

Working group on harvested material and unauthorized use of propagating material

WG-HRV/2/5.

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PROPOSALS CONCERNING THE EXPLANATORY NOTES ON PROVISIONAL PROTECTION UNDER THE UPOV CONVENTION

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1. The Working group on harvested material and unauthorized use of propagating material (WG-HRV), at its first meeting, held via electronic means on March 15, 2022, received a presentation on document WG-HRV/1/5 "Proposals concerning the Explanatory Notes on Provisional Protection under the UPOV Convention" but did not have time to discuss the document. It agreed to discuss the document at its second meeting and, in the meantime, to invite additional comments on document WG HRV/1/5 within six weeks after its first meeting (See document WG-HRV/1/6 "Report", paragraphs 14 and 15 and UPOV Circular E-22/058).
2. The purpose of this document is to present the proposals received in reply to the UPOV Circular E-21/228 of November 19, 2021 and UPOV Circular E-22/058 of April 12, 2022, for a revision of document "Explanatory Notes on Provisional Protection under the UPOV Convention" (document UPOV/EXN/PRP/2).
3. In reply to UPOV Circular E-22/058, proposals were received from Japan and the International Association of Horticultural Producers (AIPH).
4. In the Annex to this document, the proposals received in reply to Circulars E-21/228 and E-22/058 have been introduced in boxes in the text of document UPOV/EXN/PRP/2.

[Annex follows]

ANNEX

PROPOSALS CONCERNING THE EXPLANATORY NOTES ON
PROVISIONAL PROTECTION UNDER THE UPOV CONVENTION

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Note

Proposals received in reply to Circular E-21/228 of November 18, 2021 and UPOV Circular E-22/058 of April 12, 2022, on document UPOV/EXN/PRP/2, are presented in boxes.

Endnotes provide background information.

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EXPLANATORY NOTES ON PROVISIONAL PROTECTION
UNDER THE UPOV CONVENTION

PREAMBLE

1. The purpose of these Explanatory Notes is to provide guidance on “Provisional Protection” under the International Convention for the Protection of New Varieties of Plants (UPOV Convention). The only binding obligations on members of the Union are those contained in the text of the UPOV Convention itself, and these Explanatory Notes must not be interpreted in a way that is inconsistent with the relevant Act for the member of the Union concerned.
2. These Explanatory Notes provide guidance on certain aspects of the provisions on provisional protection contained in Article 13 of the 1991 Act of the UPOV Convention and in Article 7(3) of the 1978 Act of the UPOV Convention.

Proposals from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA^a

Paragraph 2 to be changed as follows: “These Explanatory Notes provide guidance on certain aspects of the provisions on provisional protection contained in Article 13 of the 1991 Act of the UPOV Convention and in Article 7(3) of the 1978 Act of the UPOV Convention in order to ensure that the minimum level of protection provided by these Conventions is applied by the member States in a uniform way.”

SECTION I: PROVISIONS ON PROVISIONAL PROTECTION

3. The provisions on provisional protection contained in Article 13 of the 1991 Act of the UPOV Convention and Article 7(3) of the 1978 Act of the UPOV Convention are reproduced below:

1991 Act of the UPOV Convention

Article 13

Provisional Protection

Each Contracting Party shall provide measures designed to safeguard the interests of the breeder during the period between the filing or the publication of the application for the grant of a breeder's right and the grant of that right. Such measures shall have the effect that the holder of a breeder's right shall at least be entitled to equitable remuneration from any person who, during the said period, has carried out acts which, once the right is granted, require the breeder's authorization as provided in Article 14. A Contracting Party may provide that the said measures shall only take effect in relation to persons whom the breeder has notified of the filing of the application.

1978 Act of the UPOV Convention

Article 7(3)

Provisional Protection

[...]

(3) Any member State of the Union may provide measures to protect the breeder against abusive acts of third parties committed during the period between the filing of the application for protection and the decision thereon.

SECTION II: CERTAIN ASPECTS OF THE PROVISIONS ON PROVISIONAL PROTECTION

4. This section provides guidance on certain aspects of the provisions on provisional protection contained in Article 13 of the 1991 Act of the UPOV Convention and Article 7(3) of the 1978 Act of the UPOV Convention.

Period and notification

Each Contracting Party shall provide measures designed to safeguard the interests of the breeder during the period between [the filing] [or] [the publication] of the application for the grant of a breeder's right and the grant of that right. [...] A Contracting Party may provide that the said measures shall only take effect in relation to persons whom the breeder has notified of the filing of the application.

5. The UPOV Convention provides that the period of protection (Article 19 of the 1991 Act and Article 8 of the 1978 Act) is counted from the date of grant of a breeder's right. The 1991 Act of the UPOV Convention requires that provisional protection is provided to the breeder during the period between the filing¹ or publication of the application for the grant of the breeder's right and the grant of that right.²

Proposals from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA^b

Paragraph 5 to be changed as follows: "The UPOV Convention provides that the period of protection (Article 19 of the 1991 Act and Article 8 of the 1978 Act) ~~is counted~~ **starting** from the date of grant of a breeder's right. The 1991 Act of the UPOV Convention requires that provisional protection is provided to the breeder during the period between the filing¹ or publication of the application for the grant of the breeder's right and the grant of that right.²

"In accordance with this principle, the applicant of a PVP filed in any UPOV Contracting Party shall enjoy provisional protection as from the date of the filing or "first application" in case of a priority claim under the respective Articles. Provisional protection and liability, including compensation and damages, for unauthorized use are reckoned from the filing date or priority date, as the case may be, of the PVP application."

Proposal from Japan^c

In relation to paragraph 5:

"Japan appreciates the positive proposal on "Provisional Protection" from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA.

When filing an application overseas, it inevitably takes time to publish the application due to quarantine or application procedures, leaving a gap in the time until provisional protection. On the other hand, the cultivation from seed or seedling taken illegally to abroad can spread immediately, and the breeder's right can no longer be exercised on the seed in time.

The Proposal raises important issues that will lead to the protection of the common interests of all member countries, and Japan supports this proposal in its essence.

However, the current Article 13 of UPOV Convention, stipulates provisional protection to be provided at each contracting party upon filing/publication of the application of that country and that each contracting party shall choose the starting point of the provisional protection to be either the filing or the publication of the application, and this should be noted in the above proposal.

Therefore, Japan is willing to move the discussion further for provisional protection that be commenced in all UPOV member states at the unified starting point (e.g., date of filing of an application in any member state) without ruling out the possibility of amending the UPOV Convention."

¹ Article 7(3) of the 1978 Act only refers to "the period between the filing of the application for protection and the decision thereon."

² Under Article 7(3) of the 1978 Act, provisional protection is an optional provision.

Proposals from AIPH ^d

“The wish for the text in the block above [Proposals on paragraph 5 from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA] is understandable against the background of the Nadorcott decision, but

- 1) is in AIPH's opinion not in accordance with the basic meaning and intention of the principle of authorization, i.e.: has to be read as consent. AIPH suggestion would be first to discuss this principle and try to reach a shared opinion about it.
- 2) The sentence as such is complicated and distracts from the basic discussion.”

6. A member of the Union may provide in its legislation that the measures of provisional protection (see below notes on “Measures”) shall only take effect in relation to persons whom the breeder has notified of the filing of the application. Such a notification may be considered to be fulfilled in relation to all persons when the law has retained the date of the publication as the initial date for provisional protection, because publication is generally recognized as a notification mechanism of third parties.

Proposals from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA ^e

Paragraph 6 to be updated with the following sentence: “A member of the Union may (...).”

“A PVP publication refers to a PVP application that has been published in an official journal or gazette, either in the form of a physical document or in an electronic format.”

Proposals from AIPH ^f

In relation to paragraph 6:

“AIPH can agree with the concerned sentence in the block above [Proposals on paragraph 6 from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA], but would like to call all member states and observers to organize good and complete PVP publication lists. Some regions have the concerned lists in good order. It would be of large help if all members organize their lists proper and at a same level.”

Measures

Such measures shall have the effect that the holder of a breeder's right shall at least be entitled to equitable remuneration from any person who, during the said period, has carried out acts which, once the right is granted, require the breeder's authorization as provided in Article 14.

7. Article 13 of the 1991 Act of the UPOV Convention provides that members of the Union bound by the 1991 Act shall provide measures designed to safeguard the interests of the breeder during the period between the filing or the publication of the application and the grant of the breeder's right. Those measures require that the holder of the breeder's right is "at least" entitled to equitable remuneration from any person who, during that period, carries out acts which, once the right has been granted, would require the breeder's authorization as provided in Article 14 of the 1991 Act of the UPOV Convention.

8. The use of the text "at least" clarifies that it is possible, for example, that the provisions on provisional protection in the law governing breeders' rights provide the holder of the breeder's right with the full scope of the breeder's right.

Proposals from ISF, CIOFORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA ⁹

Paragraph 8 to be changed as follows: "The use of the text "at least" clarifies that it is possible, for example, that the provisions term 'on provisional protection' is intended to attribute to the breeder protection during in the law governing breeders' rights provide period between the holder filing or the publication of the breeder's right with application and the full scope grant of the breeder's right. The use of the text 'at least' clarifies that the members of the Union may already provide full protection in this period.

"Full scope of protection during the period of 'provisional protection' is a key incentive for breeders for making quickly available their state-of-the-art varieties to the market. Early release of new varieties adapted to address a wide range of challenges, including sustainability, is also to the benefit of growers, consumers and society at large.

"This is particularly important for multi-annual plants (like fruit trees) where propagating material obtained during the period of provisional protection continues being cultivated and producing harvested material (fruits) for many years during the period of protection. In the case of annual plants, the breeder can exercise his right every time a third party obtains or reproduces propagating materials once the protection is provided. On the other hand, in case of perennial plants, such as fruit trees, the breeder would not have any opportunity to exercise his right over propagating material (nor the harvested material), if the grower planted and grew the propagating material which was obtained before the protection was granted (during the provisional protection period)."

Proposals from AIPH ^h

In relation to paragraph 8, AIPH has made the following general comments:

1) the wish for this text of the joint breeders is understandable against the background of the Nadorcott decision, but is not in accordance with the basic meaning and intention of the principle of authorization, i.e.: has to be read as consent. Let's first discuss the principle and after conclusions start to discuss the principle of PPM and the clarifications in the concerned EXN.

2) the sentence as such is complicated and distracts from the basic discussion.

3) is only the use of a term 'provisional protection' as title of this UPOV article, sufficient legal basis to clarify and explain the scope of the right? See the different title of art. 95 EU regulation 2400/94: Acts Prior to Grant of Community Plant Variety Rights.

4) the breeder has to be careful anyhow to whom he delivers his material, during the period of provisional protection.

5) there is a risk that excepting full protection during the provisional protection period, might open the discussion of the principle of protection (itself)."

AIPH made this specific comment on the following sentence in the box above:

"The use of the text 'at least' clarifies that the members of the Union may already provide full protection in this period."

"but members could /might diverge from it"

AIPH made this specific comment on the following sentences in the box above:

"Full scope of protection during the period of 'provisional protection' is a key incentive for breeders for making quickly available their state-of-the-art varieties to the market. Early release of new varieties adapted to address a wide range of challenges, including sustainability, is also to the benefit of growers, consumers and society at large."

"understandable from the background of Nadorcott case, but the Convention (legal situation) does not foresee in a full scope of protection, because a PVR right does not exist in this stage. If the principle of authorization or consent is discussed successfully, there is no need to explain the principle here in the EXN anymore."

9. Provisional protection is valid only in relation to acts that would require the breeder's authorization "once the right is granted". The UPOV Convention requires (see Article 30(1)(iii) of the 1991 Act and Article 30(1)(c) of the 1978 Act) that the public is informed through the regular publication of information concerning applications for and grants of breeders' rights, which includes withdrawals and rejections of applications.

10. The possibility to enter into license agreements on the basis of applications for breeders' rights and/or to initiate legal proceedings before the grants of breeders' rights will be determined by the relevant legislation of the member of the Union concerned. The relevant legislation might, in addition to the legislation governing breeders' rights, include other legislation on substantive and procedural matters (e.g. civil legislation, criminal legislation).

11. In cases where it is possible to enter into a license agreement before the grant of a breeder's right, the effects on royalties paid if the right is not granted (e.g. whether or not the licensor has to reimburse past royalties) may be provided in the relevant legislation and/or may be agreed by the parties in accordance with the legislative system.

12. In some members of the Union, legal action in respect of provisional protection can only be initiated after the right is granted. In some other members of the Union, it is possible to initiate legal proceedings before the grant of a breeder's right. In those cases, the competent judicial authority may decide that any damages during the period of provisional protection would only be enforceable once the right has been granted. In such cases, the judicial authority could, for example, request the third party to transfer the amount of the damages to a depository account for payment to the breeder if and when the right is granted.

Example provision

13. The following example provision is intended to provide assistance to States/ intergovernmental organizations wishing to draft a provision on provisional protection in their laws in accordance with the 1991 Act of the UPOV Convention:

Article [13]³
Provisional Protection

[(1)] Provisional protection is provided to safeguard the interests of the breeder during the period between [the filing] / [the publication] of the application for the grant of a breeder's right and the grant of that right.

Example A

[(2)] The holder of a breeder's right [shall at least be entitled to equitable remuneration] from any person who, during the period provided in paragraph [(1)], has carried out acts which, once the right is granted, require the breeder's authorization as provided in Article [14].

Example B

[(2)] The applicant is considered to be the holder of a breeder's right in relation to any person who, during the period provided in paragraph [(1)], has carried out acts which, once the right is granted, require the breeder's authorization as provided in Article [14]. The applicant shall have the same rights to enter into license agreements and to initiate legal proceedings as if on the [filing] / [publication] date the breeder's right had been granted to the applicant in respect of the variety concerned. The rights conferred under this paragraph shall be deemed never to have been conferred if the right is not granted.

[(3)] [Provisional protection shall only take effect in relation to persons whom the breeder has notified of the filing of the application.]

Paragraph (3) of the above example provision is not necessary if, in paragraph (1), the law has retained the date of the publication as the initial date for provisional protection (see above paragraph 6 of this document).

[End of Annex and of document]

³ The highlighted text in square brackets is intended for drafters involved in the preparation of laws and identifies, as appropriate, text to be completed, numbering of provisions that might need to be modified, or provisions of the 1991 Act of the UPOV Convention providing for a choice.

ENDNOTES

^a The proposals from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA, in reply to Circular E-21/228, are available at: https://www.upov.int/meetings/en/details.jsp?meeting_id=67773.

^b The proposals from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA are available at: https://www.upov.int/meetings/en/details.jsp?meeting_id=67773.

^c The proposal from Japan, in reply to Circular E-22/058, is available at https://www.upov.int/meetings/en/details.jsp?meeting_id=70188

^d The proposals from AIPH, in reply to Circular E-22/058, are available at https://www.upov.int/meetings/en/details.jsp?meeting_id=70188

^e The proposals from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA are available at: https://www.upov.int/meetings/en/details.jsp?meeting_id=67773.

^f The proposal from AIPH, in reply to Circular E-22/058, is available at https://www.upov.int/meetings/en/details.jsp?meeting_id=70188

^g The proposals from ISF, CIOPORA, CropLife International, Euroseeds, APSA, AFSTA, and SAA are available at https://www.upov.int/meetings/en/details.jsp?meeting_id=67773

^h The proposal from AIPH, in reply to Circular E-22/058, is available at https://www.upov.int/meetings/en/details.jsp?meeting_id=70188