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UPOV

RC/ad hoc/ 5

ORIGINAL: English

DATE: August 29, 1978

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

AD HOC COMMITTEE ON
THE REVISION OF THE CONVENTION

Geneva, September 11 to 15, 1978

OBSERVATIONS ON THE DRAFT REVISED CONVENTION

submitted by the United States of America

The Department of State in Washington transmitted, by a letter dated August 22, 1978, comments of the United States of America on the draft revised Act of the Convention and proposed that they be distributed only within the UPOV member States. The comments appear in the Annex to this document.

[Annex follows]

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ANNEX



DEPARTMENT OF STATE

Washington, D.C. 20520

August 22, 1978

Dr. Arpad Bogisch
Secretary-General
The International Union for the
Protection of New Plant Varieties
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Dear Dr. Bogisch:

I am writing to provide to you and the Ad Hoc Committee on Revision of the UPOV Convention the views of the United States on the Articles of the Draft Revised Convention that still concern us, except for Article 13. Very shortly, I will forward our views on Article 13. With the expectation that our difficulties may be resolved by the Ad Hoc Committee at its forthcoming meeting, I suggest that this letter and our letter to follow on Article 13 be distributed only to interested officials of the present member States of UPOV.

Article 3

It is our understanding that the Patent and Trade-mark Office may continue to accord national treatment under the terms and conditions of Articles 2 and 3 of the Paris Convention. The Plant Variety Protection Office, I have been informed by the Department of Agriculture, will provide reciprocal rights under paragraph (3).

Article 4

Proposed paragraphs (3)(a) and (b) are drafted in a way that allows a State to adhere to the Convention by protecting no more than twenty-four species of a single plant genus. We wonder if these provisions are intended to make Union membership available to a State offering such limited protection to plant breeders, or if their undue narrowness is the consequence of a drafting error.

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In either case, we suggest deleting the words "or species" in these paragraphs. This would still allow the Council, on the basis of paragraph (4), to accept new member States unable to offer broader protection.

Article 5

We have carefully deliberated about the desirability of mandatory protection for cut flowers. Practical considerations have persuaded us, however, that such protection should be left to the discretion of member States, as it now is under paragraph (4).

The effective exercise of breeders' rights in preventing the unauthorized sale of cut flowers depends mainly on the breeder's ability to prohibit their importation. As breeders realize, many countries (including the United States) do not have totally adequate laws for this purpose. A requirement in the Convention to provide this protection would make adherence difficult or impossible for many States. The best way of protecting breeders is the widespread adoption of the Convention, and this requirement could be self-defeating.

At the same time, breeders should receive every reasonable encouragement to propagate new varieties. Accordingly, we believe it would be appropriate for the Diplomatic Conference to recommend that member States take measures to protect cut flowers under their national laws. The Committee of Experts of Interpretation and Revision of the Convention, at its September, 1977 meeting, agreed on the desirability of a similar recommendation for the protection of plantlets. The two recommendations might be combined.

Article 6

The UPOV Council has determined, we understand, that the Patent and Trademark Office may apply the provisions of Sections 102 and 103 of our patent laws under Article 34A(2), in lieu of the requirements of paragraphs (1)(a) and (b). We further understand and agree that the Plant Variety Protection Office cannot utilize this Article. In administering a breeders' rights law, this Office is expected to judge novelty by the standards of paragraphs (1)(a) and (b).

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The Department of Agriculture acknowledges that Section 42 of the Plant Variety Protection Act does not include the four-year bar to protection required by paragraph (1)(b)(ii). At various UPOV meetings, this Department has agreed to pursue a minor amendment to Section 42 establishing a four-year bar. It regards such an amendment as being in the best interests of our seed trade, and foresees no opposition to its enactment.

The Plant Variety Protection Office will utilize the grace period of Article 6, although this Article does not contemplate the barring of legal rights because of prior use or knowledge of the variety. I am informed by the Department of Agriculture, however, that these grounds for barring protection are really not applicable to the seed trade. Aside from testing, the trade does not publicize new varieties except in connection with marketing. Accordingly, the Department of Agriculture will pursue an amendment to the Plant Variety Protection Act limiting the benefits of its grace period to the offering for sale or selling of a new variety.

The sentence in paragraph (1)(b) "Trials of the variety ... right to protection." implies that a trial involving an offer for sale or sale, even as a necessary incident of the trial, might affect the breeder's right to protection. Such an interpretation contradicts the Committee of Experts' conclusion in the Observations on this Article (document IRC/VI/2) that each member State can and, in fact, must decide for itself the dividing line between experimental use and commercialization. Some resolution of this contradiction seems needed.

Article 7

I understand that both the Patent and Trademark Office and the Plant Variety Protection Office will conduct their examination proceedings in accordance with the Council's Statement (at its Tenth Ordinary Session) on this Article.

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Article 10

At various UPOV meetings, United States delegations have expressed concern about the limited nature of Article 10. It does not take into account the fact that patent rights may be qualified or nullified in the United States to remedy a violation of our antitrust laws. The same is undoubtedly true of certificates of plant protection, although this question has never been litigated.

This apparent conflict between Article 10 and our antitrust jurisprudence, we understand, is resolved by reliance on Article 9. Article 9 permits, if not requires, breeders' rights to be restricted in the public interest. Violations of our antitrust laws obviously affect the public interest, and any remedy provided for this purpose will not violate Article 10. Our understanding of the relationship between Articles 9 and 10 and our antitrust laws is nowhere recorded, however.

Paragraph (2) states that a breeder's legal rights shall be forfeited when he is no longer able to provide the examining office with material capable of reproducing the protected variety. We agree with the principle of paragraph (2) that breeders' rights should not continue in a variety which the breeder is no longer able to reproduce. As we understand the provision, it imposes a burden of proof on the breeder in litigation over the validity of his right. This burden of proof may not be required by our plant patent law. Users of the plant patent system have pointed out, however, that their legal rights and the system itself might be strengthened if retention of a sample of propagating material were required. In comparison, our law on microbiological inventions requires the retention and public availability of the microorganism relied upon by the patentee.

We do not believe there would be any serious objection to an appropriate amendment of our plant patent law. Such an amendment could provide that a plant patent owner would forfeit his right to protection if he refuses or is unable to provide a sample of the protected variety to a court considering patent validity or to an authorized government office.

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In the English version, paragraph (2) seems to be more than a "burden of proof" provision. It could be read as authorizing a competent authority to demand propagating material and for the breeder to forfeit his right if this demand is not met. Reading the paragraph this way makes its relationship to paragraph (3) very confusing.

Could paragraph (2) be changed to make clear that it has nothing to do with the variety maintenance measures of paragraph (3)? One way of doing this is by changing the words "is no longer in a position to provide the competent authority with" in paragraph 2 to "no longer possesses."

Article 11

This Article accords the breeder of a new variety the right to decide in which UPOV member State he will first apply for breeders' rights. Sections 184 to 186 of our patent laws, however, require the breeder to obtain a license if he first applies for legal protection in a foreign State. These Sections are based on the Government's need to control the transmittal abroad of any information possibly affecting national security.

The same considerations also arise under the Paris Convention. Although the Paris Convention does not include a specific provision authorizing a national member of a State to apply for a patent first in another member State, its right of priority provisions have always been understood as implicit authorization to do so. A national of a member State filing his first application in another member State may claim the right of priority in his own State on the basis of the first application. It is also understood that the right to file a patent application abroad under the Paris Convention, even without a public interest provision equivalent to UPOV Article 9, may be qualified or prevented for national security reasons. Therefore, we consider Sections 184 to 186 of our patent laws consistent with Article 11 for the same reason that these Sections are consistent with the Paris Convention.

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Article 12

This rather complicated Article concerns the right of priority, as does Article 4 of the Paris Convention. The requirements and conditions for receiving this right differ in some respects, however, between the two Conventions. The Paris Convention extends the priority year when the last day falls on a holiday or a day when an examining office is closed. Also, priority under the Paris Convention need not be based on the first-filed application if that application is abandoned with no legal rights left outstanding. Neither of these advantages are available to breeders under the UPOV Convention.

There are also differences between the Conventions in regard to the procedural requirements for receiving the right of priority. The UPOV Convention allows a breeder only three months after filing a foreign application to provide a copy of his home application to the foreign office. The Paris Convention, on the other hand, does not set any time limit for doing this. Nor does the UPOV Convention authorize an examining office to require a certified translation of the home application.

It has been informally agreed, I understand, that the Patent and Trademark Office may continue to apply the terms and conditions of the Paris Convention to nationals of Paris Convention member States seeking the right of priority here. The Plant Variety Protection Office will apply Article 12 of the UPOV Convention. An appropriate recording of this understanding is needed.

Paragraph (3) provides a four-year period for a breeder to furnish propagating material to each foreign examining office where he claims the right of priority. This material is used to carry out field tests. Examination of the application for breeders' rights cannot begin until the material is received.

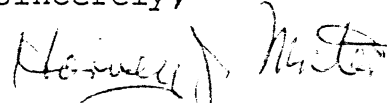
Our delegations at UPOV meetings have explained that such a four-year period has meaning only if the propagating material is to be tested by the examining office. If no governmental testing is to be conducted, as would be true of the United States, there is no reason for an examining office to wait as long as four years before beginning its examination of an application for breeders' rights or a patent.

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The Council has agreed that we should not be required to delay our examination of such an application. However, this agreement is not consistent with the proposed new text of paragraph (3). This inconsistency would be removed by adding to the end of the first sentence of paragraph (3) the phrase "for testing the said material."

I believe it would be most helpful to an expeditious resolution of any questions that may arise in connection with this Government's views on the various articles discussed above and in Article 13 if a representative of this Government could be invited to the forthcoming meeting of the Ad Hoc Committee on the Revision of the UPOV Convention, September 11-15, 1978. If this is feasible, please inform us as soon as possible so that we can make the appropriate arrangements for attendance at the meeting. In the meantime if you have any questions about our views or wish further explanations, please let me know.

Sincerely,



Harvey J. Winter
Director, Office of
Business Practices

[End of Annex and of document]