



CIOPORA Position

on

General Plant Breeders' Rights Matters

as approved by its Annual General Meeting on 28 April 2015 in Hamburg

1. Genera and species to be protected

According to Article 3 of the UPOV 1991 Act a new member-country of UPOV shall provide protection at the date on which it accedes to this Act for at least 15 plant genera or species and, at the latest after 10 years after the accession, to all plant genera and species.

Countries, which are already bound by an earlier UPOV Act, shall provide protection at the date on which it accedes to the 1991 Act for all those plant genera and species, which are protected under the earlier Act and, at the latest after five years after the accession, to all plant genera and species.

Countries, which are bound by the UPOV 1978 Act, must provide protection only for at least twenty-four genera or species.

CIOPORA requires that all countries, which provide for PBR protection, shall cover all genera and species.

The limitation of the number of genera and species, for which PBR-protection is provided, makes the PBR legislation non-conform to Article 27 (3) b) of the TRIPS agreement, which requires an effective sui generis system for all plant varieties.

Such limitation is not justifiable and on the top not necessary anymore. In the past decades a high expertise in the examination of all kind of species has been developed, and for most of the species, which are in commerce, exists a (at least national) test-guideline. The take-over of test-reports allows all Plant Breeders' Rights authorities to grant a title.

Therefore, the limitation of the number of protectable genera and species is no longer caused by technical limitation, but is used solely for political reasons, for the supposed



benefit of growers in the country, who shall be continuously enabled to grow a species without contributing to the work of the breeders.

2. Conditions of Protection

2.1 Novelty

According to Article 6 (1) of the UPOV 1991 Act, a variety shall be deemed to be new if, at the date of filing of the application, propagating or harvested material of the variety has not been sold or otherwise disposed of to others within the territory earlier than one year before that date and outside the territory earlier than four years or, in the case of trees or of vines, earlier than six years before the said date.

In order to avoid confusion because of different legal understanding of “sales”, **the triggering point for the start of the period of grace should be linked to the physical transfer of propagating material for commercial purposes.**

It also should be clarified that the physical transfer of material for testing purposes shall not harm the novelty of the variety, as long as the material remains under the supervision of the breeder. Additionally, the physical transfer of material of the variety, which has been produced from plants grown for test purposes and which is not used for further reproduction or multiplication, shall not be deemed to be exploitation of the variety, provided that the said material is transferred without variety identification.

Additionally, a variety should be considered as “disclosed” (i.e. no longer “new”) only where material, which is capable of producing new plants true-to-type, has been made accessible to the trade or to the public by the breeder or by its successor in title or with its consent.

The marketing of harvested material, which is not capable of producing a new plant true-to-type (such as the majority of fruits) shall not trigger the period of grace, because it does not allow a continued utilization of the variety.

Additionally, the mere publication of a description of a variety should not be considered as a disclosure of that variety.

When the so called “period of grace” was perpetuated by the UPOV 1991 Act, the marketing of protected new plant varieties was more or less confined to a fairly limited number of countries. Today, as a consequence of globalization on the one hand, and because of the shift of production to new territories on the other hand, new plant varieties have to be tested in many more territories and the marketing plans have become far more intricate and time consuming. Therefore the placing of a variety on the world markets stretches over a much longer period of time. Some varieties, which were supposed to be



adapted to only very specific conditions, become demanded by the trade or by the public in an entirely different environment after a number of years. As consequence, the long period of time necessary for the proper launching of a variety does require a more adequate period of grace, especially for fruit trees, where a minimum 10-year period of grace would be more in line with the actual requirements of breeders.

Therefore, the period of grace should be extended for non-woody plants to six years and for woody plants to ten years.

Finally, for the calculation of the period of grace the time of quarantine should not be taken into consideration.

Transitional period for varieties of recent creation

According to Article 6 (2) of the UPOV 1991 Act, a UPOV member which applies this Convention to a plant genus or species to which it did not previously apply this Convention or an earlier Act may consider a variety of recent creation existing at the date of such extension of protection to satisfy the condition of novelty even where the sale or disposal to others took place earlier than the original time limits defined for novelty.

In order to compensate the disadvantages for breeders due to a late implementation of Plant Breeders' Rights in a country, countries should allow a sufficient "transitional period", during which breeders can apply for Plant Variety Protection for their varieties, even if these varieties do not meet the requirements for novelty anymore. This should happen also if a country, which is already a member to the UPOV 1978 Act, upgrades its PBR-law and accedes to the UPOV 1991 Act.

In this respect there should be the possibility for breeders – within a specified time after enacting the respective provision – to apply for all of their varieties, irrespective of how old they are. In return the duration of protection might be limited to the remaining duration of the respective Plant Breeders' Right in the first country of registration.

2.2 Reference collections (Use of DNA analysis for the set up)

In many crops reference collections are necessary in order to perform solid DUS examinations.

The maintenance of reference collections causes – particularly in fruit tree species - a significant part of the costs for the DUS examination.



Therefore, the composition of reference collections must be evaluated permanently and shall reflect the developments in breeding. Old varieties with no relevance for modern breeding and with no relevance for the phenotypic appearance of new varieties should be eliminated.

If such old varieties are maintained on the premises of the examination offices for other reasons, the cost for their maintenance shall not be included in the calculation of the cost of the DUS examination.

A tool to reduce costs in respect of reference collections may be molecular markers that are reproducible between laboratories. Molecular markers can be useful to generate a genetic conformity measure as additional information when planning DUS trials, to come to an optimized setting of variety comparisons in DUS trials and for management of reference collections (UPOV option 2, UPOV documents TC/38/14-CAJ/45/5 and TC/38/14 Add.-CAJ/45/5 Add.).

Care must be taken that no phenotypically similar varieties are omitted from the comparative trials. To avoid appeal in later examination years, which unnecessarily expand the examination period, applicants and owners of reference varieties must be fully informed and consulted on beforehand about the composition of the trials.

Additionally, CIOPORA in general favours the idea of involving panels of experts from outside the examination offices to identify the reference varieties, which should be compared with the candidate varieties, if no permanent living reference collection exists.

However, it is indispensable that the process of selecting the experts is completely transparent and ensures a balanced participation of the international breeders' community in each panel, preferably in co-operation with the respective breeders' organizations.

2.3 Suitable Variety Denomination

According to Article 5 (2) of the UPOV 1991 Act a variety, for which an application for protection is filed, must be designated by a denomination in accordance with the provisions of article 20 of the UPOV 1991 Act.

The bars to the acceptability, by national PBR authorities of a member country of UPOV, of a denomination proposed by an applicant for plant variety protection are restrictively enumerated by the UPOV Convention. Therefore, UPOV member countries must not be more restrictive than the UPOV Convention itself as to what may constitute a valid denomination. In general, CIOPORA supports a high flexibility as to the names, words, codes or signs that are eligible for the identification of a variety.



Where applicants use fancy names or words, instead of codes, then the examining authorities should not only make a prior search within the lists of other existing variety denominations for the same or closely related species, but also within the list of prior trademarks filed for closely related products in the international class 31. This would save unnecessary litigation with holders of trademark rights having priority over the applicant of plant variety protection¹. By using coded denominations applicants avoid potential opposition and delays in the application process due to “prior use” of an identical fancy denomination.

CIOPORA considers that the “re-use” of a variety denomination can be a source of confusion. In particular in perennial species, trees, shrubs, perennial herbs and garden roses, plants of a specific variety are maintained in public or private gardens for a long time, even if the variety is not “on the market” any more. In such cases the variety has not ceased to exist, but it is extremely difficult to discover this. Additionally, the possibility of such re-use seems to be needless. In case of using codes as denominations there is no trouble whatsoever. If a breeder wishes to use a fancy name as denomination, it should be easy for him to find a denomination that is not identical with the denomination of an “old” variety. CIOPORA considers the denomination of a variety as its permanent identifier, irrespective whether the variety is commercialized any more or not.

2.4 Formalities

The breeder’s right shall be granted according to Article 5 of the UPOV 1991 Act where the variety is new, distinct, uniform and stable. The grant of the breeder’s right shall not be subject to any further or different conditions, provided that the variety is designated by a denomination in accordance with the provisions of Article 20, that the applicant complies with the formalities provided for by the law of the Contracting Party with whose authority the application has been filed and that he pays the required fees.

The formalities provided for by the national PBR laws should not go beyond what is necessary to accomplish the application. The compliance with obligations based e.g. on the Convention on Biodiversity (CBD) shall not be considered to be a formality for the grant of a Plant Breeders’ Right.

¹ A variety denomination should be considered as absolute ground for refusal for a trademark where the use of such trade mark may be prohibited pursuant to the variety denomination.



3. The process of application and granting

3.1 Documents and forms used

- Harmonization
- Electronic application
- PBR-CT system desired – one application – one DUS examination

CIOPORA strongly supports the development of harmonized application forms and technical questionnaires and the set-up of technical tools for electronic applications, including a harmonized language regime.

The ultimate objective should be an optional system which would allow breeders to apply for their new variety on one application form (electronically) and choose the countries in which the application shall be accomplished. This should be combined with a DUS examination for the variety in a competent examination office and the take-over of the test report in the countries chosen.

The requirements and formalities for the certification of documents, such as the Power of Attorney, should be reduced to what is absolutely necessary.

3.2 Plant material requested

CIOPORA considers that the applicant for a plant breeders' rights certificate should be obliged to supply nothing but the material of the variety for which the application is filed.

In some countries, a practice has developed, on the part of plant variety rights' offices to routinely ask applicants to also furnish to the examination authority material of "comparative" varieties. While breeders are usually willing to cooperate when they are in a position to do so, this request should not be transformed into an obligation. Indeed the examination authority, alone, should have the responsibility of keeping whatever collection of "varieties of common knowledge" it may consider as appropriate for the purpose of comparing the latter to the candidate variety.

As regards the phytosanitary condition of plant material requested from breeders by DUS examination offices, CIOPORA acknowledges that such material should be in good sanitary condition in order not to infect other material that is being grown by said authorities. The recently stricter measures imposed by some DUS examining offices against the presence of pests and viruses seem to be going beyond what is strictly necessary or reasonable for the purpose of the DUS examination. Additionally, if a breeder provides to an authority material that does not meet the sanitary standards, this should not automatically lead to the refusal of the application.



Sufficiently broad time limits and possible extensions should be provided for the supply of plant material of the candidate variety. This is especially necessary for varieties that originate from another hemisphere than the one where the Examination Office is located, particularly if long periods of quarantine exist.

If plant material has to be sent to an examination office at a fixed period of time, the period should be communicated to the breeders in due time.

3.3 Priority

The claiming of the UPOV priority and the Paris Convention priority should be harmonized so that it can operate smoothly between all countries that are parties either to the UPOV Convention or to the Paris Convention, irrespective of whether the plant variety protection system is by patents or by a sui generis system.

In that respect the term “breeder’s right”, used in the UPOV 1991 Act, should be replaced by the term “title of protection” and the latter should be the subject of a broad definition in article 1 of the 1991 Convention, covering both sui generis breeders’ rights and patents.

The texts of national or regional laws applying any given Act of the UPOV convention should be harmonized.

3.4 The DUS examination

In general CIOPORA is of the opinion that an IP title for a plant variety should be based on a DUS examination conducted by a governmental or specialized private entity.

The quality of the DUS examination should be high and should be harmonized on a world-wide level. A quality assurance system should be established.

CIOPORA is of the opinion that governmental or private entities, which conduct DUS examinations, should not be active in breeding the crops on which they do the DUS examination.

The conduct of the DUS examination should be as reasonably close as possible to standard commercial growing conditions.

Taking into consideration the significant influence of the environment on the phenotype of plant material and as a consequence also on the result of the DUS examination, the DUS examination should be conducted in areas having the best



climatic conditions for the growing of the respective species and the candidate variety.

The DUS examination should be as short as possible in the given environment.

3.5 Ownership of plants, DUS reports, DNA samples and analyses

The property in the plants, which are shipped to the examination offices, belongs to the breeder. The mere shipping of plants to the examination office for the purpose of a DUS examination or the planting of the material into the ground of the examination office cannot be seen as transfer of property. As a consequence, the examination office is not allowed to keep or forward the plant material or parts of it, including DNA samples, during and after the end of the DUS examination without the authorization of the owner of the material.

3.6 Take-over of existing test reports

The examination offices / PBR offices shall make available the DUS examination report to other PBR offices for a reasonable handling fee. The current price for the take-over of an examination report of 240 EUR, as proposed by UPOV and accepted by the UPOV members is too high.

In principle PBR offices should be obliged to take over existing DUS reports. Precondition for such take-over is that the quality of the DUS examination is harmonized on a high level. In any case take-over of DUS reports should be compulsory between examination offices, which operate under a common system and observe the same procedures.

3.7 Duration of the application process

- **The entire application process should be as short as possible. In general, the PBR title should be issued not later than six months after the DUS examination has been completed.**



4. Farmers' exemption

CIOPORA points out that the so called Farmers' exemption has been admitted by UPOV under strictly limited conditions only for seed species grown by farmers and not in the horticultural sector (see the Recommendation relating to Article 15 (2) published in the Final Draft of the 1991 Act of the UPOV Convention and the UPOV document CAJ/50/3, No. 10, 11 and 13).

Applying the farmers' exemption to vegetatively reproduced ornamental and fruit varieties makes a PBR law for such species totally ineffective, and thus is contrary to the UPOV 1991 Convention and the TRIPS Agreement.

5. Compulsory License

CIOPORA points out that according to Article 17 of the UPOV 1991 Act (Restrictions on the Exercise of the Breeder's Right) no UPOV member may restrict the free exercise of a breeder's right for reasons other than of public interest, except where expressly provided in this Convention. Similar provisions can be found in Articles 30 and 31 of the TRIPS Agreement.

Taking into consideration the large assortment of all kinds of ornamental and fruit varieties, CIOPORA is of the opinion that in general there exists no public interest in the commercialization of a specific variety of such crops, so that the preconditions for a compulsory license usually are not given as far as ornamental and fruit varieties are concerned.

6. Duration of protection

The minimum compulsory duration of a plant variety right under the UPOV 1991 Act is 25 years for trees and vines and 20 years for all other species, according to Article 19 (2).

CIOPORA is in favour of extending the duration for PBR to 30 years for all species for the following reasons:

- the requirements to a new variety increase steadily, and new varieties in general are of higher value than older ones,
- the costs for breeding and research increase, while the average royalty payments for varieties decrease,
- the breeder invests in average 10 to 20 years before a new variety enters the market; alone the testing period and the period for building up elite mother plants lasts 5 - 10 years,



- the scope of protection is not entirely effective,
- the desire of the public to get free access to the variety is fulfilled to a huge extent already during the protection period.

Such an extension will have no consequences for the vast majority of varieties. The vast majority of varieties have a rather short commercial life due to the rapid exchange of varieties in the market. It is only the exceptional, long-living varieties which would benefit from such extension. For such varieties it is necessary to have sufficient period of protection, because they earn most of the return on investment for the whole breeding program of the breeder. Additionally, it is justified to say that because of their excellence these varieties deserve a longer protection.

7. Provisional Protection between application and grant

Article 13 of the UPOV 1991 Act [Provisional Protection] provides that each UPOV member shall provide measures designed to safeguard the interests of the breeder during the period between the filing or the publication of a PBR application and the grant of that right. Such measures shall have the effect that the holder of a breeder's right shall at least be entitled to equitable remuneration from any person who, during the said period, has carried out acts which, once the right is granted, require the breeder's authorization. A state may provide that the said measures shall only take effect in relation to persons whom the breeder has notified of the filing of the application.

Different to inventions, which as a general rule are not released to the public before the patent is granted, breeders start the exploitation of their new varieties often even before they apply for protection, namely within the *period of grace*. This is to the benefit of the growers, too, because growers usually aim to access new varieties as soon as possible in order to reap the benefits of the improved characteristics of such varieties.

In order to create a real incentive for breeders to launch their innovation at an early stage, the breeder of the new variety must be in the position to control the exploitation of his variety, i.e. to grant licenses and to stop "infringers", even before the protection title is granted.

Article 13 of the UPOV 1991 Act provides the basis for such an effective provisional protection. However, it shows that most the UPOV members make use only of the least possible measure to protect the breeder, i.e. granting to the title-holder the right to an equitable remuneration to be paid by the persons, who use the variety between the publication of the application and the grant of the title.

Safeguarding the interest of the breeder, however, requires a more strict approach. First of all, in the national PBR laws the application for a PBR should be designed as a true object



of property of the breeder, which can serve as a basis of contractual exploitation rights and for enforcement, including court proceedings against infringers.

Additionally and consequently, the applicant of the PBR should be entitled to enforce his right already during the period between the publication of the application and the grant.

If the application has been withdrawn, is deemed to be withdrawn or is finally refused the rights listed above shall be deemed never to have existed. In this case benefits received are to be returned, unless otherwise agreed by the parties.

If a PBR law provides that the said measures shall only take effect in relation to persons whom the breeder has notified of the filing of the application, the publication of the application in the official gazette of the competent authority should be considered as a proper notification.

CIOPORA is of the opinion that according to the current provisions concerning the provisional protection plants, which have been produced in the period of provisional protection without the authorization of the applicant remain illegal, even if the producer has paid an equitable remuneration to the applicant or title-holder. This is particular important for fruit-trees, which are usually produced for a long-lasting use.

8. The use of the variety denomination

According to the Article 20 (7) of the UPOV 1991 Act [Obligation to use the denomination] any person who offers for sale or markets propagating material of a variety protected within the protected territory shall be obliged to use the denomination of that variety, even after the expiration of the breeder's right in that variety.

The variety denomination shall be the unique identifier of the variety. UPOV and its members should see to it that the denomination of a variety is the same in all member states of UPOV, with as little exceptions as possible. The best way to avoid different denomination for one and the same variety is the use of code denominations, as promoted by CIOPORA since long.

In order to provide for clarity and transparency in the business and towards the consumers the mandatory use of the variety denomination for each and any material of the variety is necessary.

Therefore, the use of the variety denomination should not only be obligatory in relation to propagating material, but also in relation to harvested material.



This should apply not only for the protected variety, but also for varieties according to Article 14 (5) (a) of the UPOV 1991 Act, namely EDV (also non-protected EDV, see chapter ...), varieties which are not clearly distinguishable from the protected variety and varieties, whose production require the repeated use of the protected variety.

9. Cost of Protection

The costs for the acquisition and maintenance of a Plant Breeders' Right should not be unnecessarily high².

Particularly the fees for the DUS examination of fruit tree varieties reach in some countries a level which forms a barrier for the breeders to apply for protection.

Maintenance fees should be meant to cover just the administration costs by Plant Variety Rights Offices, no more. In view of the shorter and shorter turnover of varieties they should be kept at a minimal flat rate.

10 Enforcement

10.1 Effective enforcement measures

According to Article 30 (1) (i) of the UPOV 1991 Act each Contracting Party shall provide for appropriate legal remedies for the effective enforcement of breeders' rights.

Additionally, Article 41 of the TRIPS Agreement provides that members of the WTO 'shall ensure that enforcement procedures are available under their law so as to permit effective action against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringement. Procedures concerning the enforcement of intellectual property rights shall be fair and equitable. They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays'.

The enforcement of plant variety protection depends largely on the scope of rights. This is why a sufficiently broad scope of the PBR is priority in all countries concerned.

Additionally, in order to be effective, a Plant Breeders' Rights law must be accompanied by effective enforcement tools. Such enforcement tools should contain at least

² Countries, which have unnecessarily costly fees for the acquisition and maintenance of IP rights violate Article 62 (4) in combination with 41 (2) of the TRIPS Agreement.



- Civil measures
 - (i) provisional measures, to grant access to premises of a probable infringer, to prevent or stop an infringement of the breeder's right, and/or to preserve evidence, e.g. to collect samples of infringing material;
 - (ii) measures to allow a civil action to prohibit the committing, or continuation of the committing, of an infringement of the breeder's right;
 - (iii) measures to provide adequate damages to compensate the loss suffered by the holder of the breeder's right and to constitute a deterrent to further infringements;
 - (iv) measures to allow destruction or disposal of infringing material;
 - (v) measures to provide payment by the infringer of the expenses of the holder of the breeder's right (e.g. court fees and attorney's fees);
 - (vi) measures to require an infringer to provide information to the holder of the breeder's right on third persons involved in the production and distribution of infringing material.
- Customs measures
 - (i) measures to allow suspension by the customs authorities of the release into free circulation, forfeiture, seizure or destruction of material which has been produced in contravention of the breeder's right;
 - (ii) measures to allow the suspension by the customs authorities of the release of the infringing material destined for exportation.
- Administrative measures
 - (i) provisional measures to prevent or stop an infringement of the breeder's right, and/or to preserve evidence (e.g. collect samples of infringing material from greenhouses);
 - (ii) measures to prohibit the committing, or continuation of the committing, of an infringement of the breeder's right;
 - (iii) measures to allow destruction or disposal of infringing material;



- (iv) measures to require an infringer to provide information to the holder of the breeder's right on third persons involved in the production and distribution of infringing material;
- (v) measures to allow the forfeiture, seizure of material which has been produced in contravention of the breeder's right;
- (vi) measures for authorities responsible for the testing and certification of propagating material to provide information to the holder of the breeder's right regarding propagating material of his varieties;
- (vii) administrative sanctions or fines in the case of a breach of the legislation on breeders' rights or of a non-compliance with provisions on, or misuse of, variety denominations.

- Criminal measures

Criminal actions and penalties in cases of willful or negligent violation of the breeders' right

CIOPORA is of the opinion that national legislation, which does not include at least the measures as listed above, does not fulfill the requirements of Article 30 (1) (i) of the UPOV 1991 Act and of Article 41 of the TRIPS Agreement. The consequences are particularly severe and damaging for small and medium sized enterprises.

10.2 Affordable cost of enforcement

The enforcement of IP Rights must be affordable for all title holders, particularly for small and medium sized enterprises. Too high costs form a practical barrier for enforcement, particularly for companies which do not have high financial reserves.

CIOPORA requests that infringers of IP rights shall be obliged to compensate all reasonable costs incurred by enforcement proceedings.

10.3 Specialized Courts

Plant Breeders' Rights law is – due to the specifics of the material incurred – difficult and to judge about such cases it needs special knowledge.



Thus, it is advisable to direct Plant Breeders' Rights court cases to selected courts, which are specialized in Plant Breeders' Rights law or at least to courts that already are established for patent infringement cases because of similar experience in industrial property. This guarantees a unitary and qualified case law.

10.4 Use of molecular techniques for the enforcement

The effective enforcement of IP rights is of utmost importance for breeders. CIOPORA supports the elaboration of a standard *modus operandi* of DNA analysis as an additional tool to improve the enforcement of IP rights; molecular markers are then very useful for variety identification³.

Particularly in regard to the harvested material of fruit varieties, such as apples or grapes, DNA analysis is the only way to prove or at least to provide a *prima facie* proof that the harvested material belongs to a protected variety, because in most fruit species it is not possible to produce a true-to-type plant from the harvested material.

³ See the CIOPORA position "The use of molecular techniques for plant variety protection", approved by the AGM 2011 in Rome.