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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Eleventh Session

Geneva, April 26 and 27, 1983

MINIMUM DISTANCES BETWEEN VARIETIES

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LEGAL QUESTIONS

Document prepared by the Office of the Union

1. At the joint meeting held by the Administrative and Legal Committee and the Technical Committee on November 17, 1982, it was decided that the Administrative and Legal Committee would consider at its eleventh session the legal questions raised in the Annex to document TC/XVIII/7 and a further question raised during the discussions, on the basis of the said document and of the replies to a questionnaire (see paragraph 20(i) of document CAJ/X/8).

2. Annex I to this document contains the questionnaire sent to member States by the Office of the Union. The replies from member States are reproduced in Annexes II to IX as follows:

Annex II	:	Federal Republic of Germany
Annex III	:	Belgium
Annex IV	:	France
Annex V	:	Israel
Annex VI	:	New Zealand
Annex VII	:	United Kingdom
Annex VIII	:	Sweden
Annex IX	:	Switzerland

[Annexes follow]

LEGAL ASPECTS OF THE QUESTION OF
MINIMUM DISTANCES BETWEEN VARIETIES

Questionnaire drawn up by the Office of the Union

(Annex to circular No. U 771/08.1, dated January 20, 1983)

I. DISTINCTNESS

Article 6 (1) (a) of the UPOV Convention:

"Whatever may be the origin, artificial or natural, of the initial variation from which it has resulted, the 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 precise description in a publication. The characteristics which permit a variety to be defined and distinguished must be capable of precise recognition and description."

1. When is a variety "another variety" in the meaning of the above provision? Does a variety that is identical or almost identical with the variety the subject of an application for protection, but that has been bred independently by someone else ("parallel breeder"), belong to the variety the subject of an application for protection or is it "another variety"?

2. What conditions must be fulfilled by the "other variety"? Must the "other variety" with which the variety the subject of an application for protection has to be compared when the latter is tested for distinctness be a "finished" variety, that means a variety that is sufficiently homogeneous, or can it be a plant population that does not--yet--fulfill the requirements for homogeneity (a so-called "quasi-variety", as for instance are most of the varieties distributed by CIMMYT)?

3. What conditions must be fulfilled by the "other variety" for it to be able to be considered as a matter of common knowledge on the basis of a "precise description in a publication"? Is a description by the breeder, published or submitted to the plant variety protection office, sufficient? In the case of a hybrid variety, is it sufficient to indicate the formula if the parent lines are a matter of common knowledge, or are there additional conditions that have to be fulfilled? If so, what are they (must it be certain that the "other variety" does not only exist on paper)?

4. What conditions have to be fulfilled by a characteristic for it to be used in testing for distinctness?

(a) Should the decision be taken species by species, account being taken of the development of plant breeding? If not, what common rules can be established?

(b) Should characteristics be considered that are not "capable of precise recognition" without means that are not normally available to:

(i) breeders

(ii) plant variety protection authorities?

(c) Before taking into account a new characteristic (i.e. a characteristic that is not yet included in the list of characteristics), must it be assured that to do so will not lead to a disturbance of the system of plant variety protection for the species in question, for instance by encouraging grants of plant breeders' rights that would prejudice rights already granted? What criteria are to be taken into account?

II. NOVELTY

Article 6 (1) (b) of the UPOV Convention:

"At the date on which the application for protection in a member State of the Union is filed, the variety

- (i) 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, in the territory of that State, and
- (ii) must not have been offered for sale or marketed, with the agreement of the breeder, in the territory of any other State for longer than six years in the case of vines, forest trees, fruit trees and ornamental trees, including, in each case, their rootstocks, or for longer than four years in the case of all other plants.

Trials of the variety not involving offering for sale or marketing shall not affect the right to protection. The fact that the variety has become a matter of common knowledge in ways other than through offering for sale or marketing shall also not affect the right of the breeder to protection."

1. What is covered by the expression "the variety" in the meaning of the above provision? Is it detrimental to novelty in the meaning of the above provision if material that is identical with the variety, but that has been developed independently by someone other than the breeder/applicant ("a parallel breeder"), is offered for sale or marketed (please note the connection with question I.1 above)? If the answer to this question is positive, whose agreement must have been given for the activity to be detrimental to novelty; that of the breeder of the variety the subject of an application for protection or that of the "parallel breeder"?

2. Is offering for sale or marketing detrimental to novelty if it takes place at a time at which the variety is not yet "finished" and is thus still a "quasi variety" (see question I.2 above), not yet completely fulfilling the conditions for homogeneity?

3. Is the offering for sale or marketing of a hybrid variety detrimental at the same time to the novelty of the parent lines?

III. SCOPE OF PROTECTION

Article 5(1) of the UPOV Convention:

"The effect of the right granted to the breeder is that his prior authorisation shall be required for

- the production for purposes of commercial marketing
- the offering for sale
- the marketing

of the reproductive or vegetative propagating material, as such, of the variety.

Vegetative propagating material shall be deemed to include whole plants. The right of the breeder 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."

1. What is meant by "propagating material of the variety" in this context?

- (a) Only material corresponding to the variety description and deriving from material of the breeder (the owner of the plant breeder's right)?

- (b) Also material identical with that referred to in (a) above, but originating from a "parallel breeder"?
- (c) Also material that may only be distinguished from material of the breeder to such a small extent that it cannot constitute another variety eligible for protection? In other words, material that is only distinguishable from material of the breeder by unimportant characteristics or by an important characteristic for which the difference is not clear?
- (d) Also material that is clearly distinguishable by one or more important characteristics from material of the breeder, but that has been developed manifestly to by-pass a breeders' right and that constitutes a slavish imitation of the protected variety?

Guidance for replying to the questionnaire:

1. In so far as there exist(s) in your country in respect of any of the above questions:

- (a) case-law,
- (b) decisions or other publications of authorities competent for plant variety matters,
- (c) doctrines or scientific articles,

please indicate this and add reprints (if necessary with translations or an indication where such translations may be obtained).

2. If necessary, you should indicate not only the present legal situation but also the solution that is considered desirable or that is thought to be preferable for the future.

3. Remarks (excluding remarks of a purely technical nature) on other legal questions or on questions of legal policy, if connected with the problems of distinctness, novelty, scope of protection or minimum distances between varieties, will also be most welcome.

4. To enable the Office of the Union to prepare quickly a synthesis of the replies, it would be helpful if the order and numbering of the questions is followed.

[Annex II follows]

REPLIES FROM THE DELEGATION OF THE
FEDERAL REPUBLIC OF GERMANY

Letter, dated February 21, 1983, from Mr. H. Kunhardt
to the Office of the Union

We reply to the questionnaire as follows:

I. DISTINCTNESS

1. Concept of "other variety"

(a) "Identical variety"

In terms of pure logic, the case on which Article 6(1)(a) is based is not conceivable. Identity means "the unity of being" ("Wesenseinheit"), and so logically precludes the assumption of two subjects that can be defined independently of each other. Conceptually, therefore, there cannot be "two identical varieties." What is meant by this expression could be better expressed as follows: the material submitted corresponds completely to material of an existing variety and so is not distinguishable from that material. This has the consequence embodied in Article 6 that protection may not be granted for the subject matter of the new application, either because such protection has already been granted for a variety with corresponding material and may therefore, by virtue of the exclusive nature of the right, not be granted again, or because a variety with corresponding material is already a matter of common knowledge, i.e. in the public domain, and may not be subsequently monopolized under a plant breeder's right.

Article 6 does not make the distinction just described, but rather reduces the requirement to the condition of "distinguishable... from any other variety." Therefore we work according to this concept in our decisions, despite the inherent logical inconsistency, and it generally enables us to solve outstanding questions. In a few cases, however, that logical inconsistency does become a legal problem, namely in the following situation:

If according to the above criterion, we discover, on looking at an application, that the material is not distinguishable from that of an existing variety, so that we would have to reject the application, it may happen that the applicant then changes his application and expressly claims protection for that other variety (should it not yet be protected in our country). This is not specifically precluded by Article 6. In this situation the question arises whether we are now obliged to examine the application to determine whether the applicant fulfills the personal requirements (in particular whether he is the "breeder") and whether novelty is still given. This would mean that the question whether an existing variety is "another" or "the" (the same) variety in relation to the subject matter of the application is ultimately determined by the applicant. This is an idea foreign to industrial property, and the problems arising from it will be treated below when we discuss novelty.

(b) "Almost identical varieties"

It is difficult to imagine a case in which the subject matter of the application corresponds to such a degree to an already existing variety that the material in question cannot be distinguished from that of the other variety if the most precise methods (for instance electro-focusing, gas chromatography) are used. Normally some technical differences can be discovered that are not clear, however. In these cases it is possible, from a technical standpoint, to speak of "another variety", for two "almost" identical varieties are logically not part of the same variety. Yet that does not settle the question of the legal consequences. In this context the following should be considered:

A "variety" that is not clearly distinguishable from "another variety" may well be situated in the area within which the "other variety" can itself vary without breach of the requirement of stability. This means that a breeder for whom variety A is protected and whose variety B is not clearly distinguishable from variety A, could market material of variety B as material of variety A. It follows from this that another breeder could also file an application for protection for the already existing variety A (but not yet protected in the State of application), submitting material of his selection B. Thus, legally, the same problem arises as that described above under (a).

2. Conditions that the "other variety" has to fulfill

It must be a variety which in the expression of its characteristics may be recognized and described, i.e. defined. As far as homogeneity is concerned however, it is important to establish how much a lack of homogeneity affects the possibility of defining the variety. A variety with a number of off-types slightly in excess of the tolerance could not, according to the general conception of our varietal provisions, be denied the status of "variety" on that ground alone, even though the conditions for granting protection (or registration in the national list of varieties) would not be fulfilled. This would only be the case if the group of plants (population) showed such a range of expressions of characteristics that it could no longer be defined precisely enough on the basis of those expressions.

3. Requirements for the "other variety" to be common knowledge

Since in the cases decided so far the other varieties have usually been varieties already protected or registered in the national list of varieties (in the country or abroad), there is no precedent for other cases. Subject to more precise examination when such a borderline case does arise, we are inclined to take the following view:

We regard the "entry in an official register of varieties... in the course of being made" referred to in Article 6(1)(a) as meaning the filing of an application for protection or for registration of a variety in the list of varieties. In the case of a hybrid variety the application form must, as with other varieties, be properly completed, which means that in addition to the specification of the hereditary components a description of the hybrid variety must also be given. If the application for the "other variety" is rejected because no propagating material, or not the right propagating material was submitted, then that variety is no longer considered commonly known if it has only been the subject of an application. A variety that has been the subject of protection or registration that has lapsed remains a "commonly known variety," even if it is no longer cultivated. Otherwise it would be possible to prolong variety protection simply by filing new applications after termination of protection, and the principle of the limited duration of plant variety protection written into Article 8 would be violated.

4. Requirements for the characteristics used in distinctness testing

(a) The question as to what characteristics are "important" for distinctness, and thus "permit a variety to be defined and distinguished" within the meaning of Article 6(1)(a), can only be decided according to the botanical characteristics of each species and to those relevant to plant breeding.

(b) "Defining and distinguishing" a variety is a particular task of the office charged with the granting of protection; indeed it is the basic work behind its decisions. The suitability of characteristics depends therefore, among other things, on whether they may be "recognized and described"--within the meaning of Article 6(1)(a)--with the means available to the office. However, it is considered necessary that the office should keep itself informed on the testing methods introduced in science and plant breeding, and to secure access to them.

(c) The scope of protection of a granted plant breeder's right does not imply that further rights may only be granted on the basis of those characteristics that were relevant to the first grant. The enlargement of lists of characteristics is therefore not regarded as upsetting the whole system of plant breeders' rights; on the contrary, it will often be necessary in order to maintain the efficiency of the system. The general criterion for it is whether the additional characteristic is "important." Whether this is true of a particular species has to be decided independently from case to case.

II. NOVELTY

1. Concept of "the variety"

Here the situation is as follows, if we take the observations made in Chapter I into account: If the material of a variety is not distinguishable from that from a parallel breeder, the case is examined first from the point of view of distinctness and possibly decided. A special situation arises where the applicant states in his application that he requests protection for the existing variety (which is not yet protected in the country). In that case the requirements of novelty would have to be examined. Usually this will show that the first breeder or other persons deriving their right from him have already marketed propagating material or harvested material of the variety. This cannot be held against the applicant under Article 6(1)(b)(i), however, since that marketing did not take place "with the agreement of the breeder" (meaning in this context the breeder/applicant). The consequences of this set of circumstances, which incidentally is foreign to industrial property, may be seen in the following examples:

(a) Breeder A creates a hybrid variety in country A from certain hereditary components, and secures protection for it (as a first step) only in country A. Breeder B also creates that hybrid from the same material (and is thus himself a breeder) and submits it for protection in country B, specifying that so far no material of the variety has been marketed with his agreement.

(b) Breeder A breeds a variety for which variety protection is not granted to him for lack of novelty since material has already been marketed with his agreement. Breeder B, as a parallel breeder, also creates the variety. No material has yet been marketed with his agreement, so that the lack of novelty cannot be held against him. It is obvious that this gives breeders the possibility of bypassing obstacles to protection by concerted action.

(c) A variety has been registered in the list of varieties for many years and may be multiplied and marketed by anyone who fulfills the conditions laid down by the law regulating the marketing of seeds. A breeder then creates the variety anew and applies for protection, again specifying that no material has been marketed with his agreement. Thus anyone could subsequently monopolize a successful variety that has long been freely available to all, by parallel breeding for that very purpose.

Protection granted in the above-mentioned and similar cases would lead to a result that is manifestly not intended according to the basic concepts of plant variety protection. It can therefore be maintained that applying for protection for an already existing variety, claiming thereby an independent breeding of the variety (parallel breeding) and the absence of the applicant's agreement to the marketing of material of the variety, would be contrary to the purpose of the Convention, so that parallel breeding would in each case have to be examined exclusively from the point of view of distinctness, regardless of the phrasing of the application. Since under such circumstances the logical problems mentioned earlier would arise again, and since the wording of Article 6(1)(b) does not expressly exclude such cases, there is no way of predicting the result of any legal proceeding that might arise on this question. In any case we believe it may be justifiably stated that the general conception of

Article 6, which combines the distinctness concept from traditional seed legislation (where that it had a certain justification) with the novelty concept derived from industrial property legislation, the latter having been adapted to the legal considerations peculiar to seed marketing (in that common knowledge of the variety itself, and even its marketing if performed without the agreement of the applicant, are not detrimental to novelty), is a cause of friction that shows up the systematic unsoundness of the whole set of rules.

2. Marketing of "unfinished" varieties

Marketing is detrimental to novelty if it has taken place at a time when the result of the breeding work could already be defined as a variety. In that connection we refer to the observations made in Chapter I, under 2.

3. Hybrid varieties

In our understanding, hybrid varieties and hereditary components are completely separate things from a legal point of view. It is therefore possible in our country to obtain protection separately for the hereditary components and for the deriving hybrid. Thus, if only the material of the hybrid is marketed, the novelty of the hereditary components is not prejudiced. The situation is different, however, if for instance material of the hereditary components is given to a grower as basic seed for the production of seed of the hybrid to be certified. In that case material of the hereditary components is marketed, with the resulting detrimental effect on their novelty.

III. SCOPE OF PROTECTION

1. Concept of "propagating material of the variety"

(a) We take this to mean material which may be identified according to the expressions of its characteristics as corresponding to the variety (true to the variety--"sortenecht").

(b) Material resulting not from the breeding work of the owner of the plant breeder's right but from that of another person can also be true to the variety. In that case the owner of the plant breeder's right may assert that right to prevent the other person from marketing the material he has produced (otherwise an existing plant breeder's right could be deprived of all effect). As for whether the owner of the right also has a claim to the other person's material, this is governed not by the law on plant breeders' rights but by the civil law provisions on real property.

(c) On the basis of the considerations in Chapter I, under paragraph 1, we regard it as conceivable, subject to future court decisions, that the exclusivity right of the owner applies also to the material of another person that differs somewhat, but not clearly enough, from the material of the protected variety. Otherwise one could reason in reverse as follows: if the plant breeder's right were not infringed by such similar material, there would be no obstacle to that material being considered an independent variety and to the grant of plant variety protection for it. So here again we find the conceptual inconsistency mentioned before. It would hardly be logical, in the granting procedure, to base the rejection of an application on the ground that the material submitted is not clearly enough distinguishable from material of a variety already protected, if on the other hand the applicant were allowed to market his material freely on the ground that that material is sufficiently distinguishable from the protected variety for the subject matter of protection to be unaffected.

(d) As we said before, it can be assumed that the exclusive right of the owner of protection applies to all material for which variety protection may not be granted for want of distinctness in relation to the protected variety. To that extent, therefore, the criterion determining the scope of protection ultimately corresponds to the criterion determining distinctness. For the examination of distinctness we establish characteristics that are important (and suitable) for distinguishing. The fact that newly-introduced characteristics may give breeders the chance to take a share in a type of variety that already exists and has proved successful, thereby restricting the commercial possibilities of other owners of protection, is an inevitable consequence of the nature of the protection right (see also the observations in Chapter I, under 4(c)). Another question of course is how far such considerations are taken into account when the "importance" of a characteristic is decided upon. As we said above in Chapter I, under 4, this is a question to be decided from case to case, according to species and characteristic. The conclusion seems clear in any event: protection does not cover material that is clearly distinguishable, by at least one established important characteristic, from material of the protected variety, since it could be granted protection of its own according to Article 6(1)(a).

IV. CONCLUDING REMARKS

On the above questions we have neither case law nor administrative regulations or official publications, nor do we know of any expert statements. So far all cases have been settled without recourse to court decisions (applications have been withdrawn, the breeders have come to a private agreement, etc.). We do, however, consider it useful to examine once again the normative philosophy of the Convention, and we shall therefore be submitting a paper on a possible new drafting of the provisions concerned with a view to avoiding the problems that have manifested themselves.

[Annex III follows]

REPLIES FROM THE DELEGATION OF
BELGIUM

Annex to a letter, dated February 18, 1983, from Mr. J. Rigot
to the Vice Secretary-General

I. DISTINCTNESS

1. Under Article 6(1)(a) of the UPOV Convention, an applicant variety must be clearly distinguishable by at least one important characteristic from "any other variety" whose existence is a matter of common knowledge at the time protection is applied for. If such other variety from a parallel breeder cannot be distinguished from the applicant variety, the latter cannot be protected.
2. However, the "other variety," with which the applicant variety is to be compared in order to judge distinctness, must be a true variety meeting the conditions for being entered as a finished variety in a catalogue or register.
3. Simple publication of a description of such "other variety" would not seem enough for that variety to be deemed a matter of common knowledge within the meaning of Article 6(1)(a). In addition, the genealogical formula, in the case of a hybrid variety deriving from parent lines that are common knowledge, should also be checked to ensure that the "other variety" does not simply exist on paper. All information, documents, identification material, deemed necessary for examining the applicant variety and the variety that is a matter of common knowledge and is claimed to be identical, should be available for establishing possible distinctness.
4. (a) The decision to use a new characteristic in examining for distinctness should be taken species by species, taking into account the level of development of plant breeding.
(b) and (c) A new characteristic should only be taken into account for examining distinctness if the following conditions are met:
 1. The method enabling the characteristic to be established should be capable of standardization and application without error both by breeders and by examining services;
 2. The interaction between environment and the characteristic should be clearly established;
 3. The characteristic should satisfy the requirements of homogeneity and stability;
 4. The characteristic should not endanger titles of protection that have already been granted nor disturb the system of protection for the species concerned.

II. NOVELTY

1. In our view, the term "the variety," within the meaning of Article 6(1)(b) of the UPOV Convention, covers reproductive or vegetative propagating material of the variety (Belgium). If material of an "other variety," which is a matter of common knowledge and cannot be distinguished from the applicant variety, has already been marketed or offered for sale by a parallel breeder, the applicant variety may no longer be protected. The "agreement of the breeder" referred to in this Article is of relevance only in the case of a new variety which is distinguishable from any variety that is a matter of common knowledge.

2. We do not feel that offering for sale or marketing of a quasi-variety is detrimental to the novelty of the variety derived from such pre-variety since protection is only given where the conditions of distinctness, homogeneity and stability of a variety are fully met.
3. We feel that offering for sale or marketing of a hybrid variety is detrimental to the novelty of the parent lines in those cases where:
 1. The unprotected parent lines belong to the breeder of the hybrid;
 2. The unprotected parent lines belong to a different breeder but have been used with his agreement for creating the hybrid.

III. SCOPE OF PROTECTION

1. (a) Propagating material of the variety, within the meaning of Article 5(1) of the UPOV Convention, is to be understood as the material referred to in items 1(a), (b) and (c).
1. (d) If the material is distinguishable by one or more important characteristics from the breeder's material, it is in fact no longer a slavish imitation of the protected variety, as noted in the questionnaire.

IV. CASE LAW

Three cases of infringement have been brought before the courts, two in the ornamental plants area (roses) and one in the agricultural plants area (cereals).

These proceedings are currently running and the decisions are likely to take a fair amount of time.

[Annex IV follows]

REPLIES FROM THE DELEGATION OF
FRANCE

Annex to a letter, dated March 2, 1983, from Mr. M. Simon
to the Vice Secretary-General

I. DISTINCTNESS

I.1 A variety cannot be both one and the same variety and another variety. It is defined by the plant material composing it. Material stated to be identical or almost identical supposes the existence of like material. Identical or almost identical material bred independently by someone else must necessarily be considered in relation to that of the applicant variety. Since no identical or almost identical material could be distinguished from like material, the application should be examined under the following hypotheses:

- the identical or almost identical material corresponds to a variety that is common knowledge (earlier material than that of the application). The application for protection must be rejected for lack of distinctness.
- the identical or almost identical material does not correspond to a variety that is common knowledge. The title may be issued to the applicant who has filed the first application, subject to the material corresponding to a distinct, homogeneous and stable variety.

the applicant or the holder of a title will of course assert his rights in respect of any material that is identical or almost identical to that of the protected variety. In the event of opposition, it will be for a court to decide whether there exists a imitation or infringement.

- protection of identical or almost identical material which is not common knowledge and has been bred independently by a person is applied for by that person later than the initial application registered for like material [in the name of another person]:
 - (a) under a different name: the application must be refused for lack of distinctness;
 - (b) under the name given in the initial application: the application must be rejected since the name refers to "protectable" or protected material.
- the type of material referred to above is the subject of an initial application for protection in country B, whereas the application is of a later date than that filed in country A for like material:
 - (a) under a different name: the application must be rejected for lack of novelty;
 - (b) under the name given in the initial application: the application must be rejected; this has not been the case in the Netherlands.

Incidentally, it is open to question whether another person having personally and independently bred, prior to the application for protection, a variety represented by identical or almost identical material, would be committing an infringing act if personally exploiting the variety without being authorized by the owner of the protection, although he had proved that he was in good faith the personal prior owner.

In this respect, Article 31 of the Patent Law of January 2, 1968, as revised on July 13, 1978, reads as follows:

"31. Any person who, within the territory where this Law applies, at the filing date or priority date of a patent, was, in good faith, in possession of the invention which is the subject of the patent shall, despite the existence of the patent, enjoy a personal right to exploit that invention. The right granted under this section is only transferable with the business to which it belongs."

- I.2 An unfinished or quasi-finished variety (lack of homogeneity or stability) cannot be the subject of a plant breeder's certificate. The plant material corresponding to a "quasi-finished" variety may be used, however, as a reference for determining the novelty of any new plant material for which protection is applied for. The conditions for this are that the "quasi-finished" variety is common knowledge and that its various components are observable and identifiable.

Among the varieties that are common knowledge, only those should be taken into account that are marketed or officially entered in a catalogue, an official register or an officially recognized trade register. These variety references are only of relevance if accompanied by detailed variety descriptions. The name of the species, the variety denomination and the date of registration must be clearly stated, as must where relevant the name of the breeder (and) or the person having applied for registration. A representative sample of the variety must also be available.

Any quasi-finished variety, other than those referred to above, for example which is the subject of an application for registration or for protection and is then rejected for lack of homogeneity or of novelty, must, on the other hand, be excluded from the varieties that are common knowledge.

- I.3 The requirement of "publication" in order to establish common knowledge of a "quasi-finished" variety must be the same as that used for "conventional" varieties, including the availability of a representative sample of the variety.

Publication of the formula in the case of a hybrid variety enables any other person to reproduce it faithfully. It contributes, if accompanied by information (variety behavior, description, seed produced) to making the hybrid variety common knowledge.

The fact that a variety has been marketed or offered for sale prior to filing of the application can be invoked as establishing common knowledge against the applicant or indeed against anyone else and prevents the issue of a certificate. The fact that the variety has become common knowledge by any other means (publication of a list, presence in a reference collection, publication of a hybridization formula, use in hybrids) cannot be invoked against the breeder, or his successors in title, applying for protection. On the other hand, it can be invoked against any other person subsequently presenting another variety which is not distinguishable from it, with a view to establish common knowledge of that variety.

- I.4 Whatever may be the origin, artificial or natural, of the initial variation from which it has resulted, the variety must be clearly distinguishable by one or more important characteristics from any other variety whose existence is a matter of common knowledge; such is the requirement that must be met for a variety to be eligible for protection.

- (a) It is for each State to draw up, species by species, a list of those characteristics that are recognized as being important. A characteristic is deemed important if shown in the list with the note "compulsory." Other characteristics may be declared to be important at the request of experts. In all events, an important characteristic must be discriminating and it must be possible to observe and describe it in accordance with a reliable method.
- (b) There is no "a priori" reason to exclude from the list of important characteristics those that may only be observed with exactitude with the aid of advanced instruments or sophisticated methods. However, these instruments or methods should be known to breeders and to plant variety protection services.

- (c) It is indeed necessary, before selecting the new characteristic, to ensure that it will not disturb the plant variety protection system by encouraging the issue of titles of protection that could cause damage to titles previously issued. Any additional characteristic modifying neither the morphology of the plant nor the physiological characteristics usually observed should be rejected unless it serves as a back-up characteristic to confirm a perceptible difference which is not easily observable or measurable.

Distinctness as between two varieties is decided by the distance separating the observed variety aspects for one and the same characteristic. This distance must be big enough to avoid any overlap due to the fluctuation inherent in any aspect of a characteristic in a case of a plant belonging to a self-fertilizing species.

Distinctness should derive from a different approach, which has in fact been abundantly described, for plants belonging to cross-fertilized species.

II. NOVELTY

- II.1 The term "variety" covers
- propagating material (seed or seedlings)
 - plant material derived from propagating material.

Offering for sale or marketing of material that is identical or almost identical to the variety will cause the concept of novelty to be lost if the first offer for sale or the first marketing was made before the application was filed (reference to varieties that are common knowledge), except where such offer for sale (or marketing) has been made without the knowledge of the breeder with the intention to knowingly prejudice his breeder's rights.

The concept of "parallel breeder" does not exist.

It is for the official authorities alone to determine, on the basis of the sequence of events, whether the application for protection satisfies or does not satisfy the concept of novelty.

- II.2 Where a quasi-variety is one of the varieties that are common knowledge, offering it for sale or marketing it may prejudice novelty in the same way as in the case of a finished variety.
- II.3 Offering for sale or marketing of a hybrid variety is not prejudicial, according to the Convention, to the novelty of its parent lines if they have not themselves been offered for sale or marketed.

The present terms of the Convention mean that these lines may be used regularly under official control over a long period for manufacturing a hybrid variety, without losing their novelty. This is a matter for thought.

III. SCOPE OF PROTECTION

1(a), 1(b), 1(c): No distinction should be made between the material referred to in 1(a), 1(b) and 1(c) since this would lead to imitation and infringement.

1(d): If the material is distinguishable by one important characteristic, it corresponds to another variety. If, on the other hand, it constitutes a slavish imitation of a protected variety, it will be necessary to review the concept of important characteristic and minimum distance used for distinguishing varieties.

ANNEX V

REPLIES FROM THE DELEGATION OF
ISRAEL

Extract from a letter, dated March 16, 1983, from Mrs. H. Gelmond
to the Vice Secretary-General

I. Distinctness1. "A variety that is identical or almost identical" ... etc.

The question is what is meant by "almost"? I am afraid we are drifting again to the problem of "minimum distances". When examining a variety or comparing between varieties, we refer to the final product, the finished variety only. As such, varieties are considered to be identical even when their mode of production or breeders vary.

2. Must the variety be a "finished variety" to be compared with the "other variety"?

Yes. The "other variety" cannot be a "quasi-variety" or a plant population. It has to be finished and homogeneous, as much as possible.

3. Is a description of the breeder, published or submitted to the PVR Office sufficient for it to be considered to be of common knowledge?

Only when the description specifies the mode of production in such a way that a person with professional training can reproduce it in accordance with the particulars so made known, then the variety can be considered to be of common knowledge. As to a hybrid, it is sufficient to indicate the formula if the parents are of common knowledge. Furthermore, it must be certain that the variety does not exist on paper^{only} by having its propagative material in the possession of the breeder, available upon demand, in both above-mentioned cases.

4. a. What conditions have to be fulfilled by a characteristic to be used in testing for distinctness?

The decision should be taken species by species. Generally speaking, the characteristics used in testing for distinctness should be clearly distinguishable by the examiners.

b. Should characteristics be considered that are not "capable of precise recognition" without means that are not normally available to breeders or to plant variety protection authorities?

We cannot imagine a situation whereby a characteristic was declared to be found that cannot be tested by anyone. If not by the breeder nor the plant protection authorities, then perhaps by someone else within reach.

c. What conditions are to be fulfilled for a new characteristic to be taken into account?

Every new characteristic found that can contribute to the distinguishing of a new variety, is to be considered and added to the list of characteristics. However, the fact that such a characteristic was not considered in the past, does not mean we should continue to ignore it in the present.

II. Novelty

1. Is it detrimental to novelty if material, identical with the variety but that has been developed independently by someone other than the breeder/applicant is offered for sale?

As accepted, priority right is given to the first breeder/applicant. Thus, if a permission is required for the sale of the propagative material, it should be taken from the first applicant/breeder. The relationship between the first applicant/breeder and the "parallel breeder" is a matter for the court to decide.

2. Is offering for sale or marketing detrimental to novelty when the variety is not yet "finished"?

When a variety that is not yet "finished" is being offered for sale or marketed, it could perhaps be detrimental to novelty. But, as we are concerned only with finished varieties, we do not see what we can do about it.

3. Is offering for sale or marketing of a hybrid variety detrimental at the same time to the novelty of the parent lines?

No. It is not detrimental to the novelty of the parent lines as long as the formula of the hybrid is not specified.

III. Scope of Protection

1. a. Does propagating material of a variety refer only to the material corresponding to the variety description...?

The answer is positive.

- b. Does propagating material also refer to material originating from a "parallel breeder"?

The answer is negative.

- c. Also material that may only be distinguished from that of the breeder to such a small extent that it cannot constitute another variety eligible for protection?

We do not quite understand the question. If the characteristic is distinguishable, then it is a new variety. If the difference is unclear, then it cannot be clearly distinguishable.

- d. Also materialthat constitute a slavish imitation

If the propagative material of the variety is clearly distinguishable by one or more important characteristics, then it is a new and another variety and should be treated as such.

REPLIES FROM THE DELEGATION OF
NEW ZEALAND

Extract from a letter, dated February 18, 1983, from M. F.W. Whitmore
to the Office of the Union

- I. 1. A variety that is identical or almost identical with the variety that is the subject of an application, but that has been bred independently by someone else, should be regarded as being the same variety as the subject of the application.
- I. 2. We believe that the "other variety " does not necessarily have to be a "finished variety" and that we should, and in fact do, compare a variety which is the subject of an application with varieties that may not necessarily fulfil UPOV requirements for homogeneity. (Such a situation can be a reality in New Zealand - because this country does not have a Seeds Act it is possible for "quasi-varieties" to be marketed.)
- I. 3. To the question "Is a description by the breeder, published or submitted to the plant variety protection office, sufficient?", with respect to the general policy followed in New Zealand for reasons of practicality, our answer is "no." For us to regard the particular variety as one of common knowledge it would also be necessary that it
- had been sold or offered for sale, and
 - that reproductive material still be available.

However we recognize that in specific instances we may be obliged to recognize another variety to be one of common knowledge on the basis of a description alone.

I would add that the question "what is a variety of common knowledge?" is currently under discussion in New Zealand.

We offer no answer to the questions relating to hybrids because we have had no practical experience in this Office with these varieties.

- I. 4. (a) Such a decision should be taken species by species.
- (b) We do not see a particular problem here. If there was a possibility that distinctness might be established to our satisfaction using equipment or a technique not normally available to breeders or to this Office, we would be prepared to accept the results of work carried out by a competent person or organisation with the special equipment or technique - at the applicant's expense.

- (c) It is evitable that from time to time new characteristics must be taken into account. Also this Office accepts that for the purpose of granting rights, distinctness may be established using a characteristic not included in the list of characteristics in the UPOV Guideline or in the New Zealand objective description form. When utilising new characters we appreciate that there is a risk of prejudicing rights already granted - with earlier rights grants the varieties may well display heterogeneity with respect to the characteristic. However in practice there has been no evidence that such a policy has actually disadvantaged holders of existing rights - although admittedly our scheme is comparatively young and numbers of protected varieties not large. Our breeders have some understanding of the consequences of our policy and accept the risks involved.
- II. 1. It would be detrimental to novelty if material developed by the "parallel breeder" is offered for sale or marketed. It would be detrimental if the agreement had been given by the "parallel breeder" (or indeed if given by the breeder of the variety that is the subject of the application - although it is hard to envisage the latter breeder being in a position to give such agreement.).
- II. 2. Yes.
- II. 3. No (our answer is on theoretical grounds - we have no practical experience of this situation).
- III. 1. "Propagating material" should include the material referred to in (a) and (b). In theory it should also include the material referred to in (c) - but this might not necessarily happen in practice. It is possible that material as referred to in (c) could be sold without the knowledge of the breeder of the protected variety. If the latter was aware there could well be a dispute which, if not settled between the parties concerned, could be decided by the Court.

According to our understanding of the UPOV Convention and New Zealand legislation "propagating material" does not include the material referred to in (d). The motives involved are quite irrelevant.

[Annex VII follows]

REPLIES FROM THE DELEGATION OF THE
UNITED KINGDOM

Letter, dated February 25, 1983, from Mrs. J.M. Allfrey
to the Vice Secretary-General

Your letter of January 20 requested replies to a questionnaire on minimum distances (circular U771-08.1). I am enclosing some replies to these questions which relate to fundamental and difficult problems. Ultimately interpretation of such points must lie with the Courts in the UK and we have, as yet, little case-law. Therefore the replies are the personal opinions of some of those in the UK involved in Plant Breeders' Rights. I should add that, because of the time limit for reply, we have been unable to consult as widely or consider these points as deeply as might have been desirable.

Your paper also requested any relevant decisions, case-law etc. There are two decisions of the Plant Varieties and Seeds Tribunal relating to distinctness which may be of interest. The first relates to a spring wheat, Rothwell Sprite, and can be found in the Plant Varieties and Seeds Gazette No 32 October 1967 p26-28. The second relates to a ryegrass, Prego, and was published in the Gazette No 131, December 1975 p37-46.

SECTION I - DISTINCTNESS

- (1) If two plant populations are not clearly distinguishable ^{are considered} we consider them to be the same variety as far as plant breeders' rights. Their origin is immaterial. We have, in several cases rejected applications where an applicant "variety" was not clearly distinguishable from an existing variety although there may be grounds for considering the two separate "varieties" in purely biological terms.
- (2) For practical reasons it is generally only possible to compare an application with "finished" varieties. If a so-called "quasi-variety" is not homogeneous it is not a variety and we have no firm standard against which to compare the application.
- (3) The PVRO would normally wish to have access to the "other variety" in a reference collection since it is difficult, if not impossible, for any written description to be sufficiently precise to enable a decision on distinctness to be made. However, if it could be made sufficiently precise, a description in a reputable journal might be acceptable. A formula for a hybrid would have to describe the characteristics of the hybrid as well as its formula.
- (4)(a) The decision should be taken on a species-by-species basis.
- (b) It is generally not desirable to test distinctness on the basis of characteristics that can only be detected with means not normally available to breeders or plant protection authorities. It would be undesirable to employ characteristics which breeders are unable to recognise and describe since they would not have the opportunity to ensure that candidate varieties

were sufficiently uniform. However, the methods available are continually developing and we would review the characteristics used in the light of these changes in consultation with UPOV and with breeders. Should a breeder claim that a particular characteristic, which would not normally be measured, distinguishes his variety from all others we should have to investigate this aspect provided it did not entail undue effort or expense and could be measured by reproducible procedures ("Prego" Tribunal, Gazette No 131, December 1975).

- (c) We should always endeavour to ensure the minimum disturbance by full consultation with interested organisations before taking account of a new characteristic. However, no breeder can expect to have a guarantee that new developments will not allow a new plant population, previously indistinguishable from his variety, to be recognised as a distinct variety.

SECTION II - NOVELTY

- (1) If material identical with an applicant's variety had already been offered for sale or marketed the applicant's variety would not be considered distinct. The question of novelty then becomes irrelevant.
- (2) A "quasi-variety" is not a variety within the meaning of the Convention.
- (3) No. The marketing of a hybrid variety need not affect the novelty of the parent lines.

SECTION III - SCOPE OF PROTECTION

- (1) (a) No. This definition is too narrow.
- (b) Yes.
- (c) and (d). It is difficult to answer generalised questions as each case would have to be examined on its own merits. Ultimately interpretation would rest with the Courts. However, in the majority of cases we should expect the answer to (c) to be "Yes" and (d) to be "No" despite the arguments for the two populations suggested in (c) being different varieties in the biological sense.

ANNEX VIII

REPLIES FROM THE DELEGATION OF
SWEDEN

Annex to a letter, dated March 10, 1983, from Mr. O. Svensson
to the Vice Secretary-General

I Distinctness

1. According to the preparatory studies on which the Swedish legislation is based, a parallel variety is to be regarded as "another variety".
2. The "Other variety" must be a variety, which is a distinct, "finished" variety. Consequently, a "quasivariety" is not "another variety".
3. An application accompanied by a variety description submitted to the Swedish Plant Variety Board is immediately available to the public in Sweden and thus regarded as a matter of common knowledge. Article 3, second section of the Swedish Law reads: "A plant variety shall be deemed known if material thereof has been commercially offered for sale or otherwise been made available, or if it has been the subject of an entry in an official list of varieties or of an application for such purposes, if it appears in a reference collection accessible to the public, if it has been the subject of a precise description in written matter accessible to the public, or if it has otherwise come to public knowledge."

In the extension and for practical reasons the description would have to be verified in an official test.

As regards hybrids, we have little experience from practice but in our opinion the formula is not sufficient. Also the resulting hybrid needs to be described.

4. From the preparatory studies to our legislation is quoted: "it is not possible to precisely earmark characteristics regarded as sufficiently important or distinctive to identify varieties. The importance of characteristics is in first hand related to the species but certain conditions in a particular case would have to be taken into account. A less important characteristic from identification point of view may for a certain variety be decisive and thus regarded as important."
- (a) Yes
 - (b) Yes. The Swedish Board has accepted characteristics described and recognized by methods not normally available to the Board e.g. erucic acid content/gaschromatography, chemical composition/statistical analysis.
 - (c) For the time being we are not prepared to express a definite opinion.

II Novelty

1. Reference is made to I 1.
2. A "quasi-variety" is not yet a variety. Thus the marketing of the variety would not be detrimental to the novelty of a variety. However, we realize that this point of view may lead to consequences hard to tackle in practice.
3. We have little experience from hybrids but theoretically the reply would still be 'No'.

III Scope of Protection

1. (a) No. Also material corresponding to the description but not necessarily deriving from material of the breeder.
(b) Yes.
(c) Yes.
(d) No and with the same comment as in II:2.

[Annex IX follows]

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ANNEX IX

REPLIES FROM THE DELEGATION OF
SWITZERLANDLetter, dated February 23, 1983, from Mr. W. Gfeller
to the Vice Secretary-General

With your circular No. U 771-08-1 you invited the members of the Administrative and Legal Committee to reply to particular questions on legal aspects of minimum distances between varieties.

Before we try to reply to your questions in detail, we wish to state that so far we have not conducted any practical examinations of varieties on homogeneity, distinctness and stability. We could neither consult well-known literature on such questions nor could we have recourse to case-law or decisions of our own office in comparable cases. Our reply to your questions thus reflects only the present state of our understanding of the problems put on the table by you. With the deepening of our understanding, the one or other reply could in future be different.

From Swiss breeding circles we were informed that the expression "Mindestabstände" might lead to confusion as it might be understood as signifying distances (in terms of length) between varieties in cultivation. Maybe the better French expression "écart minimal" could be translated into German by "Minimalunterschied" (in English: "minimal difference") in order to avoid any such misunderstanding.

In assuming that basically only an original (in its nature new, creative) breeding result should be recognized and protected, we reply to your question as follows:

- I. 1. If in all characteristics which can be examined, another variety is identical with the variety in question, then we have one variety. What is not quite satisfactory in this answer is the certainty that no examining technique will ever be sufficiently fine to assess and qualify truly all characteristics and attributes of a plant. An actual example of this is the assessment of the protein content in wheat.
2. Homogeneity is only a condition for the granting of a plant breeder's right. If the other variety exists and may be recognized and described, it can be used in the comparison.
3. Basically we consider a variety only then as existing if it is not only precisely described in a publication, but also is existing in the form of propagating material. As a border case to which we cannot give an answer, the "theoretical" question remains whether a variety which was precisely described in a publication but was never marketed by the breeder and the propagating material of which only leads unused life, may be held against an identical variety if the second breeder has discovered a market hole overlooked by the first breeder.
4. (a) Yes, whereby we mean species by species.
(b) This would be a question to be discussed with the breeders organizations.
(c) The examinations must be open to modification in order to consider new knowledge and new technique. We have difficulties in replying to this question since we cannot imagine how the plant breeders' rights system may be disturbed by the introduction of additional characteristics, in particular if they are only applied to future varieties.

- II. 1. Either it is indeed detrimental to novelty that material corresponding to the variety is marketed which comes from the breeder himself, or the requirement of distinctness from a variety already known is not met. In both cases the conditions for granting plant breeders' rights would not be satisfied.
2. As under I.2 we recognize under these conditions also the unfinished variety.
3. We are of the opinion that parent lines do not enjoy protection via the hybrid variety so that a breeder may, without agreement of the owner of the right in the hybrid variety, use those lines for the combination of other hybrids. Obviously many breeders share this opinion, for in Switzerland most parent lines of protected hybrid varieties are protected on their own.
- III. 1(a) Propagating material of a parallel breeder which is identical with
(b) the variety is propagating material of the variety. Though we mark in the register of rights who is the holder thereof, the right is attached to the variety. This has the consequence that the variety prevents an identical variety from being protected and submits by reason of the scope of protection its propagation to the agreement of the owner of the right. The judge would not consider as a valid defence the statement that the material came from a parallel breeding of an identical variety which would not fall under the scope of protection of the protected variety.
- (c) According to the letter of the Convention the expert conducting the
(d) examination is obliged to examine and to consider all characteristics which make a difference, without assessing the value. There might, nevertheless, be a certain discretionary power admitted, according to which breeding efforts manifestly undertaken only to bypass the protection would be examined according to more rigid standards than other breeding efforts. The limits for this discretionary power would be the subject of more intense discussions.

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