

**COMMENTS ON DOCUMENT UPOV/EXN/EDV/3 DRAFT 2 OF SEPTEMBER 3, 2021:
EXPLANATORY NOTES ON ESSENTIALLY DERIVED VARIETIES UNDER THE 1991 ACT OF
THE UPOV CONVENTION**

1. INTRODUCTION

Morocco agrees with Draft 2 of Document UPOV/EXN/EDV/3, and welcomes this revision, which corrects certain aspects of the previous version (Document UPOV/EXN/EDV/2 of April 6, 2017), which were erroneous and contradicted Article 14(5) of the 1991 Act of the UPOV Convention.

2. COMMENTS TO CERTAIN PROVISIONS WHICH HAVE BEEN SUBJECT MATTER OF PROPOSALS BY OTHER MEMBER STATES.

2.1 PARAGRAPH 11 (PAGE 7)

(A) Morocco agrees with the amended wording of paragraph 11 as proposed in Draft 2 of Document UPOV/EXN/EDV/3. In particular, the sentence “*which may also include differences in essential characteristics*” needs to be kept.

(B) We disagree with the amendment proposal from Spain, which, in our view, is based in a misinterpretation of Article 14(5)(b)(iii) of the 1991 UPOV Convention. According to this Article: (1) all differences which result from the act of derivation are clearly excluded from the comparison (“*except for the differences which result from the act of derivation*”); and (2) even in connection with those differences that do not result from the act of derivation (and thus can be taken into consideration), there is not a qualitative or quantitative limit as long as the new variety retains the essential characteristics of the initial one (“*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*”), which puts the focus in the retention of the essential characteristics, regardless of whether there may be differences in (essential or non-essential) characteristics.

The amendment proposed by Spain would entail a denial of the purposes of the 1991 UPOV Convention against free-riding practices that take undue advantage of well-known and successful varieties thanks to techniques such as induced mutagenesis.

(C) We agree with Mexico’s amendment proposal.

2.2 PARAGRAPH 13 (PAGE 7)

(A) For the same reasons explained above in connection with paragraph 11, we disagree with the amendment proposal from Spain. Indeed, during the discussions that led to the 1991 UPOV Convention the German delegation proposed to specify that an essentially derived variety should differ from the original one only in one or few characteristics. Such proposal was rejected, which makes it clear that the intent of the 1991 UPOV Convention was to not establish a limit on the number of differences between the original variety and the essentially derived one.

- (B) The comment of Spain according to which this revised version would put “obstacles” to “*granting rights for new varieties that do indeed possess unique essential characteristics in comparison with existing varieties*” is blatantly incorrect. An EDV can indeed be protected by plant variety rights. In fact, for being considered an EDV it is necessary that the variety in question meets the distinguishability requirement [as expressly stated in Article 14(5)(b)(ii): “it is ***clearly distinguishable*** from the initial variety”]. Otherwise, we would be talking about the same variety or a non-clearly distinguishable variety in the sense of Article 14(5)(a)(ii).
- (C) This is in line with what happens with other intellectual property rights, as it is the case of patent dependency. A new invention that meets the novelty, inventiveness and industrial application requirements may be patentable, but as long as its exploitation requires using a previous patent it will require the authorisation of the owner of the original patent. This same principle underlies the EDV concept under the 1991 UPOV Convention, as it is clear from the discussions held prior to its adoption.
- (D) In summary, the EDV concept is not conceived for cases of mere cosmetic changes (as Spain seems to suggest), since those would already be dealt with in Article 14(5)(a)(ii), but for cases of clearly distinct varieties (which may include differences in essential characteristics) that may be eligible for PVR protection.

2.3 PARAGRAPH 14 (PAGE 8)

- (A) The comments from Spain should be rejected. This paragraph is not penalizing new technologies. On the contrary, it aims to provide certainty on the EDV concept and to protect plant breeders from third parties that may benefit from original plant varieties to easily create new ones by simple acts of derivation. Again, this point is not disincentive to development (just like patent dependency is not a disincentive to technology improvement in other fields), but quite the opposite.

2.4 PARAGRAPHS 15 AND 17 (PAGE 8)

- (A) The comment of Spain must be rejected and the wording of the draft has to remain unchanged. Mutations (whether induced or spontaneous) have always been acknowledge as a paradigmatic example of predominant derivation within the horticultural community.
- (B) In addition, paragraph 17 uses the term “*typically*”, which leaves sufficient room for those exceptional cases where even if this technique is being used, the result might not be an EDV.

2.5 PARAGRAPH 20 (PAGE 9)

- (A) The comments from Spain should be rejected.

[End of comments]