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GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

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INTERPRETATION OF ARTICLE 2(1) AND RELATED PROVISIONS OF THE CONVENTION

Study by the Office of the Union

1. At the fourteenth session of the Administrative and Legal Committee, held in November 1984, the Delegation of the Netherlands raised the question whether it was possible under the UPOV Convention to obtain industrial patents for plant varieties in addition to the titles based on the rules and principles of the Convention itself (paragraph 33 of document CAJ/XIV/6 Prov.). After some explanations had been given by a representative of the Office of the Union, the Committee decided to enter the question on the agenda of its next session.

The Office of the Union wishes to express the following opinion on this question:

The Basic System

2. The main obligation on UPOV member States under the UPOV Convention (hereinafter referred to as "the Convention") consists in recognizing and ensuring plant breeders' rights under the conditions defined in its provisions (Article 1(1) of the Convention). On becoming a member State of UPOV, the State must be in a position, under its domestic law, to give effect to the provisions of the Convention (Article 30(3) of the Convention).

3. The UPOV Convention is not per se applicable to the whole plant kingdom. It may--but need not--be applied to all botanical genera and species. It allows member States to apply its provisions to a limited number of botanical genera and species only, and most member States have made use of this possibility of limited application. The Convention also allows its member States to limit application within a given genus or species to certain types of varieties, namely those "with a particular manner of reproduction or multiplication, or a certain end-use" (Articles 4 and 2(2) of the Convention). Thus, in almost all UPOV member States, there are genera and species to which the Convention is applied and others to which it is not applied. In some member States there are also types of varieties, for instance hybrid varieties, that are excluded from the application of the Convention. Where the Convention is not applied, there is no obligation to recognize and enforce plant breeders' rights.

4. The drafters of the UPOV Convention were aware of the difficulties, indeed the impossibility in many States, of obtaining protection for plant varieties under patent law. They therefore intended, at the Diplomatic Conference of 1957-1961, to provide that a special title of protection--a new type of an industrial property right--was to be granted. However, one of the States

participating in the negotiations differed from this view and favored the protection of plant breeders' rights in the form of patents, mainly in order to ensure the applicability of the Paris Convention for the Protection of Industrial Property to the envisaged plant breeders' rights. This controversy resulted in the compromise now contained in the Convention: it was left to each member State to protect plant varieties either in the form of a special title of protection or in the form of a patent (Article 2(1), first sentence, of the Convention). It was not expressly mentioned--but obviously agreed between the drafters--that a State was even free to apply both systems, i.e. to protect plant varieties in one and the same State by patents and by special titles of protection. It was however feared that legal security would be in danger if such protection were available for varieties of the same botanical genus or species, in other words for varieties competing with each other in the marketplace. For that reason it was provided in Article 2(1), second sentence, of the Convention that varieties of one and the same genus or species might only be given protection in one of the two possible forms (prohibition of "double protection"). Thus States allowing protection in both forms have to make a choice on whether to protect varieties of one and the same genus or species by a special title of protection or by a patent (except where the State can invoke Article 37(1) of the Convention: see below).

5. It follows from Article 1(1) of the Convention that a plant breeder's right, even when granted in the form of a patent, has to comply with the conditions defined in the UPOV Convention (a partial exception may be invoked under Article 37(1) of the Convention: see below). The patent laws of member States that have opted for protection in the form of the patent therefore contain particular rules on the application of those laws to plant varieties. The patents granted for plant varieties are sometimes referred to as "plant patents."

6. In some recent publications and discussions the question was raised whether a member State of UPOV was free to protect a plant variety by granting a "normal"--industrial--patent rather than, or in addition to, a "plant patent" or a special right of protection. It was argued that the interdiction of double protection in the second sentence of Article 2(1) of the Convention referred only to plant breeders' rights granted in one of the two forms mentioned in that Article, i.e. plant patents and special titles of protection, and that it was not the intention of that rule to exclude protection under the normal patent system. Although the sentence in question does indeed seem to refer only to special titles of protection and plant patents, as evidenced by the interplay of Article 1 and the two sentences of Article 2(1) of the Convention, the argument that member States of UPOV are not prevented from granting industrial patents for all plant varieties still appears to be wrong, and this shows if one takes a closer look at the two situations possible under the Convention, namely on the one hand that the Convention is applied to the genus or species in question (and the type of variety in question) and on the other hand that it is not applied.

(a) Where the Convention is applied, industrial patents that are not adapted to the UPOV Convention may not be granted for plant varieties, since they would not be in conformity with Article 1(1) of the Convention; they would not fulfill the conditions that are specified in the UPOV Convention. It must be kept in mind that those conditions are provided in the UPOV Convention not only for the benefit of the breeder but also in order to ensure certain necessary limitations that the public interest may dictate. In view of that fact, it would be wrong to assume that Article 1(1) of the Convention intended only to ensure that plant breeders' rights (in the form of either a special title of protection or a plant patent) were provided for in addition to the possibilities available under the general patent law; where the Convention is applicable, member States may provide plant breeders' rights only by a special title or by a plant patent, never by an industrial patent that is not adapted to the UPOV Convention. On becoming members of UPOV, States must discontinue the grant of industrial patents for varieties of genera and species to which they apply the Convention; this is proved by the fact that those member States that were involved in the writing of the UPOV Convention by the Diplomatic Conferences of 1957-1961, and in which grant of industrial patents for plant varieties was conceivable, in general excluded such grant in their national law in connection with their ratification of the Convention (at least for those genera and species to which they applied the Convention).

(b) Where the Convention is not applicable on the other hand, i.e. where it is not applied to a given genus or species (as permitted by Article 4 of the Convention) or where, within a given genus or species, varieties of a certain type are excluded from application (according to Article 2 of the Convention), there is no obligation under Article 1(1) or Article 2 of the Convention. In that case, States may grant any rights, including industrial patents, and those rights need not conform to any provision of the Convention. In accordance with this legal situation, the industrial patents which may still be granted in France and in the Federal Republic of Germany--for varieties of those genera and species to which the Convention is not yet applied in those States--are governed by the rules of the national patent law concerned and not by any rules of the UPOV Convention or national plant variety protection laws. Also, the prohibition of double protection written into the second sentence of Article 2(1) of the Convention is not applicable to such industrial patents, but there will be no double protection and no conflict, since under normal circumstances, in the area where the Convention is not yet applied, plant breeders' rights are not yet granted.

(c) Even in the last-mentioned case, member States are still not free to perpetuate any existing protection for plant varieties under the industrial patent system, or even to reintroduce the patent system for plant varieties at their discretion. In Article 4(2) of the Convention member States have undertaken "to adopt all measures necessary for the progressive application of this Convention to the largest possible number of botanical genera and species." This is a mandatory legal obligation assumed by the UPOV member States, not a mere declaration of intent. Any member State extending--or unduly maintaining--the general patent protection for plant varieties at the expense of plant breeders' rights would be acting against that obligation to apply the Convention progressively to the largest possible number of genera and species. It was the clear intention of the legislative bodies in UPOV member States when approving the UPOV Convention, to introduce the system of plant breeders' rights as--eventually--the only system for the protection of plant varieties, and many UPOV member States have already expressly excluded any protection of plant varieties by industrial patents. Any shift in the opposite direction--away from plant breeders' rights back to protection by industrial patent--would thus infringe Article 4 of the Convention.

The Exceptional Rules (Article 37 of the Convention)

7. For States which, before becoming members of UPOV, already provided for protection of plant varieties of the same genus or species in different forms, Article 37 of the Convention offered the possibility of reserving the right to continue the practice after they had become members of UPOV. Only the United States of America made use of that faculty. The Article deserves attention not only in view of the situation in the United States of America, but also for the more general reason that it has recently been cited as proof that, during the Diplomatic Conference of 1978, UPOV softened its rigid line and now considers "double protection" acceptable under certain conditions.

8. Article 37 of the Convention was indeed introduced and adopted by the Diplomatic Conference of 1978. The basic draft originally submitted to that Conference was more restricted. It was designed to cover only the legal situation as existing in the United States of America. That situation can be briefly described as follows: there are two systems for protection which are separated according to the kind of multiplication or propagation of the plants: asexually (vegetatively) propagated varieties, with the exception of tuber-propagated plants (in practical terms potatoes and Jerusalem artichokes) and also plants discovered in a non-cultivated state, may be protected by a plant patent, introduced by amendment of the US Patent Law in 1930. Sexually (generatively) reproduced varieties, with the exception of fungi, bacteria and first-generation hybrids, may be protected by a plant protection certificate, which is granted under a special Law of 1970. The Diplomatic Conference of 1978 was convinced that this system in general prevented any serious double protection and could therefore be accepted by UPOV.

9. The wording of the original proposal submitted to the Diplomatic Conference of 1978 (as Article 34 A) was as follows (Records of the Geneva Diplomatic Conference on the Revision of the International Convention for the Protection of New Varieties of Plants, UPOV publication No 337 (E), page 66):

"Exceptional Rules for Protection Under Two Forms

"(1) Notwithstanding the provisions of paragraph (1) of Article 2, any State which, at the date of opening for signature of this Act, provides for protection under different forms for sexually reproduced and for vegetatively propagated varieties of one and the same genus or species may continue to do so if, at the time of signing this Act or of depositing its instrument of ratification or accession to this Act, it notifies the Secretary-General of the Union of that fact.

....."

10. This draft was amended during the Conference, mainly at the request of the Japanese Delegation (Conference document DC/73, pages 116 and 117 of the above-mentioned Records), which at that time was considering making use of the faculty provided in what is now Article 37, but without knowing exactly which route the Japanese legislator would choose to follow. The Japanese Delegation therefore wished to have a more flexible rule adopted which did not expressly refer to different forms of protection for sexually reproduced and vegetatively propagated varieties. The Diplomatic Conference followed the Japanese proposal in principle, but made it clear, on a proposal by the Delegation of South Africa, that the different forms of protection had to be the two forms mentioned in Article 2(1) of the Convention (see paragraphs 813 to 821 of the Summary Minutes of the Plenary of the Diplomatic Conference 1978, page 175 of the Records). In the end, however, Japan never made use of Article 37 of the Convention.

11. This history of Article 37 shows that it was not the intention of the Diplomatic Conference of 1978 either to tolerate generally any double protection by new member States or to give them absolute freedom. It was merely intended that States should be allowed to continue applying a system which --though differing from the general UPOV approach of separating the two systems of protection along the line of botanical genera and species--nevertheless avoided the danger of double protection.

12. Article 37 of the Convention, in the form finally adopted, still reflects this intention. It allows a State making use of the faculty to "continue" to provide protection in the different forms for one and the same genus or species. It thus legalizes the status quo, and not any further extension. Moreover, it speaks of the forms "referred to in Article 2(1)" of the Convention. In other words it concerns the special title of protection and the type of patent that may be granted by member States to "recognize the right of the breeder" in terms of Article 1 of the Convention, i.e. the plant patent and not the industrial patent; the industrial patent that is not adapted to the UPOV Convention does not come under Article 2(1) of the Convention and so is not covered by Article 37(1). That Article therefore does not justify the grant of a non-adapted industrial patent for plant varieties in the area in which the Convention is applied.

13. This interpretation is confirmed by Article 37(2) of the Convention. Paragraph (2) allows a State having validly made a notification under Article 37(1) of the Convention to apply, in connection with the patents granted or to be granted, certain rules of its national patent legislation in derogation of the UPOV Convention. This exception is however limited to two types of legal provision, namely those concerning the "patentability criteria" and those concerning the "period of protection"; only to that extent may the rules of patent legislation be applied. However, even where Article 37(1) of the Convention applies, patents must fulfill the other "conditions" defined in the UPOV Convention, such as the scope of protection and in particular the limitation mentioned in Article 5(3). Industrial patents would probably not fulfill most of those other conditions.

14. It has to be mentioned, however, that a State having made a notification under Article 37 is in no way restricted where it does not (yet) apply the UPOV Convention. Thus the United States of America is free--subject to the above-mentioned obligation under Article 4(2) of the Convention to apply the UPOV Convention progressively to the largest possible number of genera and species--to grant industrial patents, if it wishes and if the national law permits, to tuber-propagated plants, hybrids or mushrooms of the higher order.

Scope of Exclusion of Patents

15. Where industrial patents are excluded for the protection of plant varieties, the question arises to what kinds of patent that exclusion refers. It certainly covers product patents for plant varieties, which would be the direct competitors of plant breeders' rights. The European Patent Convention (Article 53(b)) and the national patent laws of a number of States go beyond this and exclude also "essentially biological processes for the production of plants." The exclusion of such processes is to some extent a consequence of the fact that, shortly before the Convention was established, breeders had tried in some countries to obtain patent protection for their varieties by claiming the vegetative propagation of the mother plant of a newly-bred variety, the mother plant being described by the mention of certain characteristics. It is obvious that, in order to avoid double protection effectively, that type of "manipulated" process claim had to be included in the prohibition. This background shows the intention that underlay the exclusion of certain process claims, which was to prevent the scope of protection of an industrial patent from being extended to plant varieties that should be reserved for the new type of protection, namely plant breeders' rights. It is hoped that this intention is kept in mind by patent offices and courts called upon to interpret the terms used in the European Patent Convention and in the corresponding national patent laws.

16. Patents for new processes that are not essentially biological are not excluded in the European Convention or national laws, and indeed it appears difficult to exclude them. Under most patent laws process patents cover also the products that are the immediate results of the application of the process. However, as was explained in detail in document CAJ/XIII/3, such products are never a plant variety as such, i.e. all plants possessing the same characteristics, and they can only exceptionally be identical with a population of plants that represents a good part of a variety. Thus there is not too great a danger of overlapping unless national courts interpret the term "product being the immediate result of a patented process extensively."

Preservation of Existing Rights (Article 39)

17. The UPOV Convention contains a provision (Article 39) stating that the Convention shall not affect existing rights under national laws or international agreements. The decision on the precise extent of that rule and the corresponding national rules will be a matter for the national offices and courts of member States. Article 39 will certainly protect the owners of industrial patents that were granted for plant varieties before the application of the Convention to the genus or species in question. In certain States it may also protect persons who already have "expectations", for instance persons having filed an application for patent protection or having obtained a priority right for such applications under an international agreement. In any case, this rule is only of temporary importance, and does not interfere with the basic system of the Convention as far as protection in its two different forms, special title or patent, is concerned.

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