

## European Union

Contribution on policy issues relevant for essentially derived varieties (EDVs)  
(UPOV Circular E-19/232, of December 23, 2019)

It is important that the UPOV explanatory notes give clear guidance as they are used by court judges for studying practical implementation of law although they are not binding law. The European Union welcomes the efforts of clarifying the Explanatory Note on EDV. The European Union would like to make the following remarks in relation to the UPOV request of 23 December 2019 on the questions concerning EDVs.

### ***“SECTION I: PROVISIONS OF ESSENTIALLY DERIVED VARIETIES***

***“(a) Relevant provisions of the 1991 Act of the UPOV Convention***

***“(b) Defining an essentially derived variety***

***Predominantly derived from the initial variety (Article 14(5)(b)(i))***

***Clearly distinguishable from the initial variety (Article 14(5)(b)(ii))***

***Conformity with the initial variety in the expression of the essential characteristics (Article 14(5)(b)(iii))”***

The issue at hand is about the interpretation of Article 14(5)(b)(i) concerning the notion ‘while retaining the expression of the essential characteristics’ that results from the genotype and combination of genotypes’. The interpretation as presented in the explanatory note is rather narrow in this regard and therefore we suggest to remove the sentence ‘differences should be one or very few’ in paragraph 10 of the explanatory note. For example, a mutation can be very different although it retains the majority of the genotype. In the ornamental sector, e.g. the colour is in all or at least in almost all cases an essential characteristic. Interpreting that sentence to the letter would mean that a colour mutant is not an EDV since it does not retain all essential characteristics of the parent variety

Thus we believe that the interpretation on EDV is too narrow and that the Article 14 of the UPOV Convention allows for a broader view.

Emphasis should be made to the fact that EDV should conform essentially to the initial variety. To draw a line on how many differences and how important such differences are for EDV to remain sufficiently confirmed to the Initial Variety is a challenge. This may vary depending on factors such as the characteristic in question, the breeding method and the species in question. It should also be noted that essential characteristics can be all characteristics. It does not need to be DUS characteristics, it can be VCU characteristics or any other.

It is noted that according to the position paper on EDV of several breeders’ organisations, the predominant derivation from an initial variety, as confirmed by a high genotypic conformity, could be a key requirement for determining EDV.

### ***Method of breeding***

#### Are mutants always EDVs?

We claim that in most cases mutants are EDVs. However, as there are different kinds of mutagenesis techniques - spontaneous or induced mutagenesis provoking a single or several mutations - it would be good to discuss and reach a common understanding on mutagenesis. In any case mutants are always predominantly derived. One argument supporting this conclusion is that there is only one initial variety. The mutant is thus completely derived from the initial variety.

#### Back crossing

In relation to back crossing, thresholds can be defined to establish predominant derivation and to shift the burden of proof which is not the case with mutants (see above). The difference between backcrossing and mutation is that in case of backcrossing there are two parent varieties providing each of them their genome. In order to avoid a limitation of the breeder’s exemption it is therefore particularly important to draw a borderline regarding the conformity. This can be done by using the terminology “repeated backcrossing”. It should also be stated that in relation to repeated backcrossing the limitation to “one or a few differences” would remain an important principle for the conformity assessment

## Impact of new breeding techniques

The use of new breeding techniques (targeted mutagenesis) should in all cases lead to the conclusion that the EDV is predominantly derived from the initial variety. The focus should be on the conformity rather than the differences.

### **“SECTION I: PROVISIONS OF ESSENTIALLY DERIVED VARIETIES**

**[...]**

**“(b) Defining an essentially derived variety**

**[...]**

**Direct and indirect derivation**

**“(c) Scope of the breeder’s right with respect to initial varieties and essentially derived varieties**

**“(d) Territoriality of protection of initial varieties and essentially derived varieties**

**“(e) Transition from an earlier Act to the 1991 Act of the UPOV Convention”**

### **“SECTION II: ASSESSMENT OF ESSENTIALLY DERIVED VARIETIES”**

The determination of whether a variety is an EDV should be made by industry and at the end through an arbitration process and by courts. It is not for the granting authorities to play the dispute resolving role. Plant variety protection is part of the civil laws system and it is up to the holder of a right to defend its intellectual property should it not be respected. Experts from plant variety examination offices could nevertheless be called as experts by courts. This concept was deleted from the previous explanatory note but should be re-introduced.

DNA analysis is used for determining the aspect of derivation with genetic thresholds. For conformity, both genotype and phenotype are considered. A judge could have access to the breeding book and information on phenotypical similarities in order to decide if a variety is an EDV.

For some species, there are position papers developed by the industry in which thresholds on genetic similarities are indicated which would trigger the change of the burden of proof as to whether a variety is predominantly derived. Such papers do not include thresholds as regards how many characteristics must be similar/different when assessing if a variety is an EDV. A court is not bound by such papers but may take into account implementation practice when assessing a given case.