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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Thirteenth Session
Geneva, April 4 and 5, 1984

REPORT

adopted by the CommitteeOpening of the Session

1. The Administrative and Legal Committee (hereinafter referred to as "the Committee") held its thirteenth session on April 4 and 5, 1984. The list of participants is given in Annex I to this document.
2. The session was opened by Mr. M. Heuver (Netherlands), Chairman of the Committee, who welcomed the participants.

Adoption of the Agenda

3. The Committee adopted the agenda as given in document CAJ/XIII/1.

Adoption of the Report on the Twelfth Session of the Committee

4. The Committee adopted the report on its twelfth session on the basis of the draft after having approved a number of minor amendments. The final version of the report is given in document CAJ/XII/8.

Intentions of Member States Regarding Amendment of National Plant Variety Protection Law

5. The representative of Belgium announced that the fees charged for variety examination had been increased as of March 29, 1984.
6. The representative of Denmark announced that the committee set up by the Ministry of Agriculture to study a revision of the law on plant variety protection had met recently. Furthermore, two matters of current concern to the interested circles, mainly the horticultural producers, were:
 - (i) the fact that producers were being offered contracts requiring them to pay royalties for non-protected varieties that were covered by a trademark;
 - (ii) the fact that one or the other species was not protected by all member States, thereby leading to a distortion of competition at international level.
7. As to the first matter, the representative of Denmark stated that the Danish authorities could possibly study the advisability of prohibiting that practice. The Vice Secretary-General mentioned that the matter had also been raised in the Committee for the Protection of Plant Breeders' Rights of the International Association of Horticultural Producers (AIPH) at its meeting held

in Berlin on January 27 and 28, 1984. Some of the producers had protested at that meeting against contracts that covered more than one variety or which concerned varieties that were not as yet protected. The AIPH Committee had examined the possibility of drawing up a model contract and had decided to hold a joint meeting with CIOFORA to that end. The meeting had taken place in Paris on March 9, 1984, but no results had been forthcoming. It had been felt at that meeting that UPOV should look into the question of contracts between breeders and producers. The Committee agreed that, for the time being, UPOV should go no further than to follow attentively any further developments.

8. As for the second matter, it was decided to enter on the agenda for the next session an item headed "harmonization of the lists of protected species." It was also pointed out that the fact that a species was covered by the plant variety protection system in two member States did not mean that the breeder of a variety would ask for protection in those two States nor that he would grant licenses on the same terms in those States and therefore distortion of competition resulting from the breeder's commercial policy remained quite possible.

9. The representative of Ireland announced that extension of protection was being prepared for swede rape, cocksfoot, field bean, timothy, field pea, hybrid ryegrass and Italian ryegrass.

10. The representative of Italy announced that the Parliament of his country would be soon authorizing ratification of the 1978 Act of the Convention and the resultant amendment to the Law on Plant Variety Protection. Additionally, the Ministry of Agriculture was intending to propose abandoning the current system based on an adaptation of patent legislation and adopting a specific system of plant variety protection similar to that in force in most of the UPOV member States.

11. The representative of Japan repeated that the Japanese authorities were envisaging an extension to the list of protected genera and species but were faced with the problem of choosing the new genera and species in view of the limitations imposed by the workload of the examining services.

12. The representative of the Netherlands announced that, as of April 1, 1984, protection had been extended to Christmas and Easter cactus, cotoneaster, spindle tree, busy lizzie, mahonia, eryngo and cinquefoil. In addition, protection previously provided for florists' chrysanthemum and carnation had been extended to the whole of the genera concerned.

13. The representative of the United Kingdom informed the meeting that extension of protection to Choisya, Crocosmia, Curatone, Euphorbia pulcherrima, ornamental Fragaria, Gerbera, Nerine, Ribes partim (red currant), Rubus and Rubus hybrids and Zygocactus (and neighboring genera) was in preparation.

Evaluation of the Results of the Meeting with International Organizations held on November 9 and 10, 1983

14. Discussions were based on documents CAJ/XIII/2 and IOM/I/11.

a. General Discussion

15. It was noted that discussions at the meeting with the international organizations had not been particularly open. The Committee therefore felt that it should be proposed to the Council that future meetings of that type should take the form of a discussion between representatives of the member States and UPOV and representatives of the international organizations and should no longer constitute a hearing.

16. The representative of Switzerland was of the opinion that a great amount of work could be avoided if the international professional organizations were invited regularly to participate in the sessions of UPOV bodies instead of being invited to a special meeting once a year or once every two years. It was pointed out in that context that certain States were firmly opposed to such participation.

b. Minimum Distances Between Varieties

17. It was felt that the general conclusion to be drawn from the meeting with the international organizations was that although problems were possible they should in any event be settled on a species-by-species basis.

18. The Committee considered that questions 3 to 8, 10 and 13 raised in document CAJ/XIII/2 were of a mainly technical nature and were therefore to be examined by the Technical Committee. However, questions 6 and 7 comprised an important legal element and would be examined by the Committee on the basis of the conclusions reached by the Technical Committee.

19. Question 1. - The Committee held that the concepts used in the Convention to describe minimum differences, particularly in the provision that "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," did not need interpreting in a way different from current acceptance nor did they need more precise interpretation.

20. Question 2. - The Committee felt that the concept should be maintained of a characteristic being considered "important" once it was "important for distinguishing the variety" whether or not it was additionally a functional characteristic. However, it appeared to be a task for the Technical Committee to determine whether the considerations set out in paragraph 9 of document IOM/I/3 were to be confirmed or modified.

21. It was pointed out that the opinion that the drafters of the Convention had been thinking of "a characteristic important for the economic value of the variety" when they chose the term "important characteristic" (see paragraph 15 of document IOM/I/11) was not justified. However, the Records of the 1957-1961 Diplomatic Conference were not very explicit in that respect.

22. Question 9. - It was pointed out that although the exclusion of hybrids from protection could represent a technical solution, it would meet with legal obstacles in various States, particularly as a result of Article 2(2) of the 1961 Convention, which included hybrids in the definition of the word "variety" for the purposes of the Convention.

23. Question 11. - That question had to be answered by the technical bodies of UPOV. Nevertheless, the Committee held that meetings with breeders working with a given species, organized by the examining authorities at the place of examination, similar to that held in the Federal Republic of Germany in respect of Begonia Elatior, were to be preferred to participation of breeders in sessions of the Technical Working Parties.

24. Question 12. - It was emphasized that the wording of the Convention did not permit the breeder to be given a "droit de suite" in mutations derived from his variety: any mutant could be protected in the name of the person who had bred it or discovered it, irrespective of the amount of breeding work that had been done, if it were clearly distinct from the other varieties--particularly the mother variety--in one or more important characteristics. In fact, the problem under discussion was not so much that of mutations but indeed that of minimum distances and, consequently, solutions, at least partial ones, could be found in a consensus on the question of those distances. It was also pointed out that although it was sometimes attempted to resolve the problem contractually, that procedure met with legal obstacles in some States. Furthermore, the producers were opposed to that solution as had been shown in recent discussions held between representatives of AIPH and representatives of CIOPORA.

c. International Cooperation

25. Question 14. - The Committee felt that realistic thinking demanded that the current policy be continued, that is to say concluding bilateral agreements for cooperation in examination on the basis of a UPOV model agreement.

26. Question 15. - The Committee held that a general stance could not be taken at international level on whether a breeder had the right to request a purely national examination instead of an examination carried out by another State

within the framework of cooperation. Indeed, the matter depended on national law, on the situation as regards examination (some States did not examine certain species or no longer did so) and possibly on the circumstances of the individual case.

27. Question 16. - It was felt that the four-year period laid down by Article 12(3) of the Convention for supplying additional documents and material did not constitute a restraint on international cooperation. Indeed, it only applied where such documents or material were necessary and did not comprise a right for the breeder to have the decision postponed at his request.

28. Question 17. - It was noted that the replacement of the network of bilateral agreements by a multilateral agreement encountered various problems resulting, in particular, from the differences existing between the current agreements. On the other hand, the introduction of centralized filing of applications should be envisaged as soon as possible. Finally, the granting of a title of protection by one State for a number of States and the automatic acceptance of titles granted in another State appeared problematic and would not seem to offer any great additional advantages over centralized applications and examinations. Such possibilities could however prove of interest to a small country, such as Luxembourg, where they had in fact been proposed.

29. Question 18. - It was explained that the question had been put, in particular, as a result of the expansion of the Union. UPOV now included States on the five continents, subject to climatic conditions that differed greatly, of which some were additionally members of regional economic unions. As a result, there were fields well suited to initiatives and activities pursued within restricted groups of member States. Three considerations were advanced in that context:

(i) It was preferable that matters concerning plant variety protection be examined within the framework of UPOV even where those same problems also arose in other fields, as was the case for the examination of distinctness, homogeneity and stability (also carried out in respect of the entry in national catalogues of varieties authorized for marketing). UPOV was indeed better placed for consultations between all of the member States and coordination between them than were bodies that were either more restricted or had more general tasks.

(ii) Nothing prevented the setting-up of limited groups of States having the same problems. On the contrary, Articles 29 and 30(ii) of the Convention foresaw the conclusion of special agreements for the protection of new varieties of plants and individual contracts with a view to the joint utilization of the services of the authorities entrusted with the examination of varieties. It was, however, essential that such groups should inform the other States of their intentions so as to enable them to participate in the best possible way if they so wished since it was much easier to amend a project than to change a decision or a final text if the need was then felt.

(iii) It did not at all seem necessary to set up new limited groups. A better solution would be to draw up agendas for the sessions of bodies of the Union on which the matters of special interest to certain States would be grouped together. This would enable the different States, particularly those located a long way from the headquarters of UPOV or from the venue for the meeting concerned, to decide more easily on the advisability of being represented at the meeting and, therefore, to participate more actively and more effectively in the work of the Union.

30. Question 19. - It was emphasized that it was quite legitimate and even desirable for an organization to study the projects of other organizations where those projects, of course, also concerned it. It was thus to be regretted that UPOV had not attempted to reach a common point of view on the recent proposals made by FAO as regards genetic resources, as far as their links with plant variety protection were concerned.

d. UPOV Recommendations on Variety Denominations

31. Question 20. - The general conclusions that could be drawn from the meeting with the international organizations were that the opinions expressed by the breeders' organizations were not new and that, consequently, any discussion

could but be a repetition. However, it appeared that those organizations, or at least most of them, were not opposed to the principle of drafting recommendations but only criticized certain points in the text submitted to them, which were too inflexible in their view. Furthermore, the comments made by AIPH showed clearly that some form or other of recommendation was necessary in the interests of the users of varieties. That being the case, the Committee agreed that of the various solutions available (maintaining the former Guidelines for Variety Denominations, application of the International Code of Nomenclature of Cultivated Plants, new recommendations), a text based on the Recommendations on Variety Denominations would be best able to reconcile the needs and interests of all parties.

32. Questions 22 and 23. - The Committee agreed to entrust a drafting committee, composed of Mr. Espenhain (Denmark), Mr. Kunhardt (Federal Republic of Germany), Mr. Schneider (Chairman of the International Commission for the Nomenclature of Cultivated Plants) and the Office of the Union, with the finalization of the Recommendations for Variety Denominations with a view to submission to the Council for adoption.

33. Question 24. - The documents reproduced in Annexes II and III to this report were distributed during the meeting in order to give detailed information on the variety registration system recommended by CIOPORA. The Committee did not feel that there was any need to examine that system but agreed to enter it on the agenda for its next session should the need be felt.

e. Action to be Taken on the Documentation Relating to the Meeting with the International Organizations

34. The Committee considered that the documentation relating to the meeting with the international organizations should be given limited circulation, for the time being at least, pending a possible decision by the Council, to the authorities and to the participants at the meeting. In addition, the Office of the Union was requested to inform the organizations concerned as to the procedure for following up the work of that meeting.

Biotechnology and Plant Variety Protection

35. Discussions were based on document CAJ/XIII/3. A detailed report is given below since the matter was entered on the agenda for the session mainly to enable the Symposium to be held on October 17, 1984, at the time of the eighteenth session of the Council, to be correctly prepared and also because the request was made that certain statements be recorded in the report.

36. Introducing document CAJ/XIII/3, the Vice Secretary-General emphasized that the biotechnological methods, techniques and processes of particular interest under this item of the agenda were those already used or envisaged for creating new plants and therefore destined to replace the traditional methods of plant breeding or to supplement them. From the point of view of legal protection, the prime comment to be made was that the system based on the UPOV Convention was open to all new varieties whatever the means--conventional or depending on genetic engineering--adopted to breed them. However, it appeared that certain quarters, particularly those developing new genetic engineering techniques, were not happy with that type of protection that applied to the product alone, and wished to obtain protection for the techniques by means of industrial patents, that is to say process patents. Such patents gave less effective protection than product patents or, in the case in point, plant variety protection certificates (or plant patents). Whereas a product patent covered the product whatever its mode of fabrication or utilization, a process patent covered only the process and the products obtained directly by means of that process, but not identical products obtained by a different mode of fabrication. Nevertheless, a process patent had a wider spectrum since it could be applied to a number of plant species. In view of the fact that the conventional processes for plant breeding were not generally patentable, it was to be feared that developments in genetic engineering would lead to attempts, at least, to extend the field of application of the patent system to the detriment of the special system of plant variety protection.

37. In the past, the lawmaker had drawn a boundary between the two systems. In the UPOV Convention, that boundary was set out in Article 2(2). In various international treaties and national laws on patents, it took the form of an exclusion from patentability:

(i) of plant varieties,

(ii) of animal varieties (particularly due to the fact that at the time the exclusion was included the institution of a special system of protection for animal varieties was envisaged, comparable with the system applied to plant varieties, for which the UPOV Convention was the model),

(iii) to essentially biological processes for the production of plants or animals (particularly to avoid indirect protection for plant or animal varieties by making use of process patents).

At the same time, exclusion was accompanied by an exception in favor of microbiological processes and the products of such processes in view of the growing value of microorganisms to the pharmaceutical industry, that is to say for an area very different from that of agriculture for which there existed the special system of plant variety protection.

38. The clarity of that boundary was debatable. It was thus possible, at least in theory, for patents to be granted in the plant breeding field or adjoining areas for processes that were not essentially biological or for microbiological processes. Indeed the possibilities were growing apace with the progress made in genetical engineering. In addition, the progress that had already been made or was hoped for had led certain legal writers to contest the exclusion from patentability referred to above and to demand its abolition on the grounds that the claimed drawbacks of dual protection (by a patent and by a plant variety protection certificate) had been exaggerated and that exclusion from patentability was an obstacle to creativeness in the field of biotechnology.

39. That development appeared dangerous and, to say the least, unjustified, for the following reasons:

(i) The plant variety protection system was specifically adapted to the needs of plant breeding. In general, the patent system was not appropriate; in the past, it had not operated satisfactorily in that field and there was no reason to expect that it would do so in future in respect of one part of that field, that which was based on genetical engineering.

(ii) The patent system did not contain the provisions comprised in the special system of protection which allowed for the public interest, particularly the limitation on the scope of production to the propagating material (with exceptions) and the right to freely use a protected variety as the initial source of variation for the creation of other varieties.

Consequently, it appeared reasonable to limit the fields of competence of the two systems so as to avoid any overlap and, in fact, to maintain the existing demarcation.

40. In that respect, the first step that had to be taken was for the plant variety protection services to maintain close links with the patent offices. Those relations had already been established in some States. They were particularly necessary since the patent offices had been faced, or would be faced in the near future, with applications for patents concerning a field of technology in which their documentation was inadequate. However, it was also necessary to examine, at the present session or on some other occasion, whether it had not become necessary to defend the existing legal situation, that is to say the demarcation of the areas of competence of the two systems.

41. The Chairman explained that the question of biotechnology and its implications for plant variety protection had already been examined in the Netherlands by a working group of experts from the public sector and the private sector, specializing in patent law, plant variety protection law, plant breeding and biotechnology. He noted that so far plant breeding methods had rarely been covered by patents but he was convinced that they would be granted in future with the result that cases of conflict between the two systems of

protection could arise. Nevertheless, he was not sure that those problems would be as serious as expected by the Office of the Union. However that may be, the two systems of protection would continue to exist--and to co-exist--in future. Thus, there was no reason for the UPOV experts to carry out an in-depth examination of the patent system for which there were specialists; UPOV should simply monitor closely developments in that field.

42. On the other hand, a time would come when man would be able to manufacture genes and to insert them into plants. It was at that time that conflicts would arise between the patent system and the special system of plant variety protection when the creator of such genes applied for patent protection thereof, in respect of a substance. In such case, it was essential to safeguard the principle, anchored in the special system of protection in the interests of the continuation of plant breeding work, according to which a variety could be used freely as an initial source of variation.

43. Mr. Skov (Denmark), seconded by a number of other representatives, congratulated the Office of the Union on the document serving as a basis for discussions. He announced to the Committee that the Ministry of the Interior of Denmark had set up a working group to examine the implications of genetic engineering. The group was to review existing legislation and propose new instruments, particularly as regards the dangers of genetic manipulation in the laboratory or in the field.

44. Mr. Skov had already communicated his concern to the chairman of that working group and to the representative of the Ministry of Agriculture in the group as regards genetic engineering applied to plant breeding. That concern was exactly as expressed by the Vice Secretary-General. It centered principally on possible violation of the principle set out in Article 2(2) of the Convention, the risk of blocking plant breeding and the possibility of a patent owner being able to control all the production activities based on a variety covered by his patent.

45. Finally, Mr. Skov felt it would be desirable for the members of that working group and the officials of the Patent Office to be present at the forthcoming UPOV Symposium and for them to receive detailed information on the matters being dealt with.

46. Mr. Gfeller (Switzerland) considered that document CAJ/XIII/3 and the introduction given orally by the Vice Secretary-General should be addressed essentially to specialists in patent law. He asked whether it would not be possible to communicate them to such specialists, for example at a session of one of the WIPO bodies or through the goods offices of the International Bureau of WIPO.

47. The Vice Secretary-General felt that the Office of the Union could do no more than take note of that wish since it did not control the agendas for meetings of WIPO bodies. Nevertheless, the Office would endeavor to make known the views of the UPOV experts.

48. The Chairman felt that it was mainly for the experts from the member States to inform their respective patent offices. Thus, in the Netherlands, the above-mentioned working group would make it possible to give such information.

49. Mr. Rigot (Belgium) noted that the question of biotechnology constituted a problem that was important in itself and also for the future of UPOV. As far as informing the patent specialists was concerned, he felt that contacts could be established between the Office of UPOV and the International Bureau of WIPO and that some of the problems could possibly be already resolved at that level. Furthermore, as had been suggested by the Chairman, the experts from the member States should inform their patent offices of those problems.

50. In Belgium, researchers using genetic engineering techniques for plant breeding considered that protection should be sought for the results of their work, particularly the new varieties, and not for the means used to obtain those results. In fact, the problems had to be classified and the first question was whether the methods used to create the new plants were indeed patentable. Should they prove to be patentable, then the question should also be put whether there were real possibilities for controlling the use made of them in a laboratory. At first sight, those possibilities appeared inadequate, meaning that protection afforded by a patent would not be effective.

51. Mr. Kämpf (Switzerland) first emphasized the need for continuing relations between the plant variety protection offices and the patent and trademark offices, not only as regards the matter under discussion but also for others such as the relationship between trademarks and variety denominations. He then explained that the Swiss Intellectual Property Office had not met with many problems of demarcation in applying the patent law. The latter now contained a provision excluding certain fields of biology from patentability as had been described by the Vice Secretary-General in his preliminary remarks. That provision had been constantly interpreted to mean that living organisms were not patentable as such and the Swiss authorities felt that such had been the intention of those that had drafted it. By means of that interpretation, the demarcation of the fields of application of the patent law and of the law on plant variety protection was very clear-cut. Prior to the adoption of the law on plant variety protection, patents had been applied for from time to time for new plants but no patent had ever been granted. The reason was that the Federal Court had held new plant varieties to be non-patentable on the grounds that inventions in that field did not satisfy one of the basic principles of patent law, that is to say that they were not reproducible at all or not with a sufficient likelihood of success.

52. Mr. Tschiyama (Japan), noting that new varieties obtained by genetic engineering could be adequately protected under the special system of plant variety protection, particularly when compared with the possibilities offered by the patent system, had the following preliminary remarks to make:

(i) The protection of new varieties, as such, under the patent system raised a certain number of problems. It had to be borne in mind, in particular, that the special system of plant variety protection was based on a balance achieved between the needs of protecting the varieties and those of developing agriculture. The need for that balance had been recognized in many countries and there was reason to believe that numerous others would do likewise. The advent of varieties created by biotechnological processes would not seem to change that fact. Indeed, the special system enabled all varieties to be protected whatever the method adopted for breeding them; it therefore applied quite naturally to varieties created by means of biotechnological processes.

(ii) In the case of cell and tissue culture techniques, protoplast fusion or genetic recombination, it could be accepted that a patent be granted for a technique that constituted a genuine advance in relation to known techniques. However, the following had also to be taken into account: assuming that a method for variety creation was patentable, the patent should not extend to the reproduced plants; a patent covering a method for propagation could not extend to plants propagated by other methods, particularly conventional methods.

(iii) It was doubtful whether genes or cells, as such, could be covered by patents. Assuming that such were the case, it would have to be admitted that the patent could not extend to a plant containing such genes or cells.

(iv) As a result of the changes that biotechnology could bring to propagation methods, it could prove useful to improve the protection afforded by the special system of plant variety protection, and the latter possessed the necessary flexibility for that purpose.

53. Mr. Obst (Commission of the European Communities) explained that the question of biotechnology had become an important topic for discussion within the European Communities not only as regards the problems it posed but also as regards the promotion and development of biotechnology within the European Communities. The main debates had not been held under the auspices of the Directorate General for Agriculture, of which Mr. Obst was a member. Nevertheless, he felt it true to say that in fact biotechnology experts said and wrote little on the subject, and that those that spoke and wrote did not really master the subject. He felt that document CAJ/XIII/3 constituted a notable exception to that rule.

54. Mr. Obst further stated that he had been instructed by the relevant Directorate General to read out the following statement:

"The Council of the European Communities has instructed the Commission to draw up proposals for promoting the use of biotechnology within the Communities. The Commission is undertaking studies concerning the various

fields involved. These studies also concern the question of patentability of biotechnological processes and products and, necessarily, the question of demarcation of the field of patents against other forms of protection, including plant breeders' rights. In the case of the activities carried out at international level [for example, by the OECD] and the drafting of possible proposals for making it easier to obtain patents, the Commission will associate the Community Member States in its work at the appropriate time."

55. Mr. Schlosser (United States of America) observed that his country was one of the small number of those that felt that the patent system operated satisfactorily for protecting plants. As far as the preceding question on the patentability of methods for plant breeding was concerned, the United States of America granted patents for such methods and no problem had arisen so far in that respect. Furthermore, that practice had not proved prejudicial to the protection of plants as such. Obviously, it was difficult to predict the development of any possible future legislation in the United States of America in a field that was as vital and as highly technical as plant breeding and genetic engineering.

56. As far as the patentability of genes was concerned, it seemed to Mr. Schlosser that genes were chemical substances and that, consequently, it would not be consistent for a patent office that granted patents for chemical substances to refuse to grant them for genes in the absence of a specific statutory provision. In the same way as the Chairman, he thought that it was a field that could create problems in the future.

57. Mr. Jackman (New Zealand) pointed out that it was altogether reasonable that governments should endeavor to create an environment favorable to the development of biotechnology. If one of the constraints was that the inventor in that field did not have satisfactory access to protection, it was up to them to find a remedy. UPOV was directly concerned by biotechnology where it was applied to plant breeding. Thus, although obliged to adopt a favorable attitude to biotechnology, it was legitimate for UPOV to make known its possible preoccupation in those circumstances. Indeed, it had preoccupations. One of them was related to the fact, evidenced during the Symposium organized by UPOV in 1982, that it would not be impossible to patent a mutant gene in some countries. The possibility of someone being able to appropriate or take control of a thing that was essentially a part of nature raised ethical problems for many UPOV representatives and that fact should not be passed over in silence. It was the main question that should receive UPOV's attention.

58. The Chairman shared Mr. Jackman's point of view. It seemed to him that UPOV should only act in the event of conflict with the system of plant variety protection.

59. Mr. Fikkert (Netherlands) observed that the working group previously mentioned by the Chairman was on the point of publishing its conclusions and recommendations and that it was intended to translate the report, into English at least, in order to give it wider distribution. He explained that the main problem seen was that of patent protection for genes that were then inserted into plants. On the other hand, the fact that new methods of variety creation could be patentable was not a source of problems. Indeed, it would seem that a patent granted for such a method could only cover the first plant created by means of that method and that any plant derived from it by propagation no longer fell under the patent. However that may be, breeders would have to get used to that prospect even if it seemed hard to them.

60. As far as the provision that in the patent law of many States excluded animal and plant varieties from patentability was concerned, Mr. Fikkert pointed out that it was interpreted in some quarters as not excluding genera and species from patentability.

61. Mr. Kämpf (Switzerland) stated that Switzerland interpreted that provision as excluding any living organism from patentability and, consequently, also therefore genera and species. The demarcation was therefore quite clear-cut. On the other hand, it was not as clear for the provision that excluded from patentability "essentially biological processes for the production of plants or animals." Indeed, where technical means were used to intervene in a biological process, it had to be determined whether that process remained "essentially biological" or not.

62. Mr. Hutin (France) asked whether, when speaking of the patentability of genes, it was assumed that there existed genes outside the environment in which they played their part as a medium for genetic information. It would have seemed to him that an isolated gene, taken out of that environment, was merely an inert chemical compound.

63. Mr. Schlosser (United States of America) replied that Mr. Hutin had touched upon the crux of the problem: if an isolated gene was indeed an inert chemical compound then it might be patentable under the same conditions as other chemical substances. The question could be asked, as a principle, whether living matter should be patentable or not and the law adapted if necessary. The Patent and Trademark Office had in fact already granted patents for microorganisms--as had the offices of various other member States--and to some, it could be difficult to distinguish, at least from a patent law point of view, microorganisms from plants.

64. Replying to a question put by the Vice Secretary-General, Mr. Schlosser stated that the general patent statute said nothing specific as regards the scope of protection in the case of microorganisms and other living matter. In his opinion, a patent referring to a process would not cover the product manufactured with the aid of that process. It was open to question whether the doctrine of equivalents also applied to the field of living matter.

65. Mr. Skov (Denmark) emphasized once more that it was of prime importance that a patented variety could also be used freely as the initial source of variation for plant breeding activities. He pointed out in that respect that a large number of governments had underwritten, within FAO, a resolution containing an undertaking relating to free access to genetic sources.

Novelty Concept in the Case of Hybrids and their Parent Lines

66. The Committee took note, following a short exchange of views, of the information contained in document CAJ/XIII/4 and its addenda (further information received shortly before the session is reproduced in Annex IV to this document). It emerged from the exchange of views that the problem raised was considered by some to be one of interpretation of national law and for other persons a matter of substance, that is to say how a line lost its novelty in the event of direct utilization and whether there was a gap in the Convention that possibly needed filling.

Pilot Project in the Examination of Proposed Variety Denominations

67. Discussions were based on document CAJ/XIII/5.

68. The Committee thanked the delegations from the Federal Republic of Germany and from the United Kingdom for their proposals and for their intention of undertaking the pilot project in respect of which the following points were decided:

(i) The project would concern the complete examination of the proposed denomination within the limits of the practical possibilities of the executing office (maximum option proposed by the delegation of the United Kingdom under item 5 of Annex I to document CAJ/XIII/5).

(ii) The request for examination of proposed denominations would be made by means of the plant variety protection gazette.

(iii) The results of the examination would be communicated by sending the computer printout (showing whether identical or similar denominations existed and, if so, listing them) and, where appropriate, comments entered on the UPOV form currently in use.

Fees to be Paid in Relation to Cooperation in Examination

69. The Committee took note of the information given in document CAJ/XIII/6 and its addenda (further information received shortly before the session is reproduced in Annex V to this document).

Improvement of UPOV Models

70. Discussions were based on document CAJ/XIII/7.

71. It was explained that the draft model administrative agreement for international cooperation in the testing of varieties differed from the model agreement previously used insofar as its Article 5 placed an obligation on the office of one contracting member State to take over results of testing carried out by the office of the other contracting State in the event of both offices having testing structures for the species involved. The draft, that had also been improved as regards its wording in comparison with the preceding model agreement, could be used to replace the latter if it were stated that that article were to be excluded and that consequential amendments were to be made to a number of further articles in a cooperation agreement by which, basically, the office of one member State entrusted to the office of another member State the testing of varieties of certain species.

72. As regards the model forms, it was explained that they had been drawn up on the same principle as the UPOV Model Plant Breeders' Rights Gazette and that they therefore gave more freedom to the member States in drawing up their national forms, the essential factor being to respect the numbering and the subject matter of the items.

73. It emerged from the discussions that certain States, that had made use of the model forms previously adopted, were satisfied with those forms and would prefer them to be maintained, at least in their general layout. The proposed forms nevertheless offered a number of very interesting improvements (particularly the indication of the State in which testing had been carried out or was in progress and the designation of the representative sample of the variety), but certain items, such as the item concerning prior marketing, still needed reviewing. In addition, since certain States would possibly copy the UPOV model forms for drawing up their own national forms, it seemed advisable to adapt those forms to the amendments made to the Convention in 1978 (for example, by providing for the indication of the mode of propagation or the final use of the variety in the item on the botanical identity of the variety, and by giving an alternative in the item on prior marketing to cover the possibility of a period of grace). Finally, it was desirable to give more information to the member States on how to convert the model forms into national forms.

74. Finally, the Committee decided to request the Office of the Union to carry out a review of the proposed model forms, based on the considerations recorded in the preceding paragraph, and to submit the revised forms to the Council for adoption.

Any Other Business

75. The delegation of Switzerland drew attention to the fact that the Federal Intellectual Property Office of its country had communicated to its National Plant Variety Protection Office patent documents concerning plant varieties that had been distributed to the patent offices by the Patent and Trademark Office of the United States of America. In view of the fact that such documents were frequently very expensive to prepare, it suggested that the same procedure could also be followed by other member States. The delegation of the United States of America thought that it could possibly make a direct distribution to the plant variety protection offices. It was requested to look into the matter at national level and to report to the next session of the Committee.

Program for the Fourteenth Session of the Committee

76. Subject to any new matters that might arise, the agenda of the fourteenth session of the Committee would include the following items:

- (i) Intentions of member States regarding amendment of national plant variety protection law (reports on any new event);

(ii) Evaluation of the results of the Symposium held within the framework of the eighteenth ordinary session of the Council, with the topic "patents and plant breeders' rights--their fields of application and possible demarcation";

(iii) Minimum distances between varieties (examination of certain legal aspects on the basis of the conclusions reached by the Technical Committee as to technical aspects);

(iv) Harmonization of lists of protected species.

77. This report has been adopted by correspondence.

[Annexes follow]

LIST OF PARTICIPANTS/LISTE DES PARTICIPANTS/TEILNEHMERLISTE

I. MEMBER STATES/ETATS MEMBRES/VERBANDSSTAATEN

BELGIUM/BELGIQUE/BELGIEN

- Mr. J. RIGOT, Ingénieur en chef, Directeur au Ministère de l'agriculture
- M. R. D'HOOGH, Ingénieur principal, Chef de service, "Protection des obtentions végétales", Ministère de l'agriculture

DENMARK/DANEMARK/DÄNEMARK

- Mr. H. SKOV, Chief of Administration, State Plant Production Office
- Mr. F. ESPENHAIN, Head of Office, Board for Plant Novelties

FRANCE/FRANKREICH

- M. M.N. SIMON, Secrétaire général, Comité de la protection des obtentions végétales
- M. C. HUTIN, Directeur du Groupe d'études et de contrôle des variétés et des semences, INRA/GEVES
- Mlle N. BUSTIN, Secrétaire général adjoint, Comité de la protection des obtentions végétales

GERMANY (FED. REP. OF)/ALLEMAGNE (REP. FED. D')/DEUTSCHLAND (BUNDESREPUBLIK)

- Mr. H. KUNHARDT, Leitender Regierungsdirektor, Bundessortenamt
- Mr. W. BURR, Regierungsdirektor, Bundesministerium für Ernährung, Landwirtschaft und Forsten

IRELAND/IRLANDE/IRLAND

- Mr. D. FEELEY, Department of Agriculture
- Mr. W.P. DOYLE, Assistant Principal, Department of Agriculture

ITALY/ITALIE/ITALIEN

- Dr. L. ZANGARA, Primo Dirigente, Ministère de l'agriculture et des forêts

JAPAN/JAPON/JAPAN

- Mr. M. TSUCHIYAMA, Director, Seeds and Seedlings Division, Agricultural Production Bureau, Ministry of Agriculture, Forestry and Fisheries
- Mr. T. KATO, First Secretary, Permanent Mission of Japan, Geneva

NETHERLANDS/PAYS-BAS/NIEDERLANDE

- Mr. M. HEUVER, Chairman, Board for Plant Breeders' Rights
- Mr. K.A. FIKKERT, Legal Adviser, Ministry of Agriculture and Fisheries

NEW ZEALAND/NOUVELLE-ZELANDE/NEUSEELAND

Mr. J.B. JACKMAN, Agricultural Counsellor, New Zealand High Commission, London

SOUTH AFRICA/AFRIQUE DU SUD/SÜDAFRIKA

Dr. J. LE ROUX, Agricultural Counsellor, South African Embassy, Paris

SPAIN/ESPAGNE/SPANIEN

M. R. LOPEZ DE HARO Y WOOD, Sous-directeur technique, Laboratoires et Office des variétés, Institut national des semences et plants

M. J.-M. ELENA ROSSELLO, Chef du Registre des variétés, Institut national des semences et plants

Dr. J.R. PRIETO HERRERO, Counsellor for questions of agriculture and fisheries, Permanent Delegation of Spain, Geneva

SWEDEN/SUEDE/SCHWEDEN

Mr. S. MEJEGÅRD, President of Division of the Stockholm Court of Appeal

Prof. L. KÄHRE, Vice-Chairman of the National Plant Variety Board, State Seed Control

SWITZERLAND/SUISSE/SCHWEIZ

Dr. W. GFELLER, Leiter des Büros für Sortenschutz, Bundesamt für Landwirtschaft

M. R. KÄMPF, Abteilungschef, Bundesamt für geistiges Eigentum

M. O. STEINEMANN, Direktor des Schweizerischen Saatzuchtverbands, SZV

UNITED KINGDOM/ROYAUME-UNI/VEREINIGTES KÖNIGREICH

Ms. J.M. ALLFREY, Deputy Controller, Plant Variety Rights Office

Mr. D.J. MOSSOP, Higher Executive Officer, Plant Variety Rights Office

UNITED STATES OF AMERICA/ETATS-UNIS D'AMERIQUE/VEREINIGTE STAATEN VON AMERIKA

Mr. S.D. SCHLOSSER, Attorney, Office of Legislation and International Affairs, United States Patent and Trademark Office, Department of Commerce

Mr. L. DONAHUE, Administrator, National Association of Plant Patent Owners

II. INTERGOVERNMENTAL ORGANIZATIONS/
ORGANISATIONS INTERGOUVERNEMENTALES/
ZWISCHENSTAATLICHE ORGANISATIONEN

COMMISSION OF THE EUROPEAN COMMUNITIES (EC)/COMMISSION DES COMMUNAUTES EUROPEENNES (CE)/KOMMISSION DER EUROPÄISCHEN GEMEINSCHAFTEN (EG)

M. D.M.R. OBST, Administrateur principal

EUROPEAN FREE TRADE ASSOCIATION (EFTA)/ASSOCIATION EUROPEENNE DE LIBRE-ECHANGE (AELE)/EUROPÄISCHE FREIHANDELSASSOZIATION (EFTA)

Mr. J.G. PETERSSON, Legal Affairs Officer

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III. OFFICERS/BUREAU/VORSITZ

Mr. M. HEUVER, Chairman
Mr. F. ESPENHAIN, Vice-Chairman

IV. OFFICE OF UPOV/BUREAU DE L'UPOV/BÜRO DER UPOV

Dr. H. MAST, Vice Secretary-General
Dr. M.-H. THIELE-WITTIG, Senior Counsellor
Mr. A. HEITZ, Senior Officer
Mr. A. WHEELER, Senior Officer
Mr. K. SHIOYA, Associate Officer

[Annex II follows/
Annexe II suit/
Anlage II folgt]

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ANNEX II

C I O P O R A

COMMUNAUTE INTERNATIONALE DES OBTENTEURS DE
PLANTES ORNEMENTALES DE REPRODUCTION ASEXUEE
4, place Neuve - Genève

SUBJECT : VARIETY DENOMINATIONS AND TRADE MARKS

I - Practice in professional circles

The breeders of ornamental plants have always used fancy names, i.e. trade marks, in order to commercialize their new varieties.

There is certainly no need any more to prove that trade marks are of economic and legal significance. Nevertheless it must be emphasized that this significance is independant of the protection of plant varieties.

Since 1954, the breeders of ornamental plants use a system of code-denominations on an international scale by means of which the new varieties can be identified without giving rise to errors or leading to confusion. The SNPNE (Syndicat National des Producteurs de Nouveautés Horticoles) is the French institution that has been entrusted with the defense of the breeders of vegetatively reproductive plants. It has set up a register into which the varieties are entered and introduced the above-mentioned regulations for forming variety denominations

The problem of the simultaneous use of trade marks and variety denominations for the same variety, which has already been discussed at the 1st Conference on the Protection of Plant Varieties on 20th April, 1967, has become particularly serious ever since two countries, namely England and Denmark, passed laws that gravely affect the breeders' rights to a trade-mark, on the one hand, and since the "provisional" guide lines prepared by the Working Committee of the UPOV ran down the system of identification for varieties, on the other hand, which the breeders had employed up to then.

II - The legislation

1) The Paris Convention of 2nd December, 1961

Art. 13 (9) provides that it shall be permitted, in respect of "one and the same variety", to add a trade mark or trade name to the denomination.

2) Section 5A of the English Plant Varieties and Seeds Act

The principle underlying this regulation is that a trade mark may only be added to the denomination of a variety if this trade mark is used only as a "house mark". Consequently, the use of a trade mark for one variety exclusively becomes unlawful. This constitutes a violation of Art 13 (9) of the Convention of 1961 as well as an encroachment on the rights the breeders may derive on the basis of the Paris Convention of 1883 for the Protection of Industrial Property.

3) The Danish Decree of 5th August, 1970 (cf. Appendix)

While accepting that a trade mark may be simultaneously used with the denomination for each variety, the Danish legislation imparts a roll to the denomination which goes beyond that of a simple reference by stipulating that the trade mark

be lower in rank than the denomination ;
must not be more conspicuous in appearance than
the denomination ;
must not appear in larger or different print or
any colour different from the denomination.

As a result, the trade mark becomes ineffective in practice.

- 4) The "Provisional Guide Lines" of the Council of the UPOV
(28/29th October, 1970) on variety denominations
(cf. Appendix)

Art. 4 of the Guide Lines causes severe obstacles to the
use of code-denominations.

It may be concluded from the above that the Guide Lines are
more restrictive than the Convention, while the latter
constitutes the lowest level with regard to the breeders'
rights, and it should not be admitted to go beneath this
level.

III- Actual Consequences

The interplay

between the Paris Plant Varieties Convention
(Art.13 (5)),
Section 5A of the English law, and
the Danish Decree of 5th August, 1970

presently leads to an inextricable situation for which the
following example may be given :

The French breeder of a variety he had given the denomination
BEIMELVET 0658 F (SNPNH register) decided to commercialize
the same under the trade mark "SCNIA".

He was then faced with the following alternative :

If he were to apply for the registration of the denomination MEIHEL VET in Holland or Germany, this denomination became obligatory in all of the Convention countries (Art.13 (5)) and notably in Great Britain.

In the latter country, MEIHEL VET would then become the only means of reference for the variety and the breeder did not have the right to use an attractive trade mark for this variety allowing him to advertise it,
or else, if he were to apply for the registration of SONIA as a denomination in England, SONIA became an obligatory denomination in all of the Convention countries and the breeder lost his right to use and control his trade mark, which would have been unfair and intolerable.

In consequence, the breeder was compelled to use a fancy name for denomination that was sufficiently attractive for the commercialisation of his variety in Great Britain : SWEET PROMISE.

Results in actual fact

In France, Germany and Holland he continued to advertise under the trade mark SONIA, while at the same time, the denomination SWEET PROMISE appeared of course, in reference of the variety, though in less conspicuous manner.

Due to the above-mentioned decree, in Denmark the commercialisation had to be carried under the "double name"
SWEET PROMISE - SONIA in equivalent characters.

Besides, cut flowers of the same variety having been sent from Holland to England with labels reading "SONIA" - are being sold in England right next to flowers of the same variety produced in England and bearing labels reading "SWEET PROMISE".

Consequently, the consumers in professional circles gain the impression that they are being cheated and the result is an inextricable situation incomprehensible to all.

IV - The remedies CIGPCRA proposes

A - Trade Mark Sector

The breeders attach great importance to asserting their right to the trade mark.

1) Legal Aspect

The trade mark covers the goodwill in commerce connected with the fancy name which characterizes the variety in a much more complete and efficacious manner than the denomination could do. The protection covers all the horticultural products (class 31 of the international trade mark classification) and not only "one and the same species or a related species". With regard to flowers it is also possible, on account of the trade mark, to control the use of commercial names for artificial flowers and even products in a very different field, if it is a "notorious" mark.

With a trade mark rapid and efficacious intervention with regard to infringers using the registered name is often possible whereas an infringement suit in connection with a patent or variety right is often tedious and complicated.

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Finally, by means of a trade mark indirect protection of the variety is often possible in those countries where variety right laws do not exist in that at least the use of the fancy name under which the variety is advertised may be controlled.

A trade mark may be applied for long before it is known which variety it will serve to commercialize, thus guaranteeing exclusiveness.

2) Economic Aspect

A mark may be different from one country to the next depending on the attractiveness in commerce of the name chosen in a particular country or depending on possible difficulties with regard to the pronunciation.

Notorious marks used in other sectors may become the basis of license agreements so that the plant varieties can thus profit from the notoriousness connected with these trade marks.

The commercial value a trade mark represents does not depend on the lifetime of the variety right or the commercial value of the variety. At a time, when varieties tend to succeed each other more and more rapidly, the use of the same trade mark for the commercialisation of successive improvements of the same type of variety may be considered

B - Variety denomination Sector

For almost twenty years, the breeders who are members of the CIOFCRA, have been using a code-denomination system on an international scale which has the following advantages :

- 1) The denomination as defined by the SNPNH regulation

allows the new variety to be identified ;
is not solely composed of figures ;
does not give rise to confusion, either with regard to the properties of the variety or with regard to the breeder's identity. On the contrary, due to the unequivocal statement as to who is the breeder (indicated by the first 3 letters of the denomination), it conveys an excellent guarantee during the entire lifetime of the variety right.

It is thus in conformity with the requirements according to Art. 13 of the Convention.

- 2) By means of a code-denomination it is possible to uniformly identify the same variety in all countries. Any difficulty regarding the pronunciation or the translation is avoided.
- 3) A code-denomination system based on words consisting of syllables and figures is much more extensible than any reference system by means of fancy names.

It also facilitates data processing in a computer.

Long and costly research as to priorities are avoided. As a matter of fact, chances are very slim that a code-denomination will have been previously registered, and it can definitely be distinguished by the registration number of the variety right application.

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Finally, a denomination can automatically be found for the variety at the time when this particular variety is protected, whereas the choice of a commercial name, the trade mark, often depends on the marketing conditions.

C - Consequently

The CICPCRA recommends :

That the Council of the Union take any steps possible so as to cause England and Denmark to review their above mentioned legislations, such that the breeders may enjoy the right to the trade mark to a full extent;

That Article 4 of the "Provisional Guide Lines" be dismissed for ornamental plants and that, taking into account the internationally established custom in this field, a code-denomination system be prepared :

either based on the existing system (SNPNH regulation), or based on an improved system which could be studied by the Working Committee "Variety Denominations" of the UPOV ;

That the "Provisional Guide Lines" provide that, to the extent in which the variety denomination has been indicated and rendered sufficiently apparent, the trade mark chosen by the breeder may appear first in rank and in more significant print than the denomination.

[Annex III follows]

Annex A to document UPOV/VD/V/6

INTERNATIONAL CONVENTION FOR THE PROTECTION
OF NEW VARIETIES OF PLANTS

VARIETAL DENOMINATIONS AND TRADE MARKS

Note by the United Kingdom

Background

1. Article 13 of the Convention requires member States, in respect of each plant variety which is the subject of an application for rights, to register the variety under a denomination which:

- (i) will identify the variety (para (2));
- (ii) will be different from the denominations of other varieties of the same or a related species (para (2));
- (iii) will be the same (with limited exceptions) in all member countries (para (5));
- (iv) is required to be used by all concerned, including breeders, when commercialising the variety in a member country (para (7));
- (v) may not be used in a member country for any other variety of the species or of related species (para (8));

2. These provisions help to protect the breeder against:

- (i) misuse by other people of the registered denomination of his variety e g by applying it to different varieties and
- (ii) infringement of his rights in the variety by other people selling it under a different name

and to protect the buyer of seed etc. against fraud and error by making it an offence (in conjunction with the seed laws of the country concerned) to sell plant material under the wrong name.

3. Although a varietal denomination is registered in connection with a particular variety in which the breeder is granted rights in accordance with the Convention, the breeder does not "own" the varietal denomination in the way the proprietor of a trade mark

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owns his mark. The registered denomination is, in the words of the Convention, "generic". (Article 13(8)(b)). It must be applied to all reproductive etc. material of the variety, whether produced and sold by the breeder or produced and sold by any other person. It does not signify a connection in the course of trade with the holder of the rights in the variety concerned, nor is it capable of distinguishing between examples of the same variety coming from different sources.

4. This fundamental difference between a varietal denomination on the one hand, and a trade mark or name on the other, is underlined by Article 13 which expressly states:

(i) in paragraph (3) that a breeder with an existing right to a trade mark or trade name may not submit the mark or name for registration in a member country as a varietal denomination unless the right to the mark or name is either renounced or not enforced;

(ii) in paragraph (8)(b) that the registered denomination of a variety may not be a trade mark or trade name in any member State of the Union.

Further, Article 36 provides that trade mark and trade name protection of denominations existing when the Convention comes into force in any State should be either renounced or not enforced

5. It is therefore abundantly clear that the intention of signatory States under Article 13, read in conjunction with the remainder of the Convention, was to provide an improved means of assisting breeders, different in kind, scope and effect from the trade mark and trade name system, by protecting both the names of plant varieties and the use of the varieties themselves.

The Convention aimed to replace the relatively limited protection afforded to breeders in certain countries through trade marks, by a more effective and comprehensive system which protected the variety itself for a defined period, coupled with registration and obligatory use by all concerned of an approved varietal denomination.

Position in the UK

6. The Convention system of variety protection, so far as it deals with the naming of varieties, required no significant change in the law, principles or practice of variety denomination in the United Kingdom. A clear distinction already existed in the UK between trade marks and variety names and this was not affected by the Convention. In the UK a registered trade mark is a mark of origin distinguishing the goods originating from the owner of the mark or a registered user of that mark. A variety name, on the other hand, distinguishes material of one plant variety from that of other plant varieties and is used in connection with all reproductive material of the variety irrespective of the source from which it comes. Even prior to the 1961 Convention the UK Registrar of Trade Marks would not register a name as a trade mark if it were intended to use the mark as a variety name, because it would not then be distinctive of the goods of the proprietor of the mark.

7. Rules made under Part I of the Plant Varieties and Seeds Act, 1964 (as amended in 1969) give effect in the United Kingdom to the requirements of Article 13 of the Convention

as regards protected varieties. These rules are consistent with and form part of the general regulations concerning the use of varietal names which apply equally to protected and to unprotected varieties. These regulations are laid down under the seed laws (the Seeds Act, 1920 and Part II of the 1964 Act). They may require a variety to be indexed (i.e. registered) under a name, before it may be commercialised in the United Kingdom; the indexed variety name must be used by all concerned when the variety is commercialised: and the name may not be used for any other variety.

8. The provisions of Article 13(9) of the Convention may be considered against the general background described in the foregoing paragraphs. Article 13(9) states "It shall be permitted, in respect of one and the same product, to add a trade mark or trade name to the denomination of the new variety". According to the interpretation adopted in the United Kingdom, this paragraph requires member States to permit examples (seeds etc.) of a protected variety to be commercialised under a name or mark, indicating the trade source of those particular seeds and distinguishing them from other examples of the same variety, in addition to the registered name of the variety the use of which is mandatory and which alone may identify the variety as such, irrespective of the trade source of any particular lot of seeds. It is permitted for example to sell seeds as "Suttons" seeds plus the registered variety name, where Sutton is the name of the trade source of a particular lot of seeds, or as e.g. "Apex" seeds plus the registered variety name, where "Apex" has been registered on behalf of a seed house as a trade mark applying to seeds of

any variety issued by that house. As mentioned in paragraph 6 above, under present UK practice a condition would be imposed on the registration of "Apex" as a trade mark that the owner shall not use it as a varietal name. If he should do so, the Registrar of Trade Marks has power to apply to the courts for cancellation of the registration for breach of the varietal name condition. It should be noted that the permission to use a trade mark or trade name alongside the registered variety name is not confined to the owner of the rights in the variety. Any person may add his own mark or name to the registered variety name when selling his own goods.

9. The clear distinction outlined above between a varietal denomination on the one hand, and a trade mark or name on the other, is crucial to an understanding of the UK approach and to Article 13. This distinction in UK law and practice was confirmed and emphasised in 1969 by a new law (S 5A of the Plant Varieties and Seeds Act, 1964) which, while expressly permitting the use of a trade mark or trade name in connection with a registered variety denomination (to satisfy the requirements of Article 13(9) of the Convention), stated that the mark or name could not be used exclusively in connection with the variety denomination concerned. In effect, a trade mark or name could not be used for one variety only: it might however be used in connection with more than one varietal name e.g. the names of a group of varieties, or applied to a class of goods of which seeds of the variety formed part. The use of a trade mark or name exclusively for one variety is in the opinion of the United Kingdom incompatible with Article 13 of the Convention,

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contrary to UK law and custom on the naming of plant varieties, and contrary to international custom in a large number of countries and for varieties of a wide range of crops.

10. It is quite true that so far as the UK trade mark law in general is concerned, there is nothing to prevent the owner of a registered trade mark from using the mark exclusively for a single item of goods. This practice is quite common in relation to goods other than seed and plants. The law also allows the use of a registered trade mark by registered users who are otherwise unconnected in the course of business with the owner of the mark. It seems clear, however, that if a trade mark is in fact used by the owner of the mark, and by registered users, solely for one variety, the trade mark could become de facto a mark distinguishing that variety from other varieties. It could become therefore in practice a rival or synonym of the registered denomination, contrary to the clear intention of the Convention and the long-established objectives of UK laws on seeds and plants. The UK is not prepared to have this situation arise and cannot accept that it was the intention to allow or encourage double nomenclature of plant varieties under Article 13(9) of the Convention.

CIOPORA code reference system

11. The varietal name/trade mark problem arose in a specially complex form as a result of an attempt by a small number of rose breeders to register a series of code references as varietal denominations for the purpose of UK plant breeders' rights. A similar attempt was made in other UPOV States. These code references were not recognisable as variety names in the customary sense. The code reference for each variety consisted of three components. The first component comprised a series of 6 or 7 letter

forming a "manufactured" word. The first 3 of these letters indicated the name of the breeder e g MEI for Meilland, MAC for McGredy. The second component comprised 4 or 5 numerals, and the third component a letter or letters. It is understood that all such code designations formed part of a series devised by the Syndicat des Producteurs de Nouveautés Horticoles. Examples are:

MEI figa 0467F	MACsas 62 2221 IRL
MEI danu 0497F	MACmed 61 2561 IRL
MEI dad 0500F	MACmer 61 321
MEI elpa 0498F	
MEI cham 00283F	
MEI desi 00258F	
MEI bisb 00318F	
MEI daud 00321F	

12. At the same time some of the breeders concerned applied to the registration authorities under the International Code of Nomenclature to register a "fancy" name for each of the varieties concerned. Enquiries showed that in practice the breeders in question were commercialising plants of their varieties in the United Kingdom under the "fancy" name, and encouraging or acquiescing in the use of the "fancy" name by other buyers and sellers. The code reference for each variety was used as a secondary means of identifying plants of the variety in certain transactions. It was nevertheless claimed by the breeders that the code reference was the variety denomination and that the "fancy" name was a trade name. It was further claimed that both could be used together in accordance with the provisions of Article 13(9) of the Convention.

13. In the opinion of the UK this code reference system was a misuse of Article 13 (particularly Article 13(9)) and attempted to stand the accepted system of variety nomenclature "on its head". The applications for registration of code references as variety denominations were refused in the UK on the grounds:

- (a) the use of code references as variety names for rose varieties was contrary to national and international custom;
- (b) the varieties were not in fact being commercialised under those references but primarily under fancy names;
- (c) registration of code references as varietal names would endorse and encourage a system of double nomenclature contrary to policy and the Convention;
- (d) the code references, each of which was very similar to others in the same series, (see examples in paragraph 10 above) were liable to lead to confusion concerning the identity of varieties.

In addition, the practice of commercialising a variety under two "names", (one the variety name and the other a trade mark or trade name used exclusively for that variety), was expressly declared illegal under the new law of 1969 (see paragraph 9 above).

14. The UK applications for registration of code designations were finally withdrawn by the breeders concerned and replaced in most cases by applications for "fancy" names which were duly registered. It is understood, however, that CIOFORA may still be hoping to win support for the code reference system in some member and signatory States. It is a matter of importance

therefore that all member and prospective member States should adopt a common policy in this matter and generally in relation to Article 13 of the Convention.

Nomenclature Guide Lines - Article 4

15. Article 4 of the draft Guide lines in the original form agreed by the Nomenclature Working Party in London would as a matter of practice result in the denial of registration to code references such as those specified in paragraph 11 above.

The adoption by all member States of draft Article 4 in the original form would therefore offer a practical solution to the problem of code references as presented by CIOPORA.

amongst others is
For this reason/its adoption/supported by the UK.

16. Breeders could however evade the effect of draft Article 4 by devising a different code reference system which dispensed with letters and figures. In these circumstances the UK proposes that the Council, irrespective of the decision on draft Article 4 of the Guide lines, should declare that any code reference system based on the principles described in paragraphs 11 and 12 above is unacceptable for the reasons given in paragraph 13.

Alternative solution

17. Although the code reference system is unacceptable in the UK, the UK would not be opposed to any solution to the breeders' problems of nomenclature provided the solution is consistent with the principles of the Convention, with trade mark law and practice, and with the rules for variety nomenclature. As the UK understands the position, breeders

of roses and ~~other~~ decorative species with international markets are faced with the problem that protection under the Convention system is for the present limited to a small number of European countries only. Elsewhere, and possibly for some time to come, the registered trade mark is stated to be the only form of variety protection available. Naturally, therefore, the breeder who wants to advertise and sell his varieties both in Convention and non-Convention countries would prefer to use a denomination which is acceptable and can be protected under either system. In principle, the UK is in sympathy with this aim, but is opposed to the CIOFORA solution above.

18. Article 13 does not appear to preclude registration in a Convention country, as a variety denomination, of a name which is trade marked in a non-Convention country. It has been suggested however that registration of a variety denomination under the Convention is an obstacle to trade mark registration in non-Convention countries, including protection by means of an international trade mark. The difficulty may be that a registered variety denomination is by definition generic and non-distinctive in UPOV countries. While the UK is not aware that the registration of a variety denomination in a UPOV country necessarily has consequences in non-Convention countries, the UK would be glad to join with other States and with breeders' organisations in examining the position.

Further point for consideration

19. The United Kingdom also wishes to bring to the attention of member States a practical difficulty which arises when a varietal denomination is submitted for registration which is the same as or similar to a ^{Trade} mark or name for goods of a similar character.

Paragraph (3) of Article 13 precludes a breeder or his successor

in title from submitting a varietal name which is identical or similar to a trade mark or trade name for identical or similar products unless he undertakes to renounce his right to the mark or name as from the date of registration of the varietal name. The paragraph does not however deal with the situation where a varietal name is submitted which is identical or similar to a trade mark or trade name held by another party for similar goods. Paragraph (10) of Article 13 refers to "signs" and its meaning is uncertain.

20. Under UK trade mark law the Registrar of Trade Marks does not allow identical or confusingly similar marks if they are for identical goods or goods of the same description. UK practice as regards registered varietal names is similar and the PVRO does not accept for registration a varietal name which is identical or similar to a registered trade mark or trade name for goods of the same description unless, in certain cases, the owner of the mark or name gives the necessary authority. Difficulty in applying this rule has been encountered when the Trade Marks Registry has reported identical or conflicting marks registered within certain parts of classes e g

Class 29 - Preserved, dried and cooked fruit and vegetables.

Class 30 - Flour and preparations made from cereals; bread, biscuits, cakes, pastry, baking powder

Class 31 - Agricultural, horticultural and forestry products and grains not included in other classes; seeds; food stuffs for animals

and also within the following very widely based classes which operated before the current Act of 1938:

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Class 42 - Substances used as food or as ingredients as food

Class 46 - Seeds for agricultural and horticultural purposes

21. The United Kingdom would be interested to learn what policy is followed in other member States, whether in furtherance of that policy practical difficulties have been encountered, and to discuss measures for securing a common approach on the part of the member States.

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[Annex IV follows]

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ANNEX IV

NOVELTY CONCEPT IN THE CASE OF HYBRIDS
AND THEIR PARENTAL LINES

Further Information Received by the Office of the Union
Shortly Before the Thirteenth Session of the
Administrative and Legal Committee

The Office of the Union received shortly before the thirteenth session of the Administrative and Legal Committee information from the delegation from Denmark (letter dated March 30, 1984) and from the delegation from Israel (letter dated April 3, 1984) according to which there are no official or commercial catalogues in those countries for inbred lines entering into the formula of hybrid varieties.

[Annex V follows]

FEES IN RELATION TO COOPERATION IN EXAMINATION

Further Information Received by the Office of the Union
Shortly Before the Thirteenth Session of the
Administrative and Legal Committee

1. The Office of the Union received shortly before the thirteenth session of the Administrative and Legal Committee the following information from the delegation from Denmark and from the delegation from Israel on the question of fees in relation to cooperation in examination.

2. Denmark.- the Danish authorities made the following statement in a letter dated March 30, 1984:

"As indicated at several UPOV meetings, cooperation between Denmark and other countries may take place outside the framework of formally signed agreements for cooperation. As also indicated, we do hope that these agreements will be formalized in the foreseeable future.

"Consequently, the Board for Plant Novelties makes from time to time decisions on the basis of the examination report from another UPOV member State; such reports are in all cases requested from countries with which we usually cooperate and are always being paid for according to the UPOV Recommendation (at present 350 Swiss francs).

"Furthermore, we can inform you that plant breeders' rights would be granted in respect of a variety only on the basis of an examination report requested from and paid to the authorities of another UPOV member State, even where a copy of the certificate of grant of breeders' rights in another country has been attached to the application filed with our office."

3. Israel.- The Israeli authorities informed the Office of the Union by letter dated April 3, 1984, that they took into account examination reports from other countries as far as novelty was concerned. They explained that the applicant may state that the variety being the subject of an application in Israel had been examined and found novel in another UPOV member State, simply by informing the authorities that protection had already been granted and by submitting evidence in the form of the results of the examination or a copy of the certificate. Nevertheless, the Israeli authorities examined the variety again, in Israel, in order to be able to describe its conduct under local conditions, which frequently did not correspond to that found abroad. This was the reason why the Israeli authorities did not pay a consideration for the test results; furthermore, as a matter of principle, they did not pay for any document submitted by the applicant to support his application. The preceding developments also gave the answer to the question whether Israel envisaged to apply the UPOV Recommendation on Fees in Relation to Cooperation in Examination. The Israeli authorities already brought their point of view to the attention of UPOV at several occasions, in particular in a letter dated January 17, 1982, addressed to the Office of the Union.

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