preparation for propagation;
- (3) an offer for its sale;
- (4) its sale, export, import or marketing in any other manner;
- (5) its maintenance for purposes of one of the acts enumerated in this definition;
- (6) other acts, determined by the Minister with approval by the Knesset Economics Committee;

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Definition and Protection of Essentially Derived Variety

The right of a holder of breeders' right, as said in subsections shall also apply to –

- A variety essentially derived from the protected variety, provided the protected variety itself is not an essentially derived variety; for this purpose, a variety shall be deemed essentially derived from another variety (hereafter: initial variety), if all the following hold true for it:
 - It is predominantly derived from the initial variety or from a variety which itself was predominantly derived from the initial variety, while retaining the expression of essential characteristics that result from the genotype or combination of genotypes of the initial variety; an essentially derived variety may have been obtained by the selection of a natural or induced mutant or of a somaclonal variant, by the selection of a variant individual from plants of the initial variety, by backcrossing, by a transformation by genetic engineering, or by any other similar method;
 - It is clearly distinguishable from the initial variety;
 - Except for differences which result from the act of derivation, it conforms to the initial variety in the essential characteristics that result from the genotype or combination of genotypes of the initial variety;

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Definition and Protection of EDV Under The International Convention

- (a) The provisions of paragraphs (1) to (4) shall also apply in relation to:
- (i) Varieties which are essentially derived from the protected variety, where the protected variety is not itself an essentially derived variety;
 - (ii) Varieties which are not clearly distinguishable in accordance with Article 7 from the protected variety and;
 - (iii) Varieties whose production requires the repeated use of the protected variety;
- (b) For the purposes of subparagraph (a)(i), a variety shall be deemed to be essentially derived from another variety ("the initial variety") when:
- (i) it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety;
 - (ii) it is clearly distinguishable from the initial variety and
 - (iii) Except for the differences which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.
- (c) Essentially derived varieties may be obtained for example by the selection of a natural or induced mutant, or of a somaclonal variant, the selection of a variant individual from plants of the initial variety, backcrossing, or transformation by genetic engineering.

Compulsory License for Utilization of EDV

Where the Council concluded that the holder of a breeders' right did not utilize the registered variety, or that he utilized it under circumstances and under conditions not in the public interest, **or that he prevented the holder of an essentially derived variety from utilizing the derived variety**, or that he set conditions for the utilization of a variety that are not in the public interest, may – in consultation with the Breeders' Rights Committee – permit such variety to be utilized under conditions prescribed by it and without the consent of the holder of the right.

Terms of Compulsory license for EDV



A License under sections 40 or 41:

Shall specify its period and conditions including payment to the holder of the right.

**Plaintiff's Original Variety
Dangypmini (Million Stars)**

**Defendant's EDV
Blancanieves**



Shifting of Burden of Proof

- ◆ Where an action is brought by the holder of an original protected variety (hereafter: plaintiff) against the holder of a variety, in respect of which it is argued that it is an essentially derived variety (hereafter: defendant), the defendant shall bear the burden of proof that the variety is not essentially derived, if the plaintiff has proven one of the following:
 - ◆ Genetic conformity between the original variety protected and the variety, in respect of which it is claimed to be essentially derived variety;
 - ◆ The variety, claimed to be essentially derived variety maintains, except for minor differences, the expression of the essential characteristics that arise out of the genotype or out of a combination of genotypes of the original protected variety.

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The Court's Construction of Onus of Proof

“The fact that a plaintiff is required to prove in an allegation of an EDV is that the defendant used the original variety in order to produce therefrom the derived variety. Where the plaintiff does not have direct evidence showing such use, the Act enables it to prove a genetic or a morphological conformity between the two varieties. Such proof is rebuttable because it is circumstantial evidence based on probabilities. In other words, if there exists a genetic or a morphological conformity between the two varieties, the assumption is that the defendant actually used the original variety to produce the EDV. As stated, this is only prima facie evidence, by which the burden of proof is shifted to the defendant, who now has to explain the suspicious conformity”.

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