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***Report on Protection of Plant Varieties***

Final Report

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## EXECUTIVE SUMMARY

Plants contribute to everyday life of people in terms of the quantity, quality and cost of our requirements for food, fuel and fiber. In addition they also provide raw materials for industry, such as vegetable oils, rubber and pharmaceutical materials.

In order to address the challenge of feeding an ever-increasing population we must develop improved plants that can produce more food and fiber of increased quality on less land with less water. Plant breeders will make the major contribution to meeting these challenges since the essence of their craft is to develop plants that are genetically equipped to produce higher yields of quality products.

The breeding of new plant varieties is an economically important activity that contributes in many different ways to the social and economic well being of society, through research, commercialization and wealth creation.

Experience worldwide has shown that it is difficult for a breeder to recover his financial investment if he must sell his initial product without protection in the first years of a new variety's life. Under this scenario the breeder's competitors could secure supplies of propagating material and in a short time compete directly with him profiting from the many years of breeding effort. It may take between 10 and 20 years to develop new varieties in most plant species.

Plant variety protection regimes are implemented in order to:

- Provide breeders (frequently including institutions of the State) with an opportunity to receive a reasonable return on past investments,
- Provide an incentive for continued or increased investment in the future,
- To recognize the legal right of the innovator to be recognized as such and his economic right to remuneration for his efforts.

Harmonizing these laws and agreements within the global economy is the mandate of the International Union for the Protection of New Varieties of Plants (UPOV).

As part of its entry into the global economy though accession to the World Trade Organization, Jordan is implementing plant variety protection legislation in order to be compatible to those of other WTO member counties. This should open the doors to increased investment in plant breeding and the development of new markets for its innovative plant products.

This report outlines the existing International framework legislation (UPOV), the draft law on plant varieties under legislative consideration by the Government of Jordan, and the regulations needed for implementation and effective operation of the law. The report also provides a number of appendices that show other important interfaces with the International community and provides draft forms that may be used by the Jordanian PVP office.

A training program will complement this report that will enhance the skills of the staff that will be responsible for the day-to-day operations of the office.

I hope and trust that this report will assist the Government of Jordan its important task of implementing regulations and operating a globally effective plant variety protection program and office.

## INTRODUCTION TO THE REPORT

This report is a written compilation of documents provided in order to allow the implementation of an effective plant variety protection office and system in the Kingdom of Jordan.

The report provides

- The background legislation of UPOV
- The Plant Variety Protection laws currently under adoption in Jordan.
- THE PROPOSED REGULATIONS
- Additional practical notes that will assist in the start up of the office and the development of its staff.
- Additional reference material from UPOV
- Reference to the training module that accompanies this report.

The report is intended to provide a detailed guide to those persons with direct responsibility for the establishment and efficient daily operation of the office. The text is drafted so as to be generally compatible with that of other UPOV signatory countries.

The author would welcome feedback on the merits and deficiencies of the report so as to refine this type of analysis for the future. Please contact:

John Dodds

# UPOV
# "INTERNATIONAL CONVENTION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS."
## THE 1991 ACT

This document is attached for background reference purposes and to show the agreed International Underpinning to the legal protection of plants varieties. WTO membership requires adoption of a mechanism for protecting plant varieties, this act provides the International legal standard that must now be adopted. Countries entering UPOV must now accept the 1991 act and not the earlier 1978 version.

# (UPOV)

# ACT OF 1991

# INTERNATIONAL CONVENTION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

**Of December 2, 1961**

**as Revised at Geneva on November 10, 1972,**

**on October 23, 1978, and on March 19, 1991**

**ACT OF 1991**

# INTERNATIONAL CONVENTION

## FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

of December 2, 1961,
as Revised at Geneva on November 10, 1972,
on October 23, 1978, and on March 19, 1991

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# UPOV

## CHAPTER I

## DEFINITIONS

### Article 1

### Definitions

For the purposes of this Act:

(i) "this Convention" means the present (1991) Act of the International Convention for the Protection of New Varieties of Plants;

(ii) "Act of 1961/1972" means the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as amended by the Additional Act of November 10, 1972;

(iii) "Act of 1978" means the Act of October 23, 1978, of the International Convention for the Protection of New Varieties of Plants;

(iv) "breeder" means

- the person who bred, or discovered and developed, a variety,
- the person who is the employer of the aforementioned person or who has commissioned the latter's work, where the laws of the relevant Contracting Party so provide, or
- the successor in title of the first or second aforementioned person, as the case may be;

(v) "breeder's right" means the right of the breeder provided for in this Convention;

(vi) "variety" means a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a breeder's right are fully met, can be

- defined by the expression of the characteristics resulting from a given genotype or combination of genotypes,
- distinguished from any other plant grouping by the expression of at least one of the said characteristics and
- considered as a unit with regard to its suitability for being propagated unchanged;

(vii) "Contracting Party" means a State or an intergovernmental organization party to this Convention;

(viii) "territory," in relation to a Contracting Party, means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituting treaty of that intergovernmental organization applies;

(ix) "authority" means the authority referred to in Article 30(1)(ii);

(x) "Union" means the Union for the Protection of New Varieties of Plants founded by the Act of 1961 and further mentioned in the Act of 1972, the Act of 1978 and in this Convention;

(xi) "member of the Union" means a State party to the Act of 1961/1972 or the Act of 1978, or a Contracting Party.

## CHAPTER II

## GENERAL OBLIGATIONS OF THE CONTRACTING PARTIES

### Article 2

### Basic Obligation of the Contracting Parties

Each Contracting Party shall grant and protect breeders' rights.

### Article 3

### Genera and Species to be Protected

(1) [*States already members of the Union*] Each Contracting Party which is bound by the Act of 1961/1972 or the Act of 1978 shall apply the provisions of this Convention,

(i) at the date on which it becomes bound by this Convention, to all plant genera and species to which it applies, on the said date, the provisions of the Act of 1961/1972 or the Act of 1978 and,

(ii) at the latest by the expiration of a period of five years after the said date, to all plant genera and species.

(2) [*New members of the Union*] Each Contracting Party which is not bound by the Act of 1961/1972 or the Act of 1978 shall apply the provisions of this Convention,

(i) at the date on which it becomes bound by this Convention, to at least 15 plant genera or species and,

(ii) at the latest by the expiration of a period of 10 years from the said date, to all plant genera and species.

### Article 4

### National Treatment

(1) [*Treatment*] Without prejudice to the rights specified in this Convention, nationals of a Contracting Party as well as natural persons resident and legal entities having their registered offices within the territory of a Contracting Party shall, insofar as the grant and protection of breeders' rights are concerned, enjoy within the territory of each other Contracting Party the same treatment as is accorded or may hereafter be accorded by the laws of each such other Contracting Party to its own nationals, provided that the said nationals, natural persons or legal entities comply with the conditions and formalities imposed on the nationals of the said other Contracting Party.

(2) [*"Nationals"*] For the purposes of the preceding paragraph, "nationals" means, where the Contracting Party is a State, the nationals of that State and, where the Contracting Party is an intergovernmental organization, the nationals of the States which are members of that organization.

## CHAPTER III

## CONDITIONS FOR THE GRANT OF THE BREEDER'S RIGHT

### Article 5

### Conditions of Protection

(1) [*Criteria to be satisfied*] The breeder's right shall be granted where the variety is

(i) new,

(ii) distinct,

(iii) uniform and

(iv) stable.

(2) [*Other conditions*] 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.

## Article 6

## Novelty

(1) [*Criteria*] The variety shall be deemed to be new if, at the date of filing of the application for a breeder's right, propagating or harvested material of the variety has not been sold or otherwise disposed of to others, by or with the consent of the breeder, for purposes of exploitation of the variety

(i) in the territory of the Contracting Party in which the application has been filed earlier than one year before that date and

(ii) in a territory other than that of the Contracting Party in which the application has been filed earlier than four years or, in the case of trees or of vines, earlier than six years before the said date.

(2) [*Varieties of recent creation*] Where a Contracting Party applies this Convention to a plant genus or species to which it did not previously apply this Convention or an earlier Act, it may consider a variety of recent creation existing at the date of such extension of protection to satisfy the condition of novelty defined in paragraph (1) even where the sale or disposal to others described in that paragraph took place earlier than the time limits defined in that paragraph.

(3) [*"Territory" in certain cases*] For the purposes of paragraph (1), all the Contracting Parties which are member States of one and the same intergovernmental organization may act jointly, where the regulations of that organization so require, to assimilate acts done on the territories of the States members of that organization to acts done on their own territories and, should they do so, shall notify the Secretary-General accordingly.

## Article 7

## Distinctness

The variety shall be deemed to be distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of the filing of the application. In particular, the filing of an application for the granting of a breeder's right or for the entering of another variety in an official register of varieties,

in any country, shall be deemed to render that other variety a matter of common knowledge from the date of the application, provided that the application leads to the granting of a breeder's right or to the entering of the said other variety in the official register of varieties, as the case may be.

### Article 8

### Uniformity

The variety shall be deemed to be uniform if, subject to the variation that may be expected from the particular features of its propagation, it is sufficiently uniform in its relevant characteristics.

### Article 9

### Stability

The variety shall be deemed to be stable if its relevant characteristics remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.

## CHAPTER IV

## APPLICATION FOR THE GRANT OF THE BREEDER'S RIGHT

### Article 10

### Filing of Applications

(1) [*Place of first application*] The breeder may choose the Contracting Party with whose authority he wishes to file his first application for a breeder's right.

(2) [*Time of subsequent applications*] The breeder may apply to the authorities of other Contracting Parties for the grant of breeders' rights without waiting for the grant to him of a breeder's right by the authority of the Contracting Party with which the first application was filed.

(3) [*Independence of protection*] No Contracting Party shall refuse to grant a breeder's right or limit its duration on the ground that protection for the same variety has not been applied for, has been refused or has expired in any other State or intergovernmental organization.

## Article 11

## Right of Priority

(1) [*The right; its period*] Any breeder who has duly filed an application for the protection of a variety in one of the Contracting Parties (the "first application") shall, for the purpose of filing an application for the grant of a breeder's right for the same variety with the authority of any other Contracting Party (the "subsequent application"), enjoy a right of priority for a period of 12 months. This period shall be computed from the date of filing of the first application. The day of filing shall not be included in the latter period.

(2) [*Claiming the right*] In order to benefit from the right of priority, the breeder shall, in the subsequent application, claim the priority of the first application. The authority with which the subsequent application has been filed may require the breeder to furnish, within a period of not less than three months from the filing date of the subsequent application, a copy of the documents which constitute the first application, certified to be a true copy by the authority with which that application was filed, and samples or other evidence that the variety which is the subject matter of both applications is the same.

(3) [*Documents and material*] The breeder shall be allowed a period of two years after the expiration of the period of priority or, where the first application is rejected or withdrawn, an appropriate time after such rejection or withdrawal, in which to furnish, to the authority of the Contracting Party with which he has filed the subsequent application, any necessary information, document or material required for the purpose of the examination under Article 12, as required by the laws of that Contracting Party.

(4) [*Events occurring during the period*] Events occurring within the period provided for in paragraph (1), such as the filing of another application or the publication or use of the variety that is the subject of the first application, shall not constitute a ground for rejecting the subsequent application. Such events shall also not give rise to any third-party right.

## Article 12

## Examination of the Application

Any decision to grant a breeder's right shall require an examination for compliance with the conditions under Articles 5 to 9. In the course of the examination, the authority may grow the variety or carry out other necessary tests, cause the growing of the variety or the carrying out of other necessary tests, or take into account the results of growing tests or other trials which have already been

carried out. For the purposes of examination, the authority may require the breeder to furnish all the necessary information, documents or material.

### Article 13

### Provisional Protection

Each Contracting Party shall provide measures designed to safeguard the interests of the breeder during the period between the filing or the publication of the application for the grant of a breeder's right 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 as provided in Article 14. A Contracting Party 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.

## CHAPTER V

## THE RIGHTS OF THE BREEDER

### Article 14

### Scope of the Breeder's Right

(1) [*Acts in respect of the propagating material*] *(a)* Subject to Articles 15 and 16, the following acts in respect of the propagating material of the protected variety shall require the authorization of the breeder:

(i) production or reproduction (multiplication),

(ii) conditioning for the purpose of propagation,

(iii) offering for sale,

(iv) selling or other marketing,

(v) exporting,

(vi) importing,

(vii) stocking for any of the purposes mentioned in (i) to (vi), above.

*(b)* The breeder may make his authorization subject to conditions and limitations.

(2) [*Acts in respect of the harvested material*] Subject to Articles 15 and 16, the acts referred to in items (i) to (vii) of paragraph (1)*(a)* in respect of harvested material, including entire plants and parts of plants, obtained through the

unauthorized use of propagating material of the protected variety shall require the authorization of the breeder, unless the breeder has had reasonable opportunity to exercise his right in relation to the said propagating material.

(3) [*Acts in respect of certain products*] Each Contracting Party may provide that, subject to Articles 15 and 16, the acts referred to in items (i) to (vii) of paragraph (1)*(a)* in respect of products made directly from harvested material of the protected variety falling within the provisions of paragraph (2) through the unauthorized use of the said harvested material shall require the authorization of the breeder, unless the breeder has had reasonable opportunity to exercise his right in relation to the said harvested material.

(4) [*Possible additional acts*] Each Contracting Party may provide that, subject to Articles 15 and 16, acts other than those referred to in items (i) to (vii) of paragraph (1)*(a)* shall also require the authorization of the breeder.

(5) [*Essentially derived and certain other varieties*] *(a)* The provisions of paragraphs (1) to (4) shall also apply in relation to

(i) varieties which are essentially derived from the protected variety, where the protected variety is not itself an essentially derived variety,

(ii) varieties which are not clearly distinguishable in accordance with Article 7 from the protected variety and

(iii) varieties whose production requires the repeated use of the protected variety.

*(b)* For the purposes of subparagraph *(a)*(i), a variety shall be deemed to be essentially derived from another variety ("the initial variety") when

(i) it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety,

(ii) it is clearly distinguishable from the initial variety and

(iii) except for the differences which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.

*(c)* Essentially derived varieties may be obtained for example by the selection of a natural or induced mutant, or of a somaclonal variant, the selection of a variant individual from plants of the initial variety, backcrossing, or transformation by genetic engineering.

## Article 15

## Exceptions to the Breeder's Right

(1) [*Compulsory exceptions*] The breeder's right shall not extend to

(i) acts done privately and for non-commercial purposes,

(ii) acts done for experimental purposes and

(iii) acts done for the purpose of breeding other varieties, and, except where the provisions of Article 14(5) apply, acts referred to in Article 14(1) to (4) in respect of such other varieties.

(2) [*Optional exception*] Notwithstanding Article 14, each Contracting Party may, within reasonable limits and subject to the safeguarding of the legitimate interests of the breeder, restrict the breeder's right in relation to any variety in order to permit farmers to use for propagating purposes, on their own holdings, the product of the harvest which they have obtained by planting, on their own holdings, the protected variety or a variety covered by Article 14(5)*(a)*(i) or (ii).

## Article 16

## Exhaustion of the Breeder's Right

(1) [*Exhaustion of right*] The breeder's right shall not extend to acts concerning any material of the protected variety, or of a variety covered by the provisions of Article 14(5), which has been sold or otherwise marketed by the breeder or with his consent in the territory of the Contracting Party concerned, or any material derived from the said material, unless such acts

(i) involve further propagation of the variety in question or

(ii) involve an export of material of the variety, which enables the propagation of the variety, into a country which does not protect varieties of the plant genus or species to which the variety belongs, except where the exported material is for final consumption purposes.

(2) [*Meaning of "material"*] For the purposes of paragraph (1), "material" means, in relation to a variety,

(i) propagating material of any kind,

(ii) harvested material, including entire plants and parts of plants, and

(iii) any product made directly from the harvested material.

(3) [*"Territory" in certain cases*] For the purposes of paragraph (1), all the Contracting Parties which are member States of one and the same intergovernmental organization may act jointly, where the regulations of that organization so require, to assimilate acts done on the territories of the States members of that organization to acts done on their own territories and, should they do so, shall notify the Secretary-General accordingly.

**Article 17**

**Restrictions on the Exercise of the Breeder's Right**

(1) [*Public interest*] Except where expressly provided in this Convention, no Contracting Party may restrict the free exercise of a breeder's right for reasons other than of public interest.

(2) [*Equitable remuneration*] When any such restriction has the effect of authorizing a third party to perform any act for which the breeder's authorization is required, the Contracting Party concerned shall take all measures necessary to ensure that the breeder receives equitable remuneration.

**Article 18**

**Measures Regulating Commerce**

The breeder's right shall be independent of any measure taken by a Contracting Party to regulate within its territory the production, certification and marketing of material of varieties or the importing or exporting of such material. In any case, such measures shall not affect the application of the provisions of this Convention.

**Article 19**

**Duration of the Breeder's Right**

(1) [*Period of protection*] The breeder's right shall be granted for a fixed period.

(2) [*Minimum period*] The said period shall not be shorter than 20 years from the date of the grant of the breeder's right. For trees and vines, the said period shall not be shorter than 25 years from the said date.

**CHAPTER VI**

# VARIETY DENOMINATION

## Article 20

## Variety Denomination

(1) [*Designation of varieties by denominations; use of the denomination*] *(a)* The variety shall be designated by a denomination which will be its generic designation.

*(b)* Each Contracting Party shall ensure that, subject to paragraph (4), no rights in the designation registered as the denomination of the variety shall hamper the free use of the denomination in connection with the variety, even after the expiration of the breeder's right.

(2) [*Characteristics of the denomination*] The denomination must enable the variety to be identified. It may not consist solely of figures except where this is an established practice for designating varieties. It must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder. In particular, it must be different from every denomination which designates, in the territory of any Contracting Party, an existing variety of the same plant species or of a closely related species.

(3) [*Registration of the denomination*] The denomination of the variety shall be submitted by the breeder to the authority. If it is found that the denomination does not satisfy the requirements of paragraph (2), the authority shall refuse to register it and shall require the breeder to propose another denomination within a prescribed period. The denomination shall be registered by the authority at the same time as the breeder's right is granted.

(4) [*Prior rights of third persons*] Prior rights of third persons shall not be affected. If, by reason of a prior right, the use of the denomination of a variety is forbidden to a person who, in accordance with the provisions of paragraph (7), is obliged to use it, the authority shall require the breeder to submit another denomination for the variety.

(5) [*Same denomination in all Contracting Parties*] A variety must be submitted to all Contracting Parties under the same denomination. The authority of each Contracting Party shall register the denomination so submitted, unless it considers the denomination unsuitable within its territory. In the latter case, it shall require the breeder to submit another denomination.

(6) [*Information among the authorities of Contracting Parties*] The authority of a Contracting Party shall ensure that the authorities of all the other Contracting Parties are informed of matters concerning variety denominations, in particular the submission, registration and cancellation of denominations. Any

authority may address its observations, if any, on the registration of a denomination to the authority which communicated that denomination.

(7) [*Obligation to use the denomination*] Any person who, within the territory of one of the Contracting Parties, offers for sale or markets propagating material of a variety protected within the said territory shall be obliged to use the denomination of that variety, even after the expiration of the breeder's right in that variety, except where, in accordance with the provisions of paragraph (4), prior rights prevent such use.

(8) [*Indications used in association with denominations*] When a variety is offered for sale or marketed, it shall be permitted to associate a trademark, trade name or other similar indication with a registered variety denomination. If such an indication is so associated, the denomination must nevertheless be easily recognizable.

## CHAPTER VII

## NULLITY AND CANCELLATION OF THE BREEDER'S RIGHT

### Article 21

### Nullity of the Breeder's Right

(1) [*Reasons of nullity*] Each Contracting Party shall declare a breeder's right granted by it null and void when it is established

(i) that the conditions laid down in Articles 6 or 7 were not complied with at the time of the grant of the breeder's right,

(ii) that, where the grant of the breeder's right has been essentially based upon information and documents furnished by the breeder, the conditions laid down in Articles 8 or 9 were not complied with at the time of the grant of the breeder's right, or

(iii) that the breeder's right has been granted to a person who is not entitled to it, unless it is transferred to the person who is so entitled.

(2) [*Exclusion of other reasons*] No breeder's right shall be declared null and void for reasons other than those referred to in paragraph (1).

## Article 22

## Cancellation of the Breeder's Right

(1) [*Reasons for cancellation*] *(a)* Each Contracting Party may cancel a breeder's right granted by it if it is established that the conditions laid down in Articles 8 or 9 are no longer fulfilled.

*(b)* Furthermore, each Contracting Party may cancel a breeder's right granted by it if, after being requested to do so and within a prescribed period,

(i) the breeder does not provide the authority with the information, documents or material deemed necessary for verifying the maintenance of the variety,

(ii) the breeder fails to pay such fees as may be payable to keep his right in force, or

(iii) the breeder does not propose, where the denomination of the variety is cancelled after the grant of the right, another suitable denomination.

(2) [*Exclusion of other reasons*] No breeder's right shall be cancelled for reasons other than those referred to in paragraph (1).

# CHAPTER VIII

# THE UNION

## Article 23

## Members

The Contracting Parties shall be members of the Union.

## Article 24

## Legal Status and Seat

(1) [*Legal personality*] The Union has legal personality.

(2) [*Legal capacity*] The Union enjoys on the territory of each Contracting Party, in conformity with the laws applicable in the said territory, such legal capacity as may be necessary for the fulfillment of the objectives of the Union and for the exercise of its functions.

(3) [*Seat*] The seat of the Union and its permanent organs are at Geneva.

(4) [*Headquarters agreement*] The Union has a headquarters agreement with the Swiss Confederation.

**Article 25**

**Organs**

The permanent organs of the Union are the Council and the Office of the Union.

**Article 26**

**The Council**

(1) [*Composition*] The Council shall consist of the representatives of the members of the Union. Each member of the Union shall appoint one representative to the Council and one alternate. Representatives or alternates may be accompanied by assistants or advisers.

(2) [*Officers*] The Council shall elect a President and a first Vice-President from among its members. It may elect other Vice-Presidents. The first Vice-President shall take the place of the President if the latter is unable to officiate. The President shall hold office for three years.

(3) [*Sessions*] The Council shall meet upon convocation by its President. An ordinary session of the Council shall be held annually. In addition, the President may convene the Council at his discretion; he shall convene it, within a period of three months, if one-third of the members of the Union so request.

(4) [*Observers*] States not members of the Union may be invited as observers to meetings of the Council. Other observers, as well as experts, may also be invited to such meetings.

(5) [*Tasks*] The tasks of the Council shall be to:

(i) study appropriate measures to safeguard the interests and to encourage the development of the Union;

(ii) establish its rules of procedure;

(iii) appoint the Secretary-General and, if it finds it necessary, a Vice Secretary-General and determine the terms of appointment of each;

(iv) examine an annual report on the activities of the Union and lay down the program for its future work;

(v) give to the Secretary-General all necessary directions for the accomplishment of the tasks of the Union;

(vi) establish the administrative and financial regulations of the Union;

(vii) examine and approve the budget of the Union and fix the contribution of each member of the Union;

(viii) examine and approve the accounts presented by the Secretary-General;

(ix) fix the date and place of the conferences referred to in Article 38 and take the measures necessary for their preparation; and

(x) in general, take all necessary decisions to ensure the efficient functioning of the Union.

(6) [*Votes*] *(a)* Each member of the Union that is a State shall have one vote in the Council.

*(b)* Any Contracting Party that is an intergovernmental organization may, in matters within its competence, exercise the rights to vote of its member States that are members of the Union. Such an intergovernmental organization shall not exercise the rights to vote of its member States if its member States exercise their right to vote, and vice versa.

(7) [*Majorities*] Any decision of the Council shall require a simple majority of the votes cast, provided that any decision of the Council under paragraphs (5)(ii), (vi) and (vii), and under Articles 28(3), 29(5)*(b)* and 38(1) shall require three-fourths of the votes cast. Abstentions shall not be considered as votes.

## Article 27

## The Office of the Union

(1) [*Tasks and direction of the Office*] The Office of the Union shall carry out all the duties and tasks entrusted to it by the Council. It shall be under the direction of the Secretary-General.

(2) [*Duties of the Secretary-General*] The Secretary-General shall be responsible to the Council; he shall be responsible for carrying out the decisions of the Council. He shall submit the budget of the Union for the approval of the Council and shall be responsible for its implementation. He shall make reports to the Council on his administration and the activities and financial position of the Union.

(3) [*Staff*] Subject to the provisions of Article 26(5)(iii), the conditions of appointment and employment of the staff necessary for the efficient performance of the tasks of the Office of the Union shall be fixed in the administrative and financial regulations.

## Article 28

## Languages

(1) [*Languages of the Office*] The English, French, German and Spanish languages shall be used by the Office of the Union in carrying out its duties.

(2) [*Languages in certain meetings*] Meetings of the Council and of revision conferences shall be held in the four languages.

(3) [*Further languages*] The Council may decide that further languages shall be used.

## Article 29

## Finances

(1) [*Income*] The expenses of the Union shall be met from

(i) the annual contributions of the States members of the Union,

(ii) payments received for services rendered,

(iii) miscellaneous receipts.

(2) [*Contributions: units*] *(a)* The share of each State member of the Union in the total amount of the annual contributions shall be determined by reference to the total expenditure to be met from the contributions of the States members of the Union and to the number of contribution units applicable to it under paragraph (3). The said share shall be computed according to paragraph (4).

*(b)* The number of contribution units shall be expressed in whole numbers or fractions thereof, provided that no fraction shall be smaller than one-fifth.

(3) [*Contributions: share of each member*] *(a)* The number of contribution units applicable to any member of the Union which is party to the Act of 1961/1972 or the Act of 1978 on the date on which it becomes bound by this Convention shall be the same as the number applicable to it immediately before the said date.

*(b)* Any other State member of the Union shall, on joining the Union, indicate, in a declaration addressed to the Secretary-General, the number of contribution units applicable to it.
*(c)* Any State member of the Union may, at any time, indicate, in a declaration addressed to the Secretary-General, a number of contribution units different from the number applicable to it under subparagraph *(a)* or *(b)*. Such declaration, if made during the first six months of a calendar year, shall take effect from the beginning of the subsequent calendar year; otherwise, it shall take effect from the beginning of the second calendar year which follows the year in which the declaration was made.

(4) [*Contributions: computation of shares*] *(a)* For each budgetary period, the amount corresponding to one contribution unit shall be obtained by dividing the total amount of the expenditure to be met in that period from the contributions of the States members of the Union by the total number of units applicable to those States members of the Union.

*(b)* The amount of the contribution of each State member of the Union shall be obtained by multiplying the amount corresponding to one contribution unit by the number of contribution units applicable to that State member of the Union.

(5) [*Arrears in contributions*] *(a)* A State member of the Union which is in arrears in the payment of its contributions may not, subject to subparagraph *(b)*, exercise its right to vote in the Council if the amount of its arrears equals or exceeds the amount of the contribution due from it for the preceding full year. The suspension of the right to vote shall not relieve such State member of the Union of its obligations under this Convention and shall not deprive it of any other rights thereunder.

*(b)* The Council may allow the said State member of the Union to continue to exercise its right to vote if, and as long as, the Council is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(6) [*Auditing of the accounts*] The auditing of the accounts of the Union shall be effected by a State member of the Union as provided in the administrative and financial regulations. Such State member of the Union shall be designated, with its agreement, by the Council.

(7) [*Contributions of intergovernmental organizations*] Any Contracting Party which is an intergovernmental organization shall not be obliged to pay contributions. If, nevertheless, it chooses to pay contributions, the provisions of paragraphs (1) to (4) shall be applied accordingly.

# CHAPTER IX

# IMPLEMENTATION OF THE CONVENTION; OTHER AGREEMENTS

## Article 30

## Implementation of the Convention

(1) [*Measures of implementation*] Each Contracting Party shall adopt all measures necessary for the implementation of this Convention; in particular, it shall:

(i) provide for appropriate legal remedies for the effective enforcement of breeders' rights;

(ii) maintain an authority entrusted with the task of granting breeders' rights or entrust the said task to an authority maintained by another Contracting Party;

(iii) ensure that the public is informed through the regular publication of information concerning

- applications for and grants of breeders' rights, and
- proposed and approved denominations.

(2) [*Conformity of laws*] It shall be understood that, on depositing its instrument of ratification, acceptance, approval or accession, as the case may be, each State or intergovernmental organization must be in a position, under its laws, to give effect to the provisions of this Convention.

## Article 31

## Relations Between Contracting Parties and States Bound by Earlier Acts

(1) [*Relations between States bound by this Convention*] Between States members of the Union which are bound both by this Convention and any earlier Act of the Convention, only this Convention shall apply.

(2) [*Possible relations with States not bound by this Convention*] Any State member of the Union not bound by this Convention may declare, in a notification addressed to the Secretary-General, that, in its relations with each member of the Union bound only by this Convention, it will apply the latest Act by which it is bound. As from the expiration of one month after the date of such notification and until the State member of the Union making the declaration becomes bound by this Convention, the said member of the Union shall apply the latest Act by which it is bound in its relations with each of the members of the Union bound only by this Convention, whereas the latter shall apply this Convention in respect of the former.

## Article 32

## Special Agreements

Members of the Union reserve the right to conclude among themselves special agreements for the protection of varieties, insofar as such agreements do not contravene the provisions of this Convention.

# CHAPTER X

# FINAL PROVISIONS

## Article 33

## Signature

This Convention shall be open for signature by any State which is a member of the Union at the date of its adoption. It shall remain open for signature until March 31, 1992.

## Article 34

## Ratification, Acceptance or Approval; Accession

(1) [*States and certain intergovernmental organizations*] *(a)* Any State may, as provided in this Article, become party to this Convention.

*(b)* Any intergovernmental organization may, as provided in this Article, become party to this Convention if it

(i) has competence in respect of matters governed by this Convention,

(ii) has its own legislation providing for the grant and protection of breeders' rights binding on all its member States and

(iii) has been duly authorized, in accordance with its internal procedures, to accede to this Convention.

(2) [*Instrument of adherence*] Any State which has signed this Convention shall become party to this Convention by depositing an instrument of ratification, acceptance or approval of this Convention. Any State which has not signed this Convention and any intergovernmental organization shall become party to this Convention by depositing an instrument of accession to this Convention.

Instruments of ratification, acceptance, approval or accession shall be deposited with the Secretary-General.

(3) [*Advice of the Council*] Any State which is not a member of the Union and any intergovernmental organization shall, before depositing its instrument of accession, ask the Council to advise it in respect of the conformity of its laws with the provisions of this Convention. If the decision embodying the advice is positive, the instrument of accession may be deposited.

**Article 35**

**Reservations**

(1) [*Principle*] Subject to paragraph (2), no reservations to this Convention are permitted.

(2) [*Possible exception*] *(a)* Notwithstanding the provisions of Article 3(1), any State which, at the time of becoming party to this Convention, is a party to the Act of 1978 and which, as far as varieties reproduced asexually are concerned, provides for protection by an industrial property title other than a breeder's right shall have the right to continue to do so without applying this Convention to those varieties.

*(b)* Any State making use of the said right shall, at the time of depositing its instrument of ratification, acceptance, approval or accession, as the case may be, notify the Secretary-General accordingly. The same State may, at any time, withdraw the said notification.

**Article 36**

**Communications Concerning Legislation and the Genera and Species Protected; Information to be Published**

(1) [*Initial notification*] When depositing its instrument of ratification, acceptance or approval of or accession to this Convention, as the case may be, any State or intergovernmental organization shall notify the Secretary-General of

(i) its legislation governing breeder's rights and

(ii) the list of plant genera and species to which, on the date on which it will become bound by this Convention, it will apply the provisions of this Convention.

(2) [*Notification of changes*] Each Contracting Party shall promptly notify the Secretary-General of

(i) any changes in its legislation governing breeders' rights and

(ii) any extension of the application of this Convention to additional plant genera and species.

(3) [*Publication of the information*] The Secretary-General shall, on the basis of communications received from each Contracting Party concerned, publish information on

(i) the legislation governing breeders' rights and any changes in that legislation, and

(ii) the list of plant genera and species referred to in paragraph (1)(ii) and any extension referred to in paragraph (2)(ii).

## Article 37

## Entry into Force; Closing of Earlier Acts

(1) [*Initial entry into force*] This Convention shall enter into force one month after five States have deposited their instruments of ratification, acceptance, approval or accession, as the case may be, provided that at least three of the said instruments have been deposited by States party to the Act of 1961/1972 or the Act of 1978.

(2) [*Subsequent entry into force*] Any State not covered by paragraph (1) or any intergovernmental organization shall become bound by this Convention one month after the date on which it has deposited its instrument of ratification, acceptance, approval or accession, as the case may be.

(3) [*Closing of the 1978 Act*] No instrument of accession to the Act of 1978 may be deposited after the entry into force of this Convention according to paragraph (1), except that any State that, in conformity with the established practice of the General Assembly of the United Nations, is regarded as a developing country may deposit such an instrument until December 31, 1995, and that any other State may deposit such an instrument until December 31, 1993, even if this Convention enters into force before that date.

## Article 38

## Revision of the Convention

(1) [*Conference*] This Convention may be revised by a conference of the members of the Union. The convocation of such conference shall be decided by the Council.

(2) [*Quorum and majority*] The proceedings of a conference shall be effective only if at least half of the States members of the Union are represented at it.

A majority of three-quarters of the States members of the Union present and voting at the conference shall be required for the adoption of any revision.

## Article 39

## Denunciation

(1) [*Notifications*] Any Contracting Party may denounce this Convention by notification addressed to the Secretary-General. The Secretary-General shall promptly notify all members of the Union of the receipt of that notification.

(2) [*Earlier Acts*] Notification of the denunciation of this Convention shall be deemed also to constitute notification of the denunciation of any earlier Act by which the Contracting Party denouncing this Convention is bound.

(3) [*Effective date*] The denunciation shall take effect at the end of the calendar year following the year in which the notification was received by the Secretary-General.

(4) [*Acquired rights*] The denunciation shall not affect any rights acquired in a variety by reason of this Convention or any earlier Act prior to the date on which the denunciation becomes effective.

## Article 40

## Preservation of Existing Rights

This Convention shall not limit existing breeders' rights under the laws of Contracting Parties or by reason of any earlier Act or any agreement other than this Convention concluded between members of the Union.

## Article 41

## Original and Official Texts of the Convention

(1) [*Original*] This Convention shall be signed in a single original in the English, French and German languages, the French text prevailing in case of any discrepancy among the various texts. The original shall be deposited with the Secretary-General.

(2) [*Official texts*] The Secretary-General shall, after consultation with the interested Governments, establish official texts of this Convention in the Arabic, Dutch, Italian, Japanese and Spanish languages and such other languages as the Council may designate.

## Article 42

## Depositary Functions

(1) [*Transmittal of copies*] The Secretary-General shall transmit certified copies of this Convention to all States and intergovernmental organizations which were represented in the Diplomatic Conference that adopted this Convention and, on request, to any other State or intergovernmental organization.

(2) [*Registration*] The Secretary-General shall register this Convention with the Secretariat of the United Nations.

## Resolution on Article 14(5)

The Diplomatic Conference for the Revision of the International Convention for the Protection of New Varieties of Plants held from March 4 to 19, 1991, requests the Secretary-General of UPOV to start work immediately after the Conference on the establishment of draft standard guidelines, for adoption by the Council of UPOV, on essentially derived varieties.

## Recommendation Relating to Article 15(2)

The Diplomatic Conference recommends that the provisions laid down in Article 15(2) of the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as Revised at Geneva on November 10, 1972, on October 23, 1978, and on March 19, 1991, should not be read so as to be intended to open the possibility of extending the practice commonly called “farmer’s privilege” to sectors of agricultural or horticultural production in which such a privilege is not a common practice on the territory of the Contracting Party concerned.

## Common Statement Relating to Article 34

The Diplomatic Conference noted and accepted a declaration by the Delegation of Denmark and a declaration by the Delegation of the Netherlands according to which the Convention adopted by the Diplomatic Conference will not, upon its ratification, acceptance, approval or accession by Denmark or the Netherlands, be automatically applicable, in the case of Denmark, in Greenland and the Faroe Islands and, in the case of the Netherlands, in Aruba and the Netherlands Antilles. The said Convention will only apply in the said territories if and when Denmark or the Netherlands, as the case may be, expressly so notifies the Secretary-General.

**DRAFT LAW : of the JORDANIAN PLANT VARIETY PROTECTION ACT:**

Following is a copy of the proposed law(s) that is/are due to be signed thus enabling the creation under the Ministry of Agriculture of the Plant Variety Protection Office.

# Draft
# Law No. (  ) for the Year 2000
# The Law for the Protection of New Varieties of Plants

**Article (1)**

This Law shall be known as (The Law for the Protection of New Varieties of Plants for the Year 2000), and shall come into force thirty days after the date of its publication in the Official Gazette.

Definitions

**Article (2)**

THE FOLLOWING WORDS AND PHRASES, WHEREVER MENTIONED IN THIS LAW SHALL HAVE THE MEANINGS DESIGNATED HEREUNDER, UNLESS OTHERWISE INDICATED BY CONTEXT:

Ministry: Ministry of Agriculture.

Minister: Minister of Agriculture.

Plant Variety: The hierarchy of the plants in the Plants Kingdom shall be from the grouping, to the rank, to the family, to the genus, to the specie, to the variety.

Variety: Any plant grouping within a single botanical taxon of the lowest known rank, irrespective of whether the conditions for the grant of the protection right are fully met, and is defined by the expression of the characteristics resulting from a genotype or combination of genotypes, distinguished from any other plant grouping by the expression of at least one of the said characteristics, and considered as one unit with regard to its suitability for being propagated without changing any of its characteristics.

The Protected Variety: The variety that is registered according to the provisions of this Law.

Breeding: To breed, or to discover and develop, a new plant variety.

Breeder: The person who bred, or discovered and developed, a new plant variety, or his successor in title.

The Registrar: The New Plant Variety Registrar, nominated by the Minister.

The Register: The New Plant Variety Register.

**Article (3)**

The provisions of this Law shall apply on varieties thereunder plant genera or species, which shall be specified in the Regulation issued in accordance with the provisions of this Law.

**Article (4)**

A- A Register named "The New Plant Variety Register" shall be established at the Ministry, under the supervision of the Registrar, in which records shall be maintained of all information related to the new plant varieties, their denominations, names and addresses of their breeders, registration certificates, and any changes thereto resulting from procedures and legal acts including the following:

1- Any assignment, transfer of ownership, or license in respect of its use granted by the owner to others, subject to the confidentiality provisions in the licensing contract.
2- The hypothecation or attachment placed upon the protected variety or any restriction on its use.

B- The Register and the documents related to the rights granted for the breeder shall be available for the public. The growing tests and any other necessary tests provided for in this Law shall also be available for the public, in accordance with the Instructions issued by the Minister for this purpose, which shall be published in the Official Gazette.

C- The Ministry may maintain computerized records for the registration of varieties and the related data thereto, such data and documents retrieved therefrom and certified by the Registrar shall be valid proof against others, unless the interested party proves otherwise.

**Registration of New Plant Varieties**

**Article (5)**

The variety may be registered if the following conditions are met:

A- 1- If it is new, in the sense that, at the date of filing the application or the priority date stated in paragraph (A) of Article (9) of this Law, as the case may be, propagating or harvesting material of the variety has not been sold or otherwise transferred to others, by or with the consent of the breeder, for purposes of exploitation of the variety according to the following:

- For more than a year inside the Kingdom, and for more than four years outside the Kingdom.
- For more than six years outside the Kingdom, in the case of trees and vines.

2- The variety does not lose its novelty if it is sold or transferred to others for the purpose of research and development, or if it is transferred to others as a result of an infringement upon the breeder's right.

B- If it is distinct, in the sense that, it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the date of filing of the application. In particular, the filing of an application for registering another variety, or for registration thereof in an official register of varieties in any country, shall be deemed to render that other variety a matter of common knowledge from the date of the application, provided that the application leads to the registration of the variety and to accord the right therein to the breeder.

C- If it is uniform, in the sense that, it is sufficiently uniform in its relevant characteristics, subject to the variation that may be expected from the particular features of its propagation.

D- If it is stable, in the sense that, its relevant characteristics remain unchanged after repeated propagation, or in case of a particular cycle of propagation, at the end of each such cycle.

**Article (6)**

The right to register the variety shall be as follows:

A- To the breeder or to whom the variety right passes thereafter.

B- To the persons participating in its breeding, if it is the result of their joint efforts, provided that it is registered equally and jointly between them, unless agreed otherwise.

C- To the first breeder to file an application, if the breeding is independently made by more than one person.

D- To the employer, if the breeding is a result of an employment contract, which requires the employee to carry out such breeding, unless otherwise stipulated by contract.

**Article (7)**

The registration of a variety shall be as follows:

A- An application for registration shall be filed with the Registrar, on the form designated for this purpose, stating the botanical taxon of the variety, the suggested denomination, and any other issues or data specified in the Regulation issued in accordance with the provisions of this Law.

B- The application shall be limited to one variety, which shall be subject to the payment of the prescribed fees.

3rd- If the application is filed by a non-national person in the Kingdom or a non-resident, the breeder shall have to appoint a legal representative in the Kingdom.

**Article (8)**

A- The date the Registrar receives the application shall be considered the date of filing, provided that the application fulfills all the legal requirements, and attached thereto all the data indicating the identity of the applicant and a sample of the variety subject to registration.

B- Where the Registrar finds that the application has not fulfilled the requirements stated in paragraph (A) of this Article, he shall invite the applicant to fulfill such requirements, or to make the necessary amendments within thirty days of notification, and shall record the date of fulfilling such requirements as the date of filing of the application. Otherwise, the Registrar shall have the right to issue a decision that would deem the applicant to have abandoned the application. His decision may be appealed to the High Court of Justice within sixty days of its notification.

**Article (9)**

A- 1- The applicant of a variety may claim priority in the application, for an application submitted by him and filed on a prior date in a country with which the Kingdom is a party to a treaty to protect intellectual property, provided that the application is filed in the Kingdom within a period not exceeding twelve months, calculated from the day following the date of filing of the first application.

2- If the application for registration includes a priority right, according to clause (1) of this paragraph, the Registrar may request the applicant within three months from the date of filing of an application, to submit a copy of the documents which constitute the first application certified to be a true copy by the office with which it is filed. The Registrar may also request the applicant, within the period stated, to submit any samples or evidence to prove that the variety which is the subject matter of both applications is the same. In such case, the date of filing of the application for registration shall be the same date in which the application was filed in the other country.

B- If the applicant fails to prove the priority right according to paragraph (A) of this Article, the application shall be registered as of the date of filing with the Registrar.

C- The applicant may request for an additional period of two years after the expiration of the priority period, to provide the Registrar with the information, documents and materials required according to the Law, for the purpose of examination according to Article (10) of this Law, provided that, if the first application is rejected or withdrawn in the other country, the applicant shall be given six months from the date of rejection or withdrawal of the application, to submit the information, documents, and material required for the examination.

**Article (10)**

A- The variety shall undergo a technical examination to verify the following:

1. It belongs to the botanical taxon stated in the application for registration.
2. It fulfills the requirements of distinction, uniformity and stability stated in paragraphs (B, C and D) of Article (5) of this Law.

B- The examination provided for in clause (2) of paragraph (A) of this Article shall be made under the supervision of the Ministry in one of the following methods:

1. To rely on growth and germination examinations, and any other essential exams or tests, made by a technical authority inside or outside the Kingdom, if such tests or exams are carried out in environmental circumstances consistent with the environmental circumstances in the Kingdom; or,
2. The Ministry may carry out the tests and exams stated in clause (1) of this paragraph by itself, or through any authority on its behalf and on the breeder's expense.

C- A Technical Committee of experts shall be formed by virtue of Instructions issued by the Minister to verify the results of the tests and exams stated in paragraph (B) of this Article, in order to conclude the procedures of the registration of the variety, provided that such Instructions determine the other tasks of the Committee, including the way it functions, makes its decisions, and all other matters related thereto.

**Article (11)**

A- The Registrar may request the applicant to furnish all the related information, documents, and required materials to carry out the technical examination provided for in Article (10) of this Law, within the period determined in the Regulation issued according to this Law. If such information, documents and materials are not furnished, the Registrar shall have the right to issue a decision that would deem the applicant to have abandoned his application. The Registrar's decision in this regard may be appealed to the High Court of Justice within sixty days of its notification.

B- The examination provided for in Article (10) of this Law is for the purpose of approving of the registration. The examination may also be carried out after the registration for the purpose of verifying the stability and uniformity of the variety.

**Article (12)**

A- If the application fulfilled all the conditions and requirements provided for in this Law, the Registrar shall announce its acceptance, and shall grant the applicant with a preliminary approval, which shall be published in the Official Gazette after collecting the prescribed fees. The announcement shall include the plant variety and denomination thereof.

2nd- Any person shall be entitled to object the registration of any new plant variety at the Registrar within ninety days of the publication of the preliminary approval in the Official Gazette.

C- The period for publication, information to be published, objection procedures on preliminary approval for accepting the registration, conditions for extending the periods of objection, notifications, and other matters related thereto, shall be determined in the Regulation issued in accordance with the provisions of this Law.

**Article (13)**

The applicant shall be entitled to a temporary protection between the period of the publication of the application in the Official Gazette and the date of the registration of the variety. The applicant may use the variety within such period, and take procedures to prove any infringement thereof.

**Article (14)**

If no objection on the registration of the variety is submitted, or if it is rejected, the Registrar shall register the variety and grant the breeder a certificate for this purpose after collecting the prescribed fees.

**Protection of the Variety**

**Article (15)**

Subject to the provisions of Articles (16) and (17) of this Law:

A- The breeder, after registration thereof, shall have the right to protect the variety, by preventing others not having his consent from doing the following, in respect of the propagating material of the protected variety for commercial purposes:

1- Production or reproduction (multiplication).
2- Conditioning for the purpose of propagation.
3- Offering for sale.
4- Selling or other marketing activities.

5- Exporting.
6- Importing.
7- Stocking for any of the purposes mentioned in this paragraph.

B- The acts referred to in paragraph (A) of this Article in respect of harvested or reaped material, including entire plants or parts of the plants, obtained through the unauthorized use of propagating material of the protected variety shall require the authorization of the breeder, unless the breeder has had reasonable opportunity to exercise his right in relation to the said propagating material.

C- The provisions of paragraphs (A) and (B) of this Article shall also apply on the following varieties:

1. Varieties, which are essentially, derived from the protected variety where the protected variety is not itself an essentially derived variety. A variety shall be deemed to be essentially derived from another variety if the following conditions are met:
   - if it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety,
   - if it is clearly distinguishable from the initial variety,
   - if except for the differences, which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.
2. Varieties, which are not clearly distinguishable in accordance with, paragraph (B) of Article (5) of this Law from the protected variety.
3. Varieties whose production requires the repeated use of the protected variety.

D- In particular, essentially derived varieties may be obtained as a result of the selection of natural or induced mutants, or the selection of a variant individual from plants of the initial variety, backcrossing, or transformation by genetic engineering.

E- Any person committing any of the acts stated in paragraphs (A) and (B) of this Article, shall be considered committing an act of infringement upon the rights of the breeder of the protected variety, and shall be subject to legal liability, if he knew or if he should have known that he is infringing upon the breeder's rights of the protected variety.

**Article (16)**

Notwithstanding what is stated in Article (15) of this Law, the breeder's right shall not extend to the following:

A- Acts done privately for non-commercial purposes, for experimental purposes, or for the purpose of breeding new varieties.

B- Restriction of farmers from using for propagating purposes, on their own lands, the product of the harvest which they have obtained by planting any protected variety, or any variety as stated in clauses (1) and (2) of paragraph (C ) of Article (15) of this Law.

**Article (17)**

A- The breeder's right does not extend to the acts related to the materials of the protected variety, or the materials of any variety stated in paragraph (C ) of Article (15) of this Law, or any materials derived from the said material, which the breeder had sold or marketed in any other mean in the Kingdom by himself or with his consent, unless such acts:

1. Involve further propagation of the variety in question, or
2. Involve exportation of the material of the variety, which enables the propagation of the variety, into a country, which does not protect varieties of the plant genus, or species to which the variety belongs, unless the exportation is for consumption purposes.

B- For purposes of paragraph (A) of this Article, "*material*" means propagating material of any kind and harvesting material, including entire plants or parts of plants.

**Article (18)**

The term of protection for the protected variety shall be for twenty years beginning from the date of filing of an application for registration. As for trees and vines the term of protection shall be for twenty-five years.

**Transfer of Ownership, Hypothecation, and Attachment of the Variety**

**Article (19)**

1st- The breeder's rights may be transferred, completely or partially, with or without consideration, and may be subject to hypothecation or attachment.

2nd- Rights in a protected variety may pass by succession.

3rd- The procedures of the transfer of ownership of the protected variety, its hypothecation, attachment and all other legal acts related thereto, shall be determined in Instructions issued by the Minister for this purpose, which shall be published in the Official Gazette.

4th- Transfer of ownership of a variety and its hypothecation shall not be effective against others prior to the date of its recording in the Register, which shall be published in the Official Gazette.

## Licensing to Exploit the Variety

**Article (20)**

The breeder may grant others license to exploit the protected variety, by virtue of a written contract to be recorded with the Registrar.

**Article (21)**

A- The Minister may, upon the Registrar's recommendation, grant to other than the breeder, and without his consent, a license to exploit the variety for the public interest. In such case, the breeder shall have an adequate remuneration taking into consideration the economic value of the license.

B- The Minister may, upon his own initiative, or upon the breeder's request, cancel the compulsory license if the licensee violates any of the conditions thereof, or if the reasons for granting it are no longer applicable. This cancellation shall not affect the related rights of others having interest in the license.

Nullification and Cancellation of the Registration of the Variety

**Article (22)**

The registration of a variety shall be considered null in any of the following cases:

A- If it is proved that the variety is not new, or distinct at the date of filing of the application, or the priority date, as the case may be.

B- If it is proved that the variety is not uniform or stable at the date of filing of the application or the priority date, as the case may be, where the registration had been essentially based upon information and documents furnished by the breeder on the said date.

C- If the registration is made for a person other than the breeder contrary to the provisions of this Law.

**Article (23)**

A- The Registrar may cancel the registration of a variety in any of following cases:

1. If the stability and uniformity of the variety is not available anymore.
2. If the breeder does not provide the Registrar with the information, documents or materials deemed necessary for verifying the maintenance of the variety.
3. If the breeder fails to pay the annual prescribed fees.
4. If the breeder does not propose, where the denomination of the variety is cancelled after the registration, a suitable denomination for the protected variety.

B- For purposes of implementing clause (2), (3), and (4) of paragraph (A) of this Article, the Registrar shall notify the breeder of the cancellation, provided that the cancellation takes place after the lapse of the period determined in the Regulation issued in accordance with this Law.

**Article (24)**

The Registrar shall record in the Register, the decision of the nullification of the registration of the variety or cancellation thereof, and such shall be published in the Official Gazette.

**Article (25)**

All the Registrar's decisions may be subject to appeal to the High Court of Justice within sixty day from the date of its notification.

## The Variety Denomination

**Article (26)**

A- Each variety shall be registered with a denomination, which shall be considered its designation. The denomination may consist of a word, combination of words, combination of words and figures, or combination of letters and figures, with or without an existing meaning. It may not consist solely of figures except where this is an established practice for designating varieties, provided that the denomination enables the variety to be identified in all cases.

B- If the denomination had already been used for the variety in the Kingdom, or in any country, or proposed or registered in any other country, no other denomination may be used for the purpose of registration, unless there is ground for the refusal of the denomination, and another denomination shall be registered for the variety in the Register.

C- It is prohibited to use, or register any denomination identical or similar to another denomination which designates the variety, in a manner that might cause confusion in relation to an existing variety of the same plant species or a closely related species, whether such denomination is registered or known in the Kingdom, or any other country. Such prohibition shall remain even after the expiration of the exploitation of the variety, if the denomination acquired a certain connotation in relation to the variety.

D- Subject to paragraph (E) of this Article, any person who offers for sale, sells or otherwise markets propagating material of a protected variety shall be obliged to use the denomination of the variety, even after the expiration of the protection period.

E- Prior rights of others shall not be affected, by reason of the use of a denomination of a variety, in such a case, the Registrar shall require the breeder to propose another denomination for the variety.

F- When a variety is offered for sale or marketed, the use of the variety denomination in association with a trademark, trade name, or other similar indication shall be permitted, subject to the denomination remaining easily recognized.

**Article (27)**

A denomination of a variety may not be registered if:

A- It is contrary to the provisions of the Law.

B- It is contrary to the public order and mortality.

C- It is liable to mislead or to cause confusion with respect to the characteristics, value, identity, or geographical origin of the variety, or the identity of the breeder.

**Article (28)**

The suggested denomination of the variety shall be specified in the application. The registration of denominations, publication thereof, and periods related thereto, shall be determined in a Regulation issued according to the provisions of this Law.

**Provisional Measures and Penalties**

**Article (29)**

A- The breeder of a protected variety, when filing a civil lawsuit to prevent the infringement on his rights in the protected variety, or during the course of the hearings, may petition the competent Court for the following, provided that the petition is attached with a bank guaranty or a cash deposit accepted by the Court:

B-1. The breeder of a protected variety may, prior to filing a lawsuit, petition the Court to take any of the measures provided for in paragraph (A) of this Article, provided that the petition is attached with a bank guarantee or a cash deposit accepted by the Court, without notifying the counter-party. The Court may approve the petition if the breeder proves any of the following:

- That his rights had been infringed upon,
- That such infringement is imminent and is likely to cause damages of irreparable harm,
- That there is a demonstrable risk of evidence being disappeared or destroyed.

2. If the breeder of the protected variety fails to file the lawsuit within eight days from the date the Court approves his petition, all measures taken in this regard shall be nullified.
3. The counter-party may appeal the court's decision in taking the provisional measures to the Court of Appeal within eight days of notification or acknowledgment thereof. The decision of the Court of Appeal in this regard shall be final.
4. The counter-party may claim compensation for damages he suffered, if it is proven that the petitioner was unlawful in his petition to take provisional measures, or if the petitioner failed to file his lawsuit within the period determined in clause (2) of this paragraph.

C- The defendant may claim compensation for damages he suffered, if the Court decides that the plaintiff's claims are invalid.

D- The Court may seek, in all cases, experts opinion.

E- The Court may order the seizure of the variety the subject matter of infringement, tools, and materials mainly used in the infringement upon the protected variety. The Court may also order destruction of such variety, tools and materials, or use of such outside the channels of commerce.

## General Provisions

**Article (30)**

A- The Council of Ministers shall issue the necessary Regulations for implementing the provisions of this Law, including determining the annual fees for the renewal of registration, and other fees that should be collected in accordance with the provisions of this Law.

B- Instructions referred to in this Law shall be published in the Official Gazette.

**Article (31)**

The Prime Minister and the Ministers shall be responsible for implementing the provisions of this Law.

## Plant variety protection regulations

The following pages outline draft regulations that can be adopted for the implementation of the operation of the Plant Variety Protection Office and its activities.

**Note that the accompanying training report contains annotated notes to these regulations.**

# PLANT VARIETY PROTECTION (PVP) REGULATIONS

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TEXT OF REGULATIONS

**Scope** **Space for Notes**

Sec. 1 General.

Certificates of protection are issued by the Plant Variety Protection office for new, distinct, uniform, and stable varieties of sexually reproduced or tuber propagated plants. Each certificate of plant variety protection certifies that the breeder has the right, during the term of the protection, to prevent others from selling the variety, offering it for sale, reproducing it, importing or exporting it, conditioning it, stocking it, or using it in producing a hybrid or different variety from it, as provided by the act.

**Definitions**

Sec. 2 Meaning of words.

Words used in the regulations in this part in the singular form will import the plural, and vice versa, as the case may demand. The definitions of terms contained in the Act shall apply to such terms when used in this part. As used throughout the regulations in this part, unless the context requires otherwise, the following terms will be construed to mean:

Abandoned application. An application which has not been pursued to completion within the time allowed by the Office or has been voluntarily abandoned.

Act. The Jordanian Plant Variety Protection Act

Applicant. The person who applied for a certificate of plant variety protection.

Application. An application for plant variety protection under the Act.

Assignee. A person to whom an owner assigns his/her rights in whole or in part.

Board. The Plant Variety Protection Board appointed by the Minister.

Certificate. A certificate of plant variety protection issued under the Act by the Office.

Certified seed. Seed which has been determined by an official seed certifying agency to conform to standards of genetic purity and identity as to variety, which standards have been approved by the Minister.

Decision and order. Includes the Minister's findings of fact; conclusions with respect to all material issues of fact and law, as well as the reasons or basis thereof; and order.

Examiner. An employee of the Plant Variety Protection Office who determines whether a certificate is entitled to be issued. The term

shall, in all cases, include the Registrar.

Foreign application. An application for plant variety protection filed in a foreign country.

Hearing Officer. An Administrative Law Judge duly assigned to preside at a hearing held pursuant to the rules of this part.

Office or Plant Variety Protection Office. The Plant Variety Protection Office.

Official Journal. The “Official Journal of the Plant Variety Protection Office, or the Official Gazette or Newspaper Notice."

Owner. A breeder who developed or discovered a variety for which plant variety protection may be applied for under the Act, or a person to whom the rights to such variety have been assigned or transferred.

Person. An individual, partnership, corporation, association, government agency, or other business or governmental entity.

Minister. The Minister of Agriculture of the Kingdom of Jordan or any other officer or employee of the Ministry of Agriculture, to whom authority has heretofore been delegated, or to whom authority may hereafter be delegated to act in his or her stead.

Registrar. The Examiner in Charge of the Office.

Seed certifying agency. It shall be defined as set forth in the Appropriate Seed Acts

Sale for other than seed purposes. The transfer of title to and possession of the seed by the owner to a grower or other person, for reproduction for the owner, for testing, or for experimental use, and not for commercial sale of the seed or the reproduced seed for planting purposes.

## Administration

Sec. 3 Plant Variety Protection Board.

(a) The Plant Variety Protection Board shall consist of 8 members

appointed for a 3-year term. The Board shall be appointed every 3 years and shall consist of individuals who are experts in various areas of variety development. The membership of the Board, which shall include farmer representation, shall be drawn approximately equally from the private or seed industry sector and from the government or public sector. No member shall be eligible to act on any matter involving any appeal or questions in which the member or his or her employer has a direct financial interest.

(b) The functions of the Board are to:

(1) Advise the Minister concerning adoption of rules and regulations to facilitate the proper administration of the Act;

(2) Make advisory decisions on all appeals from the examiner or Registrar;

(3) Advise the Minister on the declaration of a protected variety open to use in the public interest; and

(4) Advise the Minister on any other matters under the regulations in this part.

(c) The proceedings of the Board shall be conducted in accordance with the appropriate Jordanian Government Administrative Rules.

## The Application

Sec. 4 General requirements.

(a) Protection under the Act shall be afforded only as follows:

(1) Nationals and residents of the Kingdom of Jordan shall be eligible to receive all of the protection under the Act.

(2) Nationals and residents of Member States of the International Union for the Protection of New Varieties of Plants (including states which are members of an intergovernmental organization which is a UPOV member) shall be eligible to receive the same protection under the Act as is

provided to nationals of the Kingdom of Jordan.

(3) Persons who are not entitled to protection under paragraph (a)(1) or (2) of this section, and who are nationals of a foreign state which is not a member of the International Union for the Protection of New Varieties of Plants, shall be entitled to only so much of the protection provided under the Act, as is afforded by such foreign state to nationals of the Kingdom of Jordan, for the same genus and species under the laws of such foreign state in effect at the time that the application for protection under the Act is filed, except where further protection under the Act must be provided in order to avoid the violation of a treaty to which the Kingdom of Jordan is a party.

(b) Applications for certificates shall be made to the Plant Variety Protection Office. An application shall consist of:

(1) A completed application form, except that the section specifying that seed of the variety shall be sold by variety name only, as a class of certified seed, need not be completed at the time of application.

(2) A completed set of the exhibits, as specified in the application form, unless the examiner waives submission of certain exhibits as unnecessary, based on other claims and evidence presented in connection with the application.

(3) Language and legibility: (i) Applications and exhibits may be in the Arabic or English language and legibly written, typed or printed.

(ii) Any inter-lineation, erasure, cancellation, or other alteration must be made in permanent ink before the application is signed and shall be clearly initialed and dated by the applicant to indicate knowledge of such fact at the time of signing.

(4) To determine the extent of reciprocity of the protection to be provided under the Law, persons filing an application for plant variety protection in the Kingdom of Jordan under the provisions of paragraph (a)(3) of this section shall, upon request furnish the Plant Variety Protection Office with a copy of the current plant variety protection laws and regulations for the country of which the applicant

is a national, and an accurate Arabic or English translation of such laws and regulations.

(a) Copies and translations of foreign laws and regulations will be requested only if they are not in the files of the Plant Variety Protection Office.

(b) Applicants may learn whether such a request will be made by writing to the address given in paragraph (c) of this section.

(c) Application and exhibit forms shall be issued by the Registrar.

(d) Effective the date of these regulations and rules of practice, the signature of the applicant, or his or her agent or attorney on any affidavit or other statement filed pursuant to these regulations and rules constitutes a certification by the applicant. The signature certifies that all information relied on in any affidavit or statement filed in the course of the proceeding is knowingly correct and false claims have not been made to mislead.

Sec. 5 Application for certificate.

(a) An application for a plant variety protection certificate shall be signed by, or on behalf, of the applicant.

(b) The application shall state the full name, including the full first name and the middle initial or name, if any, and the capacity of the person executing it.

(c) The fees for filing an application, and search or examination, shall be submitted with the application in accordance with Sec. 175 through 178.

(d) The applicant shall submit with the application:

(1) At least 2,500 seeds of the viable basic seed required to reproduce the variety;

(2) With the application for a tuber propagated variety,

verification that a viable cell culture has been deposited in a public depository approved by the Registrar and will be maintained for the duration of the certificate; or

(3) With the application for a hybrid from self-incompatible parents, verification that a plot of vegetative material for each parent has been established in a public depository approved by the Registrar and will be maintained for the duration of the certificate.

Sec. 6 Specimen requirements.

(a) The applicant may be required by the examiner to furnish representative specimens of the variety, or its flower, fruit, or seeds, in a quantity and at a specified stage of growth, as may be necessary to verify the statements in the application. Such specimens shall be packed and forwarded in conformity with instructions furnished by the examiner. If the applicant requests the examiner to inspect plants in the field before a final decision is made, all such inspection costs shall be borne by the applicant by payment of fees sufficient to reimburse the Office for all costs, including travel, per diem or subsistence, and salary.

(b) Plant specimens submitted in support of an application shall not be removed from the Office except by an employee of the Office or other person authorized by the Minister.

(c) Plant specimens submitted to the Office shall, except as provided below, and upon request, be returned to the applicant at his or her expense after the specimens have served their intended purpose. The Registrar, upon a finding of good cause, may require that certain specimens be retained in the Office for indefinite periods of time. Specimens which are not returned or not retained as provided above shall be destroyed.

Sec. 7 Drawings and photographs.

(a) Drawings or photographs submitted with an application shall disclose the distinctive characteristics of the variety.

(b) Drawings or photographs shall be in color when color is a distinguishing characteristic of the variety, and the color shall be described by use of Nickerson's or other recognized color chart.

(c) Drawings should be sent flat, or may be sent in a suitable mailing tube, in accordance with instructions furnished by the Registrar.

(d) Drawings or photographs submitted with an application shall be retained by the Office as part of the application file.

Sec. 8 Parts of an application to be filed together.

All parts of an application, including exhibits, should be submitted to the Office together, otherwise, each part shall be accurately and clearly referenced to the application.

Sec. 9 Application accepted and filed when received.

(a) An application, if materially complete when initially submitted, shall be accepted and filed to await examination.

(b) If any part of an application is so incomplete, or so defective that it cannot be handled as a completed application for examination, as determined by the Registrar, the applicant will be notified. The application will be held a maximum of 3 months for completion. Applications not completed at the end of the prescribed period will be considered abandoned. The application fee in such cases will not be refunded.

Sec. 10 Number and filing date of an application.

(a) Applications shall be numbered and dated in sequence in the order received in the Office. Applicants will be informed in writing as soon as practicable of the number and effective filing date of the application.

(b) An applicant may claim the benefit of the filing date of a prior foreign application .

A certified copy of the foreign application shall be filed upon request made by the examiner. If a foreign application is not in the English or Arabic language, an Arabic or English translation, certified as accurate by a sworn or official translator, shall be submitted with the application.

Sec. 11 When the owner is deceased or legally incapacitated.

In case of the death of the owner or if the owner is legally incapacitated, the legal representative (executor, administrator, or guardian) or heir or assignee of the deceased owner may sign as the applicant. If an applicant dies between the filing of his or her application and the granting of a certificate thereon, the certificate may be issued to the legal representative, heir, or assignee, upon proper intervention.

Sec. 12 Joint applicants.

(a) Joint owners shall file a joint application by signing as joint applicants.

(b) If an application for certificate is made by two or more persons as joint owners, when they were not in fact joint owners, the application shall be amended prior to issuance of a certificate by filing a corrected application, together with a written explanation signed by the original applicants. Such statement shall also be signed

by the assignee, if any.

(c) If an application has been made by less than all the actual joint owners, the application shall be amended by filing a corrected application, together with a written explanation, signed by all of the joint owners. Such statement shall also be signed by the assignee, if any.

(d) If a joint owner refuses to join in an application or cannot be found after diligent effort, the remaining owner may file an application on behalf of him or herself and the missing owner. Such application shall be accompanied by a written explanation and shall state the last known address of the missing owner. Notice of the filing of the application shall be forwarded by the Office to the missing owner at the last known address. If such notice is returned to the Office undelivered, or if the address of the missing owner is unknown, notice of the filing of the application shall be published once in the Official Journal, gazette or recognized national newspaper. Prior to the issuance of the certificate, a missing owner may
join in an application by filing a written explanation. A certificate obtained by less than all of the joint owners under this paragraph conveys the same rights and privileges to said owners as though all of the original owners had joined in an application.

Sec. 13 Assigned varieties and certificates.

In case the whole or a part interest in a variety is assigned, the application shall be made by the owner or one of the persons identified in Sec. 11. However, the certificate may be issued to the assignee, or jointly to the owner and the assignee, when a part interest in a variety is assigned.

Sec. 14 Amendment by applicant.

An application may be amended before or after the first examination and action by the Office, after the second or subsequent examination or reconsideration as specified in Sec. 107, or when and as specifically required by the examiner. Such amendment may include a specification that seed of the variety be sold by variety name only as a class of certified seed, if not previously specified or if previously declined. Once an affirmative specification is made, no amendment to reverse such a specification will be permitted unless the variety has not been sold and labeled or publication made in any manner that the variety is to be sold by variety name, only as a class of certified seed.

Sec. 15 Papers of completed application to be retained.

The papers submitted with a completed application shall be retained by the Office except as provided in Sec. 23(c). After issuance of a certificate of protection the Office will furnish copies of the application and related papers to any person upon payment of the specified fee.

Sec. 16 Applications handled in confidence.

(a) Pending applications shall be handled in confidence. Except as provided below, no information may be given by the Office respecting the filing of an application, the dependency of any particular application, or the subject matter of any particular application. Also, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority of the applicant, or his or her assignee or attorney or agent. Exceptions to the above may be made by the upon a finding that such action is necessary to the proper conduct of the affairs of the Office.

(b) Abandoned applications shall not be open to public inspection.

However, if an abandoned application is directly referred to in an issued certificate and is available, it may be inspected or copies obtained by any person on written request, and with written authority received from the applicant. Abandoned applications shall not be returned.

(c) Decisions of the Registrar on abandoned applications not otherwise open to public inspection (see paragraph (b) of this section) may be published or made available for publication at the Registrar's discretion. When it is proposed to release such a decision, the applicant shall be notified directly or through the attorney or agent of record, and a time, not less than 30 days, shall be set for presenting objections.

Sec. 17 Publication of pending applications.

Information relating to pending applications shall be published in the Official Journal, gazette or recognized national newspaper periodically as determined by the Registrar to
be necessary in the public interest. With respect to each application, the Official Journal, gazette or recognized national newspaper shall show:

(a) Application number and date of filing;

(b) The name of the variety or temporary designation;

(c) The name of the kind of seed; and

(d) Whether the applicant specified that the variety is to be sold by variety name only as a class of certified seed, together with a limitation in the number of generations that it can be certified.

Additional information, such as the name and address of the applicant or a brief description of the distinctive features of the variety, may be published only upon request or approval received from the applicant, at the time the application is filed or at any time before the notice of allowance of a certificate is issued.

Sec. 18 Abandonment for failure to respond within the time limit.

(a) Except as otherwise provided in Sec. 104, if an applicant fails to advance actively his or her application within 30 days after the date when the last request for action was mailed to the applicant by the Office, or within such longer time as may be fixed by the Registrar, the application shall be deemed abandoned. The application fee in such cases will not be refunded.

(b) The submission of an amendment to the application, not responsive to the last request by the Office for action, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When the applicant makes a bona fide attempt to advance the application, and is in substantial compliance with the request for action, but has inadvertently failed to comply with some procedural requirement, opportunity to comply with the procedural requirement shall be given to the applicant before the application shall be deemed abandoned. The Registrar may set a period, not less than 30 days, to correct any deficiency in the application.

Sec. 19 Extension of time for a reply.

The time for reply by an applicant to a request by the Office for certain action, shall be extended by the Registrar only for good and sufficient cause, and for a specified reasonable time. A request for extension and appropriate fee shall be filed on or before the specified time for reply. In no case shall the mere filing of a request for extension require the granting of an extension or state the time for reply.

Sec. 20 Revival of an application abandoned for failure to reply.

An application abandoned for failure on the part of the applicant to advance actively his or her application to its completion, in accordance with the regulations in this part, may be revived as a pending application within 3 months of such abandonment, upon a finding by the Registrar that the failure was inadvertent or unavoidable and without fraudulent intent. A request to revive an abandoned application shall be accompanied by a written statement showing the cause of the failure to respond, a response to the last request for action, and by the specified fee.

Sec. 21 Voluntary withdrawal and abandonment of an application.

(a) An application may be voluntarily withdrawn or abandoned by submitting to the Office a written request for withdrawal or abandonment, signed by the applicant or his or her attorney or agent of record, if any, or the assignee of record, if any.

(b) An application which has been voluntarily abandoned may be revived within 3 months of such abandonment by the payment of the prescribed fee and a showing that the abandonment occurred without fraudulent intent.

(c) An original application which has been voluntarily withdrawn shall be returned to the applicant and may be reconsidered only by re-filing and payment of a new application fee.

Sec. 22 Assignee.

The assignee of record of the entire interest in an application is entitled to advance actively or abandon the application to the exclusion

of the applicant.

## Examinations, Allowances, and Denials

Sec. 100 Examination of applications.

Examinations of applications shall include a review of all available documents, publications, or other material relating to varieties of the species involved in the application, except that if there are fundamental defects in the application, as determined by the examiner, the examination may be limited to an identification of such defects and notification to the applicant of needed corrective action. However, matters of form or procedure need not, but may, be raised by an examiner until a variety is found to be new, distinct, uniform, and stable and entitled to protection.

Sec. 101 Notice of allowance.

If, on examination, it shall appear that the applicant is entitled to a certificate, a notice of allowance shall be sent to the applicant or his or her attorney or agent of record, if any, calling for the payment of the prescribed fee, which fee shall be paid within 1 month from the date of the notice of allowance. Thereafter, a fee for delayed payment shall be made as required under Sec. 175.

Sec. 102 Amendments after allowance.

Amendments to the application, after the notice of allowance is issued, may be made, if the certificate has not been issued.

Sec. 103 Issuance of a certificate.

(a) After the notice of allowance has been issued, the prescribed fee is received by the Office, and the applicant has clearly specified whether or not the variety shall be sold by variety name only as a class of certified seed, the certificate shall be promptly issued. Once an election is made and a certificate issued specifying that seed of the variety shall be sold by variety name only as a class of certified seed, no waiver of such rights shall be permitted by amendment of the certificate.

(b) The certificate shall be delivered or mailed to the owner.

Sec. 104 Application or certificate abandoned.

(a) Except as provided in paragraph (c) of this section, if the fee specified in the notice of allowance is not paid within 1 month from the date of the notice, the application shall be considered abandoned.

(b) Upon request by the Office, the owner shall replenish the viable basic seed sample of the variety. Upon request, the sample of seed which has been replaced shall be returned to the owner, otherwise it shall be destroyed. Failure to replenish viable basic seed within 3 months from the date of request shall result in the certificate being regarded as abandoned. No sooner than 1 year after the date of such request, notices of abandoned certificates shall be published in the Official Journal, gazette or recognized national newspaper, indicating that the variety has become open for use by the public and, if previously specified to be sold by variety name as ``certified seed only," that such restriction no longer applies.

(c) If the allowance fee, the viable basic seed sample or the fee for delayed payment are submitted within 9 months of the final due date, it may be accepted by the Registrar as though no abandonment had occurred. For good cause, the Registrar may extend for a reasonable

time the period for submitting a viable basic seed sample before declaring the certificate abandoned.

(d) A certificate may be voluntarily abandoned by the applicant or his or her attorney or agent of record or the assignee of record by notifying the Registrar in writing. Upon receipt of such notice, the Registrar shall publish a notice in the Official Journal, gazette or recognized national newspaper that the
variety has become open for use by the public, and if previously specified to be sold by variety name as ``certified seed only,'' that such restriction no longer applies.

Sec. 105 Denial of an application.

(a) If the variety is found by the examiner to be not new, distinct, uniform, and stable, the application shall be denied.

(b) In denying an application, the examiner shall cite the reasons the application was denied. When a reason involves the citation of certain material which is complex, the particular part of the material relied on shall be designated as nearly as practicable. The pertinence of each reason, if not obvious, shall be clearly explained.

(c) If prior domestic certificates are cited as a reason for denial, their numbers and dates and the names of the owners shall be stated. If prior foreign certificates or rights are cited, as a reason for denial, their nationality or country, numbers and dates, and the names of the owners shall be stated, and such other data shall be furnished, as may be necessary to enable the applicant to identify the cited certificates or rights.

(d) If printed publications are cited as a reason for denial, the author (if any), title, date, pages or plates, and places of publication, or place where a copy can be found shall be given.

(e) When a denial is based on facts known to the examiner, and upon

request by the applicant, the denial shall be supported by the affidavit of the examiner. Such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

(f) Abandoned applications may not be cited as reasons for denial.

Sec. 106 Reply by applicant; request for reconsideration.

(a) After an adverse action by the examiner, the applicant may respond to the denial and may request a reconsideration, with or without amendment of his or her application. Any amendment shall be responsive to the reason or reasons for denial specified by the examiner.

(b) To obtain a reconsideration, the applicant shall submit a request for reconsideration in writing and shall specifically point out the alleged errors in the examiner's action. The applicant shall respond to each reason cited by the examiner as the basis for the adverse action. A request for reconsideration of a denial based on a faulty form or procedure may be held in abeyance by the Registrar until the question of the variety being new, distinct, uniform, and stable is settled.

(c) An applicant's request for a reconsideration must be a bona fide attempt to advance the case to final action. A general allegation by the applicant that certain language which he or she cites in the application or amendment thereto establishes the variety is new, distinct, uniform, and stable without specifically explaining how the language distinguishes the alleged new, distinct, uniform, and stable variety from the material cited by the examiner shall not be grounds for a reconsideration.

Sec. 107 Reconsideration and final action.

If, upon reconsideration, the application is denied by the Registrar, the applicant shall be notified by the Registrar of the

reason or reasons for denial in the same manner as after the first examination. Any such denial shall be final unless appealed by the applicant to the Minister within 60 days from the date of denial. If the denial is sustained by the Minister on appeal, the denial shall be final subject to appeal to the Courts.

Sec. 108 Amendments after final action.

(a) After a final denial by the Registrar, amendments to the application may be made to overcome the reason or reasons for denial. The acceptance or refusal of any such amendment by the Office and any proceedings relative thereto shall not relieve the applicant from the time limit set for an appeal or an abandonment for failure to reply.

(b) No amendment of the application can be made in an appeal proceeding. After decision on appeal, amendments can only be made to carry into effect a recommendation.

**Correction of Errors in Certificate**

Sec. 120 Corrected certificate--office mistake.

When a certificate is incorrect because of a mistake in the Office, the Registrar may issue a corrected certificate stating the fact and nature of such mistake, without charge, to be issued to the owner and recorded in the records at the Office.

Sec. 121 Corrected certificate--applicant's mistake.

When a certificate is incorrect because of a mistake by the applicant of a clerical or typographical nature, or of minor character, or in the description of the variety (including, but not limited to, the use of a misleading variety name or a name assigned to a different

variety of the same species), and the mistake is found by the Registrar to have occurred in good faith and does not require a further examination, the Registrar may, upon payment of the required fee and return of the original certificate, correct the certificate by issuing a corrected certificate, in accordance with the Act. If the mistake requires a reexamination, a correction of the certificate shall be dependent on the results of the reexamination.

**Re-issuance of Certificate**

Sec. 122 Certified seed only election.

When an owner elects after a certificate is issued to sell the protected variety by variety name only as a class of certified seed, a new certificate may be issued upon return of the original certificate to the Office and payment of the appropriate fee.

**Assignments and Recording**

Sec. 130 Recording of assignments.

(a) Any assignment of an application for a certificate, or of a certificate of plant variety protection, or of any interest in a variety, or any license or grant and conveyance of any right to use of the variety, may be submitted for recording in the Office.

(b) No instrument shall be recorded which is not in the Arabic or English language or which does not identify the certificate or application to which it relates.

(c) An instrument relating to title of a certificate shall identify the certificate by number and date, the name of the owner, and the name of the variety as stated in the certificate. An instrument relating to title of an application shall identify an application by number and date of filing, the name of the owner, and the name of the variety as stated

in the application.

(d) If an assignment is executed concurrently or subsequent to the filing of an application, but before its number and filing date are ascertained, the assignment shall identify the application by the date of the application, the name of the owner, and the name of the variety.

Sec. 131 Conditional assignments.

Assignments recorded in the Office are regarded as absolute assignments for Office purposes until canceled in writing by both parties to the assignment or by a decree of a court of competent jurisdiction. The Office shall not determine whether conditions precedent to the assignment, such as the payment of money, have been fulfilled.

Sec. 132 Assignment records open to public inspection.

(a) Assignment records relating to original or amended certificates shall be open to public inspection and copies of any recorded document may be obtained upon payment of the prescribed fee.

(b) Assignment records relating to any pending or abandoned application shall not be available for inspection except to the extent that pending applications are published .
Copies of assignment records and information on
pending or abandoned applications shall be obtainable only upon written authority of the applicant or his or her assignee, or attorney or agent of record. An order for a copy of an assignment shall give the proper identification of the assignment.

**Marking or Labeling Provisions**

Sec. 140 After filing.

Upon filing an application for protection of a variety and payment of the prescribed fee, the owner, or his or her designee, may label the variety or containers of the seed of the variety or plants produced from such seed, substantially as follows: ``Unauthorized Propagation Prohibited--(Unauthorized Seed Multiplication Prohibited)—Jordanian Variety Protection Applied For.

Sec. 141 After issuance.

Upon issuance of a certificate, the owner of the variety, or his or her designee, may label the variety or containers of the seed of the variety or plants produced from such seed substantially as follows: ``Unauthorized Propagation Prohibited--(Unauthorized Seed Multiplication Prohibited)—Jordanian Protected Variety.

Sec. 142 For testing or increase.

An owner who contemplates filing an application and releases for testing or increase, seed of the variety or reproducible plant material of the variety, may label such plant material or containers of the seed or plant material substantially as follows: ``Unauthorized Propagation Prohibited--For Testing (or Increase) Only."

Sec. 143 Certified seed only.

(a) Upon filing an application, or amendment thereto, specifying seed of the variety is to be sold by variety name only as a class of certified seed, the owner, or his or her designee, may label containers of seed of the variety substantially as follows: ``Unauthorized Propagation Prohibited--Jordanian Variety Protection Applied for Specifying That Seed of This Variety Is To Be Sold By Variety Name Only as a Class of Certified Seed."

(b) An owner who has received a certificate specifying that a variety is to be sold by variety name only, as a class of certified seed, may label containers of the seed of the variety substantially as follows: ``Unauthorized Propagation Prohibited--To Be Sold By Variety Name Only as a Class of Certified Seed –Jordanian Protected Variety."

Sec. 144 Additional marking or labeling.

Additional clarifying information that is not false or misleading may be used by the owner, in addition to the above markings or labeling.

**Attorneys and Agents**

Sec. 150 Right to be represented.

An applicant may actively advance an application or may be represented by an attorney or agent authorized in writing.

Sec. 151 Authorization.

Only attorneys or agents specified by the applicant shall be allowed to inspect papers or take action of any kind, on behalf of the applicant, in any pending application or proceedings.

Sec. 152 Revocation of authorization; withdrawal.

An authorization of an attorney or agent may be revoked by an applicant at any time, and an attorney or agent may withdraw, upon application to the Registrar. When the authorization is so revoked, or the attorney or agent has so withdrawn, the Office shall inform the interested parties and shall thereafter communicate directly with the applicant, or with such other attorney or agent as the applicant may

appoint. An assignment will not of itself operate as a revocation of authorization previously given, but the assignee of the entire interest may revoke previous authorizations and be represented by an attorney or agent of his or her own selection.

Sec. 153 Persons recognized.

Unless specifically authorized as provided in Sec. 151, no person shall be permitted to file or advance applications before the Office on behalf of another person.

Sec. 154 Government employees.

Officers and employees of the Kingdom of Jordan who are disqualified from practicing as attorneys or agents in proceedings or other matters before government departments or agencies, shall not be eligible to represent applicants, except officers and employees whose official duties require the preparation and prosecution of applications for certificates of variety protection.

Sec. 155 Signatures.

Every document filed by an attorney or agent representing an applicant or party to a proceeding in the Office shall bear the signature of such attorney or agent, except documents which are required to be signed by the applicant or party.

Sec. 156 Addresses.

Attorneys and agents practicing before the Plant Variety Protection Office shall notify the Office in writing of any change of address. The Office shall address letters to any person at the last address received.

Sec. 157 Professional conduct.

Attorneys and agents appearing before the Office shall conform to the standards of ethical and professional conduct, generally applicable to attorneys appearing before the courts of the Kingdom of Jordan.

Sec. 158 Advertising.

(a) The use of advertising, circulars, letters, cards, and similar material to solicit plant variety protection business, directly or indirectly, is forbidden as unprofessional conduct, and any person engaging in such solicitation, or associated with or employed by others who so solicit, shall be refused recognition to practice before the Office or may be suspended, excluded, or disbarred from further practice before the Office.

(b) The use of simple professional letterheads, calling cards, or office signs, simple announcements necessitated by opening an office, change of association, or change of address, distributed to clients and friends and insertion of listings in common form (not display) in a classified telephone or city directory, and listings and professional cards with biographical data in standard professional directories, shall not be considered a violation of this section.

## Fees and Charges

Sec. 175 Fees and charges.

The following fees and charges apply to the services and actions specified below:

{Amount of Fees to be determined}

(a) Filing the application and notifying the public of filing.

(b) Search or examination..... .

(c) Allowance and issuance of certificate and notifying public of issuance.....

(d) Revive an abandoned application.....

(e) Reproduction of records, drawings, certificates, exhibits or printed material (copy per page of material).....

(f) Authentication (each page).....

(g) Correcting or re-issuance of a certificate.....

(h) Recording assignments (per certificate/application).....

(i) Copies of 8 x 10 photographs in color.....

(j) Additional fee for reconsideration.....

(k) Additional fee for late payment.....

(l) Additional fee for late replenishment of seed.....

(m) Appeal to Minister (refundable if appeal overturns the Registrar's decision).....

(n) Granting of extension for responding to a request.....

(o) Field inspections by a representative of the Plant Variety Protection Office made at the request of the applicant shall be reimbursable in full (including travel, per diem or subsistence, and salary) in accordance with Customary Government Travel Regulations.

(p) Any other service not covered above will be charged for at rates prescribed by the Registrar.

Sec. 176 Fees payable in advance.

Fees and charges shall be paid at the time of making application or at the time of submitting a request for any action by the Office for which a fee or charge is payable and established in this part.

Sec. 177 Method of payment.

Checks or money orders shall be made payable to the Ministry of Agriculture. Remittances from foreign countries must be payable and immediately negotiable in the Kingdom of Jordan for the full amount of the prescribed fee. Money sent by mail to the Office shall be sent at the sender's risk.

Sec. 178 Refunds.

Money paid by mistake or excess payments shall be refunded, but a mere change of plans after the payment of money, as when a party decides to withdraw an application or to withdraw an appeal, shall not entitle a party to a refund. However, the examination or search fee shall be refunded if an application is voluntarily abandoned before a search or examination has begun.

Sec. 179 Copies and certified copies.

(a) Upon request, copies of applications, certificates, or of any records, books, papers, drawings, or photographs in the custody of the Office and which are open to the public, will be furnished to persons entitled thereto, upon payment of the prescribed fee.

(b) Upon request, copies will be authenticated by imprint of the seal of the Office and certified by the official, authorized by the Registrar upon payment of the prescribed fee.

**Availability of Office Records**

Sec. 190 When open records are available.

Copies of records, which are open to the public and in the custody of the Office, may be examined in the Office during regular business hours upon approval by the Registrar.

## Protest Proceedings

Sec. 200 Protests to the grant of a certificate.

Opposition on the part of any person to the granting of a certificate shall be permitted while an application is pending and for a period not to exceed 5 years following the issuance of a certificate.

Sec. 201 Protest proceedings.

(a) Opposition shall be made by submitting in writing a petition for protest proceedings, which petition shall be supported by affidavits and shall show the reason or reasons for opposing the application or certificate. The petition and accompanying papers shall be filed in duplicate. If it appears to an examiner that a variety involved in a pending application or covered by a certificate may not be or may not have been entitled to protection under the Act, a protest proceeding may be permitted by the Registrar.

(b) One copy of the petition and accompanying papers shall be served by the Office upon the applicant or owner, or his or her attorney or agent of record.

(c) An answer, by the applicant or owner of the certificate, or his or her assignee, in response to the petition, may be filed with the Registrar within 60 days after service of the petition, upon such person. If no answer is filed within said period, the Registrar shall decide the matter on the basis of the allegations set forth in the petition.

(d) If the petition and answer raise any issue of fact needing proof, the Registrar shall afford each of the parties a period of 60 days in which to file sworn statements or affidavits in support of their respective positions.

(e) As soon as practicable after the petition or the petition and answer are filed, or after the expiration of any period for filing sworn statements or affidavits, the Registrar shall issue a decision as to whether the protests are upheld or denied. The Registrar may, following the protest proceeding, cancel any certificate issued and may grant another certificate for the same variety to a person who proves to the satisfaction of the Registrar, that he or she is the breeder or discoverer.

Sec. 205 Definition; when declared.

A priority contest may be instituted by the Minister, on his or her own motion, or upon the request of any person who has applied for protection on the same variety, for which an adverse certificate has been issued, for the purpose of determining the question of priority between two or more parties claiming development or discovery of the same novel variety; Provided, however, That any person shall have forfeited his or her right to assert priority when an adverse certificate has been issued, if he or she fails to make a request for the institution of a priority contest within 1 year of the publication in the Official Journal, gazette or recognized national newspaper of issuance of the adverse certificate by the Minister, or if he or she fails to make the request within the period for taking action after refusal of the application on the basis of the adverse certificate.

Sec. 206 Preparation for priority contest between applicants.

(a) Before a priority contest will be handled by the Office, an examiner must determine that the same novel variety is involved in separate applications filed by two or more parties and apparently certifiable to each of the parties, subject to the determination of the

question of priority.

(b) The fact that a certificate has been issued will not prevent a priority contest.

Sec. 207 Preparation of priority papers and declaration of priority contest.

(a) When a priority question is found to exist, the examiner shall forward the pertinent files to the Registrar, together with a written statement showing the reason for the contest.

(b) The Registrar shall institute and declare the priority contest by forwarding a notice to each of the applicants involved. Each notice shall include the name and residence of each of the other applicants or those of his or her attorney or agent, if any, and of any assignee, and will identify the application of each opposing party by number and filing date, or in the case of a certificate, by the number and date of the certificate. The notice shall specify the basis of the priority contest. The notice shall specify a time, not to exceed 2 months, for filing preliminary statements.

(c) When a notice is returned to the Office undelivered, or when one of the parties resides abroad and his or her agent in the Kingdom of Jordan is unknown, notice may be given once by publication in the Official Journal, gazette or recognized national newspaper.

Sec. 208 Burden of proof.

The parties to a priority contest will be presumed to have developed their varieties in the chronological order of the filing dates of their applications for certificates involved in the priority contest, and the burden of proof will rest upon the party who last filed an application.

Sec. 209 Preliminary statement on novel variety developed in the

Kingdom of Jordan.

(a) Each party to the priority contest is required to file on or before a date fixed by the Office, a concise preliminary statement giving the facts and dates relating to the development of his or her alleged novel variety. The preliminary statement must be signed by the owner; Provided, however, That in appropriate circumstances, as when the owner is dead or legally incapacitated, or a showing is made of inability to obtain a statement from the owner, the preliminary statement may be made by the assignee or by someone authorized or entitled to make the statement, having knowledge of the facts.

(b) Preliminary statements shall be filed with the Office in duplicate. A copy shall be forwarded to each opposing party by the Office as soon as practicable after both parties have filed their statements within the requisite period.

(c) In filing a preliminary statement each party must show the following information:

(1) The date upon which the first determination of the novel variety was made.

(2) The date upon which the first written description of the novel variety was made. If a written description of the novel variety has not been made prior to the filing date of the application, it must be so stated.

(3) The date of the first act or acts susceptible of proof (other than making a written description or disclosing the novel variety to another person), which, if proven, would establish determination of the novel variety, and a brief description of such act or acts. If there have been no such acts, it must be so stated.

(4) The date of the actual production of the novel variety. If the novel variety had not been actually produced before the filing date of the application, it must be so stated.

(d) When an allegation as to the first written description

is made, a copy of such written
description shall be attached to the statement.

(e) If a party intends to rely on a prior application, domestic or foreign, the preliminary statement shall clearly identify such prior application. Copies of the cited application and related documents will be served by the Office, upon all interested parties to the contest. In the case of an application filed in a foreign country, Arabic or English translations shall be served to all interested parties by the party relying on the application filed in the foreign country.

Sec. 210 Preliminary statement on novel variety developed in a foreign country.

When the novel variety was developed in a foreign country, the preliminary statement must show (a) the information specified in Sec. 209 (c) through (e) and (b) whether, and if so, when and under what circumstances the novel variety was introduced into the United States by or on behalf of the party.

Sec. 211 Statements sealed before filing.

The preliminary statement shall be submitted in a sealed envelope bearing the name of the party filing it and the number and title of the priority contest as shown on the notice issued by the Office. The envelope should be enclosed in an outer mailing envelope marked ``To Be Opened Only by the Registrar."

Sec. 212 Correction of a statement on motion.

In case of material error arising through inadvertence or mistake, a preliminary statement may be corrected upon a satisfactory showing to the Registrar that the correction is of material significance.

Correction of the statement must be made as soon as practicable after the discovery of the error.

Sec. 213 Failure to file statements.

If any party to a priority contest fails to file a preliminary statement, he or she shall be restricted to his or her earliest effective filing date.

Sec. 214 Access to preliminary statements.

The preliminary statements shall be open to the inspection of any party after the date set for the filing of preliminary statements (Sec. 207(b)), but shall not be open to inspection prior to that time.

Sec. 215 Dissolution at the request of the Registrar.

If during a priority contest, information is submitted or found which, in the opinion of the Registrar, may render the variety ineligible for a certificate, the priority contest may be suspended by the Registrar and referred to an examiner for consideration of the matter. The parties will be notified of the reason for the suspension. Arguments of the parties regarding the suspension will be considered, if filed within 60 days of the notification. The suspension will then be continued, modified, or dismissed, in accordance with the determination by the Registrar.

Sec. 216 Concession; abandonment.

(a) An applicant or a certificate holder involved in a priority contest may, at any time, file a written concession of priority, or

abandonment of the certificate, signed by him or her. Upon the filing of such an instrument by any party, the decision shall be rendered against the interested party by the Registrar.

(b) A concession of priority may not be made by an assignee of a part interest.

Sec. 217 Affidavits and exhibits.

Affidavits and exhibits, including official records and any special matter contained in a printed publication, pertinent to the issue involved in the contest, may be introduced as evidence in a priority contest by any party to the contest. In the case of official records and printed publications, the party introducing the evidence shall specify the record or the printed publication, the page or pages to be used, indicate generally its relevancy, and submit to the Registrar the record or authenticated copy, or the printed publication, or a copy. Copies of affidavits and exhibits, including any record or publication, shall be served by the Registrar on each of the other interested parties.

Sec. 218 Matters considered in determining a priority.

In determining priority, the Registrar will consider only priority of development based on the evidence submitted. Questions of novelty generally will not be considered in the decision on priority. The Registrar may refer proposed findings of fact, conclusions, and notice of priority to the Board for an advisory decision.

Sec. 219 Recommendation by the Registrar.

The Registrar may, either before or concurrently with a decision on the question of priority, but independently of such decision, direct

the attention of the examiner to any matter not relating to priority which may come to the Registrar's attention, and which in his or her opinion establishes the fact that there has been an irregularity which amounts to a bar to the granting of a certificate to either of the parties. The Registrar may suspend the priority contest and remand the case to the examiner for further consideration of the matters, to which attention has been directed.

Sec. 220 Decision by the Registrar.

(a) When a priority contest is concluded on the basis of preliminary statements, or proposed findings of fact, conclusions and notice of priority shall be issued by the Registrar to the interested parties, giving them a specified period, not less than 30 days, to show cause why such proposed findings of fact, conclusions, and notice of priority should not be made final. Any response made during the specified period will be considered by the Registrar. Additional affidavits or exhibits will not be considered, unless accompanied by a showing of good cause acceptable to the Registrar. Thereafter, final findings of fact, conclusions, and notice of priority shall be issued by the Registrar.

(b) The decision shall be entered by the Registrar against a party whose preliminary statement alleges a date of determination later than the filing date of the other party's application.

Sec. 221 Status of claims of defeated applicant.

Whenever a final notice of priority has been issued by the Registrar in a priority proceeding, and the time limit for an appeal from such decision has expired, the claim or claims constituting the issue of the priority stand finally disposed of without further action by the Registrar.

Sec. 222 Second priority contest.

A second priority contest between the same parties shall not be entertained by the Registrar for the same novel variety.

## Appeal to the Minister

Sec. 300 Petition to the Minister.

(a) Petition may be made to the Minister from any final action of the Registrar denying an application or refusing to allow a certificate to be issued, or from any adverse decision of the Registrar .

(b) Any such petition shall contain a statement of the facts involved and the point or points to be reviewed, and the actions requested.

(c) A petition to the Minister shall be filed in duplicate and accompanied by the prescribed fee (see Sec. 175).

(d) Upon request, an opportunity to present data, views, and arguments orally, in an informal manner or in a formal hearing, shall be given to interested persons. If a formal hearing is requested, the proceeding shall be conducted in accordance with the Rules of Practice for administrative hearings as prescribed by the Minister .

(e) Except as otherwise provided in the rules in this part, any such petition not filed within 60 days from the action complained of shall be dismissed as untimely.

Sec. 301 Registrar's answer.

(a) The Registrar may, within such time as may be directed by the

Minister, furnish a written statement to the Minister in answer to the appellant's petition, including such explanation of the reasons for the action as may be necessary and supplying a copy to the appellant.

(b) Within 20 days from the date of such answer, the appellant may file a reply statement directed only to such new points of argument as may be raised in the Registrar's answer.

Sec. 302 Decision by the Minister.

(a) The Minister, after receiving the advice of the Board, may affirm or reverse the decision of the Registrar, in whole or in part.

(b) Should the decision of the Minister include an explicit statement that a certificate be allowed, based on an amended application, the applicant shall have the right to amend his or her application in conformity with such statement and such decision shall be binding on the Registrar.

Sec. 303 Action following the decision.

(a) Copies of the decision of the Minister shall be served upon the appellant and the Registrar in the manner provided in Sec. 403.

(b) When an appeal petition is dismissed, or when the time for appeal to the courts pursuant to the Act has expired and no such appeal or civil action has been filed, proceedings in the appeal shall be considered terminated as of the dismissal or expiration date, except in those cases in which the nature of the decision requires further action by the Registrar. If the decision of the Minister is appealed or a civil action has been filed pursuant to the Act, the decision of the Minister will be stayed pending the outcome of the court appeal or civil action.

**General Procedures in Priority, Protest, or Appeal Proceedings**

Sec. 400 Extensions of time.

Upon a showing of good cause, extensions of time not otherwise provided for may be granted by the Registrar or, if an appeal has been filed by the Minister for taking any action required in any priority, protest, or appeal proceeding.

Sec. 401 Miscellaneous provisions.

(a) Petitions for reconsideration or modification of the decision of the Registrar in priority or protest proceedings shall be filed within 20 days after the date of the decision.

(b) The Registrar may consider on petition any matter involving abuse of discretion in the exercise of an examiner's authority, or such other matters as may be deemed proper to consider. Any such petition, if not filed within 20 days from the decision complained of, may be dismissed as untimely.

Sec. 402 Service of papers.

(a) Every paper required to be served on opposing parties and filed in the Office in any priority, protest, or appeal proceeding, must be served by the Minister in the manner provided in Sec. 403.

(b) The requirement in certain sections that a specified paper shall be served includes a requirement that all related supporting papers shall also be served. Proof of such service upon other parties to the proceeding must be made before the supporting papers will be considered by the Registrar or Minister.

Sec. 403 Manner of service.

Service of any paper under this part must be on the attorney or agent of the party if there be such, or on the party if there is no attorney or agent, and may be made in any of the following ways:

(a) By mailing a copy of the paper to the person served by registered mail, with the date of the return receipt controlling the date of service;

(b) By leaving a copy at the usual place of business of the person served with someone in his or her employ;

(c) When the person served has no usual place of business, by leaving a copy at his or her home with a member of the family over 21 years of age and of discretion; and

(d) Whenever it shall be found by the Registrar or Minister that none of the above modes of serving the paper is practicable, service may be by notice, published once in the Office Journal, gazette or recognized national newspaper.

**Review of Decisions by Court**

Sec. 500 Appeal to Jordanian Courts

Any applicant dissatisfied with the decision of the Minister on appeal may appeal to the Jordanian Court holding jurisdiction over these matters. In such cases, the appellant or plaintiff shall give notice to the Minister, state the reasons for appeal or civil action, and obtain a certified copy of the record. The certified copy of the record shall be forwarded to the Court by the Plant Variety Protection Office on order of, and at the expense of the appellant or plaintiff.

**Public Use Declaration**

Sec. 700 Public interest in wide usage.

(a) If the Minister has reason to believe that a protected variety should be declared open to use by the public in accordance with section 44 of the Act, the Minister shall give the owner of the variety appropriate notice and an opportunity to present views orally or in writing, with regard to the necessity for such action to be taken in the public interest.

(b) Upon the expiration of the period for the presentation of views by the owner, as provided in paragraph (a) of this section, the Minister shall refer the matter to the Plant Variety Protection Board for advice, including advice on any limitations or rate of remuneration.

(c) Upon receiving the advice of the Plant Variety Protection Board, the Minister shall advise the owner of the variety, the members of the Plant Variety Protection Board, and the public, by issuance of a press release, of any decision to declare a variety open to use by the public. Any decision not to declare a variety open to use by the public will be transmitted only to the owner of the variety and the members of the Plant Variety Protection Board.

**Publication**

Sec. 800 Publication of public variety descriptions.

Voluntary submissions of variety descriptions of ``public varieties" on forms obtainable from the Office will be accepted for publication in the Official Journal, gazette or recognized national newspaper. Such publication shall not constitute recognition that the variety is, in fact, distinct, uniform, and stable.

## ADDITIONAL EXPLANATORY TEXT TO ASSIST WITH THE EFFECTIVE IMPLEMENTATION AND DAY-TO-DAY OPERATION AND ENFORCEMENT OF THE PLANT VARIETY PROTECTION REGIME:

### MEMBERSHIP AND COMPOSITION OF THE PLANT VARIETY PROTECTION BOARD:

In section 3(a) of the regulations it is envisaged that the original composition of the Plant Variety Protection Board will be composed of eight (8) members. The head of the Office will be the Registrar. It is envisaged that the Board will be composed of persons with technical and/or legal understandings of the material. These persons should also be chosen so as to represent an appropriate cross section of interests such as farmers, the private sector, universities, research institutes, the Ministry etc. While the original term is set for 3 years thought should be given to setting up a staggered system of renewal so there is continuity to the board over time and not the risk of a complete change in membership every three years.

### RELATIONSHIP TO UPOV:

I am unclear as to the current status of interactions of the Government of Jordan with the appropriate authorities at UPOV. If Jordan has not formally sought membership and made a decision as to which convention it will adopt (I recommend the 1991 version), it should do so relatively soon.

UPOV is also an excellent source of information and backstopping. The Registrar should develop a close working relationship with the UPOV secretariat and make sure they are on the mailing list for receiving materials that become available.

### RELATIONSHIP TO WTO:

Background information about WTO is attached in this report. Special attention is drawn to Article 27 of the TRIPS (Trade Related Intellectual Property) component of WTO. This provision is important since it will be a subject of review by WTO four years after accession to membership. See appendices.

## THE PLANT VARIETY REGISTER:

A computerized database should be developed for this, with appropriate hard and soft copy back-ups. There should be thought as to the physical location of this facility and it should be in a location where adequate levels of secrecy and confidentiality can be maintained.

## THE APPLICATION FORMS:

I attach with this report blank exhibit forms that may be used in connection with the operation of the office. The minimum forms that are required are:

1. An application Form.
2. A fees form
3. Exhibit form(s)
4. A sample deposit form

I also attach some exhibit forms; other forms may be developed in house as deemed appropriate.

## THE STEPS NEEDED TO START & RUN THE PVP OFFICE:

The basic operation of this office and actions can be translated in simple language into the following steps:

1. Setting up the office.
2. Appointing the staff.
3. Training the staff.
4. Establishing the formal procedures.
5. Notifying the public that the office is functional.
6. Distributing Information & Application Material.
7. Informing and educating the public on how to apply.

8. Receiving Applications.
9. Reviewing the applications.
10. Examinations standards and their application.
11. Communicating with the Client.
12. Communicating with Policy Makers.
13. Storing Deposits.
14. Preparing Certificates.
15. Issuing Certificates.
16. Dealing with Disputes.

All the above topics should be analyzed and the accompanying training program will address elements of them.

**DEPOSIT OF SAMPLES:**

An appropriate and adequate system must be in place for applicants to deposit samples of seed material. This facility may belong to the Ministry or may be with a related organization. The facility must meet appropriate international seed storage guidelines and must have adequate mechanisms for safe keeping/security of the seed samples. The equivalent organization in the USA is the American Type Culture Collection. (see appendices)

**SCOPE OF GENERA AND SPECIES COVERED BY THESE LAWS & REGULATIONS:**

Initially in terms of UPOV rules a minimum of 15 genera and species must be covered by this system. The Office may extend this, given appropriate authority to all species and genera.

**FILING DATE:**

In all aspects of Intellectual Property management the "filing date" is always a critical event. Adequate and effective measures must be taken to ensure transparency and effectiveness in the implementation of filing/ date stamp mechanisms to ensure clarity as to the effective filing date of an application.

## STANDARDS FOR THE TECHNICAL EXAMINATION OF THE MATERIAL:

The UPOV test guides are invaluable resources in this area. They can be used as a technical basis for determining the technical components required in establishing the criteria that are fundamental to the allowance of Plant Varity protection. Those being:

- Distinctiveness
- Uniformity
- Stability

**Note the training manual and the UPOV model law in the appendices give step by step analysis on how to determine these critical characteristics of a variety.**

## PUBLICATION OF APPLICATION:

Applications (parts thereof) shall be printed in a timely manner in the Official Gazette. I have also included a provision for alternative notice through publication in National newspapers under the section relating to legal notices. This may afford more flexibility to the office, especially when the load is light.

## COLLECTION OF FEES:

The Office may levy reasonable fees for the application and associated processes and services. The fee structure should be based on cost reimbursable principles. The levying of fees cannot be a form of taxation or tariff.

## RELATIONSHIP OF PVP TO OTHER FORMS OF INTELLECTUAL PROPERTY PROTECTION:

There are in many jurisdictions patent laws that will allow for the patent protection of plants. This is complementary to the PVP legislation. It is feasible and increasingly common in the USA that protection will be taken both on the variety and a patent on the inventive nature of the product and or process. It is my reading of the current Patent Law in Jordan that patent protection can not be petitioned on “Plants”. While this is unusual in many ways, it adds all the more emphasis to the need for a functional and effective PVP office.

**FORMS:**

Following are the basic forms used in the PVP process

- Plant Variety Protection Application Form
- Plant Variety Protection Fees Form
- Plant Variety Protection Attachment A form (Origin & Breeding History)
- Plant Variety Protection Attachment B form (Uniformity, Distinctness, Stability Declaration)
- Plant Variety Protection Attachment C form (Description of Variety)
- Plant Variety Protection Sample Deposit Form

| **APPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE**<br>Ministry & Agriculture; Amman Jordan | | |
|---|---|---|
| 1. NAME OF OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| 3. ADDRESS OF OWNER. | 4. PHONE No. | |
| | 5. FACSIMILE No. | |
| | 6. E MAIL ADDRESS. | |
| 7. IF OWNER IS NOT A PERSON, THEN NAME OF CORPORATION OR PARTNERSHIP. | 8. DATE OF INCORPORATION (day / month/ year) | |
| 9. NAME & ADDRESS OF OWNERS REPRESENTATIVES | | |
| 10. IF OUTSIDE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| PVPO No. # | DATE OF FILING (day/month/year) | FILING FEE PAID |
| 11. GENUS & SPECIES OF PLANT. | 12. BOTANICAL FAMILY NAME. | 13. COMMON NAME OF PLANT. |
| 14. IS THIS VARIETY A FIRST GENERATION HYBRID?<br>☐ Yes ☐ No | 15. DOES SEED NEED TO BE SOLD AS CERTIFIED SEED?<br>☐ Yes ☐ No | 16. HAS THE VARIETY BEEN SOLD, DISPOSED OF, TRANSFORM OR USED IN JORDAN OR OTHER COUNTRY?<br>Yes<br>No |

| | |
|---|---|
| 17. ATTACHMENTS ARE (Check appropriate box).<br><br>☐ Origin and Breeding History.<br>☐ Statement of Distinctness.<br>☐ Description of Variety.<br>☐ Statement of Ownership. | |
| 18. SIGNATURE | 19. DATE (day/month/year) |

**APPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE (FEES FORM)**

Ministry & Agriculture; Amman Jordan

| | |
|---|---|
| 1. NAME OF OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) |
| 3. ADDRESS OF OWNER. | 4. PHONE No.<br>5. FACSIMILE No.<br>6. E MAIL ADDRESS. |
| 7. IF OWNER IS NOT A PERSON, THEN NAME OF CORPORATION OR PARTNERSHIP. | 8. DATE OF INCORPORATION (day / month / year) |
| 9. NAME & ADDRESS OF OWNERS REPRESENTATIVES | |
| 10. IF OUTSIDE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | |

| FOR OFFICIAL USE ONLY | | |
|---|---|---|
| PVPO No. # | DATE OF FILING (day/month/year) | FILING FEE PAID |

| SUBJECT MATTER | CHECK APPROPRIATE BOX | FEES |
|---|---|---|
| (a) Filing the application and notifying the public of filing. | ☐ | |
| (b) Search or examination. | ☐ | |
| (c) Allowance and issuance of certificate and notifying public of issuance. | ☐ | |
| (d) Revive an abandoned application. | ☐ | |
| (e) Reproduction of records, drawings, certificates, exhibits or printed material (copy per page of material) | ☐ | |
| (f) Authentication (each page) | ☐ | |
| (g) Correcting or re-issuance of a certificate. | ☐ | |
| (h) Recording assignments (per certificate/application) | ☐ | |

| | | |
|---|---|---|
| (i) Copies of 8 x 10 photographs in color. | ☐ | |
| (j) Additional fee for reconsideration | ☐ | |
| (k) Additional fee for late payment | ☐ | |
| (l) Additional fee for late replenishment of seed | ☐ | |
| (m) Appeal to Minister (refundable if appeal overturns the Registrar's decision) | ☐ | |
| (n) Granting of extension for responding to a request. | ☐ | |
| (o) Field inspections by a representative of the Plant Variety Protection Office made at the request of the applicant shall be reimbursable in full (including travel, per diem or subsistence, and salary) in accordance with Customary Government Travel Regulations. | ☐ | |
| (p) Any other service not covered above will be charged for at rates prescribed by the Registrar. | ☐ | |

| **APPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE (EXHIBIT A)**<br>Ministry & Agriculture; Amman Jordan | | |
|---|---|---|
| 1. NAME OF OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| 3. ADDRESS OF OWNER. | 4. PHONE No. | |
| | 5. FACSIMILE No. | |
| | 6. E MAIL ADDRESS. | |
| 7. IF OWNER IS NOT A PERSON, THEN NAME OF CORPORATION OR PARTNERSHIP. | 8. DATE OF INCORPORATION (day / month/ year) | |
| 9.NAME & ADDRESS OF OWNERS REPRESENTATIVES | | |
| 10. IF OUTSIDE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| PVPO No. # | DATE OF FILING (day/month/year) | FILING FEE PAID |
| | EXHIBIT A: ORIGIN & BREEDING | |
| | | |
| 11. ORIGIN & BREEDING HISTORY (SEE TECHNICAL GUIDE BY CROP FOR MORE DETAILS) | | |

| 12. SIGNATURE | 13. DATE (day/month/year) |
|---|---|
| | |

| **APPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE (EXHIBIT B)**<br>Ministry & Agriculture; Amman Jordan | | |
|---|---|---|
| 1. NAME OF OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| 3. ADDRESS OF OWNER. | 4. PHONE No. | |
| | 5. FACSIMILE No. | |
| | 6. E MAIL ADDRESS. | |
| 7. IF OWNER IS NOT A PERSON, THEN NAME OF CORPORATION OR PARTNERSHIP. | 8. DATE OF INCORPORATION (day / month/ year) | |
| 9.NAME & ADDRESS OF OWNERS REPRESENTATIVES | | |
| 10. IF OUTSIDE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| PVPO No. # | DATE OF FILING (day/month/year) | FILING FEE PAID |
| | EXHIBIT B: STATEMENT OF DISTINCTIVENESS, UNIFORMITY AND STABILITY | |
| | | |
| 11. STATEMENT OF DISTINCTNESS, UNIFORMITY & STABILITY. SEE UPOV TECHNICAL GUIDE BY CROP FOR MORE DETAILS. | | |

| 12. SIGNATURE | 13. DATE (day/month/year) |
|---|---|
| | |

| **APPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE (EXHIBIT C)**<br>Ministry & Agriculture; Amman Jordan | | |
|---|---|---|
| 1. NAME OF OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| 3. ADDRESS OF OWNER. | 4. PHONE No. | |
| | 5. FACSIMILE No. | |
| | 6. E MAIL ADDRESS. | |
| 7. IF OWNER IS NOT A PERSON, THEN NAME OF CORPORATION OR PARTNERSHIP. | 8. DATE OF INCORPORATION (day / month/ year) | |
| 9.NAME & ADDRESS OF OWNERS REPRESENTATIVES | | |
| 10. IF OUTSIDE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| PVPO No. # | DATE OF FILING (day/month/year) | FILING FEE PAID |
| | EXHIBIT C: DESCRIPTION OF VARIETY | |
| | | |

| | |
|---|---|
| 11. DESCRIPTION OF VARIETY. (SEE UPOV TECHNICAL GUIDE BY CROP FOR MORE DETAILS) IF COLOR IS CLAIMED AS A CHARACTER SUPPLY 3 COPIES OF COLOR PHOTOGRAPHS. | |
| 12. SIGNATURE | 13. DATE (day/month/year) |

| **APPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE (SAMPLE DEPOSITION)**<br>Ministry & Agriculture; Amman Jordan | | |
|---|---|---|
| 1. NAME OF OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| 3. ADDRESS OF OWNER. | 4. PHONE No. | |
| | 5. FACSIMILE No. | |
| | 6. E MAIL ADDRESS. | |
| 7. IF OWNER IS NOT A PERSON, THEN NAME OF CORPORATION OR PARTNERSHIP. | 8. DATE OF INCORPORATION (day / month/ year) | |
| 9. NAME & ADDRESS OF OWNERS REPRESENTATIVES | | |
| 10. IF OUTSIDE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| PVPO No. # | DATE OF FILING (day/month/year) | FILING FEE PAID |
| SAMPLE DEPOSITION FORM | | |
| 11. SAMPLE NAME | | |
| 12. NUMBER OF SEEDS OR CULTURES | | |
| 13. DEPOSIT DATE | | |
| 14. DEPOSIT LOCATION | | |

| 15. SIGNATURE | 16. DATE<br>(day/ month/ year) |
|---|---|
| | |

# APPENDICES:

# Overview: the TRIPS Agreement

The TRIPS Agreement, which came into effect on 1 January 1995, is to date the most comprehensive multilateral agreement on intellectual property.

The areas of intellectual property that it covers are: copyright and related rights (i.e. the rights of performers, producers of sound recordings and broadcasting organizations); trademarks including service marks; geographical indications including appellations of origin; industrial designs; patents including the protection of new varieties of plants; the layout-designs of integrated circuits; and undisclosed information including trade secrets and test data.

The three main features of the Agreement are:

- **Standards**. In respect of each of the main areas of intellectual property covered by the TRIPS Agreement, the Agreement sets out the minimum standards of protection to be provided by each Member. Each of the main elements of protection is defined, namely the subject-matter to be protected, the rights to be conferred and permissible exceptions to those rights, and the minimum duration of protection. The Agreement sets these standards by requiring, first, that the substantive obligations of the main conventions of the WIPO, the Paris Convention for the Protection of Industrial Property (Paris Convention) and the Berne Convention for the Protection of Literary and Artistic Works (Berne Convention) in their most recent versions, must be complied with. With the exception of the provisions of the Berne Convention on moral rights, all the main substantive provisions of these conventions are incorporated by reference and thus become obligations under the TRIPS Agreement between TRIPS Member countries. The relevant provisions are to be found in Articles 2.1 and 9.1 of the TRIPS Agreement, which relate, respectively, to the Paris Convention and to the Berne Convention. Secondly, the TRIPS Agreement adds a substantial number of additional obligations on matters where the pre-existing conventions are silent or were seen as being inadequate. The TRIPS Agreement is thus sometimes referred to as a Berne and Paris-plus agreement.

- **Enforcement**. The second main set of provisions deals with domestic procedures and remedies for the enforcement of intellectual property rights. The Agreement lays down certain general principles applicable to all IPR enforcement procedures. In addition, it contains provisions on civil and administrative procedures and remedies, provisional measures, special requirements related to border measures and criminal procedures, which specify, in a certain amount of detail, the

procedures and remedies that must be available so that right holders can effectively enforce their rights.

- **Dispute settlement**. The Agreement makes disputes between WTO Members about the respect of the TRIPS obligations subject to the WTO's dispute settlement procedures.

In addition the Agreement provides for certain basic principles, such as national and most-favoured-nation treatment, and some general rules to ensure that procedural difficulties in acquiring or maintaining IPRs do not nullify the substantive benefits that should flow from the Agreement. The obligations under the Agreement will apply equally to all Member countries, but developing countries will have a longer period to phase them in. Special transition arrangements operate in the situation where a developing country does not presently provide product patent protection in the area of pharmaceuticals.

The TRIPS Agreement is a minimum standards agreement, which allows Members to provide more extensive protection of intellectual property if they so wish. Members are left free to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice.

## Certain general provisions Back to top

As in the main pre-existing intellectual property conventions, the basic obligation on each Member country is to accord the treatment in regard to the protection of intellectual property provided for under the Agreement to the persons of other Members. Article 1.3 defines who these persons are. These persons are referred to as "nationals" but include persons, natural or legal, who have a close attachment to other Members without necessarily being nationals. The criteria for determining which persons must thus benefit from the treatment provided for under the Agreement are those laid down for this purpose in the main pre-existing intellectual property conventions of WIPO, applied of course with respect to all WTO Members whether or not they are party to those conventions. These conventions are the Paris Convention, the Berne Convention, International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations (Rome Convention), and the Treaty on Intellectual Property in Respect of Integrated Circuits (IPIC Treaty).

Articles 3, 4 and 5 include the fundamental rules on national and most-favoured-nation treatment of foreign nationals, which are common to all categories of intellectual property covered by the Agreement. These obligations cover not only the substantive standards of protection but also matters affecting the availability, acquisition, scope, maintenance and enforcement of intellectual property rights as well as those matters affecting the use of intellectual property rights specifically addressed in the Agreement. While the national treatment clause forbids discrimination between a Member's own nationals and the nationals of other Members, the most-favoured-nation treatment clause forbids discrimination between the nationals of other Members. In respect of the national treatment obligation, the exceptions allowed under the pre-existing intellectual property conventions of WIPO are also allowed under TRIPS. Where these exceptions allow material reciprocity, a consequential exception to MFN treatment is also permitted (e.g. comparison of terms for copyright protection in excess of the minimum

term required by the TRIPS Agreement as provided under Article 7(8) of the Berne Convention as incorporated into the TRIPS Agreement). Certain other limited exceptions to the MFN obligation are also provided for.

The general goals of the TRIPS Agreement are contained in the Preamble of the Agreement, which reproduces the basic Uruguay Round negotiating objectives established in the TRIPS area by the 1986 Punta del Este Declaration and the 1988/89 Mid-Term Review. These objectives include the reduction of distortions and impediments to international trade, promotion of effective and adequate protection of intellectual property rights, and ensuring that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade. These objectives should be read in conjunction with Article 7, entitled "Objectives", according to which the protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations. Article 8, entitled "Principles", recognizes the rights of Members to adopt measures for public health and other public interest reasons and to prevent the abuse of intellectual property rights, provided that such measures are consistent with the provisions of the TRIPS Agreement.

## Substantive standards of protection Back to top

### Copyright Back to top

During the Uruguay Round negotiations, it was recognized that the Berne Convention already, for the most part, provided adequate basic standards of copyright protection. Thus it was agreed that the point of departure should be the existing level of protection under the latest Act, the Paris Act of 1971, of that Convention. The point of departure is expressed in Article 9.1 under which Members are obliged to comply with the substantive provisions of the Paris Act of 1971 of the Berne Convention, i.e. Articles 1 through 21 of the Berne Convention (1971) and the Appendix thereto. However, Members do not have rights or obligations under the TRIPS Agreement in respect of the rights conferred under Article 6*bis* of that Convention, i.e. the moral rights (the right to claim authorship and to object to any derogatory action in relation to a work, which would be prejudicial to the author's honour or reputation), or of the rights derived therefrom. The provisions of the Berne Convention referred to deal with questions such as subject-matter to be protected, minimum term of protection, and rights to be conferred and permissible limitations to those rights. The Appendix allows developing countries, under certain conditions, to make some limitations to the right of translation and the right of reproduction.

In addition to requiring compliance with the basic standards of the Berne Convention, the TRIPS Agreement clarifies and adds certain specific points.

Article 9.2 confirms that copyright protection shall extend to expressions and not to ideas, procedures, methods of operation or mathematical concepts as such.

Article 10.1 provides that computer programs, whether in source or object code, shall be protected as literary works under the Berne

Convention (1971). This provision confirms that computer programs must be protected under copyright and that those provisions of the Berne Convention that apply to literary works shall be applied also to them. It confirms further, that the form in which a program is, whether in source or object code, does not affect the protection. The obligation to protect computer programs as literary works means e.g. that only those limitations that are applicable to literary works may be applied to computer programs. It also confirms that the general term of protection of 50 years applies to computer programs. Possible shorter terms applicable to photographic works and works of applied art may not be applied.

Article 10.2 clarifies that databases and other compilations of data or other material shall be protected as such under copyright even where the databases include data that as such are not protected under copyright. Databases are eligible for copyright protection provided that they by reason of the selection or arrangement of their contents constitute intellectual creations. The provision also confirms that databases have to be protected regardless of which form they are in, whether machine readable or other form. Furthermore, the provision clarifies that such protection shall not extend to the data or material itself, and that it shall be without prejudice to any copyright subsisting in the data or material itself.

Article 11 provides that authors shall have in respect of at least computer programs and, in certain circumstances, of cinematographic works the right to authorize or to prohibit the commercial rental to the public of originals or copies of their copyright works. With respect to cinematographic works, the exclusive rental right is subject to the so-called impairment test: a Member is excepted from the obligation unless such rental has led to widespread copying of such works which is materially impairing the exclusive right of reproduction conferred in that Member on authors and their successors in title. In respect of computer programs, the obligation does not apply to rentals where the program itself is not the essential object of the rental.

According to the general rule contained in Article 7(1) of the Berne Convention as incorporated into the TRIPS Agreement, the term of protection shall be the life of the author and 50 years after his death. Paragraphs 2 through 4 of that Article specifically allow shorter terms in certain cases. These provisions are supplemented by Article 12 of the TRIPS Agreement, which provides that whenever the term of protection of a work, other than a photographic work or a work of applied art, is calculated on a basis other than the life of a natural person, such term shall be no less than 50 years from the end of the calendar year of authorized publication, or, failing such authorized publication within 50 years from the making of the work, 50 years from the end of the calendar year of making.

Article 13 requires Members to confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder. This is a horizontal provision that applies to all limitations and exceptions permitted under the provisions of the Berne Convention and the Appendix thereto as incorporated into the TRIPS Agreement. The application of these limitations is permitted also under the TRIPS Agreement, but the provision makes it clear that they must be applied in a manner that does not prejudice the legitimate

interests of the right holder.

**Related rights** Back to top

The provisions on protection of performers, producers of phonograms and broadcasting organizations are included in Article 14. According to Article 14.1, performers shall have the possibility of preventing the unauthorized fixation of their performance on a phonogram (e.g. the recording of a live musical performance). The fixation right covers only aural, not audiovisual fixations. Performers must also be in position to prevent the reproduction of such fixations. They shall also have the possibility of preventing the unauthorized broadcasting by wireless means and the communication to the public of their live performance.

In accordance with Article 14.2, Members have to grant producers of phonograms an exclusive reproduction right. In addition to this, they have to grant, in accordance with Article 14.4, an exclusive rental right at least to producers of phonograms. The provisions on rental rights apply also to any other right holders in phonograms as determined in national law. This right has the same scope as the rental right in respect of computer programs. Therefore it is not subject to the impairment test as in respect of cinematographic works. However, it is limited by a so-called grand-fathering clause, according to which a Member, which on 15 April 1994, i.e. the date of the signature of the Marrakesh Agreement, had in force a system of equitable remuneration of right holders in respect of the rental of phonograms, may maintain such system provided that the commercial rental of phonograms is not giving rise to the material impairment of the exclusive rights of reproduction of right holders.

Broadcasting organizations shall have, in accordance with Article 14.3, the right to prohibit the unauthorized fixation, the reproduction of fixations, and the rebroadcasting by wireless means of broadcasts, as well as the communication to the public of their television broadcasts. However, it is not necessary to grant such rights to broadcasting organizations, if owners of copyright in the subject-matter of broadcasts are provided with the possibility of preventing these acts, subject to the provisions of the Berne Convention.

The term of protection is at least 50 years for performers and producers of phonograms, and 20 years for broadcasting organizations (Article 14.5).

Article 14.6 provides that any Member may, in relation to the protection of performers, producers of phonograms and broadcasting organizations, provide for conditions, limitations, exceptions and reservations to the extent permitted by the Rome Convention.

**Trademarks** Back to top

The basic rule contained in Article 15 is that any sign, or any combination of signs, capable of distinguishing the goods and services of one undertaking from those of other undertakings, must be eligible for registration as a trademark, provided that it is visually perceptible. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, must be eligible for registration as trademarks.

Where signs are not inherently capable of distinguishing the relevant goods or services, Member countries are allowed to require, as an additional condition for eligibility for registration as a trademark, that distinctiveness has been acquired through use. Members are free to determine whether to allow the registration of signs that are not visually perceptible (e.g. sound or smell marks).

Members may make registrability depend on use. However, actual use of a trademark shall not be permitted as a condition for filing an application for registration, and at least three years must have passed after that filing date before failure to realize an intent to use is allowed as the ground for refusing the application (Article 14.3).

The Agreement requires service marks to be protected in the same way as marks distinguishing goods (see e.g. Articles 15.1, 16.2 and 62.3).

The owner of a registered trademark must be granted the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion must be presumed (Article 16.1).

The TRIPS Agreement contains certain provisions on well-known marks, which supplement the protection required by Article 6*bis* of the Paris Convention, as incorporated by reference into the TRIPS Agreement, which obliges Members to refuse or to cancel the registration, and to prohibit the use of a mark conflicting with a mark which is well known. First, the provisions of that Article must be applied also to services. Second, it is required that knowledge in the relevant sector of the public acquired not only as a result of the use of the mark but also by other means, including as a result of its promotion, be taken into account. Furthermore, the protection of registered well-known marks must extend to goods or services which are not similar to those in respect of which the trademark has been registered, provided that its use would indicate a connection between those goods or services and the owner of the registered trademark, and the interests of the owner are likely to be damaged by such use (Articles 16.2 and 3).

Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties (Article 17).

Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely (Article 18).

Cancellation of a mark on the grounds of non-use cannot take place before three years of uninterrupted non-use has elapsed unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark, such as import restrictions or other government restrictions, shall be recognized as valid reasons of non-use. Use of a trademark by another person, when subject to the control of its owner, must be recognized as use of the trademark for the purpose of

maintaining the registration (Article 19).

It is further required that use of the trademark in the course of trade shall not be unjustifiably encumbered by special requirements, such as use with another trademark, use in a special form, or use in a manner detrimental to its capability to distinguish the goods or services (Article 20).

**Geographical indications** Back to top

Geographical indications are defined, for the purposes of the Agreement, as indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin (Article 22.1). Thus, this definition specifies that the quality, reputation or other characteristics of a good can each be a sufficient basis for eligibility as a geographical indication, where they are essentially attributable to the geographical origin of the good.

In respect of all geographical indications, interested parties must have legal means to prevent use of indications which mislead the public as to the geographical origin of the good, and use which constitutes an act of unfair competition within the meaning of Article 10*bis* of the Paris Convention (Article 22.2).

The registration of a trademark which uses a geographical indication in a way that misleads the public as to the true place of origin must be refused or invalidated *ex officio* if the legislation so permits or at the request of an interested party (Article 22.3).

Article 23 provides that interested parties must have the legal means to prevent the use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication. This applies even where the public is not being misled, there is no unfair competition and the true origin of the good is indicated or the geographical indication is accompanied be expressions such as "kind", "type", "style", "imitation" or the like. Similar protection must be given to geographical indications identifying spirits when used on spirits. Protection against registration of a trademark must be provided accordingly.

Article 24 contains a number of exceptions to the protection of geographical indications. These exceptions are of particular relevance in respect of the additional protection for geographical indications for wines and spirits. For example, Members are not obliged to bring a geographical indication under protection, where it has become a generic term for describing the product in question (paragraph 6). Measures to implement these provisions shall not prejudice prior trademark rights that have been acquired in good faith (paragraph 5). Under certain circumstances, continued use of a geographical indication for wines or spirits may be allowed on a scale and nature as before (paragraph 4). Members availing themselves of the use of these exceptions must be willing to enter into negotiations about their continued application to individual geographical indications (paragraph 1). The exceptions cannot be used to diminish the protection of geographical indications that existed prior to the entry into force of the TRIPS Agreement (paragraph 3). The TRIPS Council shall keep under review the application of the provisions on the protection of geographical indications (paragraph 2).

**Industrial designs** Back to top

Article 25.1 of the TRIPS Agreement obliges Members to provide for the protection of independently created industrial designs that are new or original. Members may provide that designs are not new or original if they do not significantly differ from known designs or combinations of known design features. Members may provide that such protection shall not extend to designs dictated essentially by technical or functional considerations.

Article 25.2 contains a special provision aimed at taking into account the short life cycle and sheer number of new designs in the textile sector: requirements for securing protection of such designs, in particular in regard to any cost, examination or publication, must not unreasonably impair the opportunity to seek and obtain such protection. Members are free to meet this obligation through industrial design law or through copyright law.

Article 26.1 requires Members to grant the owner of a protected industrial design the right to prevent third parties not having the owner's consent from making, selling or importing articles bearing or embodying a design which is a copy, or substantially a copy, of the protected design, when such acts are undertaken for commercial purposes.

Article 26.2 allows Members to provide limited exceptions to the protection of industrial designs, provided that such exceptions do not unreasonably conflict with the normal exploitation of protected industrial designs and do not unreasonably prejudice the legitimate interests of the owner of the protected design, taking account of the legitimate interests of third parties.

The duration of protection available shall amount to at least 10 years (Article 26.3). The wording "amount to" allows the term to be divided into, for example, two periods of five years.

**Patents** Back to top

**The TRIPS Agreement requires Member countries to make patents available for any inventions, whether products or processes, in all fields of technology without discrimination, subject to the normal tests of novelty, inventiveness and industrial applicability. It is also required that patents be available and patent rights enjoyable without discrimination as to the place of invention and whether products are imported or locally produced (Article 27.1).**

**There are three permissible exceptions to the basic rule on patentability. One is for inventions contrary to *ordre public* or morality; this explicitly includes inventions dangerous to human, animal or plant life or health or seriously prejudicial to the environment. The use of this exception is subject to the condition that the commercial exploitation of the invention must also be prevented and this prevention must be necessary for the protection of *ordre public* or morality (Article 27.2).**

**The second exception is that Members may exclude from patentability diagnostic, therapeutic and surgical methods for the treatment of humans or animals (Article 27.3(a)).**

**The third is that Members may exclude plants and animals other than micro-organisms and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes. However, any country excluding plant varieties from patent protection must provide an effective *sui generis* system of protection. Moreover, the whole provision is subject to review four years after entry into force of the Agreement (Article 27.3(b)).**

**The exclusive rights that must be conferred by a product patent are the ones of making, using, offering for sale, selling, and importing for these purposes. Process patent protection must give rights not only over use of the process but also over products obtained directly by the process. Patent owners shall also have the right to assign, or transfer by succession, the patent and to conclude licensing contracts (Article 28).**

**Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties (Article 30).**

**The term of protection available shall not end before the expiration of a period of 20 years counted from the filing date (Article 33).**

**Members shall require that an applicant for a patent shall disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application (Article 29.1).**

**If the subject-matter of a patent is a process for obtaining a product, the judicial authorities shall have the authority to order the defendant to prove that the process to obtain an identical product is different from the patented process, where certain conditions indicating a likelihood that the protected process was used are met (Article 34).**

**Compulsory licensing and government use without the authorization of the right holder are allowed, but are made subject to conditions aimed at protecting the legitimate interests of the right holder. The conditions are mainly contained in Article 31. These include the obligation, as a general rule, to grant such licences only if an unsuccessful attempt has been made to acquire a voluntary licence on reasonable terms and conditions within a reasonable period of time; the requirement to pay adequate remuneration in the circumstances of each case, taking into account the economic value of the licence; and a requirement that decisions be subject to judicial or other independent review by a distinct higher authority. Certain of these conditions are relaxed where compulsory licences are employed to remedy practices that have been established as anticompetitive by a legal process. These conditions should be read together with the related provisions of Article 27.1, which require that patent rights shall be enjoyable without discrimination as to the field of technology, and whether products are imported or locally produced.**

**Layout-designs of integrated circuits** Back to top

Article 35 of the TRIPS Agreement requires Member countries to protect the layout-designs of integrated circuits in accordance with the provisions of the IPIC Treaty (the Treaty on Intellectual Property in Respect of Integrated Circuits), negotiated under the auspices of WIPO in 1989. These provisions deal with, *inter alia*, the definitions of "integrated circuit" and "layout-design (topography)", requirements for protection, exclusive rights, and limitations, as well as exploitation, registration and disclosure. An "integrated circuit" means a product, in its final form or an intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in and/or on a piece of material and which is intended to perform an electronic function. A "layout-design (topography)" is defined as the three-dimensional disposition, however expressed, of the elements, at least one of which is an active element, and of some or all of the interconnections of an integrated circuit, or such a three-dimensional disposition prepared for an integrated circuit intended for manufacture. The obligation to protect layout-designs applies to such layout-designs that are original in the sense that they are the result of their creators' own intellectual effort and are not commonplace among creators of layout-designs and manufacturers of integrated circuits at the time of their creation. The exclusive rights include the right of reproduction and the right of importation, sale and other distribution for commercial purposes. Certain limitations to these rights are provided for.

In addition to requiring Member countries to protect the layout-designs of integrated circuits in accordance with the provisions of the IPIC Treaty, the TRIPS Agreement clarifies and/or builds on four points. These points relate to the term of protection (ten years instead of eight, Article 38), the applicability of the protection to articles containing infringing integrated circuits (last sub clause of Article 36) and the treatment of innocent infringers (Article 37.1). The conditions in Article 31 of the TRIPS Agreement apply *mutatis mutandis* to compulsory or non-voluntary licensing of a layout-design or to its use by or for the government without the authorization of the right holder, instead of the provisions of the IPIC Treaty on compulsory licensing (Article 37.2).

**Protection of undisclosed information** Back to top

The TRIPS Agreement requires undisclosed information -- trade secrets or know-how -- to benefit from protection. According to Article 39.2, the protection must apply to information that is secret, that has commercial value because it is secret and that has been subject to reasonable steps to keep it secret. The Agreement does not require undisclosed information to be treated as a form of property, but it does require that a person lawfully in control of such information must have the possibility of preventing it from being disclosed to, acquired by, or used by others without his or her consent in a manner contrary to honest commercial practices. "Manner contrary to honest commercial practices" includes breach of contract, breach of confidence and inducement to breach, as well as the acquisition of undisclosed information by third parties who knew, or were grossly negligent in failing to know, that such practices were involved in the acquisition.

The Agreement also contains provisions on undisclosed test data and other data whose submission is required by governments as a condition of approving the marketing of pharmaceutical or agricultural chemical

products which use new chemical entities. In such a situation the Member government concerned must protect the data against unfair commercial use. In addition, Members must protect such data against disclosure, except where necessary to protect the public, or unless steps are taken to ensure that the data are protected against unfair commercial use.

### Control of anti-competitive practices in contractual licences Back to top

Article 40 of the TRIPS Agreement recognizes that some licensing practices or conditions pertaining to intellectual property rights which restrain competition may have adverse effects on trade and may impede the transfer and dissemination of technology (paragraph 1). Member countries may adopt, consistently with the other provisions of the Agreement, appropriate measures to prevent or control practices in the licensing of intellectual property rights which are abusive and anti-competitive (paragraph 2). The Agreement provides for a mechanism whereby a country seeking to take action against such practices involving the companies of another Member country can enter into consultations with that other Member and exchange publicly available non-confidential information of relevance to the matter in question and of other information available to that Member, subject to domestic law and to the conclusion of mutually satisfactory agreements concerning the safeguarding of its confidentiality by the requesting Member (paragraph 3). Similarly, a country whose companies are subject to such action in another Member can enter into consultations with that Member (paragraph 4).

## Enforcement of intellectual property rights Back to top

The provisions on enforcement are contained in Part III of the Agreement, which is divided into five Sections. The first Section lays down general obligations that all enforcement procedures must meet. These are notably aimed at ensuring their effectiveness and that certain basic principles of due process are met. The following Sections deal with civil and administrative procedures and remedies, provisional measures, special requirements related to border measures and criminal procedures. These provisions have two basic objectives: one is to ensure that effective means of enforcement are available to right holders; the second is to ensure that enforcement procedures are applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

The Agreement makes a distinction between infringing activity in general, in respect of which civil judicial procedures and remedies must be available, and counterfeiting and piracy -- the more blatant and egregious forms of infringing activity -- in respect of which additional procedures and remedies must also be provided, namely border measures and criminal procedures. For this purpose, counterfeit goods are in essence defined as goods involving slavish copying of trademarks, and pirated goods as goods which violate a reproduction right under copyright or a related right.

### General obligations Back to top

The general obligations relating to enforcement are contained in Article 41. Paragraph 1 requires that enforcement procedures must be such as to permit effective action against any act of infringement of intellectual property rights, and that the remedies available must be expeditious in

order to prevent infringements and they must constitute a deterrent to further infringements. On the other hand, these procedures must be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

The following three paragraphs contain certain general principles, the aim of which is to guarantee due process. Paragraph 2 deals with enforcement procedures. Such procedures must be fair and equitable, and they may not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays. Paragraph 3 concerns decisions on the merits of a case. Such decisions shall preferably be in writing and reasoned, and they shall be made available at least to the parties to the proceeding without undue delay. Decisions on the merits of a case shall be based only on evidence in respect of which parties were offered the opportunity to be heard. Paragraph 4 requires that parties to a proceeding shall have an opportunity for review by a judicial authority of final administrative decisions and, subject to jurisdictional provisions in a Member's law concerning the importance of a case, of at least the legal aspects of initial judicial decisions on the merits of a case. However, there is no obligation to provide an opportunity for review of acquittals in criminal cases.

According to paragraph 5, it is understood that the provisions on enforcement do not create any obligation to put in place a judicial system for the enforcement of intellectual property rights distinct from that for the enforcement of law in general, nor does it affect the capacity of Members to enforce their law in general. In addition, it is stated that nothing in these provisions creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general. However, a number of countries have found it helpful to establish special enforcement units that pool together required experience needed to effectively fight against counterfeiting and piracy. Moreover, some countries have centralized certain types of intellectual property issues in one or a limited number of courts in order to ensure the availability of necessary expertise.

**Civil and administrative procedures and remedies** Back to top

The second Section requires that civil judicial procedures must be available in respect of any activity infringing intellectual property rights covered by the Agreement. The provisions of the Section elaborate in more detail basic features that such procedures must provide for.

Article 42 contains certain principles aiming at ensuring due process. Defendants are entitled to written notice which is timely and contains sufficient details of the claims. Parties must be allowed to be represented by independent legal counsel, and procedures may not impose overly burdensome requirements concerning mandatory personal appearances. All parties are entitled to substantiate their claims and to present all relevant evidence, while confidential information must be identified and protected.

Article 43 deals with how the rules on evidence should be applied in certain situations. In a situation where evidence that is likely to be important for one party is in the possession of the opposing party, the court must be empowered, provided that certain conditions are met, to order the latter party to produce that evidence. In addition, courts may

be authorized to make their decisions on the basis of information presented to them, if a party refuses without good reason access to evidence that is in his or her possession, subject to providing the parties an opportunity to be heard.

The Section contains provisions on injunctions, damages and other remedies. Article 44 requires that the courts be empowered to order injunctions, i.e. to order a party to desist from infringements, including the possibility to prevent imported infringing goods from entering into domestic distribution channels. Members are not obliged to provide that authority where a person has acted in good faith. Article 45 provides that the courts must be empowered to order an infringer, at least if he or she acted in bad faith, to pay the right holder adequate damages. They must also be authorized to order the infringer to pay the right holder's expenses. These expenses may include appropriate attorney's fees. In appropriate cases, the courts may be authorized to order recovery of profits and/or payment of pre-established damages even where the infringer acted in good faith.

In order to create an effective deterrent to infringement, Article 46 requires that the judicial authorities must have the authority to order infringing goods to be disposed of outside the channels of commerce, or, where constitutionally possible, destroyed. Similarly, it must be possible to dispose of materials and instruments predominantly used in the production of the infringing goods. In considering such requests, the courts must take into account proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties. In respect of counterfeit trademark goods, it is clarified that the simple removal of the trademark unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce.

The judicial authorities may be authorized to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution (Article 47). This option is aimed at assisting the right holders to find the source of infringing goods and to take appropriate action against other persons in the distribution channels. This provision must be applied in a way that is in proportion to the seriousness of the infringement.

The Section contains certain safeguards against abuse of enforcement procedures. Article 48 provides that the judicial authorities must have the authority to order the applicant who has abused enforcement procedures to pay an adequate compensation to the defendant who has been wrongfully enjoined or restrained to cover both the injury suffered and expenses. Such expenses may include appropriate attorney's fees. Public authorities and officials are exempted from liability to appropriate remedial measures only where actions are taken or intended in good faith in the course of the administration of that law.

Article 49 provides that, to the extent that any civil remedy can be ordered as a result of administrative procedures on the merits of a case, such procedures shall conform to principles equivalent in substance to those set forth in the Section.

**Provisional measures** Back to top

Article 41 requires that enforcement procedures must permit effective action against infringements and must include expeditious remedies. As these judicial procedures may take a fair amount of time, it is necessary for the judicial authorities to be empowered to provide provisional relief for the right holder in order to stop an alleged infringement immediately. The provisions on provisional measures are contained in Article 50. It requires each country to ensure that its judicial authorities have the authority to order prompt and effective provisional measures. Such measures must be available in respect of any intellectual property right. Provisional measures have to be available in two situations. One is where they are needed to prevent an infringement from occurring, and to prevent infringing goods from entering into the channels of commerce. This includes preventing imported infringing goods from being dispersed into domestic distribution channels immediately after customs clearance. The other situation is where such measures are needed to preserve relevant evidence in regard to the alleged infringement.

Effective use of provisional measures may require that action be taken without giving prior notice to the other side. Therefore, the judicial authorities must have the authority to adopt provisional measures *inaudita altera parte*, i.e. without prior hearing of the other side, where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed (paragraph 2).

The courts may require the applicant to provide any reasonably available adequate evidence that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent (paragraph 3). The applicant may also be required to supply information necessary for the identification of the goods (paragraph 5). Where provisional measures have been adopted *inaudita altera parte*, the parties affected must be given notice, without delay after the execution of the measures at the latest. The defendant has a right to review with a view to deciding, within a reasonable period after the notification of the measures, whether these measures shall be modified, revoked or confirmed (paragraph 4).

The provisions on provisional measures contain certain safeguards against abuse of such measures. The judicial authority may require the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse (paragraph 3). Provisional measures shall, upon request by the defendant, be revoked or otherwise cease to have effect, if the applicant fails to initiate proceedings leading to a decision on the merits of the case within a reasonable period to be determined by the judicial authority ordering the measures. In the absence of such a determination, this period may not exceed 20 working days or 31 calendar days, whichever is the longer (paragraph 6). Where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant to provide the defendant appropriate compensation for any injury caused by these measures (paragraph 7).

The above principles apply also to administrative procedures to the extent that any provisional measure can be ordered as a result of such procedures (paragraph 8).

**Special requirements related to border measures** Back to top

The emphasis in the enforcement part of the TRIPS Agreement is on internal enforcement mechanisms, which, if effective, would enable infringing activity to be stopped at source, the point of production. Where possible, this is both a more efficient way of enforcing IPRs and less liable to give rise to risks of discrimination against imports than special border measures. However, the Agreement recognizes that such enforcement at source will not always be possible and that in any event not all countries are Members of the TRIPS Agreement. The Agreement therefore also recognizes the importance of border enforcement procedures that will enable right holders to obtain the cooperation of customs administrations so as to prevent the release of infringing imports into free circulation. The special requirements related to border measures are contained in Section 4 of the enforcement part of the Agreement.

According to Article 51 of the Agreement, the goods which must be subject to border enforcement procedures must include at least counterfeit trademark and pirated copyright goods that are being presented for importation (see footnote 14 to that Article for the precise definition of these terms). The Article leaves flexibility to Member governments on whether to include imports of goods which involve other infringements of IPRs. Members are also free to determine whether to apply these procedures to parallel imports. This is confirmed in footnote 13 to the Article, according to which it is understood that there shall be no obligation to apply such procedures to imports of goods put on the market in another country by or with the consent of the right holder. In accordance with Article 60, Members may exclude from the application of these procedures *de minimis* imports, i.e. small quantities of goods of a non-commercial nature contained in travellers' personal luggage or sent in small consignments. Article 51 leaves it to Members to decide whether to apply corresponding procedures to the suspension by customs authorities of infringing goods destined for exportation from their territories, or to goods in transit.

The basic mechanism required by the Agreement is that each Member must designate a "competent authority", which could be administrative or judicial in nature, to which applications by right holders for customs action shall be lodged (Article 51). The right holder lodging an application to the competent authority shall be required to provide adequate evidence of a *prima facie* infringement of his IPR and to supply a sufficiently detailed description of the goods to make them readily recognizable by the customs authorities. The competent authorities shall then inform the applicant whether the application has been accepted and, if so, for what period, and give the necessary directions to customs officers (Article 52). After this, it is the responsibility of the applicant to initiate proceedings leading to a decision on the merits of the case. The Agreement requires a system to be put in place under which action will be taken on the basis of an application from a right holder, but leaves it to Members to determine whether they require competent authorities to act upon their own initiative. Article 58 contains certain additional provisions applicable to such *ex officio* action.

The provisions on border measures require the taking of what are essentially provisional measures against imports of infringing goods. Many of the same types of safeguards against abuse as appear in Article 50 on

provisional judicial measures are provided for. The competent authority may require the applicant to provide a security or equivalent assurance sufficient to protect the defendant and the competent authorities and to prevent abuse. However, such security or equivalent assurance may not be such as to unreasonably deter recourse to these procedures (Article 53.1). The importer and the applicant must be promptly notified of the detention of goods (Article 54). If the right holder fails to initiate proceedings leading to a decision on the merits of a case within ten working days, the goods shall normally be released (Article 55). Where goods involve the alleged infringement of industrial designs, patents, layout-designs or undisclosed information, the importer must be entitled to obtain their release on the posting of a security sufficient to protect the right holder from any infringement, even if proceedings leading to a decision on the merits have been initiated (Article 53.2). Once judicial proceedings on the merits of a case have been initiated, the judicial authority may continue the suspension of the release of goods in accordance with a provisional judicial measure. In that case, the provisions on provisional measures in Article 50 shall be applied. The applicant may be required to pay appropriate compensation to persons whose interests have been adversely affected by the wrongful detention of goods or through detention of goods released pursuant to the failure of the applicant to initiate in time proceedings leading to a decision on the merits of the case (Article 56).

The competent authorities must be able to give the right holder sufficient opportunity to have any goods detained by the customs authorities inspected in order to substantiate his or her claims. Where goods have been found infringing as a result of a decision on the merits, the Agreement leaves it to Members whether to enable the right holder to be informed of other persons in the distribution channel so that appropriate action could also be taken against them (Article 57).

In regard to remedies, the competent authorities must have the power to order the destruction or disposal outside the channels of commerce of infringing goods in such a manner as to avoid any harm to the right holder. The principles contained in Article 46 on civil remedies, such as the need for proportionality, apply also to border measures. In regard to counterfeit trademark goods, the authorities may not allow the re-exportation of the infringing goods in an unaltered state or subject them to a different customs procedure, other than in exceptional circumstances. These remedies are without prejudice to other rights of action open to the right holder, such as to obtain damages through civil litigation, and are also subject to the right of the defendant to seek review by a judicial authority (Article 59).

**Criminal procedures** Back to top

The fifth and final section in the enforcement chapter of the TRIPS Agreement deals with criminal procedures. According to Article 61, provision must be made for these to be applied at least in cases of wilful trademark counterfeiting or copyright piracy on a commercial scale. The Agreement leaves it to Members to decide whether to provide for criminal procedures and penalties to be applied in other cases of infringement of intellectual property rights, in particular where they are committed wilfully and on a commercial scale.

Sanctions must include imprisonment and/or monetary fines sufficient to provide a deterrent, consistent with the level of penalties applied for

crimes of a corresponding gravity. Criminal remedies in appropriate cases must also include seizure, forfeiture and destruction of the infringing goods and of materials and instruments used to produce them.

## Other provisions Back to top

### Acquisition and maintenance of intellectual property rights and related *inter partes* procedures

On the whole, the Agreement does not deal in detail with procedural questions concerning acquisition and maintenance of intellectual property rights. Part IV of the Agreement contains some general rules on these matters, the purpose of which is to ensure that unnecessary procedural difficulties in acquiring or maintaining intellectual property rights are not employed to impair the protection required by the Agreement. According to paragraph 1 of Article 62, Members may require, as a condition of the acquisition or maintenance of rights related to trademarks, geographical indications, industrial designs, patents and layout-designs, compliance with reasonable procedures and formalities. Where the acquisition of an intellectual property right is subject to the right being granted or registered, the procedures must permit the granting or registration of the right within a reasonable period of time so as to avoid unwarranted curtailment of the period of protection (paragraph 2). Procedures concerning the acquisition or maintenance of intellectual property rights and, where a Member's law provides for such procedures, administrative revocation and *inter partes* procedures such as opposition, revocation and cancellation, must be governed by the general principles concerning decisions and review set out in paragraphs 2 and 3 of Article 41 of the Agreement (paragraph 4). Final administrative decisions in such procedures must generally be subject to review by a judicial or quasi-judicial authority (paragraph 5).

### Transitional arrangements Back to top

The TRIPS Agreement gives all WTO Members transitional periods so that they can meet their obligations under it. The transitional periods, which depend on the level of development of the country concerned, are contained in Articles 65 and 66.

Developed country Members have had to comply with all of the provisions of the TRIPS Agreement since 1 January 1996. However, all Members, even those availing themselves of the longer transitional periods, have had to comply with the national treatment and MFN treatment obligation as of 1 January 1996.

For developing countries, the general transitional period is five years, i.e. until 1 January 2000. A country whose economy is in transition, but which is not a developing country, may nonetheless delay application until the year 2000, if it meets three tests:

-it is in the process of transformation from a centrally-planned into a market, free enterprise economy;

-it is undertaking structural reform of its intellectual property system; and

-it faces special problems in the preparation and implementation of intellectual property laws and regulations.

For those countries on the United Nations list of least-developed countries, the transitional period is eleven years. The Agreement provides a possibility to extend the transitional period upon duly motivated request.

There are two important substantive obligations that have been effective from the entry into force of the TRIPS Agreement on 1 January 1995. One is the so-called "non-backsliding" clause in Article 65.5 which concerns changes made during the transitional period, and the other the so-called "mail-box" provision in Article 70.8 for filing patent applications for pharmaceutical and agricultural chemical products during the transitional period.

The "non-backsliding" clause in Article 65.5 forbids countries from using the transition period to reduce the level of protection of intellectual property in a way which would result in a lesser degree of consistency with the requirements of the Agreement.

Special transition rules apply in the situation where a developing country does not provide product patent protection in a given area of technology, especially to pharmaceutical or agricultural chemical inventions, on the general date of application of the Agreement for that Member, i.e. in the year 2000. According to Article 65.4, such a developing country may delay the application of the TRIPS obligations on product patents to that area of technology for an additional five years (i.e. to the year 2005). However, the Agreement includes additional transitional arrangements in the situation where a country does not provide, as of the date of entry into force of the WTO Agreement, patent protection for pharmaceutical and agricultural chemical products commensurate with the TRIPS provisions. In accordance with the "mail-box" provision contained in Article 70.8, the country concerned must provide, as from the date of entry into force of the WTO Agreement, a means by which patent applications for such inventions can be filed. These applications will not need to be examined for their patentability until the country starts applying product patent protection in that area, i.e. for a developing country, at the end of the ten-year transition period. However, at that time, the application must be examined by reference to the prior art as it existed at the time the application was made. If the application is successful, product patent protection would then have to be granted for the remainder of the patent term counted from the filing date of the application. If a product that has been the subject of such a patent application obtains marketing approval before the decision on the grant of the patent is taken, there is an obligation under Article 70.9 to grant exclusive marketing rights for a period of up to five years to tide over the gap. This is subject to a number of safeguards to ensure that the product concerned is a genuine invention: subsequent to the entry into force of the WTO Agreement, a patent application must have been filed, a patent granted and marketing approval obtained in another Member for the product in question.

**Protection of existing subject-matter** Back to top

An important aspect of the transition arrangements under the TRIPS Agreement is the provisions relating to the treatment of subject-matter already existing at the time that a Member starts applying the provisions of the Agreement. As provided in Article 70.2, the rules of the TRIPS Agreement generally apply to subject-matter existing on the date of application of the Agreement for the Member in question and which is

protected in that Member on the said date. In respect of copyright and most related rights, there are additional requirements. Articles 9.1, 14.6 and 70.2 of the TRIPS Agreement oblige WTO Members to comply with Article 18 of the Berne Convention, not only in respect of the rights of authors but also in respect of the rights of performers and producers of phonograms in phonograms. Article 18 of the Berne Convention as incorporated into the TRIPS Agreement includes the so-called rule of retroactivity, according to which the Agreement applies to all works which have not yet fallen into the public domain either in the country of origin or the country where protection is claimed through the expiry of the term of protection. The provisions of Article 18 allow some transitional flexibility where a country is, as a result, taking subject-matter out of the public domain and putting it under protection, in respect of the interests of persons who have in good faith already taken steps on the basis of the material being in the public domain.

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**TRIPS:** NOTIFICATIONS

# Notifications under the TRIPS Agreement

The TRIPS Agreement obliges the WTO Members to make certain notifications to the Council for TRIPS. These notifications facilitate the Council's work of monitoring the operation of the Agreement and promote the transparency of Members' policies on intellectual property protection. In addition, Members wishing to avail themselves of certain possibilities provided in the Agreement that relate to the substantive obligations have to notify the Council. In order to implement these notification obligations, the Council has adopted procedures and guidelines relating to them. In addition, the Members have agreed to make certain notifications which are not regulated in the Agreement.

## Notifications under the TRIPS Agreement Back to top

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Information on notifications relating to technical cooperation can be found under Technical Cooperation in the TRIPS area.

Detailed information on the notification procedures can be found in the Technical Cooperation Handbook on Notification Requirements: Agreement on Trade-Related Aspects of Intellectual Property Rights **(document WT/TC/NOTIF/TRIPS/1) - see documents on-line.**

### Notifications under Article 63.2

Article 63.2 of the TRIPS Agreement requires Members to notify the laws and regulations made effective pertaining to the subject-matter of the Agreement (the availability, scope, acquisition, enforcement and prevention of the abuse of intellectual property rights). The procedures for the notification of national laws and regulations under Article 63.2 are contained in document IP/C/2. These procedures provide that, as of the time that a Member is obliged to start applying a provision of the TRIPS Agreement, the corresponding laws and regulations shall be notified without delay (normally within 30 days, except where otherwise provided by the TRIPS Council).

The procedures make a distinction between so-called "main dedicated intellectual property laws and regulations" and "other laws and regulations". Document IP/C/2, paragraphs 6 and 9, and document IP/C/W/8 contain some guidelines for dividing the laws and regulations into these two categories. Main laws and regulations have to be notified in English, French or Spanish; other laws and regulations can be notified

in a Member's national language even if this is not one of those three languages. Translations of laws and regulations must be accompanied by the authentic texts of the laws and regulations in question in a national language.

The national treatment and MFN obligations of Articles 3, 4 and 5 of the TRIPS Agreement became applicable to all Members from 1 January 1996, including those Members that avail themselves of the transitional periods provided in Articles 65.2 and 66.1 of the Agreement. The Council for TRIPS has recognized that Members have a number of options for meeting their obligation to notify those laws and regulations that correspond to the national treatment and MFN obligations of Articles 3, 4 and 5 of the Agreement. Further information on these options can be found in document IP/C/9.

Notifications of laws and regulations under Article 63.2 are distributed in the IP/N/1/- series of documents. The documentation of main dedicated intellectual property laws and regulations is distributed in the following sub-series of documents:

IP/N/1/-/C/- Copyright and Related Rights

IP/N/1/-/T/- Trademarks

IP/N/1/-/G/- Geographical Indications

IP/N/1/-/D/- Industrial Designs

IP/N/1/-/P/- Patents (Including Plant Variety Protection)

IP/N/1/-/L/- Layout-Designs (Topographies) of Integrated Circuits

IP/N/1/-/U/- Undisclosed Information

IP/N/1/-/I/- Industrial Property (General)

IP/N/1/-/E/- Enforcement

IP/N/1/-/O/- Other

The texts of the laws and regulations referred to in these documents are not contained in the WTO Documents On-line, since they have not generally been put into machine-readable form by the WTO Secretariat. However, as provided in Article 2(4) of the Agreement between the World Intellectual Property Organization and the World Trade Organization, the WTO Secretariat transmits to the International Bureau of WIPO a copy of the laws and regulations received by the WTO Secretariat from WTO Members under Article 63.2 of the TRIPS Agreement in the language or languages and in the form or forms in which they were received, and the International Bureau places such copies in its collection. **The World Intellectual Property Organization** makes the laws and regulations contained in its collection available to the public in various ways, including by publishing them in its monthly review "Industrial Property and Copyright" and in its CD-ROM publication "IP-LEX".

Given the difficulty of examining legislation relevant to many of the enforcement obligations in the TRIPS Agreement, Members have undertaken, in addition to notifying legislative texts, to provide information on how they are meeting these obligations by responding to a

checklist of questions (document IP/C/5). Responses to these questions are circulated in the IP/N/6- series of documents.

**Notifications under Articles 1.3 and 3.1**

Articles 1.3 and 3.1 of the TRIPS Agreement allow Members to avail themselves of certain options in regard to the definition of beneficiary persons and national treatment, provided that notifications are made to the Council for TRIPS. Notifications made under Articles 1.3 and 3.1 are circulated in the IP/N/2/- series of documents. Further background information on these notification possibilities can be found in document IP/C/W/5.

**Notifications under Article 4(d)**

Article 4 of the Agreement on the most-favoured-nation treatment provides that, with regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members. There are certain exceptions to this obligation. According to sub paragraph (d) of that Article, exempted from this obligation are any advantage, favour, privilege or immunity accorded by a Member deriving from international agreements related to the protection of intellectual property which entered into force prior to the entry into force of the WTO Agreement, provided that such agreements are notified to the Council for TRIPS and do not constitute an arbitrary or unjustifiable discrimination against nationals of other Members. Notifications made under Article 4(d) are circulated in the IP/N/4/- series of documents.

**Notifications under Article 69**

Article 69 of the Agreement requires Members to establish and notify contact points in their administrations for the purposes of cooperation with each other aimed at the elimination of trade in infringing goods. The information on such contact points is circulated in document IP/N/3, and addenda, corrigenda and periodic revisions.

**Notifications under other provisions of the Agreement**

A number of notification provisions of the Berne and the Rome Conventions are incorporated by reference into the TRIPS Agreement but without being explicitly referred to in it. At its meeting in February 1996, the Council invited each Member wishing to make such notifications to make them to the Council for TRIPS, even if the Member in question had already made a notification under the Berne or the Rome Convention in regard to the same issue. Further background information on these notification possibilities can be found in document IP/C/W/15. Notifications of this kind are circulated in the IP/N/5/- series of documents.

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**TRADING INTO THE FUTURE:** THE INTRODUCTION TO THE WTO

The agreements

# Intellectual property: protection and enforcement

Ideas and knowledge are an increasingly important part of trade. Most of the value of new medicines and other high technology products lies in the amount of invention, innovation, research, design and testing involved. Films, music recordings, books, computer software and on-line services are bought and sold because of the information and creativity they contain, not usually because of the plastic, metal or paper used to make them.

Many products that used to be traded as low-technology goods or commodities now contain a higher proportion of invention and design in their value – for example brand-named clothing or new varieties of plants.

Creators can be given the right to prevent others from using their inventions, designs or other creations. These rights are known as "intellectual property rights". They take a number of forms. For example books, paintings and films come under copyright; inventions can be patented; brand-names and product logos can be registered as trademarks; and so on.

**TRADING INTO THE FUTURE**

**1. Basics**
**2. Agreements**

> Overview
> Tariffs
> Agriculture
> Textiles
> Services
> Intellectual property
> Anti-dumping, subsidies, etc
> Non-tariff barriers
> Plurilaterals
> Trade policy reviews

**3. Settling disputes**
**4. Beyond the agreements**
**5. Developing countries**
**6. The organization**

**> Introducing the World Trade organization**

> The WTO in Brief
> 10 benefits
> 10 misunderstandings
> Trading into the Future
> Frequently-asked questions

## Origins: into the rule-based trade system

The extent of protection and enforcement of these rights varied widely around the world; and as intellectual property became more important in trade, these differences became a source of tension in international economic relations. New internationally-agreed trade rules for intellectual property rights were seen as a way to introduce more order and predictability, and for disputes to be settled more systematically.

The 1986-94 Uruguay Round achieved that. The WTO's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) is an attempt to narrow the gaps in the way these rights are protected around the world, and to bring them under common international rules. When there are trade disputes over intellectual property rights, the WTO's dispute settlement system is now available.

The agreement covers five broad issues:

- how basic principles of the trading system and other international intellectual property agreements should be applied
- how to give adequate protection to intellectual property rights

## Types of intellectual property

The areas covered by the TRIPS agreement

- Copyright and related rights
- Trademarks, including service marks
- Geographical indications
- Industrial designs
- Patents
- Layout-designs (topographies) of integrated circuits
- Undisclosed information, including trade secrets

- how countries should enforce those rights adequately in their own territories
- how to settle disputes on intellectual property between members of the WTO
- special transitional arrangements during the period when the new system is being introduced.

## Basic principles: national treatment, MFN, and technological progress back to top

As in GATT and GATS, the starting point of the intellectual property agreement is basic principles. And as in the two other agreements, non-discrimination features prominently: national treatment (treating one's own nationals and foreigners equally), and most-favoured-nation treatment (equal treatment for nationals of all trading partners in the WTO). National treatment is also a key principle in other intellectual property agreements outside the WTO.

When an inventor or creator is granted patent or copyright protection, he obtains the right to stop other people making unauthorized copies. Society at large sees this temporary intellectual property protection as an incentive to encourage the development of new technology and creations which will eventually be available to all. The TRIPS Agreement recognizes the need to strike a balance. It says intellectual property protection should contribute to technical innovation and the transfer of technology. Both producers and users should benefit, and economic and social welfare should be enhanced, the agreement says.

## How to protect intellectual property: common ground-rules back to top

The second part of the TRIPS agreement looks at different kinds of intellectual property rights and how to protect them. The purpose is to ensure that adequate standards of protection exist in all member countries. Here the starting point is the obligations of the main international agreements of the World Intellectual Property Organization (WIPO) that already existed before the WTO was created:

- the Paris Convention for the Protection of Industrial Property (patents, industrial designs, etc).
- the Berne Convention for the Protection of

Literary and Artistic Works (copyright).

Some areas are not covered by these conventions. In some cases, the standards of protection prescribed were thought inadequate. So the TRIPS agreement adds a significant number of new or higher standards.

## Copyright back to top

The TRIPS agreement ensures that computer programs will be protected as literary works under the Berne Convention and outlines how databases should be protected.

It also expands international copyright rules to cover rental rights. Authors of computer programmes and producers of sound recordings must have the right to prohibit the commercial rental of their works to the public. A similar exclusive right applies to films where commercial rental has led to widespread copying, affecting copyright-owners' potential earnings from their films.

The agreement says performers must also have the right to prevent unauthorized recording, reproduction and broadcast of live performances (bootlegging) for no less than 50 years. Producers of sound recordings must have the right to prevent the unauthorized reproduction of recordings for a period of 50 years.

## Trademarks back to top

The agreement defines what types of signs must be eligible for protection as trademarks, and what the minimum rights conferred on their owners must be. It says that service marks must be protected in the same way as trademarks used for goods. Marks that have become well-known in a particular country enjoy additional protection.

## Geographical indications back to top

Place names are sometimes used to identify a product. Well-known examples include "Champagne", "Scotch", "Tequila", and "Roquefort" cheese. Wine and spirits makers are particularly concerned about the use of place-names to identify products, and the TRIPS

agreement contains special provisions for these products. But the issue is also important for other types of goods.

The use of a place name to describe a product in this way – a "geographical indication" – usually identifies both its geographical origin and its characteristics. Therefore, using the place name when the product was made elsewhere or when it does not have the usual characteristics can mislead consumers, and it can lead to unfair competition. The TRIPS agreement says countries have to prevent the misuse of place names.

For wines and spirits, the agreement provides higher levels of protection, i.e. even where there is no danger of the public being misled.

Some exceptions are allowed, for example if the name is already protected as a trademark or if it has become a generic term. For example, "cheddar" now refers to a particular type of cheese not necessarily made in Cheddar. But any country wanting to make an exception for these reasons must be willing to negotiate with the country which wants to protect the geographical indication in question. The agreement provides for further negotiations in the WTO to establish a multilateral system of notification and registration of geographical indications for wines.

## Industrial designs back to top

Under the TRIPS agreement, industrial designs must be protected for at least 10 years. Owners of protected designs must be able to prevent the manufacture, sale or importation of articles bearing or embodying a design which is a copy of the protected design.

## Patents back to top

The agreement says patent protection must be available for inventions for at least 20 years. Patent protection must be available for both products and processes, in almost all fields of technology. Governments can refuse to issue a patent for an invention if its commercial exploitation is prohibited for reasons of public order or morality. They can also exclude diagnostic, therapeutic and surgical methods, plants and animals (other than microorganisms), and biological processes for the production of plants or animals (other than microbiological processes).

**Plant varieties, however, must be protectable by patents or by a special system (such as the breeder's rights provided in the conventions of UPOV – the International Union for the Protection of New Varieties of Plants).**

The agreement describes the minimum rights that a patent owner must enjoy. But it also allows certain exceptions. A patent-owner could abuse his rights, for example by failing to supply the product on the market. To deal with that possibility, the agreement says governments can issue "compulsory licences", allowing a competitor to produce the product or use the process under licence. But this can only be done under certain conditions aimed at safeguarding the legitimate interests of the patent-holder.

If a patent is issued for a production process, then the rights must extend to the product directly obtained from the process. Under certain conditions alleged infringers may be ordered by a court to prove that they have not used the patented process.

## Integrated circuits layout designs back to top

The basis for protecting integrated circuit designs ("topographies") in the TRIPS agreement is the Washington Treaty on Intellectual Property in Respect of Integrated Circuits, which comes under the World Intellectual Property Organization. This was adopted in 1989 but has not yet entered into force. The TRIPS agreement adds a number of provisions: for example, protection must be available for at least 10 years.

## Undisclosed information and trade secrets back to top

Trade secrets and other types of "undisclosed information" which have commercial value must be protected against breach of confidence and other acts contrary to honest commercial practices. But reasonable steps must have been taken to keep the information secret. Test data submitted to governments in order to obtain marketing approval for new pharmaceutical or agricultural chemicals must also be protected against unfair commercial use.

## Curbing anti-competitive licensing contracts back to top

The owner of a copyright, patent or other form of intellectual property right can issue a licence for someone else to produce or copy the protected trademark, work, invention, design, etc. The agreement recognizes that the terms of a licensing contract could restrict competition or impede technology transfer. It says that under certain conditions, governments have the right to take action to prevent anti-competitive licensing that abuses intellectual property rights. It also says governments must be prepared to consult each other on controlling anti-competitive licensing.

## Enforcement: tough but fair back to top

Having intellectual property laws is not enough. They must be enforcable. This is covered in Part 3 of TRIPS. The agreement says governments have to ensure that intellectual property rights can be enforced under their laws, and that the penalties for infringement are tough enough to deter further violations. The procedures must be fair and equitable, and not unnecessarily complicated or costly. They must not entail unreasonable time-limits or unwarranted delays. People involved should be able to ask a court to review an administrative decision or to appeal a lower court's ruling.

The agreement describes in some detail how enforcement have to be handled, including rules for obtaining evidence, provisional measures, injunctions, damages and other penalties. It says courts must have the right, under certain conditions, to order the disposal or destruction of pirated or counterfeit goods. Wilful trademark counterfeiting or copyright piracy on a commercial scale must be criminal offences. Governments have to make sure that intellectual property rights owners can receive the assistance of customs authorities to prevent imports of counterfeit and pirated goods.

## Transition arrangements: 1, 5 or 11 years to fall into line back to top

When the WTO agreements took effect on 1 January 1995, developed countries were given one year to ensure that their laws and practices conform with the TRIPS agreement. Developing

countries and (under certain conditions) transition economies are given five years. Least developed countries have 11 years.

If a developing country did not provide product patent protection in a particular area of technology when the TRIPS Agreement came into force (1 January 1995), it has up to 10 years to introduce the protection. But for pharmaceutical and agricultural chemical products, the country must accept the filing of patent applications from the beginning of the transitional period, though the patent need not be granted until the end of this period. If the government allows the relevant pharmaceutical or agricultural chemical to be marketed during the transition period, it must – subject to certain conditions – provide an exclusive marketing right for the product for five years, or until a product patent is granted, whichever is shorter.

Subject to certain exceptions, the general rule is that obligations in the agreement apply to intellectual property rights that exist at the end of a country's transition period, as well as to new ones.

A Council for Trade-Related Aspects of Intellectual Property Rights monitors the working of the agreement and governments' compliance with it.

> Click here to find out more about TRIPS
> Click here for World Intellectual Property Organization

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CONTACT US : World Trade Organization, rue de Lausanne 154, CH-1211 Geneva 21, Switzerland

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## USDA GERMPLASM REPOSITIORIES

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- C.M. Rick Tomato Genetics Resource Center, Davis, CA
- Maize Genetics Cooperation - Stock Center (GSZE), Urbana, Illinois
- G.A. Marx Pea Genetic Stock Center (GSPI), Pullman, Washington
- National Clonal Germplasm Repository (COR), Corvallis, Oregon
- National Clonal Germplasm Repository for Citrus and Dates, Riverside, California
- National Clonal Germplasm Repository (HILO), Hilo, Hawaii
- National Clonal Germplasm Repository for Tree Fruit/Nut Crops and Grapes (DAV), Davis California
- National Germplasm Resources Laboratory (NGRL), Beltsville, Maryland
- National Seed Storage Laboratory (NSSL), Fort Collins, Colorado
- National Small Grains Collection (NSGC), Aberdeen, Idaho
- North Central Regional Plant Introduction Station (NC7), Ames, Iowa
- Pecan Breeding & Genetics, Brownwood and Somerville, Texas
- Plant Genetic Resources Conservation Unit, Griffin, Georgia
- Plant Genetic Resources Unit, Geneva, New York
- Subtropical Horticulture Research Station (MIA), Miami, Florida
- Tropical Agriculture Reseach Station, Mayagüez, Puerto Rico
- United States Potato Genebank - NRSP-6, Sturgeon Bay, Wisconsin
- Western Regional Plant Introduction Station, Pullman, Washington
- Wheat Genetic Stock Center (GSTR), Aberdeen, Idaho

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**SEED VIABILITY AND STORAGE RESEARCH UNIT**

**Throughout the world plant genetic diversity is being eroded. Loss of these plants will result in the loss of genes for disease and insect resistance, high yield, improved nutrition, new pharmaceuticals, and crops that can overcome global climate changes..**

**The National Seed Storage Laboratory (NSSL), as a member of the National Plant Germplasm System preserves the genetic diversity of crop plants from all over the world (more than 270,000 collections). Because many commercial crops grown in the U.S. are not native, these plant introductions have been vital for developing our food and fiber crops. Plant breeders have used these introductions and other source materials to develop high yielding varieties with disease and insect resistance. This has enabled farmers to increase yields and lower costs so that the average U.S. family now spends less than 12% of its income for food. When varieties have genetic resistance to disease and insects, reduced use of pesticides help provide a cleaner environment.**

## MISSION STATEMENT

## TOUR OF THE NATIONAL SEED STORAGE LAB

- Bud and Tissue Culture
- Cryogenic storage
- Quarantine

## VISIT SPECIAL PROJECTS

## MEET THE STAFF

## ANNUAL REPORT

*MISSION STATEMENT*

**The mission of the Seed Viability and Storage Research Unit, National Seed Storage Laboratory, is to effectively document, preserve, and maintain viable seed and propagules of diverse plant germplasm in long-term storage, to develop and evaluate procedures for determining seed quality of accessions, and to provide administrative support to allow for effective operation of this Unit. The mission also includes the distribution of seed, when not available from the active collections, for crop improvement throughout the world.**

**Specific objectives are:**

1. **To preserve the base collection of plant germplasm for the National Plant Germplasm System.**
2. **To determine initial quality and to periodically monitor viability of plant germplasm placed into storage.**
3. **To continuously maintain and update the National Seed Storage Laboratory database, the Germplasm Resources Information Network (GRIN).**

# MODEL LAW

# on

# THE PROTECTION OF NEW VARIETIES OF PLANTS

International Union for the Protection of New Varieties of Plants

Geneva 1996

# MODEL LAW

on

# THE PROTECTION OF NEW VARIETIES OF PLANTS

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# INTRODUCTION

## Background

0.1 In 1980, the International Union for the Protection of New Varieties of Plants (UPOV) published a Model Law on the Protection of New Varieties of Plants, based on the 1978 Act of the Convention.

0.2 The Convention has since been revised and a new Act was adopted on March 19, 1991. The objective of the revision was mainly:

(a) to clarify certain provisions in the light of the experience gained by the member States of UPOV in applying the Convention since the previous revision;

(b) to strengthen the protection granted to breeders in certain specific ways so as to maintain the capacity of the protection system to promote investment in the plant variety and seed sector;

(c) to reflect technological changes.

It was therefore considered necessary to draw up a new Model Law.

0.3 This Model Law has been drawn up on the basis of the work done by the Administrative and Legal Committee of UPOV at its thirty-fourth and thirty-fifth sessions in November 1994 and April 1995, in which observers from a number of non-member States took an active part. Discussions at the thirty-fifth session had been prepared by a group of four experts acting in a personal capacity.

## Nature of the Model Law

0.4 As its name suggests, the Model Law is only a model. The form of national legislation and the terminology it uses vary according to legal traditions, administrative and governmental structures and other factors. Nevertheless, as far as possible, efforts have been made to propose model provisions that can be incorporated in a national law without any major changes.

0.5 In particular, the national law should be adapted to the laws governing related areas, notably seed and seedling legislation and patent laws. It is in fact possible to accommodate the protection of new plant varieties in either type of law; with regard to the former, however, it should be noted that plant variety protection covers all categories of plants, not only those usually covered by the laws on seeds and seedlings.

## Assistance by the Office of the Union

0.6 Any national government or competent authority of a regional intergovernmental organization may, on request, obtain assistance from the Office of the Union in drafting legislative texts and defining and establishing the necessary administrative and regulatory structures.

0.7 Article 34(3) of the 1991 Act provides as follows: "Any State which is not a member of the Union and any intergovernmental organization shall, before depositing its instrument of accession, ask the Council to advise it in respect of the conformity of its laws with the provisions of this Convention. If the decision embodying the advice is positive, the instrument of accession may be deposited." It is strongly recommended that the Office of the Union be consulted at an early stage so that a draft law that is consistent with the 1991 Act may be put before the legislative power of the State or the organization envisaging accession to the Union.

Layout of this Document

0.8 The text of the Model Law is given on the odd-numbered (right-hand) pages. The commentary is on the even-numbered (left-hand) pages.

# TEXT OF THE MODEL LAW

# AND

# COMMENTARY

# COMMENTARY ON ARTICLE 1

Structure

1.1 This Article deals with two issues that can be divided up.

Paragraph (1)

1.2 This paragraph states the purpose of the Law in general terms. The proposed text is based on Article 1(1) of the 1978 Act of the Convention.

1.3 *Purpose of the law.* - The inclusion of a provision of this type in a national law is mainly a matter of legal tradition.

1.4 The Office of the Union can provide detailed documentation on the effects of protection.

1.5 *Form of protection.* - The Model Law already uses the term "breeder's right" in Article 1(1), in conformity with the 1991 Act of the Convention. Article 2 of the Convention sets out the basic obligation of the Contracting Parties as follows: "Each Contracting Party shall grant and protect breeders' rights."

1.6 The practice in the majority of States currently members of UPOV is to recognize the rights by issuing a special title of protection (for example, a "new plant variety certificate") on the basis of a special law. Protection can also be granted by entering the variety in a "register of protected varieties." Where protection is governed by patent legislation, reference is often made to "plant patents."

1.7 Whatever the name of the medium used for the recognition of breeders' rights, a law based on the Model Law is a "*sui generis* system" for the protection of varieties within the meaning of Article 27.3(b) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), which constitutes Annex 1C to the Agreement Establishing the World Trade Organization (WTO). That Article states that "Members shall provide for the protection of plant varieties either by patents or by an effective *sui generis* system or by any combination thereof."

Paragraph (2)

1.8 Paragraph (2) contains two types of definition: definitions that simplify the remainder of the text and definitions as such.

1.9 *Subsidiary legislative instruments*. - The Model Law refers to "regulations" for reasons of simplification. States will make use of one or other secondary legislative

# PART I

# PURPOSE AND SCOPE OF THE LAW

## Article 1

## Purpose of the Law and Definitions

**(1) The purpose of this Law is to recognize and to ensure to the breeder of a new plant variety or to his successor in title a right, to be known as a "breeder's right," under the conditions hereinafter defined.**

**(2) For the purposes of this Law:**

**(i) "Council" means the Plant Breeders' Rights Council referred to in Article 25;**

**(ii) "Office" means the Plant Breeders' Rights Office referred to in Article 26;**

**(iii) "Minister" means the Minister for ... [the Minister who has responsibility for the protection of new varieties of plants];**

**(iv) "Regulations" means the implementing regulations made under this Law;**

**(v) "Convention" means the International Convention for the Protection of New Varieties of Plants;**

**(vi) "Union" means the International Union for the Protection of New Varieties of Plants;**

**(vii) "Contracting Party" means a State (other than *the State*[1]) or intergovernmental organization party to the Convention;**

**(viii) "Authority of a Contracting Party" means the Authority entrusted with the implementation of the law on the protection of new varieties of plants of that Party;**

**(ix) "breeder" means the person who has bred, or discovered and developed, a variety;**

**(x) "applicant" means the person who has filed an application for the grant of a breeder's right;**

**(xi) "holder" means the holder of a breeder's right;**

[1] In this particular context, this State is the one deemed to have adopted the Model Law. The phrase "the State" has the same meaning throughout the Model Law.

instrument as required (decree, order, regulation, etc.), or several, in order to specify and complete the provisions of the law.

1.10 *Persons affected by the law.* - Whereas the UPOV Convention uses the word "breeder" in all the substantive provisions (thus assimilating entitled persons or successors in title to the breeder), the Model Law draws a distinction between the breeder, the applicant and the holder. In many cases—but not always—these will be the same person. The status of breeder is a matter of fact, independent of the existence of an application or breeder's right; the status of applicant and the status of holder are matters of both fact and law.

1.11 Consequently, the definition of the breeder given in subparagraph (ix) is simplified in comparison with that contained in Article 1 of the 1991 Act. The missing elements are dealt with in Article 10 of the Model Law.

1.12 It must be emphasized that the applicant is the person by whom or on whose behalf an application is made (by a procedural representative—see Article 4), and to whom the breeder's right will be granted.

1.13 *Variety and protected variety.* - The definition of the variety given in subparagraph (xii) corresponds to that given in Article 1(vi) of the 1991 Act.

1.14 The main purpose of the definition given in the 1991 Act and repeated in the Model Law is to emphasize that the concept of "variety" should not be assimilated to that of "protected variety" or "protectable variety." In particular, when a variety that is the subject of an application for a breeder's right is examined, it should also be compared with material that is not uniform enough to be protected but enough to be defined individually as a variety.

1.15 The definition of "protected variety" is accompanied by references to subsequent Articles. It is proposed that a variety should be defined both by the description and by the sample; such flexibility is useful for instance in infringement cases, where the circumstances may dictate reference to one or other of the two elements.

1.16 *Propagating material and harvested material.* - No attempt has been made in the Model Law to define these terms. Drafting definitions capable of covering all possible situations satisfactorily is probably a risky endeavor; it is preferable to rely on common sense and case law.

1.19 "Propagating material" undoubtedly means parts of plants used to produce new plants (for example seeds, cuttings and grafts), as well as whole plants used for planting (for example, rooted cuttings, runners and young plants grown from seed). Their end-use is a matter of fact but also of intention on the part of those concerned (producer, seller, buyer, user): the production of beet seeds is seed production, whereas bean seeds can be used for consumption or sowing.

**(xii) variety" means a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a breeder's right are fully met, can be**

- **defined by the expression of the characteristics resulting from a given genotype or combination of genotypes,**
- **distinguished from any other plant grouping by the expression of at least one of the said characteristics and**
- **considered as a unit with regard to its suitability for being propagated unchanged;**

**(xiii) "protected variety" means the variety that is the subject of a breeder's right; it shall be defined by the description established pursuant to Article 37(1)(iii) and by the official sample referred to in Article 49(1)(i), and identified by the denomination referred to in Article 5(1)(v);**

**(xiv) "notice" means, unless the context requires otherwise, a communication by the Office to a party to proceedings before the Office.**

## COMMENTARY ON ARTICLE 2

2.1 According to Article 3 of the 1991 Act, protection should be provided for all plant genera and species; States are however allowed gradually to extend the scope of the law within a period of five or ten years, according to whether they are already members or new members. The Model Law utilizes this possibility from the point of view of a State about to become a member of UPOV.

2.2 The Model Law suggests that the plant genera and species should be specified in the Regulations—so that Parliament does not have to pronounce on the list—and that the essential elements of the timetable should be set out in the law. For the purposes of this provision, the term "plant genera and species" means a taxon (a unit of botanical classification) of any rank that corresponds to a cultivated plant and is usually provided with a common name. If the protection system is applied gradually, it should start with the genera and species that are the most important to the domestic economy.

2.3 A scope of application that encompasses all plant genera and species—the whole of the plant kingdom—does not mean that the national Plant Breeders' Rights Office will receive applications for thousands of species: applications will only concern a relatively small number of cultivated species on which breeding work is being done and which are potentially deserving of protection. For example, the Netherlands—one of the States with the highest level of plant variety protection activity—had protected varieties in 232 taxa on December 31, 1994. As the example of several member States shows, it is perfectly possible to introduce a system of protection that applies to the whole of the plant kingdom from the outset.

2.4 Some States may wish to have the concept of "plant genera and species" defined. This concept should as a minimum cover all vascular plants and fungi and also algae where appropriate.

## Article 2

## Scope of the Law

**(1) This Law shall be applied to the plant genera and species specified in the Regulations.**

**(2) This Law shall be applied on the date of its coming into force to at least 15 plant genera and species, and by the expiration of a period of ten years from the said date at the latest, to all plant genera and species.**

## COMMENTARY ON ARTICLE 3

3.1 This Article corresponds to Article 4 of the 1991 Act.

3.2 Many national laws limit the possibility of acquiring a breeder's right according to the applicant's nationality or place of residence (in the case of a natural person) or registered office (in the case of a legal entity).

3.3 Some States have not introduced such restrictions. This approach is particularly recommended in the light of developments in international relations, especially the TRIPS Agreement. At the time of writing, there are differences of opinion on whether or not Article 27.3(b) of the Agreement (quoted in paragraph 1.7 above) includes the obligation to apply its Articles 3 (national treatment) and 4 (most-favored-nation treatment) in the context of a *sui generis* system. It needs only be mentioned that, as protection becomes more widespread, the interest of a provision on national treatment and reciprocity diminishes accordingly.

3.4 Paragraph (1)(i) and (ii), as completed by paragraph (2), restates the provisions of Article 3 of the 1991 Act in the abbreviated form that the general context of a national law permits. Paragraph (1)(iii) sets out the generally recognized principle of reciprocity with non-member States that possess legislation on the protection of new plant varieties and are themselves prepared to apply reciprocity.

3.5 The internationalization of trade relations and the growing complexity of company law have made the concept of "registered office" difficult to apply. The Model Law proposes completing it with the word "establishment." It should be mentioned that the Paris Convention for the Protection of Industrial Property uses the expression "real and effective industrial or commercial establishments."

3.6 Paragraph (3) entrusts the Office with the task of determining the existence of reciprocal protection. A simple procedure like the one proposed is advisable in view of the limited effect of reciprocity.

## Article 3

### Nationality, Place of Residence or Registered Office

**(1) The rights conferred by this Law may be acquired by**

**(i) nationals of *the State* and persons having their place of residence or registered office [or an establishment] in *the State*,**

**(ii) nationals of Contracting Parties and persons having their place of residence or registered office [or an establishment] in the territory of a Contracting Party, and**

**(iii) nationals of any State which, without being a Contracting Party, grants effective plant variety protection to the nationals of *the State*, and persons having their place of residence or registered office [or an establishment] in that State.**

**(2) For the purposes of paragraph (1)(ii), "nationals" means, where the Contracting Party is a State, the nationals of that State and, where the Contracting Party is an intergovernmental organization, the nationals of the States that are members of that organization.**

**(3) For the purposes of paragraph (1)(iii), the Office shall determine whether the plant variety protection offered by a State is effective.**

## COMMENTARY ON ARTICLE 4

4.1 The rule written into Article 4 is widely used. The appointment of a procedural representative makes for easier handling of breeders' rights at the administrative level and where necessary at the judicial level. In general, member States do not require the procedural representative either to be approved by the Patent Office or to be a legal adviser. On the contrary, experience shows that many foreign breeders enter into commercial relations with a local partner (breeder or producer of seeds and seedlings) and appoint him as their procedural representative.

4.2 The proposed provision implies that a procedural representative is not required for an application filed by a person who has his residence or registered office or an establishment in the State in question.

4.3 The power of attorney must be given in writing and signed by the procedural representative as well as by the principal. It may be useful to provide a special form for this.

4.4 The obligation to appoint a procedural representative may be replaced by an obligation to elect domicile in the State concerned for the purposes of procedures relating to the protection of the variety in question.

## Article 4

## Procedural Representative

**Persons having neither residence nor a registered office [nor an establishment] in *the State* may be parties to proceedings instituted pursuant to this Law and assert rights deriving therefrom only if they have a procedural representative who is resident or has an office in *the State*. The representative shall be given the power to act on his principal's behalf before the Office and in legal proceedings relating to the protection of new varieties of plants.**

# COMMENTARY ON ARTICLE 5

## Basis in the Convention

5.1 This Article corresponds to Article 5 of the 1991 Act.

## Paragraph (1)

5.2 The condition of novelty is essentially a legal one; in content it is very different from the novelty condition in patent law.

5.3 The conditions of distinctness, uniformity and stability are basically technical. They must be met before any particular plant material can constitute a variety; they must be met according to the criteria set out in Articles 7 to 9 (and the rules adopted for their application) before a variety can be protected.

5.4 The conditions of distinctness, uniformity and stability are assessed on the basis of the general criteria laid down by UPOV—especially those in the General Introduction to Test Guidelines and in the documents on the statistical exploitation of biometric data—and the specific criteria contained in the Test Guidelines drawn up for each species.

## Paragraph (2)

5.5 Paragraph (2) is not indispensable in national legislation because the implementing texts would never derogate from the provisions of the law. It does however add a detail that is useful when the implementing texts are written.

5.6 In particular, protection cannot be based on the criteria of value for cultivation and use that often apply to the national catalogue of varieties approved for trade (where such a catalogue exists). As far as legal principles are concerned, the object of the protection system is to recognize an intellectual property right, and so the notion of value in use has no place in such a system. At the practical level, value is also a concept that varies in time and space, so it is not a suitable condition of protection.

# PART II

# SUBSTANTIVE LAW

## CHAPTER I

## CONDITIONS FOR THE GRANT OF A BREEDER'S RIGHT

### Article 5

### Conditions of Protection

**(1) The breeder's right shall be granted where the variety is**

**(i) new,**

**(ii) distinct,**

**(iii) uniform,**

**(iv) stable and**

**(v) the subject of a denomination established pursuant to the provisions of Article 44.**

**(2) The grant of a breeder's right shall not be made subject to any further or different conditions provided that the applicant complies with the formalities established by this Law and pays the required fees.**

## COMMENTARY ON ARTICLE 6

Paragraph (1)

6.1 *Relation to the 1991 Act.* - Paragraph (1) corresponds to Article 6(1) of the 1991 Act. The provision contained in Article 6(2) of the Act has been converted into a model provision in Article 56 of the Model Law.

6.2 A particular feature of this provision is the expression "or, where relevant, at the priority date" added after "the date of filing of the application." It thus states one of the effects of priority, which are restated in Article 34(4)*(a)*.

6.3 Another distinguishing feature of the proposed provision is the addition of "or his successor in title" to the "breeder." This is partly due to the choice of terminology (see the commentary on Article 1(2) above).

Paragraph (2)

6.4 When the 1991 Act was adopted, it was agreed that certain commercial acts carried out in relation to the variety should not be prejudicial to its novelty. The negotiators also agreed, however, not to deal with this issue—which can be left to case law—in the Convention itself.

6.5 For the sake of legal clarity, the Model Law proposes the listing of six cases that explain or complete paragraph (1).

(a) Subparagraph (i) (abuse to the detriment of the breeder) is an explanatory provision: an abusive act of trade can only be carried out without the consent of the breeder;

(b) Subparagraph (ii) (transfer of the rights in the variety) is also explanatory: if the underlying principle is not accepted, any combined transfer of the rights and propagating material in a given State must be followed by the filing of an application in that State within the year;

(c) Subparagraph (iii) (propagation of the variety prior to marketing) is a provision that completes paragraph (1). Its aim is to allow breeders to undertake clearly-defined transactions that are necessary for the subsequent commercial exploitation of the variety before filing an application. This provision places on an equal footing "small" breeders—who do not have the means with which to do the pre-marketing propagation themselves—and "large" breeders—who do not need outside assistance in that respect;

(d) Subparagraph (iv) (tests) is also a complementary provision based on the same type of consideration as the preceding subparagraph;

## Article 6

## Novelty

**(1) The variety is new if, at the date of filing of the application or, where relevant, at the priority date, propagating material or harvested material of the variety has not been sold or otherwise disposed of to others, by or with the consent of the breeder or his successor in title, for purposes of exploitation of the variety,**

**(i) in the territory of *the State* for longer than one year and,**

**(ii) in a territory other than that of *the State* for longer than four years or, in the case of trees and grapevine, for longer than six years.**

**(2) Novelty shall not be lost as a result of any sale or disposal to others**

**(i) that is the result of an abuse to the detriment of the breeder or his successor in title,**

**(ii) that forms part of an agreement for the transfer of the rights in the variety,**

**(iii) that forms part of an agreement under which a person multiplies propagating material of the variety concerned on behalf of the breeder or his successor in title, provided that the property in the multiplied material reverts to the breeder or his successor in title, and provided that the multiplied material is not used for the production of another variety,**

**(iv) that forms part of an agreement under which a person undertakes field tests or laboratory trials, or small-scale processing trials, with a view to evaluating the variety,**

**(v) that forms part of the fulfillment of a statutory or administrative obligation, in particular concerning biological security or the entry of varieties in an official catalogue of varieties admitted to trade, or**

**(vi) that involves harvested material being a by-product or a surplus product of the creation of the variety or of the activities referred to in items (iii) to (v) of this Article, provided that the said material is sold or disposed of without variety identification for purposes of consumption.**

(e) Subparagraph (v) is basically explanatory. It is usual practice for a breeder to start by fulfilling certain obligations prior to commercial exploitation of a variety and only to file an application for protection once the commercial prospects are known; this practice also allows savings to be made in the administrative management of the protection system;

(f) Subparagraph (vi) is mixed. It deals with a practical reality but also lays down strict conditions.

Special Case of Varieties Whose Production Requires the Repeated Use of One or More Other Varieties

6.6 This case can be illustrated by the production of hybrid seed. Such seed is "propagating material" of the hybrid variety concerned. At the same time it can be the "harvested material" of the lines used for the hybrid formula or may be considered such; in the case of an $F_1$ hybrid, for example, the seeds are taken from the female line while the male line has been grown only to pollinate the female line for the purpose of obtaining the seeds. It is the view in some countries that the sale or transfer of hybrid seed to third parties for the purposes of exploiting the hybrid variety is a relevant act for the evaluation of the novelty of the lines used in the formula of the hybrid.

6.7 If this point needs to be developed further, the following provision can be inserted into the national law:

> "(3) Where the production of a variety requires the repeated use of one or more other varieties, the sale or transfer to third parties of the propagating material or the harvested material of that variety shall be relevant to the novelty of the other variety or varieties."

# COMMENTARY ON ARTICLE 7

## Basis in the Convention

7.1 This Article corresponds to Article 7 of the 1991 Act.

7.2 Regarding the addition of the words "or, where relevant, at the priority date," see the commentary on the preceding Article.

7.3 Paragraph (3) provides an illustration of the circumstances that make a variety—or cause it to be considered—a matter of common knowledge. It is based on Article 6(1)(a) of the 1978 Act.

## Distinctness as Such

7.4 The concept of distinctness raises two questions:

(a) What makes one variety distinct from another?

(b) How should one variety be distinguished from another?

7.5 *Important or relevant characteristics.* - The 1961 and 1978 Acts replied as follows to the first question: "by one or more important characteristics." This explanatory clause was deleted from the 1991 Act to eliminate a source of error and confusion, not to change administrative and technical practice (there is a tendency among, in particular, patent practitioners to interpret "important characteristic" as a characteristic conferring an additional value to the variety).

7.6 Distinctness is therefore based on an examination of the characteristics of the variety, usually taken in isolation.

7.7 Not all the characteristics are taken into account, only those qualified as "important" (or "relevant" in Articles 8 and 9). The word "important" does not call for any assessment of the value conferred on the variety by the characteristic in question or of the practical usefulness of the characteristic. It has consistently been interpreted as meaning "important for distinguishing varieties."

7.8 The characteristics taken into account when distinctness is examined are ideally characteristics that are independent of the effects of environment and enable varieties of the species in question to be described easily, both in the sense of ease of observation or measurement and in terms of cost. They are defined in the Test Guidelines drawn up by UPOV (which do not contain restrictive lists, however); the Test Guidelines are recommendations; they are periodically revised in the light of experience and technical and economic developments.

## Article 7

## Distinctness

**(1) The variety is distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of the filing of the application or, where relevant, at the priority date.**

**(2) The filing, in any country, of an application for a breeder's right or for entry in a catalogue of varieties admitted to trade shall be deemed to render the variety being the subject of the application a matter of common knowledge from the date of the application, provided that the application leads to the grant of the breeder's right or the entry in the catalogue, as the case may be.**

**(3) Common knowledge may also be established by reference to various factors such as: exploitation of the variety already in progress, entry of the variety in the register of varieties kept by a recognized professional association, or inclusion of the variety in a reference collection.**

7.9 Characteristics that affect the value of the variety for cultivation and use are usually taken into account when distinctness is examined, provided that this remains reasonable, as mentioned above. In addition, there are characteristics of purely agrobotanical interest, which usually have the advantage of being precise and not prone to fluctuation.

7.10 *Clear distinction.* - The three Acts of the Convention require the distinction to be "clear."

Priority Among Breeders of the Same Variety

7.11 The effect of Article 7 is to determine priority among persons who—independently of each other—appear to have created, or discovered and developed, the same variety or two varieties that are not clearly distinguishable: the right to protection in a given country belongs to the first person who made "his" variety a matter of common knowledge in any country. Paragraph (2) means that the filing of an application makes the variety a matter of common knowledge (even if it is actually known only to the breeder and the official authority) as from the date of the application, provided that the application is granted. In the course of normal plant breeding activities, a variety enters the commercial network through the filing of an application, so in practice these provisions mean that in the majority of cases there is a system of first-to-file priority that could extend worldwide.

7.12 It should be emphasized here that this system is different from the one usually applicable under patent law. The fact that a variety is a matter of common knowledge does not prevent it from being protected (whereas the disclosure of an invention in principle blocks the grant of the corresponding patent).

## COMMENTARY ON ARTICLE 8

8.1 This Article corresponds to Article 8 of the 1991 Act.

8.2 The uniformity requirement is not absolute, but depends rather on the characteristics of the sexual reproduction or vegetative propagation of the variety in question. Special criteria are defined according to those characteristics, representing a compromise between the uniformity that can be achieved and that which may reasonably be required, with the needs of users being also taken into account.

8.3 At one extreme there are varieties propagated by vegetative means and varieties where the model is the pure line, obtained from self-pollinating plants; in that case, the level of uniformity required may be—and is—very high. At the other extreme there are varieties of strictly cross-fertilized plants, which are necessarily heterogeneous; there, the required level of uniformity is measured in relation to that found in comparable varieties.

## Article 8

## Uniformity

**The variety is uniform if, subject to the variation that may be expected from the particular features of its propagation, it is sufficiently uniform in its relevant characteristics.**

## COMMENTARY ON ARTICLE 9

9.1 This Article corresponds to Article 9 of the 1991 Act.

## Article 9

## Stability

**The variety is stable if its relevant characteristics remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.**

# COMMENTARY ON ARTICLE 10

## Paragraph (1) and General Principles

10.1 Paragraph (1) lays down the basic principle according to which entitlement to the breeder's right belongs to the breeder; by referring to his successor in title, it acknowledges that the right is assignable and transferable. "Entitlement to the breeder's right" means the right to file an application and be granted the breeder's right. Certain issues related to assignment and transfer are dealt with in Article 18.

10.2 National legislation may contain provisions relating to three special cases, namely:

(a) where the same variety has been bred independently by two persons;

(b) where the same variety has been bred jointly by two persons;

(c) where the variety has been bred by an employee.

10.3 The commentary on Article 7 refers to the first case: this is governed by the provisions on distinctness.

10.4 In the other two cases, each State will have to consider in the light of its own legal traditions—taking into account in particular what has been done for patents—whether or not provisions should be included in the plant variety protection law and, if so, to define the contents of those provisions.

## Paragraph (2)

10.5 Paragraph (2) as proposed should basically be treated as a checklist item. The first sentence states a fact; the second proposes a rule for sharing rights in the absence of any contractual solution.

## Paragraph (3)

10.6 Paragraph (3) should also be treated as an item in a checklist.

10.7 Some States have very detailed regulations on inventions by employees, either in their patent legislation or in a special law or in texts governing labor law; these regulations deal not only with the question of whether the employer or the employee has the right to the patent, but also with related issues, foremost among which is the right to remuneration in favor of the employee (when the patent right belongs or accrues to the employer) and the right to a license to work the invention (when the patent right belongs to or is left to the employee). Those States would probably find it beneficial to extend the provisions applicable to inventions by employees to new varieties bred by employees.

# CHAPTER II

# PERSONS ENTITLED

## Article 10

## Principles

**(1) Entitlement to the breeder's right shall vest in the breeder or his successor in title.**

**(2) Where two or more persons have bred, or discovered and developed, a variety jointly, entitlement to protection shall vest in them jointly. Subject to any agreement to the contrary between the joint breeders, their shares shall be equal.**

**(3) Where the breeder is an employee, entitlement to the breeder's right shall be determined by the employment relationship in the context of which the variety was bred, or discovered and developed and in accordance with the law applicable to that relationship.**

10.8 States that do not have any special provisions for the purposes of patents, thus allowing the question to be resolved by the parties under contractual law (and case law), will probably find it in their interest to do the same for breeders' rights.

10.9 In addition to being a checklist item, paragraph (3) proposes that the law applicable to new varieties bred by employees should basically be the law of the country in which the variety has been bred. This aspect is particularly important from the point of view of any payment that might be made, in the form of premiums for example, to employees under incentive systems to encourage inventive activity: such a system should apply only to nationals of the country in question.

# COMMENTARY ON ARTICLE 11

Paragraph (1)

11.1 Paragraph (1) states the principle according to which the applicant is presumed entitled to protection. It follows that the Office does not have to verify that the applicant is in fact authorized to file the application.

11.2 It does however have to be possible to invalidate that presumption if it can be shown that the applicant is not entitled to the breeder's right. The Model Law proposes a system whereby the application is published, and third parties are given the possibility of filing objections (Article 39) which, if accepted, will result in rejection of the application (Article 41). In addition, the person entitled may bring an action (in court) for assignment to him of an application or breeder's right (Article 12). Lastly, where a breeder's right has been improperly granted, the procedure for annulment of the right may be resorted to (Article 22).

Paragraph (2)

11.3 It is proposed that the successor in title should prove his title. This provision will apply in cases of assignment (including those between an employee and his employer) or succession. Only "sufficient proof" is required, however.

## Article 11

## Presumption of Title

**(1) The applicant shall be considered entitled to protection, in the absence of proof to the contrary.**

**(2) However, where the application is made by a successor in title, it shall be accompanied by sufficient proof of the successor's title.**

# COMMENTARY ON ARTICLE 12

General remark

12.1 The provisions that might be adopted by a State on the basis of this Article should be adapted to its general legal rules and, where relevant, to the provisions of the Patent Law. This Article proposes solutions that are applied by many member States.

Paragraph (1)

12.2 Article 12 affords the lawfully entitled person a means of asserting his rights when a person not entitled to protection (for example, a third party who has unlawfully appropriated propagating material of the variety concerned) has filed an application or even obtained a breeder's right. The other means available is the filing of objections (Article 39); where a right has been improperly granted, it is also possible to have it annulled under Article 22.

12.3 The remedy provided for in Article 12 is a judicial remedy. The proposal in the Model Law is based on the fact that it is a question of settling a dispute (under private law, so before the civil courts) relating to ownership of an object. Where necessary, the competent jurisdiction will have to be defined. The remedy could also be administrative; it would then be up to the Office to decide. The solution can be considered as the rejection of an application (filed by the unlawful applicant) followed by the filing of a new application (by the lawfully entitled person), or as the cancellation of the breeder's right granted followed by the grant of a new right.

12.4 An applicant who wins his case will in principle take over the application procedure at the point at which it was left. The national law or its implementing texts could provide that the action must be notified to the Office and that the latter will defer any decision on the application until a final decision has been taken on the case.

Paragraph (2)

12.5 Action for assignment should be tied to a time limit when the defendant (applicant or entitled person) has acted in good faith. This is necessary for reasons of legal security both for the defendant and for users of the variety. On the other hand, the Model Law proposes that action may be brought at any time against a defendant who has acted in bad faith.

Paragraph (3)

12.6 This paragraph proposes that, where the action for assignment is successful, the applicant acquires a right that is in principle completely unencumbered. All licenses and pecuniary rights granted by the defendant to third

parties lapse; this rule also applies to the exclusive licenses mentioned in Article 19(3)*(a)*.

## Article 12

## Judicial Assignment of the Application for a Breeder's Right or of the Breeder's Right

**(1) Where an application for a breeder's right has been filed by a person not entitled to protection, the entitled person may bring an action for the assignment to him of the application or, if already granted, of the breeder's right.**

**(2) Such action shall be barred after five years from publication of the grant of the breeder's right. An action brought against a defendant who has acted in bad faith shall not be subject to any limitation.**

**(3)*(a)* Where the action succeeds, any rights granted by the defendant to third parties [*Alternative A, linked to Alternative A for Article 17(2)*: on the basis of the application or, where relevant, the breeder's right] [*Alternative B, linked to Alternative B for Article 17(2)*: on the basis of the breeder's right] shall become null and void.**

***(b)* However, the holder of any exploitation rights acquired in good faith who has taken genuine and effective measures with a view to exercising his rights before the date of the notification of the action or, failing such notification, of the decision may perform or continue to perform the acts of exploitation resulting from the measures taken, subject to payment of equitable remuneration to the entitled person.**

12.7 It would however be unfair for a person who has acquired an exploitation license in good faith to lose the benefit of the investment made with a view to exploiting the variety concerned. Subparagraph *(b)* allows him to pursue his activities within the prescribed limits.

12.8 Paragraph (3)*(a)* comprises two alternatives linked to the text proposed for Article 17. The first is linked to provisional protection giving the applicant the possibility of concluding license agreements on the basis of the application, and the second to provisional protection giving the applicant the sole right to receive equitable remuneration from any person who exploits the variety during the period when the application is under consideration.

# COMMENTARY ON ARTICLE 13

## General remark

13.1 This Article corresponds to Article 14 of the 1991 Act, the text of which is reproduced almost without change. It can be expected that many States will in turn reproduce the Convention wording of this and the following Articles when defining the rights granted to a breeder at the national level. By using the text contained in the 1991 Act for a national law, the State concerned will be able to take advantage of the case law of other States based on the same text.

## Paragraph (1)

13.2 *General remarks.* - This paragraph defines the fundamental right conferred by the grant of a breeder's right. The right is subject to some exceptions (Article 14) and to the principle of exhaustion (Article 15).

13.3 *General nature of the right.* - This right is similar to that conferred by a patent to the extent that the authorization of its owner is required in order to carry out certain acts of exploitation. In other words, it is a right to prohibit and not an exclusive—positive—right to do.

13.4 The holder may exercise his right in two principal ways: either by retaining the exclusive right to exploit the variety, or by granting licenses.

13.5 *Acts of exploitation.* - Paragraph (1) lists seven acts of exploitation that can be grouped in three categories: production, trading, stocking.

13.6 Acts of production—in the broad sense—are dealt with in subparagraphs (i) and (ii). It should be emphasized that "propagating material" means, in particular, the parts of the plant intended for the production of new plants, for example seeds, and that certain parts of plants may be used for either consumption or sowing. The holder may therefore authorize the growing of his variety with a view to the production of seeds; in that case, it would be a prior authorization under subparagraph (i) and, because of the continuity aspect, under subparagraph (ii).

13.7 It could happen, however, that a variety is grown for consumption but, during the growing period or after the harvest, it is decided that the harvested material will be used as seed, after "conditioning for the purpose of propagation." The main object of subparagraph (ii) is to allow the holder to intervene at the conditioning stage, especially in cases of infringement. This subparagraph does not therefore imply an extension of the right conferred by a breeder's right but is basically aimed at facilitating the exercise of the right.

# CHAPTER III

# THE RIGHTS OF THE HOLDER

## Article 13

## Scope of the Breeder's Right

**(1) Subject to Articles 14 and 15, the following acts in respect of the propagating material of the protected variety shall require the authorization of the holder:**

**(i) production or reproduction (multiplication),**

**(ii) conditioning for the purpose of propagation,**

**(iii) offering for sale,**

**(iv) selling or other marketing,**

**(v) exporting,**

**(vi) importing,**

**(vii) stocking for any of the purposes mentioned in (i) to (vi), above.**

**(2) Subject to Articles 14 and 15, the acts referred to in items (i) to (vii) of paragraph (1) in respect of harvested material, including entire plants and parts of plants, obtained through the unauthorized use of propagating material of the protected variety shall require the authorization of the holder, unless the holder has had reasonable opportunity to exercise his right in relation to the said propagating material.**

**(3) [*Alternative A*] Where so provided in the Regulations in respect of varieties of a specified plant genus or species and subject to Articles 14 and 15, the acts referred to in items (i) to (vii) of paragraph (1) in respect of products made directly from harvested material of the protected variety falling within the provisions of paragraph (2) through the unauthorized use of the said harvested material shall require the authorization of the holder, unless the holder has had reasonable opportunity to exercise his right in relation to the said harvested material.**

**[*Alternative B*: no paragraph]**

13.8 The above explanation is also applicable to offering for sale (subparagraph (iii)) in connection with selling or other marketing (subparagraph (iv)), and to stocking (subparagraph (vii)) in connection with other acts of exploitation.

Paragraph (2)

13.9 A variety can be exploited in the country in which it is protected by a breeder's right without this taking the form, in that country, of production of propagating material or of a trade act related to such material, in other words, without the owner of the breeder's right being able to exercise his right under paragraph (1). This is the case, for example, when the harvested material is imported. The aim of paragraph (2) is to give the holder the possibility of exercising his right in relation to the harvested material under the circumstances defined in this particular paragraph.

13.10 Special attention should be paid to the wording of this provision if it is decided not to use the text of the Convention: the text proposed in the Model Law implies that, in any action for infringement, the defendant will have to prove that the plaintiff (the holder of the right) could reasonably have exercised his right at an earlier stage.

Paragraph (3)

13.11 Like the preceding Acts, the 1991 Act defines the minimum scope of the breeder's right and indicates that this may be extended in a particular direction: according to paragraph (3) of Article 14 of this Act, the Contracting Parties may give a breeder the possibility of exercising his right in respect of products made directly from the harvested material if, briefly stated, he has not had a reasonable opportunity to exercise his right at an earlier stage. Such a possibility will be of particular interest for species in which the product sold is a processed product; this is the case, for example, for pharmaceutical plants and plants for perfumes.

13.12 Paragraph (3) as proposed must essentially be treated as a checklist item. It mentions the possibility of extending the basis of the right (*Alternative A*) or of not providing for such an extension (*Alternative B*). In the former case, it also mentions that the area is one in which it would be wise to state the principle in the law and provide for its application in the regulations (or any other implementing text), according to need.

13.13 The 1991 Act also provides for the possibility of extending a breeder's right to acts other than those mentioned in subparagraphs (i) to (vii) of paragraph (1) of the Model Law. This possibility is not mentioned in the Model Law itself.

Paragraph (4)

13.14 This paragraph corresponds to Article 14(1)*(b)* of the 1991 Act. Naturally, the conditions and limitations should conform to the general principles of law and more particularly those of competition law.

**(4)[2] The holder may make any authorization granted pursuant to [paragraph (1), (2) or (3)][3] subject to conditions and limitations.**

**(5) *(a)*[4] The provisions of [paragraphs (1) to (4)][5] shall also apply in relation to**

**(i) varieties which are essentially derived from the protected variety, where the protected variety is not itself an essentially derived variety,**

**(ii) varieties which are not clearly distinguishable in accordance with Article 7 from the protected variety and**

**(iii) varieties whose production requires the repeated use of the protected variety.**

***(b)* For the purposes of subparagraph *(a)*(i), a variety shall be deemed to be essentially derived from another variety ("the initial variety") when**

**(i) it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety,**

**(ii) it is clearly distinguishable from the initial variety and**

**(iii) except for the differences which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.**

***(c)* Essentially derived varieties may be obtained for example by the selection of a natural or induced mutant, or of a somaclonal variant, the selection of a variant individual from plants of the initial variety, backcrossing, or transformation by genetic engineering.**

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2 "(3)" where Alternative B to the proposed paragraph (3) is adopted.

3 "Paragraphs (1) or (2)" where Alternative B to the proposed paragraph (3) is adopted.

4 "(4)*(a)*" where Alternative B to the proposed paragraph (3) is adopted.

5 "Paragraphs (1) to (3)" where Alternative B to the proposed paragraph (3) is adopted.

Paragraph (5)

13.15 *General remarks.* This paragraph corresponds to Article 14(5) of the 1991 Act.

13.16 This paragraph gives the holder full and comprehensive rights in relation to three categories of variety. In two cases however—provided for in subparagraphs (i) and (iii)—his right may coexist (be in competition) with another right. The holders concerned will then have to reach agreement so that the varieties in question can be exploited. Such interdependence of rights is common in the case of patents.

13.17 *Essentially derived varieties.* - The concept of essentially derived varieties is probably the most important innovation in the 1991 Act. It is dealt with in detail in an Annex to this document.

13.18 *Varieties not clearly distinguishable.* - Alleged infringers taken to court have sometimes argued that they did not (unlawfully) exploit the protected variety but rather material that was slightly, albeit not clearly, distinguishable from the protected variety (for many experts, such material would not be regarded as constituting another variety). The aim of subparagraph (ii) is to avoid this type of defense.

13.19 *Varieties produced by repeated use of the protected variety.* - Subparagraph (iii) reproduces a provision of the 1978 Act: the purpose of certain varieties is to be used as the parent for the commercial production of seeds of another variety to be exploited commercially among farmers and by them. This is typically the case of inbred lines used to develop hybrids. In order to be effective, the breeder's right in relation to the line should extend to the hybrid.

13.20 Hybrid seeds are produced within the framework of a system that is closely controlled by the breeder (or breeders) concerned. It is sometimes considered that breeders of hybrid varieties do not require legal protection because they have "biological" protection. Experience shows on the one hand that this "biological" protection is often very relative, and on the other that breeders of hybrid varieties see just as great an interest in legal protection as breeders of pure-line varieties.

## COMMENTARY ON ARTICLE 14

Basis in the Convention

14.1 This Article corresponds to Article 15 of the 1991 Act.

Paragraph (1)

14.2 This paragraph sets out the compulsory exceptions to breeders' rights.

14.3 The cases mentioned in subparagraphs (i) and (ii) are customary in industrial property law. "Acts done privately and for non-commercial purposes" means exploitation of the variety concerned (the protected variety or, for example, an essentially derived variety) by a farmer in a subsistence production system (in order to meet his family's needs) or by an amateur gardener.

14.4 The case referred to in subparagraph (iii) is specific to the protection regime for new plant varieties based on the UPOV Convention. This provision—often called "breeder's exemption")—is in fact a cornerstone of the regime: in order to ensure the continuity of improvement breeding, it must be possible to use any variety freely as a genetic resource, and—with some exceptions—it must also be possible to exploit freely any variety produced subsequently as a result of the utilization, in other words without having to obtain the consent of the breeders of the original varieties. A breeder who has freely utilized a protected variety in order to create his own variety must, in return, agree to another breeder's use of his variety as a source of genetic variation in order to create a further variety.

14.5 The exceptions are the varieties referred to in the last subparagraph of Article 13(4), namely essentially derived varieties, varieties that are not clearly distinguishable and varieties whose production requires repeated use of the protected variety or a variety indirectly covered by the breeder's right; the latter case can be illustrated by the example of a single-cross maize hybrid: if it is protected, another breeder may not use the commercial seeds of the hybrid to produce double-cross hybrid seeds without the consent of the original breeder.

14.6 The exceptions do not concern use of the protected variety as an initial source of variation but only exploitation of the variety created as a result of that use. The aim of these exceptions is also to ensure the continuity of improvement breeding (see the Annex to this document).

Paragraph (2)

14.7 This provision is in square brackets to indicate that it is not proposed wording but basically a checklist item. Throughout the world farmers usually keep back part of their harvest as seed for the next crop ("farm-saved seed"). The 1991 Act allows Contracting Parties to adopt provisions on farm-saved seed. In view of the variety of circumstances that have to be taken into account, it simply states that the limitation of the breeder's right must be within reasonable limits and that the legitimate interests of the breeder must be safeguarded.

## Article 14

## Exceptions to the Breeder's Right

**(1) The breeder's right shall not extend to**

**(i) acts done privately and for non-commercial purposes,**

**(ii) acts done for experimental purposes and**

**(iii) acts done for the purpose of breeding other varieties, and, except where the provisions of [Article 13(5)][6] apply, acts referred to in [Article 13(1) to (3)][7] in respect of such other varieties.**

**[(2) The legislation may, within reasonable limits and subject to the safeguarding of the legitimate interests of breeders, restrict breeders' rights in relation to varieties of specified plant genera and species in order to permit farmers to use for propagating purposes, on their own holdings, the product of the harvest which they have obtained by planting, on their own holdings, a variety of any such plant genus or species that is the subject of a breeder's right or is covered by [Article 13(5)*(a)*(i) or (ii)][8].]**

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6 "Article 13(4)" where Alternative B to the proposed Article 13(3) is adopted.

7 "Article 13(1) and (2)" where Alternative B to the proposed Article 13(3) is adopted.

8 "Article 13(4)*(a)*(i) or (ii)" where Alternative B to the proposed Article 13(3) is adopted.

14.8 Many States, including developing countries, apply such a provision and offer models in terms of both substance and drafting. The text in the Model Law suggests that the exception should apply only to genera and species specifically designated in the regulations. The Diplomatic Conference that adopted the 1991 Act also adopted a Recommendation according to which Article 15(2) of the 1991 Act "should not be read so as to be intended to open the possibility of extending the practice commonly called 'farmer's privilege' to sectors of agricultural or horticultural production in which such a privilege is not a common practice on the territory of the Contracting Party concerned."

14.9 Article 15(2) of the 1991 Act and also the text in the Model Law limit the exception to the breeder's right to the protected variety and any essentially derived varieties or varieties that are not clearly distinguishable, on the understanding that this exception does not apply to varieties whose production requires the repeated use of other varieties.

## COMMENTARY ON ARTICLE 15

15.1 *Basis in the Convention.* - This Article corresponds to Article 16 of the 1991 Act.

15.2 *The general principle and its effects.* - The rule of exhaustion, which is common in industrial property law, is aimed at ensuring that the holder of a breeder's right can only exercise his right—and receive remuneration—once in every production cycle. For example, if he has put some seeds on the market, he cannot prohibit their resale, their use to produce a harvest, the sale or processing of the harvest, etc. If technical and economic conditions allow him to exercise his right by granting production licenses for the harvested material—for example, cut flowers—he may not prohibit the resale of the cut flowers marketed by those holding licenses.

15.3 *Exceptions.* - There are two exceptions to the rule of exhaustion. First, the right is not exhausted when, for example, certified wheat seeds are sold to farmers so that they can produce wheat for consumption and are in fact used (outside the framework of the "farmer's privilege") to produce a new generation of seeds; the right is restored when harvested material sold for the purposes of consumption is used as seed. Secondly, export may be subject to a special authorization under the conditions specified in the text of the Model Law.

## Article 15

## Exhaustion of the Breeder's Right

**(1) The breeder's right shall not extend to acts concerning any material of the protected variety, or of a variety covered by the provisions of [Article 13(5)][9], which has been sold or otherwise marketed by the holder or with his consent in the territory of *the State*, or any material derived from the said material, unless such acts**

**(i) involve further propagation of the variety in question or**

**(ii) involve an export of material of the variety, which enables the propagation of the variety, into a country which does not protect varieties of the plant genus or species to which the variety belongs, except where the exported material is for final consumption purposes.**

**(2) For the purposes of paragraph (1), "material" means, in relation to a variety,**

**(i) propagating material of any kind,**

**(ii) harvested material, including entire plants and parts of plants, and**

**(iii) any product made directly from the harvested material.**

[9] "Article 13(4)" where Alternative B to the proposed Article 13(3) is adopted.

## COMMENTARY ON ARTICLE 16

16.1 This Article corresponds to Article 18 of the 1991 Act and is basically a checklist item. The effect of the protection system is to create a right of ownership, and that right must be able to exist independently of the provisions regulating commerce; as for the exercise of the right, it of course is subject to those provisions.

16.2 In particular, where national legislation provides for an official catalogue of varieties approved for trade, the grant of a breeder's right may not be conditional on the variety being included in the catalogue.

16.3 Reference should also be made in this connection to Article 10 of the 1991 Act, according to which a Contracting Party may not enact provisions restricting a breeder's freedom of choice of the Contracting Parties in which he wishes to have his variety protected or the order in which he wishes to file his applications.

## Article 16

## Measures Regulating Commerce

**The breeder's right shall be independent of any measure taken by *the State* to regulate within its territory the production, certification and marketing of material of varieties or the importing or exporting of such material.**

## COMMENTARY ON ARTICLE 17

17.1 *Basis in the Convention.* - This Article corresponds to Articles 19 and 13 of the 1991 Act.

17.2 *Duration of protection.* - The 1991 Act lays down the minimum periods of protection from the date of grant a breeder's right; those periods are reproduced in the Model Law, but in square brackets to indicate the possibility of adopting longer terms.

17.3 The Model Law proposes that protection expire at the end of a calendar year. This system has been adopted by several member States, so that the annual fees to keep a breeder's right in force fall due at the beginning of each year, for all varieties. This facilitates the administration of rights for holders and also for the Office. Such a system is provided for in Article 46.

17.4 *Provisional protection.* - The 1991 Act also provides a minimum in this respect, namely the possibility for a breeder (applicant) to obtain equitable remuneration later, once the breeder's right has been granted, for any exploitation of the variety that occurred while the application was pending and would have required his consent had the right already been granted. This possibility is provided for in *Alternative A*.

17.5 The 1991 Act, for example, allows the right to arise from the filing of the application or its publication, depending on national practice. These possibilities are set out in *Alternatives 1* and *2*. In addition, it is stated that a Contracting Party may provide that the holder of a breeder's right is only entitled to remuneration from a person to whom he has notified the filing of the application. This provision has not been included in the Model Law, because the rule in question very often derives from texts governing civil proceedings.

17.6 *Alternative A* does not allow the applicant to apply for a restraining injunction. In many cases the possibility of taking such a step is extremely important because it allows the breeder to put his variety on the market without any risk as soon as he has filed his application. Some States have therefore decided on provisional protection that gives the applicant all the rights available under the breeder's right, with restrictions regarding the exercise of those rights. This possibility is set out in *Alternative B*.

17.7 In a provisional protection system of this type, the applicant may enter into license agreements in accordance with the law; this possibility is mentioned in Article 19 of the Model Law.

## Article 17

## Duration of the Breeder's Right; Provisional Protection

**(1) The breeder's right shall expire at the end of the [twentieth] calendar year following the grant thereof; for trees and grapevine, it shall expire at the end of the [twenty-fifth] year.**

**(2) [*Alternative A*] In respect of the period between [*Alternative 1*: the filing] [*Alternative 2*: the publication] of the application and the grant of the breeder's right, the holder shall be entitled to equitable remuneration from any person who, during the said period, has carried out acts which, once the right has been granted, require the holder's authorization as provided in Article 13.**

**[*Alternative B*] The applicant shall enjoy all rights provided for in this Chapter as from the filing of the application.**

## COMMENTARY ON ARTICLE 18

18.1 This Article sets out some simple rules regarding breeders' rights as property. Taking into account the wide variety of socio-economic and legal situations, these rules can only serve as examples. It is generally preferable to align them as closely as possible on the corresponding provisions in texts governing such things as patent law.

18.2 In any event, these rules are applicable to a breeder's right that has been granted, to the right to be granted such a title and to the rights deriving from the application, due account being taken of the interconnectedness of these three types of property.

# CHAPTER IV

# THE BREEDER'S RIGHT AS AN ITEM OF PROPERTY

## Article 18

## Transfer of Ownership

**(1) The right to apply for the grant of a breeder's right, the rights under an application and the breeder's right shall be treated in all respects as items of [intangible personal] [moveable] [industrial] [intellectual] property, and the general law relating to such property shall, except where otherwise provided in this Law, be applicable thereto.**

**(2) Such items of property may be transferred to one or more successors in title. Any transfer by assignment shall be made in writing.**

**(3) Any act by which the right to apply for the grant of a breeder's right, the rights under an application or the breeder's right are transferred or modified shall not affect the rights acquired by third parties before the date of the act.**

**(4) Any act by which the rights under an application or a breeder's right are transferred or modified, including judicial assignment, shall not be binding on third parties until it has been entered in the Register of Applications or the Register of Rights, as the case may be.**

**(5) However, an act shall be binding before such entry on third parties who acquire rights after the date of the act with notice of the act.**

## COMMENTARY ON ARTICLE 19

19.1 Like the preceding Article, this Article sets out some simple rules to serve as examples in the light of the precedents set by other branches of intellectual property law.

19.2 It should be noted, however, that certain types of variety will often be exploited by a large number of operators working within a hierarchy of licenses and sublicenses (producers and sellers of seeds, seed producers). The provisions on administrative procedures, notably the registration of the license with the Office, must therefore not be too cumbersome. Consequently, the Model Law proposes that the registration of licenses, even exclusive licenses, be merely optional.

19.3 Article 19 gives two alternatives in paragraphs (1) and (3)(*a*). These depend on the type of provisional protection adopted (the right to subsequent remuneration in the case of *Alternative A* and full rights in the case of *Alternative B*).

# CHAPTER V

# EXPLOITATION LICENSES

## Article 19

## Contractual Licenses

**(1) [*Alternative A, linked to Alternative A for Article 17(2)*: The holder] [*Alternative B, linked to Alternative B for Article 17(2)*: The applicant or the holder] may grant an exclusive or non-exclusive license relating to all or any of the rights provided for in Chapter III of this Part to any person.**

**(2) The license contract shall be in writing.**

**(3) *(a)* Any exclusive license may be entered in [*Alternative A, linked to Alternative A for Article 17(2)*: the Register of Rights] [*Alternative B, linked to Alternative B for Article 17(2)*: the Register of Applications or the Register of Rights, as the case may be], and a notice concerning it shall be published in the Gazette. A non-exclusive license may also be so entered, and the entry published at the request of either party to the contract.**

***(b)* An exclusive license shall not be binding on a third party who has acquired rights in the breeder's right in good faith unless it was so entered prior to the date of acquisition.**

# COMMENTARY ON ARTICLE 20

## Basis in the Convention

20.1 This Article is based on Article 17 of the 1991 Act, which authorizes Contracting Parties to restrict the free exercise of a breeder's right only in the public interest, and requires any compulsory license to contain a condition of equitable remuneration payable to the holder of the breeder's right.

20.2 The TRIPS Agreement is no doubt a second important source of obligations under international law. It will be necessary to provide for the possibility of bringing a case before the courts if there is disagreement on the grant or the conditions of a compulsory license. This possibility is provided for in general terms in Article 28 of the Model Law.

## General remarks

20.3 This is also an area in which some harmonization with other branches of intellectual property law is required, on the understanding however that the special characteristics of the subject matter of the breeder's right—the variety—may call for special solutions.

20.4 Experience in member States shows that compulsory licenses play a minor role in the area of plant varieties; nevertheless, the vast majority of States have legislated to allow their grant. The public interest can only be a factor with species that are indispensable to human or animal life and health. In addition, it is in the breeders' interest to market their varieties as widely as possible. Finally, the assortment of varieties is such that a user can always find an alternative.

20.5 There are two special cases, however: varieties essentially derived from the protected variety and varieties whose production requires repeated use of the protected variety. The provisions of the law should be so worded as to open the possibility of granting a compulsory license to allow the breeder of an essentially derived variety, for example, to exploit it. The Model Law achieves this by making no reference to the varieties concerned.

## Paragraph (1)

20.6 This paragraph sets out two principles: on the one hand, it deals with the public interest, and only applies if it is at stake; on the other, the safeguarding of the public interest is entrusted to economic entities and not to the authorities, which act as arbitrators (although it is possible to introduce a system that would entrust the initiative for action to the authorities alone or to them and to economic entities).

20.7 The public authority empowered to grant compulsory licenses may be the Office, a higher authority, for example the relevant ministry, or a court. The Model Law opts for the first solution.

## Article 20

## Compulsory Licenses

**(1) Any person may, by means of an application filed with the Office, seek the grant of a compulsory license in respect of the breeder's right. The Office shall grant the compulsory license only where this is necessary to safeguard the public interest.**

**(2) A compulsory license shall not be granted unless all the following conditions are fulfilled:**

**(i) The applicant for the grant of a compulsory license must be financially and otherwise able to exploit the breeder's right in a competent and efficient manner, and also willing to do so;**

**(ii) The holder has refused to grant the applicant a license or is not prepared to grant a license on reasonable terms;**

**(iii) [Three] years have elapsed between the date of the grant of the breeder's right and the date of the application for the grant of a compulsory license;**

**(iv) The applicant for the grant of a compulsory license has paid the fee prescribed in the Regulations for such grant.**

**(3) The compulsory license shall confer on the licensee a non-exclusive right to perform all or any of the acts referred to in Article 13, for the supply of the national market.**

**(4) When granting a compulsory license, the Office shall fix the equitable remuneration which the licensee shall pay to the holder. The licensee shall give the holder adequate security for the payment of the remuneration.**

**(5) The Office may require the holder to provide the licensee with as much propagating material as is necessary for reasonable use to be made of the compulsory license, against payment of adequate remuneration to the holder.**

**(6) The duration of the compulsory license shall be fixed by the Office. Only under exceptional circumstances shall the compulsory license be granted for less than [two] or more than [four] years. The term of the license may be extended where the Office is satisfied, on the basis of a new examination, that the conditions for the grant of the license continue to exist on the expiry of the first term.**

**(7) The Office shall withdraw the compulsory license where its owner has violated the conditions under which it was granted.**

**(8) Before granting a compulsory license, the Office may hear national professional organizations active in the field concerned.**

the economic sector. Under paragraph (8), the Office may also seek the advice of national professional organizations in the economic sector concerned; the relatively small size of the sector makes such concerted action possible.

Paragraph (2)

20.8 This paragraph sets out a series of conditions to be fulfilled prior to the grant of a compulsory license, indeed even to the consideration of an application for such a license. These conditions are additional to the prime condition, namely the need to safeguard the public interest. Subparagraph (iii) protects the holder of the right from untimely claims while he is developing a market after having been granted a breeder's right. "Three" is placed in square brackets to indicate that there is a choice.

Paragraph (3)

20.9 This paragraph prescribes the scope of the compulsory license. It may only be non-exclusive. The holder of a breeder's right may therefore exploit the variety himself and grant licenses. In general, the exploitation rights granted under the license must correspond to the public interest that has to be served. Only the need to supply the domestic market may give rise to the grant of a compulsory license.

20.10 The Model Law is silent on the question whether the licensee may transfer it or grant sublicenses. It is possible to imagine situations in which such a course of action should be allowed, for example, where the license concerns the exploitation of an essentially derived variety.

Paragraphs (4) to (6)

20.11 These paragraphs deal with various licensing conditions. In general, they will be equivalent to the conditions laid down for voluntary licenses granted under the same circumstances, except with regard to the duration of the license.

## COMMENTARY ON ARTICLE 21

21.1 Like other intellectual property rights deriving from registration, a breeder's right may be terminated prematurely. According to *Alternative A*, two cases may arise: surrender of the rights, which calls for a written declaration, and failure to pay the annual fee. In *Alternative B*, the holder of the breeder's right may not simply relinquish his right but must expressly surrender it.

# CHAPTER VI

# LAPSE OF THE BREEDER'S RIGHT

## Article 21

## Premature Termination

**[*Alternative A, linked to Alternative A for Article 46(1)*]**

**(1) The breeder's right shall terminate before the term provided in Article 17(1) expires**

**(i) where the holder surrenders it in a written declaration addressed to the Office, or**

**(ii) where an annual fee has become due and has not been paid.**

**(2) In the first case, the date of termination shall be that specified in the declaration or, if none is specified, the date of receipt of the declaration. In the second case, it shall be the due date of the fee.**

**[*Alternative B, linked to Alternative B for Article 46(1)*]**

**The breeder's right shall terminate before the term provided in Article 17(1) expires where the holder surrenders it in a written declaration addressed to the Office. The date of termination shall be that specified in the declaration or, if none is specified, the date of receipt of the declaration.**

## COMMENTARY ON ARTICLE 22

22.1 This Article is based on Article 21 of the 1991 Act. It should be noted that the latter does not allow any grounds for nullity other than those set out in paragraph (1). Briefly, a breeder's right is declared null and void when it has been granted by mistake.

22.2 The result of nullity is that the breeder's right is deemed never to have been granted. In principle, therefore, nullity has a retroactive effect. The situation may be more complex in practice, however. Any person who has concluded a licensing agreement will certainly have had to pay royalties, but he will also have benefited from exclusive exploitation under the breeder's right granted by mistake. In this connection, reference may be made to the statute and case law applicable to patents. According to the circumstances, this aspect may be left out of the law (as it is in the Model Law), more detailed rules may be laid down or a reference to patent law may be made.

22.3 The Model Law proposes that the annulment procedure be initiated at the request of a person having a legitimate interest (it could also be started *ex officio*). In addition, competence in annulment matters has been given to the Office (it could also be given to the judiciary).

## Article 22

## Nullity

**(1) The Office shall declare a breeder's right null and void when it is established**

**(i) that the variety was not new (Article 6) or distinct (Article 7) at the date of filing of the application or, where relevant, at the date of priority,**

**(ii) that, where the grant of the breeder's right has been essentially based upon information and documents submitted by the applicant, the variety was not uniform (Article 8) or stable (Article 9) at the said date, or**

**(iii) that the breeder's right has been granted to a person who is not entitled to it and the entitled person has not brought an action for judicial assignment under Article 12 or has renounced the right to bring such an action.**

**(2) Subject to any provision to the contrary in this Law, the breeder's right that has been declared null and void shall be deemed never to have been granted.**

**(3) Any person having a legitimate interest may file a request for annulment with the Office.**

## COMMENTARY ON ARTICLE 23

23.1 This Article is based on Article 22 of the 1991 Act. Briefly, the holder may be deprived of his rights if he does not meet the obligations incumbent on him under Articles 45 and 47.

23.2 Article 23 does not mention non-payment of the annual fee, unlike Article 22 of the 1991 Act; this is covered by *Alternative A* of Article 21.

23.3 Cancellation does not have any retroactive effect: a title that has been rightfully granted simply ceases to exist on a given date.

## Article 23

## Cancellation

**(1) The Office shall cancel a breeder's right when it is established that the holder has failed to meet his obligation under Article 47(1) and that the variety is no longer uniform or stable.**

**(2) *(a)* Furthermore, the Office shall cancel a breeder's right when**

**(i) the holder does not meet a request made by the Office under Article 47(2) for the purpose of verifying the maintenance of the variety, or**

**(ii) the Office proposes to cancel the existing denomination of the variety and the breeder does not propose a suitable denomination within the period prescribed by the Office (Article 45).**

***(b)* A breeder's right may only be canceled after the holder has been given notice of his obligation and allowed a reasonable period, specified in the notice, to comply therewith.**

**(3) The cancellation shall take effect on the date of its entry in the Register of Rights.**

## COMMENTARY ON ARTICLE 24

24.1 This Article is based on Article 30(1)(iii) of the 1991 Act. In general, it meets the need to inform the public.

## Article 24

## Publication of the Lapse

**The premature termination, nullity or cancellation of a breeder's right under Article 21, 22 or 23 and the ground for it shall be entered in the Register of Rights. They shall also be published in the Gazette.**

## COMMENTARY ON ARTICLE 25

25.1 This Article reflects a structure that has been adopted in some member States; it has the advantage of allowing the plant variety protection system to be managed jointly by all partners in the varieties and seeds sector.

25.2 Other States have even empowered this Council to decide on individual cases, such as on the grant of breeders' rights. The Council is in that case assisted by a Secretariat (General).

25.3 The majority of member States have made no provision for a Council.

25.4 The Model Law refers to a Council because it is easier, for a State wishing to draw inspiration from the Model Law, to lease out unwanted provisions.

# PART III

# ORGANIZATION AND PROCEDURE

## CHAPTER I

## ORGANIZATION, COMPETENCE AND GENERAL RULES OF PROCEDURE

### Article 25

### Plant Breeders' Rights Council

**(1) The Minister shall appoint a Plant Breeders' Rights Council composed of representatives of the various circles having an interest in the protection of plant varieties.**

**(2) The Council shall be presided over by a [Magistrate of the Court of Appeal of ...] [senior official of the Ministry].**

**(3) The conditions governing the appointment of the members of the Council and the operation of the Council shall be specified in Regulations.**

**(4) The Council shall give advice and make proposals to the Minister, assist through its advice the Office in the implementation of this Law and carry out the other tasks which are specifically entrusted to it by this Law.**

## COMMENTARY ON ARTICLE 26

26.1 This Article is based on Article 30(1)(ii) of the 1991 Act. It is basically a checklist item, and States will have to define the role, composition and form of operation, etc. of the Office in the light of their national circumstances.

26.2 The following are the principal options available:

(a) To create a new administrative structure;

(b) To entrust responsibility for administering the protection system to an existing structure, such as a department of the relevant ministry (in this particular case, it is usually the Ministry of Agriculture), to an administrative structure already active in the area of varieties and seeds (such as the department responsible for administering the catalogue of varieties approved for trade) or to the Patent Office if the plant patent option is chosen.

26.3 Administrative responsibilities can also be dissociated from technical work (examination of varieties). It is in fact highly desirable to call on all existing structures for examination, so as to make the protection system as cost-efficient as possible.

26.4 The present member States offer a wide diversity of model structures.

## Article 26

## Plant Breeders' Rights Office

**(1) The Plant Breeders' Rights Office is hereby established [as a public authority with legal personality].**

**(2) The Office shall be represented by its [President] who shall be appointed and may be removed from office by the Minister.**

**(3) Decisions of the Office shall be taken by or under the authority of the [President].**

## COMMENTARY ON ARTICLE 27

27.1 This Article sets out a general procedural principle as a checklist item.

## Article 27

## Right to be Heard by the Office

**(1) Any proposed decision of the Office adversely affecting a party to proceedings before it shall be communicated to that party with a statement of the reasons for the proposed decision.**

**(2) The said party shall be given an opportunity to submit comments orally or in writing within thirty days from the date of receipt of the notice.**

## COMMENTARY ON ARTICLE 28

28.1 This Article is based on Article 30(1)(i) of the 1991 Act and on a general principle of law.

28.2 Although this is basically a checklist item, as each State is responsible for writing its legislation to suit its national circumstances, two alternatives are offered. *Alternative A* is recommended for States expecting to have a relatively low volume of activity that would not justify having a first instance, while *Alternative B* provides for the setting up of an Appeal Board. Some States have decided on the Appeal Board of the Patent Office as the first instance.

## Article 28

## Appeals

*[Alternative A]*

**An appeal shall lie from any decision taken by the Office pursuant to this Law to the [Tribunal].**

*[Alternative B]*

**(1) An appeal shall lie from any decision taken by the Office pursuant to this Law.**

**(2) An Appeal Board shall be set up.**

**(3) A further appeal shall lie against the decisions of the Appeal Board to the [Tribunal].**

## COMMENTARY ON ARTICLE 29

29.1 This Article deals with a number of issues that have to be considered when a national law is drafted. From the point of view of overall policy, special attention should be paid to the question of access to information. The Model Law proposes that such access be restricted to persons having a legitimate interest, but with very extensive access being afforded to documents and tests.

29.2 One exception is provided however, mainly for hybrids. In view of the special nature of variety creation in that sector, breeders do not want the formulas of their hybrids to be disclosed. The proposed provision makes the protection system attractive for such breeders.

## Article 29

## Registers; Preservation of Files

**(1) The Office shall maintain a Register of Applications and a Register of Breeders Rights. The Registers shall be open to public inspection.**

**(2) Any person having a legitimate interest may inspect**

**(i) the documents relating to applications,**

**(ii) the documents relating to breeders' rights already granted, and**

**(iii) the growing tests and other necessary tests under Article 37 or Article 48.**

**(3) In the case of varieties the production of which requires repeated use of other varieties (components), the applicant may, when making his application, request that the documents and tests relating to the components be withheld from inspection.**

**(4) The Office shall preserve the originals or copies of the documents in the files until five years after the withdrawal or rejection of the application, or the lapse of the breeder's right, as the case may be.**

## COMMENTARY ON ARTICLE 30

30.1 This Article is based on Article 30(1)(iii) of the 1991 Act and on the general need to inform the public.

30.2 The Model Law refers only to "regular intervals." In practice, Gazettes are monthly, two-monthly or quarterly in member States, depending on the volume of the Office's activities.

30.3 UPOV has published a Model Plant Breeders' Rights Gazette. States that use the model present the information in a standardized form that serves to overcome a great many linguistic obstacles. UPOV is at present preparing another communication tool in the form of a database on a CD-ROM disc.

## Article 30

## Gazette

**The Office shall publish a Gazette at regular intervals. The Gazette shall record the following:**

**(i) Applications for the grant of breeders' rights;**

**(ii) Applications for variety denominations;**

**(iii) Registrations of new denominations for protected varieties;**

**(iv) Withdrawals of applications for the grant of breeders' rights;**

**(v) Rejections of applications for the grant of breeders' rights;**

**(vi) Grants of breeders' rights;**

**(vii) Changes in the persons (applicants, holders and procedural representatives);**

**(viii) Lapses of breeders' rights;**

**(ix) Licenses;**

**(x) Official announcements.**

## COMMENTARY ON ARTICLE 31

31.1 This Article is basically a checklist item.

31.2 The main fees usually charged by member States are for the following acts: filing of the application (often with special fees if the priority of an application filed in another member State is claimed, or if an application is filed without a proposed variety denomination); examination of the variety (a fee per growing season or a fee equal to the amount invoiced by the relevant service in another member State where there has been cooperation in examination); issue of the title. In addition, an annual fee is generally paid for a breeder's right to remain in force. As mentioned in connection with Article 17(1), the Model Law suggests that annual fees should fall due on one and the same date; in this connection, see Article 46.

## Article 31

## Fees

**The administrative acts of the Office shall give rise to the payment of fees, in amounts and under conditions specified in the Regulations.**

## COMMENTARY ON ARTICLE 32

32.1 This Article is basically a checklist item. One could, in preference to the *restitutio in integrum* solution, provide for an additional time limit against payment of a surcharge.

## Article 32

### *Restitutio in integrum*

**(1) Where, in spite of having taken all due care in the particular circumstances, the applicant or the holder, or any other party to proceedings before the Office, has been unable to observe a time limit in dealings with the Office, his rights shall, on request, be restored if the loss of any right or means of redress provided for in this Law is directly attributable to his failure to observe the said time limit.**

**(2) The request shall be submitted within two months after the cause of non-compliance has ceased to operate and, in any event, within one year following the expiry of the unobserved time limit. The request shall be properly substantiated and shall be accompanied by the fee for *restitutio in integrum*.**

**(3) The department competent to decide on the omitted act shall decide upon the application.**

**(4) Where the request is granted, the petitioner shall be given a time limit equal to the unobserved time limit, starting on the date of receipt of notice of the decision, within which to perform the omitted act.**

**(5) Where the rights are restored, the petitioner may not assert his rights against any person who, in good faith, has engaged in, or taken genuine and effective measures with a view to, exploitation in the period between the loss of the rights and the publication of the notice on the restoration thereof.**

## COMMENTARY ON ARTICLE 33

33.1 This Article sets out certain principles applicable to the form and content of applications. UPOV has published a model application form which provides further details on this subject.

# CHAPTER II

# THE APPLICATION

## Article 33

## Form and Content of the Application

**(1) Any person wishing to have a variety protected shall file an application with the Office and pay the application fee.**

**(2) The application shall contain at least the following elements:**

**(i) the name and address of the applicant and, where relevant, his procedural representative;**

**(ii) the name and address of the breeder, if he is not the applicant;**

**(iii) the identification of the botanical taxon (Latin and common name);**

**(iv) the denomination proposed for the variety, or a provisional designation (breeder's reference);**

**(v) where the priority of an earlier application is claimed, the Contracting Party with which the application was filed and the filing date;**

**(vi) a technical description of the variety;**

**(vii) proof of payment of the application fee.**

**(3) The detailed form and content of the application, and the documents to be attached, shall be specified in Regulations.**

## COMMENTARY ON ARTICLE 34

34.1 This Article is based on Article 11 of the 1991 Act.

34.2 Paragraph 3(*b*) allows the Office a degree of flexibility regarding the submission of translations. This is due to the fact that the standardization of national application forms based on the UPOV model form makes it easy to overcome language barriers.

## Article 34

## Priority

**(1) The applicant may avail himself of a right of priority based upon an earlier application that has been duly filed for the same variety, by himself or by his predecessor in title, with the Authority of a Contracting Party.**

**(2) *(a)* Where the application filed with the Office is preceded by several such applications, priority may be based only on the earliest application.**

***(b)* The right of priority shall be expressly claimed in the application filed with the Office. It may only be claimed within a period of twelve months from the date of filing of the earliest application. The day of filing shall not be included in the said period.**

**(3) *(a)* In order to avail himself of the right of priority, the applicant shall submit to the Office, within three months from the filing date referred to in Article 35(4), a copy of the first application, certified to be a true copy by the authority with which that application was filed.**

***(b)* The Office may request that a translation of the first application be produced within three months from the date of receipt of the request.**

**(4) *(a)* The effect of priority shall be that, with respect to the conditions of protection attaching to the variety, the application shall be deemed to have been filed at the date of filing of the first application.**

***(b)* The applicant shall moreover be entitled to request that the examination of the variety be deferred by up to two years from the date of expiry of the priority period (three years from the date of filing of the first application). However, where the first application is rejected or withdrawn, the Office shall be entitled to initiate the examination of the variety before the date specified by the applicant; in such case, it shall allow the applicant an appropriate period within which to furnish the information, documents or material required for the purpose of the examination.**

## COMMENTARY ON ARTICLE 35

35.1 This Article is the first in a series that describes each stage in the processing of an application.

35.2 The Model Law proposes that, from the administrative and legal point of view, the examination as to form and the substantive examination be dissociated, even if in most cases the two procedures can take place simultaneously.

35.3 The examination as to form makes it possible to eliminate applications that are obviously unacceptable (as long as the protection system applies to a restricted list of genera and species), to correct incomplete applications and to assign a filing date to applications that are in order.

35.4 Applications that have not been put in order are deemed not to have been filed, and so no decision is taken on them. In such cases the application fee is not refunded (this follows from the Model Law's silence on the subject in paragraph (3)); it should be mentioned that the Office has to have gone through the necessary procedural steps and invited the applicant to make good the defects.

# CHAPTER III

# PROCESSING OF THE APPLICATION

## Article 35

## Examination as to Formal Requirements; Filing Date

**(1) The Office shall examine whether the application satisfies the formal requirements for applications.**

**(2) Where the application is clearly unacceptable by reason of the botanical taxon to which the variety belongs (Article 2), the documents constituting the application shall be returned to the applicant, and the application fee shall be refunded.**

**(3) Where the application is incomplete or incorrect, the Office shall request the applicant to correct it within thirty days from the date of receipt of the request. Any application that is not corrected within the prescribed period shall be deemed not to have been filed.**

**(4) Any application that is complete and correct shall be given a filing date and shall be recorded in the Register of Applications. The date on which the information referred to in Article 33(2) is received by the Office shall be taken to be the filing date.**

## COMMENTARY ON ARTICLE 36

36.1 This Article is based on Article 12 of the 1991 Act and partly implements it. It refers to two points that are usually only verified from documents. Any irregularity results in a rejection decision. This decision may be the subject of an appeal under Article 28.

36.2 For obvious economic reasons, these points are usually verified before the variety undergoes examination (next Article).

## Article 36

## Examination of the Application as to Substance

**(1) The Office shall examine the application as to substance in order to verify, on the basis of the information given in the application, that the variety is new (Article 6) and that the applicant is entitled under Article 10.**

**(2) Where the examination reveals an obstacle to the grant of the breeder's right, the application shall be rejected.**

# COMMENTARY ON ARTICLE 37

Basis in the Convention and general remarks

37.1 This Article is based on Article 12 of the 1991 Act. In the form of a very condensed legislative text, it sets out the objectives of technical examination and the various procedures involved. Its wording would be suitable for a State wishing to introduce a very flexible system that allows all available resources to be mobilized and costs a minimum to run.

Paragraph (2)

37.2 Technical examination necessarily consists of growing tests or other tests, in particular trials carried out in laboratories. The question is who should carry out the tests, since the Office is not always equipped for the purpose and the tests must be tailored to each botanical genus or species. Paragraph (2)(*a*) starts by establishing the principle according to which the examination should be conducted under the supervision of the Office. This means that the Office should not blindly delegate responsibility for the tests.

37.3 Priority is then given to a particular form of cooperation in examination established within UPOV: tests that have been or are being undertaken and could provide the basis for a decision by the Office will not be duplicated unnecessarily. The system set up within UPOV allows the results of these tests to be obtained for a modest charge, which moreover can be passed on to the applicant (the scale of fees should take this possibility into account).

37.4 If necessary, the tests can be carried out by the Office itself or by "another institution." This wording is deliberately vague. It covers in particular institutions of the State that already examine varieties or could easily do so, for example because they have the necessary infrastructure, collections of reference varieties and know-how; this may be the service dealing with the catalogue of varieties approved for trade, research or extension institutes, universities, botanical gardens, etc., and possibly private companies.

37.5 The wording also covers services in other member States and related institutions, to which the Office may resort under another form of cooperation within UPOV. Here the Office agrees to entrust the office of another member State with tests on varieties of a given species; reciprocal agreements are also possible. Article 54 allows the Office to cooperate in examination.

37.6 Finally, the Office may entrust the applicant with the task of conducting the tests, more or less closely supervised by itself, and providing detailed biometric data to enable it to rule on the application. Such a regime can be provided for certain species only, or applied generally. It should be noted that the UPOV Council has adopted a declaration on the conditions to be met by such a system.

## Article 37

## Technical Examination of the Variety

**(1) The variety shall undergo a technical examination the purpose of which shall be**

**(i) to verify that the variety belongs to the stated botanical taxon,**

**(ii) to establish that the variety is distinct (Article 7), uniform (Article 8) and stable (Article 9), and**

**(iii) where the variety is found to meet the aforesaid requirements, to establish an official description of the variety.**

**(2) *(a)* The examination shall be undertaken under the supervision of the Office.**

***(b)* Where growing tests or other necessary tests have been or are being undertaken by the Authority of a Contracting Party, and where the results of those tests may be obtained by the Office and transposed to the agroclimatical conditions of *the State*, the examination may be based on the said results.**

***(c)* Where the examination is not based on results obtained under subparagraph *(b)*, the examination shall be based upon growing tests and other necessary tests made**

**(i) by the Office or by another institution on its behalf, or**

**(ii) by the applicant at the request of the Office.**

**(3) The Office shall specify the practical conditions for the examination.**

**(4) The official description referred to in paragraph (1)(iii) may be subsequently extended or amended on the basis of developments in agrobotanical knowledge without the subject matter of protection being affected thereby.**

Paragraph (3)

37.7 The Office's supervision is particularly noticeable in the fact that it lays down the procedural details of the examination. These could be defined on the basis of the rules and guidelines established by UPOV.

Paragraph (4)

37.8 The technical examination has two essential purposes: to verify that the variety meets the technical conditions for protection and to provide an official description of the variety. Together with the sample referred to in Article 49(1)(i), the description will serve as a reference for exploitation of the variety on the one hand (for example, for the certification of seeds but also in any infringement action) and, on the other, for the examination of varieties developed subsequently. The protected variety will have become a matter of common knowledge and will therefore have to be taken into account when distinctness is examined.

37.9 There will subsequently be many occasions for subjecting the variety to further testing and for providing additional biometric data. Paragraph (4) states that the description drawn up in the course of the procedure for the grant of the breeder's right is not immutable and can be completed or even amended.

## COMMENTARY ON ARTICLE 38

38.1 This Article is also based on Article 12 of the 1991 Act.

38.2 A technical examination is only undertaken for varieties in respect of which an application has been validly filed; consequently, failure to submit the elements required is bound to result in rejection of the application. Paragraph (2) nevertheless gives the applicant one specific opportunity to avoid rejection; this possibility could be used, for example, when bad weather conditions have caused his test to fail.

## Article 38

## Information, Documents and Material Required for the Examination

**(1) The applicant shall submit to the Office all the information, documents or material requested by the Office for the purposes of the technical examination.**

**(2) Failure to submit the requested information, documents or material shall cause the application to be rejected, unless the applicant produces a valid explanation for his omission.**

## COMMENTARY ON ARTICLE 39

39.1 The main purpose of publication of the application is to inform the public; the filing of an application gives an applicant rights, starting with the rights deriving from provisional protection (Article 17(2)). Publication also forms part of the processing of the application, because the public is given the opportunity to submit comments and objections.

39.2 The information published is usually confined to the basic data contained in the application. Some States that make general use of the system of testing by the applicant also publish a detailed description of the variety.

## Article 39

## Publication of the Application; Objections to the Grant of the Breeder's Right

**(1) As a minimum, the elements of the application referred to in Article 33(2)(i) to (v) shall be published in the Gazette**

**(2) As from the publication of the application any person may, within a time limit set by the Office, file objections to the grant of a breeder's right with the Office.**

**(3) The objections shall be made in writing and substantiated. The documentary evidence shall be attached.**

**(4) The objections may only be based upon the allegation that the variety is not new (Article 6), distinct (Article 7), uniform (Article 8) or stable (Article 9), or that the applicant is not entitled to protection (Article 10).**

## COMMENTARY ON ARTICLE 40

40.1 This Article describes in detail the general procedure to be followed when considering objections. Briefly, the procedure should bring together both parties, and the technical examination may be adapted; for example, if a third party alleges that the variety that is the subject of the application is not distinct from his own variety, the latter could be included in the test to permit direct comparison.

## Article 40

## Consideration of Objections

**(1) Objections to the grant of a breeder's right shall be communicated without delay to the applicant, who shall have a period of not less than three months within which to express his views on the objections and state whether he intends to maintain, amend or withdraw his application; the period may be extended on the basis of a properly substantiated request from the applicant.**

**(2) Where the applicant does not respond within the prescribed period, the application shall be deemed to have been withdrawn. Where he responds and seeks to maintain the application, with or without amendment, his response shall be communicated to the author of the objection, who shall have thirty days within which to express his views on the response and state whether he intends to maintain or withdraw his objection.**

**(3) *(a)* An objection that has been maintained shall be examined**

**(i) independently of the normal processing of the application where it is based on the allegation that the variety lacks novelty or that the applicant is not entitled to protection, or**

**(ii) in the course of the technical examination of the variety where it is based on the allegation that the variety lacks distinctness, uniformity or stability.**

***(b)* The Office may modify the conditions of the technical examination of the variety in order to accommodate consideration of the objection.**

**(4) The author of an objection may be required to submit further information and documents in support of his objection, or such plant material as is necessary for the technical examination. Article 38 shall apply *mutatis mutandis*.**

## COMMENTARY ON ARTICLE 41

41.1 This Article is self-explanatory and does not call for any particular comment.

## Article 41

## Grant of the Breeder's Right; Rejection of the Application

**(1) Where it is satisfied as a result of the examination that the variety fulfills the requirements of Article 5 and that the applicant has fulfilled the other requirements set out in this Law, the Office shall grant the breeder's right.**

**(2) Where it is not so satisfied, the Office shall reject the application.**

**(3) The grant of the breeder's right, or the rejection of the application, shall be recorded in the Register of Applications and published in the Gazette.**

**(4) The grant of the breeder's right shall also be recorded in the Register of Breeders' Rights. The description of the variety may be included in the Register by reference to the technical files of the Office.**

## COMMENTARY ON ARTICLE 42

42.1 This Article and the following Articles in the same Chapter are based on Article 20 of the 1991 Act and on the Recommendations on Variety Denominations adopted by the UPOV Council. Article 42 sets out the general principles applicable in variety denomination matters.

# CHAPTER IV

# VARIETY DENOMINATION

## Article 42

## Purpose of the Denomination and Signs That May Constitute a Denomination

**(1) The denomination of a protected variety shall be its generic designation.**

**(2) The denomination may consist of any word, combination of words, combination of words and figures or combination of letters and figures, with or without an existing meaning, provided that such signs allow the variety to be identified.**

**(3) Where a denomination has already been used for the variety in *the State* or a Contracting Party, or proposed or registered in a Contracting Party, only that denomination may be used for the purposes of the procedure before the Office, unless there is a ground for refusal under Article 43. Any synonyms shall be recorded in the Register of Applications and the Register of Rights.**

**(4) *(a)* For as long as a variety is exploited, it shall be prohibited to use, in the territory of *the State* [or of a Contracting Party], a designation that is identical or confusingly similar to the denomination of that variety in relation to another variety of the same or a closely related species. The prohibition shall remain in force after the variety has ceased to be exploited where the denomination has acquired particular significance in relation to the variety.**

***(b)* The aforesaid prohibition shall also apply to denominations registered in Contracting Parties.**

**(5) Any person who offers for sale, sells or otherwise markets propagating material of a protected variety shall be obliged to use the denomination of that variety. This obligation shall also apply to the varieties referred to in [Article 13(5)*(a)*(ii)][10]**

**(6) The obligation to use a denomination shall not end with the breeder's right that gave rise to it.**

**(7) Prior rights of third parties shall not be affected.**

**(8) When a variety is offered for sale or otherwise marketed, the use of the registered variety denomination in association with a trademark, trade name or other similar indication shall be permitted, subject to the denomination remaining easily recognizable.**

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[10] "Article 13(4)*(a)*(ii)" where Alternative B to the proposed Article 13(3) is adopted.

## COMMENTARY ON ARTICLE 43

43.1 The denomination is proposed by the applicant and registered by the Office, unless the latter finds it unsuitable for some reason and rejects it.

43.2 The text proposed makes a distinction between two such reasons: those that are matters of essentially public concern and therefore under the direct jurisdiction of the Office, and those that are essentially related to the private rights of third parties and (in principle) will be cited by those third parties. This distinction is also reflected in the procedure (Article 44).

## Article 43

## Grounds for Refusal

**(1) *(a)* Without prejudice to the provisions of the Convention and the rules established by the Union, registration as the denomination of a variety shall be denied to a designation that**

**(i) does not conform to the provisions of Article 42,**

**(ii) is not suitable for the identification of the variety, in particular owing to lack of distinctiveness or to linguistic unsuitability,**

**(iii) is contrary to public policy or morality,**

**(iv) consists exclusively of signs or indications that may serve, in the plant varieties and seeds sector, to designate kind, quality, quantity, intended purpose, value, geographical origin or time of production,**

**(v) is liable to mislead or to cause confusion as to the characteristics, value or geographical origin of the variety, or the links between the variety and persons such as the breeder or applicant, or**

**(vi) is identical with, or confusingly similar to a denomination that designates, in the territory of *the State* or a Contracting Party, an existing variety of the same or a closely related species, unless the existing variety is no longer exploited and its denomination has not acquired any particular significance.**

***(b)* The Office shall name the species that are closely related within the meaning of subparagraph *(a)*(vi), above.**

**(2) *(a)* Without prejudice to the provisions of the Convention and the rules established by the Union, registration as the denomination of a variety shall also be denied to a designation containing an element that hampers or is liable to hamper the free use of the denomination in connection with the variety, in particular an element that under trademark law would be denied registration as a trademark for products bearing some relation to the variety.**

***(b)* Such designations shall be refused if the holder of the rights in the element concerned has lodged with the Office a written objection to the proposed denomination.**

## COMMENTARY ON ARTICLE 44

44.1 The procedure proposed in this Article is classic.

44.2 It refers to cooperation among UPOV Contracting Parties in the examination of proposed variety denominations. That cooperation still takes place by means of the exchange of plant variety protection gazettes. At the time of writing, a computerized database is being developed for distribution in CD-ROM form.

44.3 There could be a risk of an applicant using the tactic of proposing only unacceptable denominations to delay the processing of his application. Paragraph 6(*b)* allows the Office to force a close on the procedure.

## Article 44

## Registration Procedure

**(1) *(a)* The denomination proposed for a variety shall be submitted together with the application for protection.**

***(b)* Subject to payment of the prescribed fee and the inclusion of a provisional designation for the variety in the application, the applicant may have the procedure for the registration of the denomination deferred. In such a case, the applicant shall propose a denomination for the variety within thirty days from the date of receipt of a request addressed to him by the Office. If the applicant fails to submit a proposal within the prescribed period, the application shall be rejected.**

**(2) If the Office has found no ground for refusal under Article 43(1)*(a)* and knows of no ground for refusal under Article 43(2)*(a)* the proposed denomination shall be published in the Gazette. It shall also be communicated to the Authorities of the Contracting Parties.**

**(3) Any interested person may, in the three months following publication, file an objection to the registration of the denomination based upon any one of the grounds for refusal under Article 43. The Authorities of the Contracting Parties may submit observations.**

**(4) Objections and observations shall be communicated to the applicant, who shall have thirty days within which to reply.**

**(5) *(a)* The applicant may, on the basis of the objections and observations, submit a new proposal.**

***(b)* Where the proposed denomination does not conform to the provisions of Article 43, the Office shall request the applicant to submit a new proposal within thirty days from the date of receipt of the notice. Failure to submit a proposal within the prescribed period shall entail the rejection of the application.**

**(6) *(a)* The new proposal shall be subject to the examination and publication procedure provided for in this Article.**

***(b)* Where the new proposal does not conform to the provisions of Article 43, the Office may serve notice on the applicant to propose a denomination that does conform to the said provisions. Failure to respond shall cause the application to be rejected.**

**(7) Where objections or observations have been received, any decision of the Office shall be accompanied by a statement of its reasons for the decision; it shall be notified to the parties. The refusal of a proposed denomination shall likewise be accompanied by a statement of the reasons for the refusal.**

**(8) The denomination shall be registered at the same time as the breeder's right is granted.**

## COMMENTARY ON ARTICLE 45

45.1 It can happen that, in spite of all the investigative work, a denomination is registered and then proves unacceptable. This Article covers the procedure for canceling a denomination that is not acceptable and registering a new one.

45.2 It is based on Article 20(4) of the 1991 Act, but its scope is broader. It first establishes three grounds for cancellation. The third corresponds to the one provided for in the Convention. The first (an error) is self-evident.

45.3 The second is an alternative version of the third; it is indeed more practical for the owner of a right who realizes that he is vulnerable to request the modification of the denomination rather than await a legal decision.

45.4 The denomination has to be used in commercial transactions even after the breeder's right has expired. It can happen therefore that a denomination has to be canceled after the right has expired and that the owner of the expired breeder's right is not prepared to take part in the procedure. Paragraph (2) provides that a new denomination can then be proposed by the Office.

45.5 It should be noted that the owner of the right may have his right canceled if he does not cooperate in the procedure (Article 23(2)(*a*)(ii)).

## Article 45

## Cancellation of a Denomination and Registration of a New Denomination

**(1) The Office shall cancel a registered denomination**

**(i) when it is established that the denomination has been registered despite the existence of a reason for refusal under Article 43(1)*(a)*,**

**(ii) when the holder so requests and demonstrates a legitimate interest, or**

**(iii) when the holder or any other person produces a judicial decision prohibiting the use of the denomination in connection with the variety.**

**(2) The Office shall inform the holder of the intended cancellation and request him to propose a new denomination within thirty days from the date of receipt of the request. If the variety is no longer protected, the proposal for a new denomination may be made by the Office.**

**(3) The proposed new denomination shall be subject to the examination and publication procedure provided for in Article 44. The new denomination shall be registered and published once approved; the former denomination shall be canceled at the same time.**

## COMMENTARY ON ARTICLE 46

46.1 The vast majority of States have established a system of annual fees to keep breeders' rights in force. This Article provides for such a system with two alternatives. According to the first, non-payment of the fee leads to premature termination of the right (see *Alternative A* of Article 21); in the second, the holder is obliged to pay the fees due unless he specifically surrenders his right (*Alternative B* of Article 21).

46.2 As already mentioned in connection with Article 17(1) and Article 31, the Model Law proposes a system under which all annual fees fall due on the same date, which facilitates their administration.

# CHAPTER V

# KEEPING THE BREEDER'S RIGHT IN FORCE

## Article 46

## Annual Fee

**(1) The holder shall pay an annual fee [*Alternative A*: to keep his breeder's right in force] [*Alternative B*: for the whole period of protection].**

**(2) The fee shall fall due at the beginning of the calendar year to which it relates. It shall be payable by January 31.**

## COMMENTARY ON ARTICLE 47

47.1 The obligation to maintain the variety (to carry out maintenance breeding) and the obligation to provide information, documents or material with a view to verifying the maintenance of the variety are provided for indirectly (in the form of penalties if this is not done) in Article 22 of the 1991 Act; the first obligation is in fact an essential feature of the protection system, because it is in fact the counterpart for the breeder's right. Article 47 of the Model Law makes express provision for both obligations. The penalties are specified in Article 23(1) and (2)(*a*)(i).

## Article 47

## Maintenance of the Variety

**(1) The holder shall be under an obligation to maintain the protected variety or, where relevant, its hereditary components for the whole duration of the breeder's right.**

**(2) At the request of the Office, he shall provide it or an authority designated by it, within the prescribed period, with the information, documents or material deemed necessary for verifying the maintenance of the variety.**

## COMMENTARY ON ARTICLE 48

48.1 This Article sets out the general principles applicable to verification of the maintenance of the variety. According to paragraph (2), verification is not carried out systematically (there is no justification for that), but only if there is reason to believe that the variety is not being maintained.

## Article 48

## Verification of the Maintenance of the Variety

**(1) The Office shall verify that the variety and, where relevant, its hereditary components are maintained throughout the period of protection.**

**(2) Where it is suspected that a variety is not maintained and the suspicions are not removed by the information and documents submitted by the holder under Article 47(2), the Office shall order the verification of the maintenance of the variety under conditions specified by it. The verification shall include growing tests and other tests in which the material submitted by the holder is compared with the official description and the official sample of the variety.**

**(3) Where the verification suggests that the holder has failed to maintain the variety, the holder shall be heard before a decision to cancel the breeder's right is taken under Article 23(1).**

## COMMENTARY ON ARTICLE 49

49.1 Article 1(2)(xiii) provides that a variety that is the subject of a breeder's right is defined both by the description established during the technical examination and by an official sample; according to the circumstances, reference will be made to one or the other or even both. Article 49 provides for the mandatory establishment of an official sample; this may be deposited with the Office or with an authority designated by it (for example, a gene bank or research institute), or kept by the holder of the breeder's right.

49.2 Samples may also be required for the examination of new varieties (paragraph (1)(ii)).

## Article 49

## Supply of Samples

**(1) At the request of the Office, the holder shall provide the Office or any authority designated by the latter, within a prescribed period, with reasonable samples of the protected variety or, where relevant, of its hereditary components for the purpose of**

**(i) establishing or renewing the official sample of the variety, or**

**(ii) undertaking the comparative examination of other varieties for the purposes of protection.**

**(2) At the request of the Office the holder shall maintain or preserve the official sample on behalf of the Office.**

## COMMENTARY ON ARTICLE 50

50.1 Article 30(1)(i) of the 1991 Act states that the Contracting Parties shall "provide for appropriate legal remedies for the effective enforcement of breeders' rights." The part of the TRIPS Agreement on the enforcement of intellectual property rights covered by the Agreement also constitutes a source of inspiration, if not actually a source of law.

50.2 This Article and the following Articles in Part IV are checklist items. In view of the diversity of national situations and the existence of national models, for example in the form of patent laws, no attempt has been made to propose model provisions.

50.3 Article 50 covers the following elements: first, there has to be protection under civil law; secondly, it must be possible to resort to that protection when there is a direct infringement of the breeder's right (subparagraph (i)); thirdly, it is advisable for the protection also to be available when the infringement is committed in relation to the variety denomination (subparagraphs (ii) and (iii)); fourthly, the holder of the right must be able to claim the protection; and lastly, the holder of an exclusive license should also be able to claim it.

50.4 The Model Law does not describe the civil remedies available, but confines itself to specifying that they must be the same as those provided in similar fields; as a minimum, the measures should include cessation of the alleged act and elimination of the unlawful situation, and also damages.

# PART IV

# ENFORCEMENT

## Article 50

## Civil Remedies

**(1) Any person who**

**(i) without being entitled to do so performs acts that require the authorization of the holder, under Article 13,**

**(ii) uses a designation whose use is prohibited by Article 42(4), or**

**(iii) fails to use a variety denomination whose use is obligatory under Article 42(5)**

**may be sued by the holder or the holder of an exclusive license and all such relief shall be available to the latter as is available in any corresponding proceedings in respect of infringements of other proprietary rights.**

**(2) Subject to the provisions of this Law, the provisions of the law on the enforcement of rights under a [patent] shall apply *mutatis mutandis* to the enforcement of rights under a breeder's right.**

## COMMENTARY ON ARTICLE 51

51.1 The purpose of this Article is to show that there is a need to provide protection under criminal law. In general, such protection will be identical to that provided for patents. The object of paragraph (3) is to indicate that the applicable provisions for the protection of new plant varieties will usually be the same as for the protection of inventions.

## Article 51

## Criminal Penalties

**(1) Any infringing act committed with full knowledge of the infringement shall constitute an offense punishable with a fine of ... or imprisonment for a term of ...**

**(2) In the case of a second or subsequent offense, the penalties shall be ...**

**(3) The criminal procedures and penalties provided for in the [Patent Law] shall also be available.**

## COMMENTARY ON ARTICLE 52

52.1 Article 42 of the Model Law, conforming to Article 20 of the 1991 Act, imposes obligations regarding the use of variety denominations. Article 52 lays down the corresponding penalties, which may be limited to fines.

## Article 52

## Offenses in Relation to Variety Denominations

**(1) Any person who, in full knowledge of the facts, uses a designation whose use is prohibited by Article 42(4), or fails to use a variety denomination whose use is obligatory under Article 42(5), shall be liable to a fine of ...**

**(2) In the case of a second or subsequent offense, the fine may be doubled.**

## COMMENTARY ON ARTICLE 53

53.1 This Article does not call for any particular comment.

# PART V

# FINAL AND TRANSITIONAL PROVISIONS

## Article 53

## Regulations

**The Minister shall make regulations for the implementation of this Law.**

## COMMENTARY ON ARTICLE 54

54.1 To be used effectively, the system for cooperation in examination must be operated with minimum administrative constraints. It should be the responsibility of the Office to conclude the appropriate administrative agreements.

## Article 54

## Cooperation in Examination

**The Office shall be entitled to conclude administrative agreements for cooperation in the examination of varieties and the verification of the maintenance of varieties with the authorities of Contracting Parties or with their supervisory authorities.**

## COMMENTARY ON ARTICLE 55

55.1 This Article is included in the Model Law as a reminder; the texts that may need to be amended include the Patent Law and the Trademark Law, the Code of Civil Procedure, the Code of Criminal Procedure and the Criminal Code.

## Article 55

## Amendment of Other Provisions

...

## COMMENTARY ON ARTICLE 56

56.1 This Article is based on Article 6(2) of the 1991 Act, which is an optional provision.

## Article 56

## Protection of Known Varieties

**(1) Notwithstanding Article 6, a breeder's right may also be granted for a variety that is no longer new on the date of entry into force of this Law in respect of the relevant species, subject to the following conditions:**

***(a)*** **the application shall be filed within the year following the said date; and**

***(b)*** **the variety must**

**(i) have been entered in the National Catalogue of Varieties Admitted to Trade or in a register of varieties held by a professional organization recognized by the Office, on the advice of the Council, for the purposes of this Article,**

**(ii) have been the subject of a breeder's right in a Contracting Party, or be the subject of an application in a Contracting Party, provided that the application subsequently leads to the granting of the breeder's right, or**

**(iii) be the subject of proof acceptable to the Office concerning the date on which the variety ceased to be new under the provisions of Article 6.**

**(2) The duration of the breeder's right granted under this Article shall be calculated from the date of the entry referred to in paragraph (1)*(b)*(i), above, the date of the grant of the breeder's right referred to in paragraph (1)*(b)*(ii), above, or the date upon which the variety ceased to be new referred to in paragraph (1)*(b)*(iii), above. Where relevant, the earliest of those dates shall be used.**

**(3) Where a breeder's right is granted under this Article, the holder shall be under the obligation to grant licenses on reasonable terms in order to allow the continuation of any exploitation initiated in good faith by a third party before the said filing.**

## COMMENTARY ON ARTICLE 57

57.1 This Article does not call for any particular comment.

## Article 57

## Entry into Force

**This Law shall enter into force on ...**

ANNEX

# THE CONCEPT OF ESSENTIALLY DERIVED VARIETIES

## General Remarks

1. The concepts of "essentially derived variety" and "dependency" were written into the 1991 Act for one fundamental reason: to ensure that the plant variety protection system could continue to promote plant breeding activities and thereby provide farmers with varieties that were constantly being improved.

2. This fundamental reason may be divided into three aspects:

(a) the closing of a gap in the protection system based on the 1978 Act of the Convention;

(b) the establishment of equitable relations among breeders;

(c) the establishment of equitable relations between holders of breeders' rights and patent owners.

3. The system introduced by the 1991 Act of the Convention was welcomed by all interested parties, especially breeders and genetic engineering experts.

## The Problem to Be Solved

*The provisions in the Convention*

4. The variety concept. - Simply put, a variety is a distinct, uniform and stable plant grouping.

5. Distinctness is established on the basis of characteristics, which may or may not have a bearing on the agronomic or technological value of the variety. It is only necessary to have a difference in one characteristic (qualifying as "important") in order to conclude that one variety is distinct from another.

6. "Breeder's exemption". - The protection system based on the UPOV Convention provides that a protected variety may be freely used to create other varieties (Article 5(3)) of the 1978 Act; Article 15(1)(iii) of the 1991 Act; Article 14(1)(iii) of the Model Law).

7. This provision is the cornerstone of the protection system: the essence of plant breeding—the creation of varieties—is to the crossing of two varieties and to selecting from their progeny a variety that will be better (more productive or better suited to prevailing agro-economic conditions).

8. The concept of the essentially derived variety has to do with the degree of similarity between one of the parent varieties (the "initial variety") and the derived

variety. For the derivation to be "essential," there must be a high degree of similarity and the number of characteristics inherited from the second parent (if there is one) must be very small; in an extreme case only one characteristic might be so inherited.

*The perverse effects of complete exemption*

9. Experience gained on the basis of the 1978 Act showed that in some circumstances the totally unqualified breeder's exemption was a source of problems, which are illustrated by the following theoretical examples—which are nevertheless based on specific cases encountered at the technical level. These are all typical examples of essentially derived varieties.

10. Vegetatively propagated varieties and mutation. - A breeder creates by crossing followed by selection a new carnation variety, for example, which is not only commercially attractive but also technically easier to grow. Competitors can obtain variants of this variety with little or no investment by looking for or inducing mutations within the variety.

11. Mutation is an abrupt change in genetic makeup; it is the result of an error in the transmission of genetic information. In the case of a carnation this may for example affect the color of the flower: a plant with red flowers may suddenly produce a stem with white flowers, and one need only to take cuttings from that stem to obtain a new variety.

12. The white-flower mutation is of obvious commercial interest. On the other hand, the interest of a mutation that gives a slightly different shade of red will be more debatable; a competitor of the initial breeder could however exploit it without paying anything at all to the breeder and engage in an activity that could be described as plagiaristic.

13. Custom requires a color mutation of variety 'x' to be designated for example '[color x].' Carnations may therefore be 'Pierrot' and 'Dark Pierrot' or chrysanthemums 'Reagan,' 'Apricot Reagan,' 'Bronze Reagan,' 'Coral Reagan,' 'Dark Reagan,' 'Dark Yellow Reagan,' 'Orange Reagan,' 'Pearl Reagan,' 'White Reagan' or 'Yellow Reagan' (*source: List of Protected Varieties in the Netherlands*).

14. With roses, the practice is for the climbing version of bush rose 'y' to be designated 'climbing y,' for example 'Climbing Mme A. Meilland' or 'Climbing Ena Harkness.' If the vegetative characteristics are altered, the shape and color of the flowers—which give the variety its commercial interest—are exactly the same in the climbers as in the original varieties, although the flowers may be bigger.

15. The problem mentioned here arises, to a greater or lesser degree, with almost all vegetatively propagated species.

16. Sexually reproduced varieties and backcrossing. - A breeder creates a new line of maize by crossing followed by selection, and it turns out to be an excellent parent for the creation of hybrid varieties (the seeds of which are sold to farmers).

Competitors may produce variants, with limited investment, by "converting" the line in a backcrossing program.

17. In this particular case, the program consists in crossing the line with a plant that has a simply-inherited different trait (for example silks—the filaments emerging from the ear—that are red and not yellow), then crossing the progeny with the same plant and repeating the exercise with subsequent progeny a certain number of times, always selecting the "red silk" characteristic. Eventually (possibly after self-fertilization), a line is obtained that is identical to the original line except for the color of the silk.

18. All varieties and genetic engineering. - Genetic engineering was relatively new at the time of the revision of the Convention. It offers the possibility of transforming a variety at will by inserting a special gene that confers a new characteristic on the variety.

19. Summary of the problem. - In these three cases, the problem can be summarized as follows:

(a) A breeder of a so-called initial variety has invested heavily in the creation of his variety. He will usually have been crossing and selecting plants for a number of years; he will also have been carrying out tests to assess the commercial value of the variety and define the conditions under which it can be grown.

(b) A second person (also a breeder) can, often at little cost, produce a new variety that will be considered an essentially derived variety. This will

(i) possess almost all the characteristics of the initial variety, notably those that constitute the latter's commercial interest, and

(ii) differ from the initial variety only in one or a very limited number of characteristics.

(c) The second person makes a technical and economic contribution that may be:

(i) nil (in the case of a carnation with a flower of a color slightly different from that of the original variety, a line of maize with silk that is red and not yellow or a variety that has been made resistant to a non-approved herbicide);

(ii) substantial (as with the climbing variety of a rose bush or a lettuce that has been made resistant to a disease prevalent in the production area).

(d) In any event, the second person takes full advantage of the investment made by the breeder of the initial variety, apart from being in direct competition with him, whatever the amount of his own investment and whatever his own technical and economic contribution.

20. In the case of genetic engineering that makes use of a patented process or product (for example, an entirely artificial antisense gene), relations between the breeder and the genetic engineer are unequal under the 1978 Act:

(a) the breeder may not use the patented process or product to transform (and improve) his variety without the consent of the patent owner;

(b) the patent owner, on the other hand, can freely use the protected variety to transform (and improve) it; he is also free to exploit the transformed (and improved) variety without paying any remuneration.

The Solution

21. The solution is contained in Article 14(5) of the 1991 Act and the last paragraph of Article 13 of the Model Law.

*The elements of the solution*

22. The solution can be broken down as follows:

(a) The "breeder's exemption" is retained in its entirety: any protected variety may be freely used, as in the past, to create new varieties, including essentially derived varieties.

(b) On the other hand, the exploitation of an essentially derived variety is made subject to authorization by the breeder of the initial variety; in other words, the breeder's right in the initial variety is "extended" to essentially derived varieties; and these are "dependent" on the initial variety.

(c) The conditions of this dependency are as follows:

(i) the initial variety must be protected;

(ii) the initial variety must not itself be an essentially derived variety (it must be the result of genuine variety creation work);

(iii) the essentially derived variety must meet the conditions laid down in Article 14(5)(b) of the 1991 Act, repeated word for word in the Model Law, namely:

– be genuinely derived from the initial variety,
– be sufficiently distinct to escape Article 14(5)(a)(ii) of the 1991 Act,
– be virtually consistent with the initial variety;

(i) the essentially derived variety may be derived indirectly (from a variety that is itself essentially derived); derivation is indirect, for example, when a red chrysanthemum produces a yellow mutant and the latter in turn produces a white mutant: the white mutant is essentially derived, but indirectly, from the red variety.

(d) The method of derivation is immaterial. Nevertheless, the Convention gives examples of methods that frequently produce essentially derived varieties in order to illustrate the concept.

23. The underlying aim of the solution is therefore:

(a) to promote continued investment in "classical" plant breeding (crossing followed by selection, whether or not modern methods are used), which can be described as "innovative" breeding;

(b) to discourage unfair or parasitical activities without discouraging "improvement breeding";

(c) to establish a legal basis for balanced agreements between:

(i) breeders of varieties resulting from "innovative breeding" and breeders of varieties resulting from "improvement breeding,"

(ii) breeders of varieties resulting from "innovative breeding" protected by breeders' rights and the inventors of processes or products protected by patents.

*Practical implementation of the solution*

24. All interested parties agree that the dependency relations should be handled by the breeders themselves, without the involvement of the authorities responsible for administering the plant variety protection system.

25. It therefore follows that the question of knowing

(a) whether variety B is essentially derived from variety A, and

(b) whether this derivation creates a dependency relationship

must in each case be settled by the breeders and, if they are unable to agree, by the courts in the course of infringement proceedings, for example.

26. The major national and international breeders' organizations are already drawing up recommendations regarding the practical situations in which a variety can be considered essentially derived.

27. In practice, the new system has created a framework within which interested parties can negotiate:

(a) A person who wishes to engage in "improvement breeding" (including transformation by genetic engineering) on a protected variety will conclude an agreement with the breeder of that variety before starting work (such agreements have already been signed between genetic engineering companies and "traditional" breeders);

(b) If the breeding process unexpectedly produces an essentially derived variety, the two breeders will come to an agreement on its exploitation

if it represents a genuine improvement; the price to be paid by the end-user will not be a double royalty but an amount determined by market forces (in other words by competition); if there is no improvement, either the breeder of the essentially derived variety will decide not to exploit it or the breeder of the initial variety will exercise his right to refuse the second breeder the right to exploit it;

(c) Breeders of varieties produced by "innovative" breeding and the inventors of products or processes leading to essentially derived varieties have rights that are more noticeably equal and are therefore encouraged to enter into balanced agreements.

The Concept of Essentially Derived Variety in the Intellectual Property Context

28. Protection of new plant varieties. - The effect of the new system is that the breeder of variety A may have a right that extends to variety B. Such an extension of rights is not new. It already existed in the case of lines and hybrids (second sentence of Article 5(3) of the 1978 Act).

29. Patent law. - One patent may be dependent on another patent. The dependent patent can only be worked if the principal patent is also worked.

30. Copyright. - The solution for essentially derived varieties is similar to that adopted in copyright for derived works (Article 2(3) of the Berne Convention).

## CLOSING REMARKS:

The opportunities afforded by global free trade are substantial but come with difficult periods of transition. Part of that transitional process is the implementation of harmonized legislation and the development of a series of processes and protocols to implement them.

These reports, and its accompanying training module, are intended to support the transition of Plant variety protection in the Kingdom of Jordan.

I hope and trust that this information will prove useful and instrumental in the effective introduction and development of plant variety protection in Jordan, and that this in turn will stimulate investment and economic growth in this critical area of agriculture. Increased investment will in turn serve to enhance the well being and economic status of the people of Jordan.

**END**

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## EXECUTIVE SUMMARY

This manual/report forms the basis of a training manual to be used for instruction on implementation of the new Jordanian Plant Variety Protection (PVP) program. It complements the policy report that was produced by the same author on this topic.

The breeding of new plant varieties is an economically important activity that contributes in many different ways to the social and economic well being of society, through research, commercialization and wealth creation. The implementation of PVP in Jordan should serve as a stimulus to investment in plant breeding research and agricultural development and productivity.

Experience worldwide has shown that it is difficult for a breeder to recover his financial investment if he must sell his initial product without protection in the first years of a new variety's life. Under this scenario the breeder's competitors could secure supplies of propagating material and in a short time compete directly with him profiting from the many years of breeding effort. It may take between 10 and 20 years to develop new varieties in most plant species.

Plant variety protection regimes are implemented in order to:

- Provide breeders (including institutions of the State) with an opportunity to receive a reasonable return on past investments,
- Provide an incentive for continued or increased investment in the future,
- To recognize the legal right of the innovator to be recognized as such and his economic right to remuneration for his efforts.

Harmonizing these laws and agreements within the global economy is the mandate of the International Union for the Protection of New Varieties of Plants (UPOV).

As part of its entry into the global economy though accession to the World Trade Organization, Jordan is implementing plant variety protection legislation in order to be compatible to those of other WTO member counties. This should open the doors to increased investment in plant breeding and the development of new markets for its innovative plant products.

This manual will take course participants through a step-by-step analysis of PVP. Starting with the existing International framework legislation (UPOV), then the Jordanian Law and its supporting regulations. The course will focus on the day-to-day activities involved in the processing and examination of applications. It will focus heavily on the use of examining guides produced by UPOV to assess the characteristics required in order to grant plant variety protection status.

I hope and trust that this training course and the supporting report/ manual will assist the Government of Jordan its important task of implementing regulations and operating a globally effective plant variety protection program and office.

# MODEL WORKSHOP PROGRAM

## DAY 1

### Morning Session

- **Opening ceremony**
- **An Introduction to Intellectual Property Protection**
- **An Introduction to Plant Patents**
- **An Introduction to Plant Variety Protection**
- **UPOV What it is and what it does.**

### Afternoon Session

- **The Jordanian Plant Variety Protection Law**
- **Status and Context of the Law**
- **Interface of PVP law with other Legal Instruments.**
- **Question & Answer Session**

## DAY 2

### Morning Session

- **The Jordanian Plant Variety Protection Regulations**
- **The legal basis of the regulations**
- **The status & context of the regulations**

### Afternoon Session

- **The Plant Variety Protection Office**
- **Establishment of the Office**
- **Infrastructure of the Office**
- **Operations of the Office**
- **Interactions of Office with other Government Agencies**

- **Question & Answer**

**DAY 3**

**Morning Session**

- **Plant Variety Protection Application Process**
- **The forms**
- **How to distribute forms**
- **How to "file"**
- **Introduction to the technical guidelines of UPOV**

**Afternoon Session**

- **Use of the UPOV technical guides**
- **The examination process**
- **Uniformity analysis**
- **Distinctiveness Analysis**
- **Stability Analysis**

**DAY 4**

**Morning Session**

- **Example Session**
- **Review an application**
- **Meet with an applicant**
- **Review the process**
- **Perform an examination**
- **Awarding a certificate**

**Afternoon Session**

- **PVP and the seed sector**
- **PVP and the private sector**
- **PVP and the governmental sector**
- **Round table discussion**

**DAY 5**

**Morning Session**

- **How to deliver a refusal**
- **The Appeal process**
- **The judicial Appeal Process**
- **The field Inspection Process**
- **Public Awareness of PVP**
- **Questions & Answer**

**Afternoon Session**

- **Field Inspection tour**
- **Development of follow up steps**
- **Or Early Closure**

**CLOSING CEREMONY**

## INTRODUCTION

This manual will form the basis for a training program to be implemented for staff working in and associated with the Jordanian Plant Variety Protection Office.

The course will be interactive in nature, based on lectures and case studies.

The awarding of a certificate of plant variety protection is the result of the application of a set of rules or criteria to the analysis of particular plant material. It is very much so a PROCESS.

The key to effectiveness and credibility of the PVP office is transparency, efficiency and following the rules.

This course will go over step by step the legal underpinning to the process, and how the various steps are implemented from both a legal and technical standpoint.

While this manual in of itself has use as a training tool, it should be remembered that this is only a component of the overall training package that also contains lectures, examples, question and answer sessions etc.

That said, I trust that this manual will be useful for those practicing this work in Jordan and to those going through the application process.

## UPOV Information

ABOUT UPOV FROM THE WEBSITE www.upov.org

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Collection of Laws
Collection of Texts, Models, Rules and Guidelines

Promoting the Concept of Protection by Plant Breeders' Rights
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International Convention for the Protection of New Varieties of Plants

**ACT OF 1991**

**INTERNATIONAL CONVENTION FOR THE PROTECTION**

**OF NEW VARIETIES OF PLANTS**

**of December 2, 1961**

**as Revised at Geneva on November 10, 1972,**

**on October 23, 1978, and on March 19, 1991**

**ACT OF 1991**

# INTERNATIONAL CONVENTION

## FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

of December 2, 1961,
as Revised at Geneva on November 10, 1972,
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# CHAPTER I

# DEFINITIONS

## Article 1

## Definitions

For the purposes of this Act:

(i) "this Convention" means the present (1991) Act of the International Convention for the Protection of New Varieties of Plants;

(ii) "Act of 1961/1972" means the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as amended by the Additional Act of November 10, 1972;

(iii) "Act of 1978" means the Act of October 23, 1978, of the International Convention for the Protection of New Varieties of Plants;

(iv) "breeder" means

- the person who bred, or discovered and developed, a variety,
- the person who is the employer of the aforementioned person or who has commissioned the latter's work, where the laws of the relevant Contracting Party so provide, or
- the successor in title of the first or second aforementioned person, as the case may be;

(v) "breeder's right" means the right of the breeder provided for in this Convention;

(vi) "variety" means a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a breeder's right are fully met, can be

- defined by the expression of the characteristics resulting from a given genotype or combination of genotypes,
- distinguished from any other plant grouping by the expression of at least one of the said characteristics and
- considered as a unit with regard to its suitability for being propagated unchanged;

(vii) "Contracting Party" means a State or an intergovernmental organization party to this Convention;

(viii) "territory," in relation to a Contracting Party, means, where the Contracting Party is a State, the territory of that State and, where the Contracting Party is an intergovernmental organization, the territory in which the constituting treaty of that intergovernmental organization applies;

(ix) "authority" means the authority referred to in Article 30(1)(ii);

(x) "Union" means the Union for the Protection of New Varieties of Plants founded by the Act of 1961 and further mentioned in the Act of 1972, the Act of 1978 and in this Convention;

(xi) "member of the Union" means a State party to the Act of 1961/1972 or the Act of 1978, or a Contracting Party.

## CHAPTER II

## GENERAL OBLIGATIONS OF THE CONTRACTING PARTIES

### Article 2

### Basic Obligation of the Contracting Parties

Each Contracting Party shall grant and protect breeders' rights.

### Article 3

### Genera and Species to be Protected

(1) [*States already members of the Union*] Each Contracting Party which is bound by the Act of 1961/1972 or the Act of 1978 shall apply the provisions of this Convention,

(i) at the date on which it becomes bound by this Convention, to all plant genera and species to which it applies, on the said date, the provisions of the Act of 1961/1972 or the Act of 1978 and,

(ii) at the latest by the expiration of a period of five years after the said date, to all plant genera and species.

(2) [*New members of the Union*] Each Contracting Party which is not bound by the Act of 1961/1972 or the Act of 1978 shall apply the provisions of this Convention,

(i) at the date on which it becomes bound by this Convention, to at least 15 plant genera or species and,

(ii) at the latest by the expiration of a period of 10 years from the said date, to all plant genera and species.

### Article 4

### National Treatment

(1) [*Treatment*] Without prejudice to the rights specified in this Convention, nationals of a Contracting Party as well as natural persons resident and legal entities having their registered offices within the territory of a Contracting Party shall, insofar as the grant and protection of breeders' rights are concerned, enjoy within the territory of each other Contracting Party the same treatment as is accorded or may hereafter be accorded by the laws of each such other Contracting Party to its own nationals, provided that the said nationals, natural persons or legal entities comply with the conditions and formalities imposed on the nationals of the said other Contracting Party.

(2) [*"Nationals"*] For the purposes of the preceding paragraph, "nationals" means, where the Contracting Party is a State, the nationals of that State and, where the Contracting Party is an intergovernmental organization, the nationals of the States which are members of that organization.

## CHAPTER III

## CONDITIONS FOR THE GRANT OF THE BREEDER'S RIGHT

### Article 5

### Conditions of Protection

(1) [*Criteria to be satisfied*] The breeder's right shall be granted where the variety is

(i) new,

(ii) distinct,

(iii) uniform and

(iv) stable.

(2) [*Other conditions*] 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.

## Article 6

## Novelty

(1) [*Criteria*] The variety shall be deemed to be new if, at the date of filing of the application for a breeder's right, propagating or harvested material of the variety has not been sold or otherwise disposed of to others, by or with the consent of the breeder, for purposes of exploitation of the variety

(i) in the territory of the Contracting Party in which the application has been filed earlier than one year before that date and

(ii) in a territory other than that of the Contracting Party in which the application has been filed earlier than four years or, in the case of trees or of vines, earlier than six years before the said date.

(2) [*Varieties of recent creation*] Where a Contracting Party applies this Convention to a plant genus or species to which it did not previously apply this Convention or an earlier Act, it may consider a variety of recent creation existing at the date of such extension of protection to satisfy the condition of novelty defined in paragraph (1) even where the sale or disposal to others described in that paragraph took place earlier than the time limits defined in that paragraph.

(3) [*"Territory" in certain cases*] For the purposes of paragraph (1), all the Contracting Parties which are member States of one and the same intergovernmental organization may act jointly, where the regulations of that organization so require, to assimilate acts done on the territories of the States members of that organization to acts done on their own territories and, should they do so, shall notify the Secretary-General accordingly.

## Article 7

## Distinctness

The variety shall be deemed to be distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of the filing of the application. In particular, the filing of an application for the granting of a breeder's right or for the entering of another variety in an official register of varieties, in any country, shall be deemed to render that other variety a matter of common knowledge from the date of the application, provided that the application leads to the granting of a breeder's right or to the entering of the said other variety in the official register of varieties, as the case may be.

## Article 8

## Uniformity

The variety shall be deemed to be uniform if, subject to the variation that may be expected from the particular features of its propagation, it is sufficiently uniform in its relevant characteristics.

## Article 9

## Stability

The variety shall be deemed to be stable if its relevant characteristics remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.

# CHAPTER IV

# APPLICATION FOR THE GRANT OF THE BREEDER'S RIGHT

## Article 10

## Filing of Applications

(1) [*Place of first application*] The breeder may choose the Contracting Party with whose authority he wishes to file his first application for a breeder's right.

(2) [*Time of subsequent applications*] The breeder may apply to the authorities of other Contracting Parties for the grant of breeders' rights without waiting for the grant to him of a breeder's right by the authority of the Contracting Party with which the first application was filed.

(3) [*Independence of protection*] No Contracting Party shall refuse to grant a breeder's right or limit its duration on the ground that protection for the same variety has not been applied for, has been refused or has expired in any other State or intergovernmental organization.

## Article 11

## Right of Priority

(1) [*The right; its period*] Any breeder who has duly filed an application for the protection of a variety in one of the Contracting Parties (the "first application") shall, for the purpose of filing an application for the grant of a breeder's right for the same variety with the authority of any other Contracting Party (the "subsequent

application"), enjoy a right of priority for a period of 12 months. This period shall be computed from the date of filing of the first application. The day of filing shall not be included in the latter period.

(2) [*Claiming the right*] In order to benefit from the right of priority, the breeder shall, in the subsequent application, claim the priority of the first application. The authority with which the subsequent application has been filed may require the breeder to furnish, within a period of not less than three months from the filing date of the subsequent application, a copy of the documents which constitute the first application, certified to be a true copy by the authority with which that application was filed, and samples or other evidence that the variety which is the subject matter of both applications is the same.

(3) [*Documents and material*] The breeder shall be allowed a period of two years after the expiration of the period of priority or, where the first application is rejected or withdrawn, an appropriate time after such rejection or withdrawal, in which to furnish, to the authority of the Contracting Party with which he has filed the subsequent application, any necessary information, document or material required for the purpose of the examination under Article 12, as required by the laws of that Contracting Party.

(4) [*Events occurring during the period*] Events occurring within the period provided for in paragraph (1), such as the filing of another application or the publication or use of the variety that is the subject of the first application, shall not constitute a ground for rejecting the subsequent application. Such events shall also not give rise to any third-party right.

## Article 12

## Examination of the Application

Any decision to grant a breeder's right shall require an examination for compliance with the conditions under Articles 5 to 9. In the course of the examination, the authority may grow the variety or carry out other necessary tests, cause the growing of the variety or the carrying out of other necessary tests, or take into account the results of growing tests or other trials which have already been carried out. For the purposes of examination, the authority may require the breeder to furnish all the necessary information, documents or material.

## Article 13

## Provisional Protection

Each Contracting Party shall provide measures designed to safeguard the interests of the breeder during the period between the filing or the publication of the application for the grant of a breeder's right 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 as provided in Article 14. A Contracting Party 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.

## CHAPTER V

## THE RIGHTS OF THE BREEDER

### Article 14

### Scope of the Breeder's Right

(1) [*Acts in respect of the propagating material*] *(a)* Subject to Articles 15 and 16, the following acts in respect of the propagating material of the protected variety shall require the authorization of the breeder:

(i) production or reproduction (multiplication),

(ii) conditioning for the purpose of propagation,

(iii) offering for sale,

(iv) selling or other marketing,

(v) exporting,

(vi) importing,

(vii) stocking for any of the purposes mentioned in (i) to (vi), above.

*(b)* The breeder may make his authorization subject to conditions and limitations.

(2) [*Acts in respect of the harvested material*] Subject to Articles 15 and 16, the acts referred to in items (i) to (vii) of paragraph (1)*(a)* in respect of harvested material, including entire plants and parts of plants, obtained through the unauthorized use of propagating material of the protected variety shall require the authorization of the breeder, unless the breeder has had reasonable opportunity to exercise his right in relation to the said propagating material.

(3) [*Acts in respect of certain products*] Each Contracting Party may provide that, subject to Articles 15 and 16, the acts referred to in items (i) to (vii) of paragraph (1)*(a)* in respect of products made directly from harvested material of the protected variety falling within the provisions of paragraph (2) through the unauthorized use of the said harvested material shall require the authorization of the breeder, unless the breeder has had reasonable opportunity to exercise his right in relation to the said harvested material.

(4) [*Possible additional acts*] Each Contracting Party may provide that, subject to Articles 15 and 16, acts other than those referred to in items (i) to (vii) of paragraph (1)*(a)* shall also require the authorization of the breeder.

(5) [*Essentially derived and certain other varieties*] *(a)* The provisions of paragraphs (1) to (4) shall also apply in relation to

(i) varieties which are essentially derived from the protected variety, where the protected variety is not itself an essentially derived variety,

(ii) varieties which are not clearly distinguishable in accordance with Article 7 from the protected variety and

(iii) varieties whose production requires the repeated use of the protected variety.

*(b)* For the purposes of subparagraph *(a)*(i), a variety shall be deemed to be essentially derived from another variety ("the initial variety") when

(i) it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety,

(ii) it is clearly distinguishable from the initial variety and

(iii) except for the differences which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.

*(c)* Essentially derived varieties may be obtained for example by the selection of a natural or induced mutant, or of a somaclonal variant, the selection of a variant individual from plants of the initial variety, backcrossing, or transformation by genetic engineering.

## Article 15

## Exceptions to the Breeder's Right

(1) [*Compulsory exceptions*] The breeder's right shall not extend to

(i) acts done privately and for non-commercial purposes,

(ii) acts done for experimental purposes and

(iii) acts done for the purpose of breeding other varieties, and, except where the provisions of Article 14(5) apply, acts referred to in Article 14(1) to (4) in respect of such other varieties.

(2) [*Optional exception*] Notwithstanding Article 14, each Contracting Party may, within reasonable limits and subject to the safeguarding of the legitimate interests of the breeder, restrict the breeder's right in relation to any variety in order to permit farmers to use for propagating purposes, on their own holdings, the product of the harvest which they have obtained by planting, on their own holdings, the protected variety or a variety covered by Article 14(5)*(a)*(i) or (ii).

## Article 16

## Exhaustion of the Breeder's Right

(1) [*Exhaustion of right*] The breeder's right shall not extend to acts concerning any material of the protected variety, or of a variety covered by the provisions of Article 14(5), which has been sold or otherwise marketed by the breeder or with his consent in the territory of the Contracting Party concerned, or any material derived from the said material, unless such acts

(i) involve further propagation of the variety in question or

(ii) involve an export of material of the variety, which enables the propagation of the variety, into a country which does not protect varieties of the plant genus or species to which the variety belongs, except where the exported material is for final consumption purposes.

(2) [*Meaning of "material"*] For the purposes of paragraph (1), "material" means, in relation to a variety,

(i) propagating material of any kind,

(ii) harvested material, including entire plants and parts of plants, and

(iii) any product made directly from the harvested material.

(3) [*"Territory" in certain cases*] For the purposes of paragraph (1), all the Contracting Parties which are member States of one and the same intergovernmental organization may act jointly, where the regulations of that organization so require, to assimilate acts done on the territories of the States members of that organization to acts done on their own territories and, should they do so, shall notify the Secretary-General accordingly.

## Article 17

## Restrictions on the Exercise of the Breeder's Right

(1) [*Public interest*] Except where expressly provided in this Convention, no Contracting Party may restrict the free exercise of a breeder's right for reasons other than of public interest.

(2) [*Equitable remuneration*] When any such restriction has the effect of authorizing a third party to perform any act for which the breeder's authorization is required, the Contracting Party concerned shall take all measures necessary to ensure that the breeder receives equitable remuneration.

**Article 18**

**Measures Regulating Commerce**

The breeder's right shall be independent of any measure taken by a Contracting Party to regulate within its territory the production, certification and marketing of material of varieties or the importing or exporting of such material. In any case, such measures shall not affect the application of the provisions of this Convention.

**Article 19**

**Duration of the Breeder's Right**

(1) [*Period of protection*] The breeder's right shall be granted for a fixed period.

(2) [*Minimum period*] The said period shall not be shorter than 20 years from the date of the grant of the breeder's right. For trees and vines, the said period shall not be shorter than 25 years from the said date.

**CHAPTER VI**

**VARIETY DENOMINATION**

**Article 20**

**Variety Denomination**

(1) [*Designation of varieties by denominations; use of the denomination*] *(a)* The variety shall be designated by a denomination which will be its generic designation.

*(b)* Each Contracting Party shall ensure that, subject to paragraph (4), no rights in the designation registered as the denomination of the variety shall hamper the free use of the denomination in connection with the variety, even after the expiration of the breeder's right.

(2) [*Characteristics of the denomination*] The denomination must enable the variety to be identified. It may not consist solely of figures except where this is an established practice for designating varieties. It must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder. In particular, it must be different from every denomination which designates, in the territory of any Contracting Party, an existing variety of the same plant species or of a closely related species.

(3) [*Registration of the denomination*] The denomination of the variety shall be submitted by the breeder to the authority. If it is found that the denomination does not satisfy the requirements of paragraph (2), the authority shall refuse to register it and shall require the breeder to propose another denomination within a prescribed period. The denomination shall be registered by the authority at the same time as the breeder's right is granted.

(4) [*Prior rights of third persons*] Prior rights of third persons shall not be affected. If, by reason of a prior right, the use of the denomination of a variety is forbidden to a person who, in accordance with the provisions of paragraph (7), is obliged to use it, the authority shall require the breeder to submit another denomination for the variety.

(5) [*Same denomination in all Contracting Parties*] A variety must be submitted to all Contracting Parties under the same denomination. The authority of each Contracting Party shall register the denomination so submitted, unless it considers the denomination unsuitable within its territory. In the latter case, it shall require the breeder to submit another denomination.

(6) [*Information among the authorities of Contracting Parties*] The authority of a Contracting Party shall ensure that the authorities of all the other Contracting Parties are informed of matters concerning variety denominations, in particular the submission, registration and cancellation of denominations. Any authority may address its observations, if any, on the registration of a denomination to the authority which communicated that denomination.

(7) [*Obligation to use the denomination*] Any person who, within the territory of one of the Contracting Parties, offers for sale or markets propagating material of a variety protected within the said territory shall be obliged to use the denomination of that variety, even after the expiration of the breeder's right in that variety, except where, in accordance with the provisions of paragraph (4), prior rights prevent such use.

(8) [*Indications used in association with denominations*] When a variety is offered for sale or marketed, it shall be permitted to associate a trademark, trade name or other similar indication with a registered variety denomination. If such an

indication is so associated, the denomination must nevertheless be easily recognizable.

## CHAPTER VII

## NULLITY AND CANCELLATION OF THE BREEDER'S RIGHT

### Article 21

### Nullity of the Breeder's Right

(1) [*Reasons of nullity*] Each Contracting Party shall declare a breeder's right granted by it null and void when it is established

(i) that the conditions laid down in Articles 6 or 7 were not complied with at the time of the grant of the breeder's right,

(ii) that, where the grant of the breeder's right has been essentially based upon information and documents furnished by the breeder, the conditions laid down in Articles 8 or 9 were not complied with at the time of the grant of the breeder's right, or

(iii) that the breeder's right has been granted to a person who is not entitled to it, unless it is transferred to the person who is so entitled.

(2) [*Exclusion of other reasons*] No breeder's right shall be declared null and void for reasons other than those referred to in paragraph (1).

### Article 22

### Cancellation of the Breeder's Right

(1) [*Reasons for cancellation*] *(a)* Each Contracting Party may cancel a breeder's right granted by it if it is established that the conditions laid down in Articles 8 or 9 are no longer fulfilled.

*(b)* Furthermore, each Contracting Party may cancel a breeder's right granted by it if, after being requested to do so and within a prescribed period,

(i) the breeder does not provide the authority with the information, documents or material deemed necessary for verifying the maintenance of the variety,

(ii) the breeder fails to pay such fees as may be payable to keep his right in force, or

(iii) the breeder does not propose, where the denomination of the variety is cancelled after the grant of the right, another suitable denomination.

(2) [*Exclusion of other reasons*] No breeder's right shall be cancelled for reasons other than those referred to in paragraph (1).

## CHAPTER VIII

## THE UNION

### Article 23

### Members

The Contracting Parties shall be members of the Union.

### Article 24

### Legal Status and Seat

(1) [*Legal personality*] The Union has legal personality.

(2) [*Legal capacity*] The Union enjoys on the territory of each Contracting Party, in conformity with the laws applicable in the said territory, such legal capacity as may be necessary for the fulfillment of the objectives of the Union and for the exercise of its functions.

(3) [*Seat*] The seat of the Union and its permanent organs are at Geneva.

(4) [*Headquarters agreement*] The Union has a headquarters agreement with the Swiss Confederation.

### Article 25

### Organs

The permanent organs of the Union are the Council and the Office of the Union.

### Article 26

## The Council

(1) [*Composition*] The Council shall consist of the representatives of the members of the Union. Each member of the Union shall appoint one representative to the Council and one alternate. Representatives or alternates may be accompanied by assistants or advisers.

(2) [*Officers*] The Council shall elect a President and a first Vice-President from among its members. It may elect other Vice-Presidents. The first Vice-President shall take the place of the President if the latter is unable to officiate. The President shall hold office for three years.

(3) [*Sessions*] The Council shall meet upon convocation by its President. An ordinary session of the Council shall be held annually. In addition, the President may convene the Council at his discretion; he shall convene it, within a period of three months, if one-third of the members of the Union so request.

(4) [*Observers*] States not members of the Union may be invited as observers to meetings of the Council. Other observers, as well as experts, may also be invited to such meetings.

(5) [*Tasks*] The tasks of the Council shall be to:

(i) study appropriate measures to safeguard the interests and to encourage the development of the Union;

(ii) establish its rules of procedure;

(iii) appoint the Secretary-General and, if it finds it necessary, a Vice Secretary-General and determine the terms of appointment of each;

(iv) examine an annual report on the activities of the Union and lay down the program for its future work;

(v) give to the Secretary-General all necessary directions for the accomplishment of the tasks of the Union;

(vi) establish the administrative and financial regulations of the Union;

(vii) examine and approve the budget of the Union and fix the contribution of each member of the Union;

(viii) examine and approve the accounts presented by the Secretary-General;

(ix) fix the date and place of the conferences referred to in Article 38 and take the measures necessary for their preparation; and

(x) in general, take all necessary decisions to ensure the efficient functioning of the Union.

(6) [*Votes*] *(a)* Each member of the Union that is a State shall have one vote in the Council.

*(b)* Any Contracting Party that is an intergovernmental organization may, in matters within its competence, exercise the rights to vote of its member States that are members of the Union. Such an intergovernmental organization shall not exercise the rights to vote of its member States if its member States exercise their right to vote, and vice versa.

(7) [*Majorities*] Any decision of the Council shall require a simple majority of the votes cast, provided that any decision of the Council under paragraphs (5)(ii), (vi) and (vii), and under Articles 28(3), 29(5)*(b)* and 38(1) shall require three-fourths of the votes cast. Abstentions shall not be considered as votes.

## Article 27

## The Office of the Union

(1) [*Tasks and direction of the Office*] The Office of the Union shall carry out all the duties and tasks entrusted to it by the Council. It shall be under the direction of the Secretary-General.

(2) [*Duties of the Secretary-General*] The Secretary-General shall be responsible to the Council; he shall be responsible for carrying out the decisions of the Council. He shall submit the budget of the Union for the approval of the Council and shall be responsible for its implementation. He shall make reports to the Council on his administration and the activities and financial position of the Union.

(3) [*Staff*] Subject to the provisions of Article 26(5)(iii), the conditions of appointment and employment of the staff necessary for the efficient performance of the tasks of the Office of the Union shall be fixed in the administrative and financial regulations.

## Article 28

## Languages

(1) [*Languages of the Office*] The English, French, German and Spanish languages shall be used by the Office of the Union in carrying out its duties.

(2) [*Languages in certain meetings*] Meetings of the Council and of revision conferences shall be held in the four languages.

(3) [*Further languages*] The Council may decide that further languages shall be used.

## Article 29

## Finances

(1) [*Income*] The expenses of the Union shall be met from

(i) the annual contributions of the States members of the Union,

(ii) payments received for services rendered,

(iii) miscellaneous receipts.

(2) [*Contributions: units*] *(a)* The share of each State member of the Union in the total amount of the annual contributions shall be determined by reference to the total expenditure to be met from the contributions of the States members of the Union and to the number of contribution units applicable to it under paragraph (3). The said share shall be computed according to paragraph (4).

*(b)* The number of contribution units shall be expressed in whole numbers or fractions thereof, provided that no fraction shall be smaller than one-fifth.

(3) [*Contributions: share of each member*] *(a)* The number of contribution units applicable to any member of the Union which is party to the Act of 1961/1972 or the Act of 1978 on the date on which it becomes bound by this Convention shall be the same as the number applicable to it immediately before the said date.

*(b)* Any other State member of the Union shall, on joining the Union, indicate, in a declaration addressed to the Secretary-General, the number of contribution units applicable to it.
*(c)* Any State member of the Union may, at any time, indicate, in a declaration addressed to the Secretary-General, a number of contribution units different from the number applicable to it under subparagraph *(a)* or *(b)*. Such declaration, if made during the first six months of a calendar year, shall take effect from the beginning of the subsequent calendar year; otherwise, it shall take effect from the beginning of the second calendar year which follows the year in which the declaration was made.

(4) [*Contributions: computation of shares*] *(a)* For each budgetary period, the amount corresponding to one contribution unit shall be obtained by dividing the total amount of the expenditure to be met in that period from the contributions of the States members of the Union by the total number of units applicable to those States members of the Union.

*(b)* The amount of the contribution of each State member of the Union shall be obtained by multiplying the amount corresponding to one contribution unit by the number of contribution units applicable to that State member of the Union.

(5) [*Arrears in contributions*] *(a)* A State member of the Union which is in arrears in the payment of its contributions may not, subject to subparagraph *(b)*, exercise its right to vote in the Council if the amount of its arrears equals or exceeds the amount of the contribution due from it for the preceding full year. The suspension of the right to vote shall not relieve such State member of the Union of its obligations under this Convention and shall not deprive it of any other rights thereunder.

*(b)* The Council may allow the said State member of the Union to continue to exercise its right to vote if, and as long as, the Council is satisfied that the delay in payment is due to exceptional and unavoidable circumstances.

(6) [*Auditing of the accounts*] The auditing of the accounts of the Union shall be effected by a State member of the Union as provided in the administrative and financial regulations. Such State member of the Union shall be designated, with its agreement, by the Council.

(7) [*Contributions of intergovernmental organizations*] Any Contracting Party which is an intergovernmental organization shall not be obliged to pay contributions. If, nevertheless, it chooses to pay contributions, the provisions of paragraphs (1) to (4) shall be applied accordingly.

## CHAPTER IX

## IMPLEMENTATION OF THE CONVENTION; OTHER AGREEMENTS

### Article 30

### Implementation of the Convention

(1) [*Measures of implementation*] Each Contracting Party shall adopt all measures necessary for the implementation of this Convention; in particular, it shall:

(i) provide for appropriate legal remedies for the effective enforcement of breeders' rights;

(ii) maintain an authority entrusted with the task of granting breeders' rights or entrust the said task to an authority maintained by another Contracting Party;

(iii) ensure that the public is informed through the regular publication of information concerning

- applications for and grants of breeders' rights, and
- proposed and approved denominations.

(2) [*Conformity of laws*] It shall be understood that, on depositing its instrument of ratification, acceptance, approval or accession, as the case may be, each

State or intergovernmental organization must be in a position, under its laws, to give effect to the provisions of this Convention.

### Article 31

### Relations Between Contracting Parties and States Bound by Earlier Acts

(1) [*Relations between States bound by this Convention*] Between States members of the Union which are bound both by this Convention and any earlier Act of the Convention, only this Convention shall apply.

(2) [*Possible relations with States not bound by this Convention*] Any State member of the Union not bound by this Convention may declare, in a notification addressed to the Secretary-General, that, in its relations with each member of the Union bound only by this Convention, it will apply the latest Act by which it is bound. As from the expiration of one month after the date of such notification and until the State member of the Union making the declaration becomes bound by this Convention, the said member of the Union shall apply the latest Act by which it is bound in its relations with each of the members of the Union bound only by this Convention, whereas the latter shall apply this Convention in respect of the former.

### Article 32

### Special Agreements

Members of the Union reserve the right to conclude among themselves special agreements for the protection of varieties, insofar as such agreements do not contravene the provisions of this Convention.

## CHAPTER X

## FINAL PROVISIONS

### Article 33

### Signature

This Convention shall be open for signature by any State which is a member of the Union at the date of its adoption. It shall remain open for signature until March 31, 1992.

### Article 34

**Ratification, Acceptance or Approval; Accession**

(1) [*States and certain intergovernmental organizations*] *(a)* Any State may, as provided in this Article, become party to this Convention.

*(b)* Any intergovernmental organization may, as provided in this Article, become party to this Convention if it

(i) has competence in respect of matters governed by this Convention,

(ii) has its own legislation providing for the grant and protection of breeders' rights binding on all its member States and

(iii) has been duly authorized, in accordance with its internal procedures, to accede to this Convention.

(2) [*Instrument of adherence*] Any State which has signed this Convention shall become party to this Convention by depositing an instrument of ratification, acceptance or approval of this Convention. Any State which has not signed this Convention and any intergovernmental organization shall become party to this Convention by depositing an instrument of accession to this Convention. Instruments of ratification, acceptance, approval or accession shall be deposited with the Secretary-General.

(3) [*Advice of the Council*] Any State which is not a member of the Union and any intergovernmental organization shall, before depositing its instrument of accession, ask the Council to advise it in respect of the conformity of its laws with the provisions of this Convention. If the decision embodying the advice is positive, the instrument of accession may be deposited.

**Article 35**

**Reservations**

(1) [*Principle*] Subject to paragraph (2), no reservations to this Convention are permitted.

(2) [*Possible exception*] *(a)* Notwithstanding the provisions of Article 3(1), any State which, at the time of becoming party to this Convention, is a party to the Act of 1978 and which, as far as varieties reproduced asexually are concerned, provides for protection by an industrial property title other than a breeder's right shall have the right to continue to do so without applying this Convention to those varieties.

*(b)* Any State making use of the said right shall, at the time of depositing its instrument of ratification, acceptance, approval or accession, as the case may be,

notify the Secretary-General accordingly. The same State may, at any time, withdraw the said notification.

## Article 36

### Communications Concerning Legislation and the Genera and Species Protected; Information to be Published

(1) [*Initial notification*] When depositing its instrument of ratification, acceptance or approval of or accession to this Convention, as the case may be, any State or intergovernmental organization shall notify the Secretary-General of

(i) its legislation governing breeder's rights and

(ii) the list of plant genera and species to which, on the date on which it will become bound by this Convention, it will apply the provisions of this Convention.

(2) [*Notification of changes*] Each Contracting Party shall promptly notify the Secretary-General of

(i) any changes in its legislation governing breeders' rights and

(ii) any extension of the application of this Convention to additional plant genera and species.

(3) [*Publication of the information*] The Secretary-General shall, on the basis of communications received from each Contracting Party concerned, publish information on

(i) the legislation governing breeders' rights and any changes in that legislation, and

(ii) the list of plant genera and species referred to in paragraph (1)(ii) and any extension referred to in paragraph (2)(ii).

## Article 37

### Entry into Force; Closing of Earlier Acts

(1) [*Initial entry into force*] This Convention shall enter into force one month after five States have deposited their instruments of ratification, acceptance, approval or accession, as the case may be, provided that at least three of the said instruments have been deposited by States party to the Act of 1961/1972 or the Act of 1978.

(2) [*Subsequent entry into force*] Any State not covered by paragraph (1) or any intergovernmental organization shall become bound by this Convention one month after the date on which it has deposited its instrument of ratification, acceptance, approval or accession, as the case may be.

(3) [*Closing of the 1978 Act*] No instrument of accession to the Act of 1978 may be deposited after the entry into force of this Convention according to paragraph (1), except that any State that, in conformity with the established practice of the General Assembly of the United Nations, is regarded as a developing country may deposit such an instrument until December 31, 1995, and that any other State may deposit such an instrument until December 31, 1993, even if this Convention enters into force before that date.

## Article 38

## Revision of the Convention

(1) [*Conference*] This Convention may be revised by a conference of the members of the Union. The convocation of such conference shall be decided by the Council.

(2) [*Quorum and majority*] The proceedings of a conference shall be effective only if at least half of the States members of the Union are represented at it. A majority of three-quarters of the States members of the Union present and voting at the conference shall be required for the adoption of any revision.

## Article 39

## Denunciation

(1) [*Notifications*] Any Contracting Party may denounce this Convention by notification addressed to the Secretary-General. The Secretary-General shall promptly notify all members of the Union of the receipt of that notification.

(2) [*Earlier Acts*] Notification of the denunciation of this Convention shall be deemed also to constitute notification of the denunciation of any earlier Act by which the Contracting Party denouncing this Convention is bound.

(3) [*Effective date*] The denunciation shall take effect at the end of the calendar year following the year in which the notification was received by the Secretary-General.

(4) [*Acquired rights*] The denunciation shall not affect any rights acquired in a variety by reason of this Convention or any earlier Act prior to the date on which the denunciation becomes effective.

## Article 40

## Preservation of Existing Rights

This Convention shall not limit existing breeders' rights under the laws of Contracting Parties or by reason of any earlier Act or any agreement other than this Convention concluded between members of the Union.

## Article 41

## Original and Official Texts of the Convention

(1) [*Original*] This Convention shall be signed in a single original in the English, French and German languages, the French text prevailing in case of any discrepancy among the various texts. The original shall be deposited with the Secretary-General.

(2) [*Official texts*] The Secretary-General shall, after consultation with the interested Governments, establish official texts of this Convention in the Arabic, Dutch, Italian, Japanese and Spanish languages and such other languages as the Council may designate.

## Article 42

## Depositary Functions

(1) [*Transmittal of copies*] The Secretary-General shall transmit certified copies of this Convention to all States and intergovernmental organizations which were represented in the Diplomatic Conference that adopted this Convention and, on request, to any other State or intergovernmental organization.

(2) [*Registration*] The Secretary-General shall register this Convention with the Secretariat of the United Nations.

## Resolution on Article 14(5)

The Diplomatic Conference for the Revision of the International Convention for the Protection of New Varieties of Plants held from March 4 to 19, 1991, requests the Secretary-General of UPOV to start work immediately after the Conference on the establishment of draft standard guidelines, for adoption by the Council of UPOV, on essentially derived varieties.

## Recommendation Relating to Article 15(2)

The Diplomatic Conference recommends that the provisions laid down in Article 15(2) of the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as Revised at Geneva on November 10, 1972, on October 23, 1978, and on March 19, 1991, should not be read so as to be intended to open the possibility of extending the practice commonly called “farmer’s privilege” to sectors of agricultural or horticultural production in which such a privilege is not a common practice on the territory of the Contracting Party concerned.

## Common Statement Relating to Article 34

The Diplomatic Conference noted and accepted a declaration by the Delegation of Denmark and a declaration by the Delegation of the Netherlands according to which the Convention adopted by the Diplomatic Conference will not, upon its ratification, acceptance, approval or accession by Denmark or the Netherlands, be automatically applicable, in the case of Denmark, in Greenland and the Faroe Islands and, in the case of the Netherlands, in Aruba and the Netherlands Antilles. The said Convention will only apply in the said territories if and when Denmark or the Netherlands, as the case may be, expressly so notifies the Secretary-General.

# UPOV: TEST GUIDELINES BY CROP

Test Guidelines - English Index

Legend: tr Trilingual version
E English version
F French version
G German version
S Spanish version

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| 056 | tr | Almond |
| 029 | tr | Alstroemeria |
| 086 | tr | Anthurium |
| 014 | tr | Apple |
| 163 | E F G S | Apple Rootstocks |
| 070 | tr | Apricot |
| 130 | tr | Asparagus |
| 141 | tr | Aster |
| 097 | tr | Avodado |
| 123 | tr | Banana |
| 019 | tr | Barley |
| 060 | E F G S | Beetroot |
| 030 | tr | Bent |
| 068 | tr | Berberis |
| 040 | tr | Black Currant |
| 063 | E F G S | Black Radish |
| 116 | tr | Black Salsify, Scorzonera |
| 073 | tr | Blackberry |
| 137 | tr | Blueberry |
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| 008 | tr | Broad Bean, Field Bean |
| 151 | tr | Broccoli |
| 054 | tr | Brussels Sprouts |
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| 143 | tr | Chick-Pea |
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| 105 | tr | Chinese Cabbage |
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| 026 | tr | Chrysanthemum |
| 083 | tr | Citrus (Oranges, Mandarins, Lemons and Grapefruit) |

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| 032 | | | | tr | Common Vetch |
| 075 | | | | tr | Cornsalad |
| 088 | | | | tr | Cotton |
| 091 | | | | tr | Crown of Thorns |
| 061 | | | | tr | Cucumber, Gherkin |
| 090 | | | | tr | Curly Kale |
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| 098 | | tr Kiwifruit |
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| 095 | | tr Lagerstroemia |
| 106 | | tr Leaf Beet |
| 154 | E F G S | Leaf Chicory |
| 085 | E F G S | Leek |
| 083 | | tr Lemons |
| 013 | | tr Lettuce |
| 127 | | tr Leucadendron |
| 128 | | tr Leucospermum |
| 059 | | tr Lily |
| 168 | E F G S | Limonium |
| 094 | | tr Ling, Scotch Heather |
| 139 | | tr Lingonberry |
| 057 | | tr Linseed |
| 159 | E F G S | Loquat |
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| 066 | | tr Lupins |
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| 147 | | | | | tr | Pyracantha, Firethorn |
| 169 | E | F | G | S | | Pyrus Rootstocks |
| 100 | | | | | tr | Quince |
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| 094 | | | | | tr | Scotch Heather |
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| 157 | E | F | G | S | | Serruria |
| 046 | E | F | G | S | | Shallot |
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| 119 | | | | | tr | Squash |
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| 022 | | | | | tr | Strawberry |
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End of English index

**THE UNITED STATES PLANT VARIETY PROTECTION WEBSITE**

www.usda.com

**Science and Technology Programs**

**Mission**

The Plant Variety Protection Office administers the Plant Variety Protection Act, by issuing Certificates of Protection in a timely manner. The Act provides legal intellectual property rights protection to developers of new varieties of plants which are sexually reproduced (by seed) or tuber-propagated.

**General Information**

What is Plant Variety Protection?(PVP)

Who may apply for PVP?

How is protection obtained?

What is the total cost of protection?

What actions are people prohibited from taking with a protected variety?

What exemptions are there to the protection provided?

The Plant Variety Protection Act (PVPA)

Application Requirements

Forms and Instructions

PVP Crop Description Databases

PVP Application/Certificate Status Database

PVP Office Official Journal

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Other Links of Interest for PVPO Viewers

What is Plant Variety Protection (PVP)?

**The Plant Variety Protection Act (PVPA)**, enacted in December of 1970, and amended in 1994, provides legal intellectual property rights protection, to developers of new varieties of plants that are sexually reproduced (by seed) or are tuber-propagated. Bacteria and fungi are excluded. The PVPA is administered by the United States Department of Agriculture.

A Certificate of Protection is awarded to an owner of a variety after an examination shows that it is new, distinct from other varieties, and genetically uniform and stable through successive generations.

The term of protection is 20 years for most crops and 25 years for trees, shrubs, and vines. The owner of a U.S. protected variety has exclusive rights to multiply and market the seed of that variety.

Who benefits from PVP?

The public benefits as the recipient of quality food, feed, fiber, and other products that result directly from improved plant varieties. Growers of food and ornamental, industrial, or medicinal crops benefit when higher quality varieties are available. Plant Variety Protection allows owners of new varieties to maintain control over the purity and the marketing of the variety. Such protection helps companies or

individuals spending time and money developing a variety to obtain a return on their investment.

Who may apply for PVP?

Anyone who is the owner, breeder, developer, or discoverer of a unique cultivator of a sexually reproduced or tuber-propagated plant may apply for Plant Variety Protection. This applies to citizens of the United States, as well as citizens of countries that are members of the International Union for the Protection of New Varieties of Plants (UPOV). The applicant may be an individual, a public institution, or a corporation.

What if I've already sold seed of my variety but would still like to have it protected?

As long as you have not sold seed of the variety, offered or advertised it for sale for more than 1 year in the United States, prior to the date your application is filed in the Plant Variety Protection Office, your variety is still eligible for protection. You have more than one year of eligibility if the variety has only been sold in a foreign country. Ordinarily that time would be 4 years, and 6 years for a tree or vine.

How is protection obtained?

The Plant Variety Protection Office will provide application forms for protection of a plant variety with instructions on how to file applications. To obtain an Application by mail, please send an inquiry via the Webmaster, or mail written inquiries to:

**Cheryl Sultzer, Webmaster**
**Plant Variety Protection Office**
National Agricultural Library, Room 500
10301 Baltimore Boulevard
Beltsville, MD 20705-2351

Phone: 301-504-5518
Fax: 301-504-5291
E-Mail: *Cheryl.Sultzer@usda.gov*

Please include a complete mailing address with all inquiries.

**What is the total cost of protection?**

The total cost of protection is $2,750. This price includes $2,450 for the application, examination, and the certificate fee of $300, upon issuance of the certificate. These fees are subject to change.

**What protection do I obtain?**

Without explicit consent from the owner, a person is prohibited from selling, marketing, offering delivering, consigning, exchanging, or exposing the variety for sale. In addition, a person is prohibited from soliciting an offer to buy the variety, transfer, or possess it in any manner. It is also illegal to import or export the variety, sexually multiply it, propagate it by tuber, use the variety in producing (as distinguished from developing) a hybrid, or condition the variety for the purpose of propagation.

**Does this mean that the home gardener or farmer cannot propagate the seed of a protected variety and save it for future planting?**

No. Growers and home gardeners can grow any legally purchased and protected variety they wish. They can collect and save the seed for future planting on their own holdings without violation of the law.

**What exemptions are there to the protection provided?**

In general, there are two exemptions to the protection provided.

1. A research exemption to allow the use for breeding to develop a new variety; and
2. A farmer's exemption to allow the saving of seed for the sole use of replanting the farmer's land. Neither plant patents nor utility patents provide these exemptions.

**How is protection of the variety enforced?**

The owner of a protected variety may bring civil action against persons infringing on his or her rights. The owner may ask a court to issue an injunction to prevent others from further violations. It is the owner of the protected variety who must bring suit in such cases. USDA will not take that action. In the USA, intellectual property protection for plants is provided through plant patents, plant variety protection an utility patents. Plant patents provide protection for asexually reproduced (by vegetation) varieties excluding tubers. Plant variety protection provides protection for sexually (by seed) reproduced varieties including tubers, $F_1$ hybrids, and essentially derived varieties. Utility patents currently offer protection for any plant type or plant parts. A plant variety can also receive double protection under a utility patent and plant variety protection.

For additional information concerning utility and plant patents please contact the Patent and Trademark Office at Patents and Trademarks, Washington, DC, 20231, or their internet web site at: http: //www.uspto.gov. Their web site provides answers to frequently asked questions concerning patents, guides to filing utility and plant patent applications, and access to their database.

**Application Requirements**

The name or temporary designation of the new variety;

proof that the variety is distinct, uniform , and stable;

The pedigree, breeding methods, and selection criteria used in developing the variety;

A statement of the basis of ownership and explanation of who, including the breeder, has rights to the variety;

A sample of at least 2,500 of the untreated viable basic seed required to reproduce the variety, or for a tuber-propagated variety, declaration that a viable cell culture will be deposited in a public depository and will be maintained for the duration of the certificate; and

Filing and examination fees totaling $2,450 payable when the application is submitted.

**Proof:** Proof of the distinctness, uniformity, and stability of the new variety lies with the owner.

**Distinctness:** The applicant may:

1. List the single variety he or she believes is the one most similar to the new variety and describe how the new variety differs from it;
2. List a group of varieties to which the new variety is similar, and describe how it differs from that group; or,
3. Describe how the variety differs from all other known varieties in the crop

kind.

Additionally, the PVP Office maintains databases for crops of both public and private varieties. The examiner uses those and other sources to determine which, if any, varieties are indistinguishable from the new one. If the examiner finds varieties that appear to be indistinguishable from the application variety, the applicant will be notified that supplemental data are necessary. To obtain additional data, applicants may perform additional field or greenhouse replications and may use DNA profiling other analyses to substantiate distinctness. The USDA does not perform tests to confirm distinctness of a variety. That responsibility rests with the applicant.

**Uniformity:** A statement of uniformity must report the level of variability in any characteristic of the variety. Variation which is predictable, describable, and commercially acceptable may be allowed.

**Stability:** A statement of genetic stability is required, showing the number of cycles of seed reproduction for which the variety has remained unchanged in all distinguishing characteristics.

**Description of Contents of a Complete Application and Exhibit Forms**

**Note:** PVP is working on making forms and guidelines available on this website, however they all are not available. Please contact our office for any forms or guidelines that you do not find on our website.
A PVP application consists of a completed and signed Form SD-470 which includes:

1. Exhibits A, B, C, & E (Exhibit D is optional);
   a) Exhibit A (Breeding History)
   b) Exhibit B (Statement of Distinctness)
   c) Exhibit C (Objective Description)
   d) Exhibit D (Additional descriptive Information)
   e) Exhibit E (Statement of Ownership)

2. A sample of at least 2,500 untreated viable seeds capable of propagating the application variety, for a tuber propagated variety a verification that a viable cell culture will be deposited; and ,

3. a check drawn on a U.S. bank for the current fee of $2,450.00 (application and examination fee), payable to "Treasure of the United States".

**Form SD-470**

The applicant is required to give their name, address, representative, the variety's genus, species, and the variety name, except that a temporary name will suffice until the certificate is issued. The proposed variety name must also be cleared with the Seed Regulatory and Testing Branch to avoid conflicts with other variety names. The Seed Regulatory and Testing Branch may be contacted at:

U.S. Department of Agriculture
Agricultural Marketing Service

Livestock and Seed Programs
Seed Regulatory and Testing Branch
Building 306, Room 213, BARC-East
Beltsville, Maryland 20705-2325

Or contact their web site at http://www.ams.usda.gov/lsg/seed/ls-sd.htm

In addition, the applicant must complete a statement for the basis of the claim that the variety is new. A variety may be considered new only if propagating or harvested material of the variety has not been sold or otherwise disposed of to other persons for purposes of exploitation of the variety for more than 1 year in the U.S. or 4 years outside of the U.S.

**Exhibit A--Breeding History**

The applicant is required to provide:

1. A full disclosure of the genealogy back to publicly known varieties, lines, or clones, including the breeding method;
2. The details of subsequent stages of selection and multiplication used to develop the variety;
3. A statement of uniformity reporting the level of variability in any characteristics of the variety (commercially acceptable variability is allowed);
4. A statement of genetic stability showing the number of cycles of seed reproduction for which the variety has remained unchanged in all distinguishing characteristics;
5. The type and frequency of variants observed during reproduction and multiplication; and
6. The frequency of off-types observed or known to occur.

See the Guidelines Exhibit A, Origin and Breeding History.

**Exhibit B--Statement of Distinctness (Formally Titled "Novelty Statement")**

The applicant is required to give a summary of the variety's distinctness, stating clearly how the application variety may be distinguished from all other varieties in the same crop. If the variety is most similar to one variety or group of varieties, the applicant must:

1. Identify these varieties and state all differences objectively;
2. Attach statistical data for characters expressed numerically and demonstrate that these are clear differences; and
3. Submit, if helpful, seed and plant specimens or photographs (prints) of seed and plant comparisons that clearly indicate distinctness.

See the Guidelines Exhibit B, Statement of Distinctness.

**Exhibit C--Objective Description of Variety**

The PVP Office has prepared forms for the applicant to provide a botanical description of the variety for most crops. These forms list the botanical characteristics for a kind of crop and the degree of expression of each characteristic. These forms also provide a list of recommended varieties that the applicant should compare to the application variety. The applicant needs to complete the form for his/her variety as thoroughly as possible.

**Exhibit D--Optional Supporting Information**

The applicant may provide additional information, specimens, and/or materials in support of the claims of the application.

**Exhibit E--Statement of Ownership**

The applicant is required to furnish a statement for the basis of the applicant's ownership. The PVP Office has prepared a form to simplify this requirement. The form also includes a statement to verify the applicant is eligible to file for PVP in the U.S.

**The Plant Variety Protection Act--Federal Regulations**

**Forms and Instructions**

- The Latest Application Form SD-470
- Instruction Page
- All Exhibit C Forms
- Exhibit E Form
- Guidelines for Exhibit A--Origin and Breeding History
- Guidelines for Exhibit B--Statement of Distinctness

**Plant Variety Protection Office Official Journal**

**Other Links of Interest for PVPO Viewers:**

The Seed Regulatory and Testing Branch
http://www.ams.usda.gov/lsg/seed/ls-sd.htm

U.S. Patent and Trademark Office
http://www.uspto.gov/

Union Internationale Pour La Protection Des Obentions Vegetales
http://www.upov.org/

World Seed Industry Organization
http://www.worldseed.org/

International Seed Trade Association
http://www.seedtest.org/

PVP Application/Certificate Status Database
http://www.ars-grin.gov/cgi-bin/npgs/html/pvplist.pl

PVP Crop Description Databases

The PVP crop databases are used to scrutinize the most similar varieties to the application variety and verify the application variety is distinct. These databases contain descriptions of varieties for all PVP applications in the U.S. and the descriptions for all varieties that are publicly known or a matter of common knowledge. A publicly known variety, according to the PVP Act, is "a variety that is adequately described by a publication reasonably considered to be a part of the public technical knowledge in the United States". The PVP Act requires that the

description include a disclosure of the principal characteristics by which a variety can be distinguished.

As time permits, the PVP Office is posting a public version of the crop databases. The posted public crop databases do not contain an applicant's description for a variety unless a PVP certificate has been issued for that variety, as they are confidential.

**What actions are people prohibited from taking with a protected variety?**

Without explicit consent from the owner, a person is prohibited from : selling, marketing, offering, delivering, consigning, exchanging, or exposing the variety for sale. In addition, a person is prohibited from soliciting an offer to buy the variety or transfer or possess it in any way. It is also illegal to import or export the variety, sexually multiply it, propagate it by tuber, use the variety in producing (as distinguished from developing) a hybrid, or condition the variety for the purpose of propagation.

Does this mean that the home gardener or farmer cannot propagate the seed of a protected variety and save it for future planting?

No. Growers and home gardeners can grow any legally purchased protected variety they wish. They can collect and save the seed for their own future planting without violation of the law.

How is protection of the variety enforced?

The owner of a protected variety may bring civil action against persons infringing on his or her rights. The owner may ask a court to issue an injunction to prevent others from further violations. It is the owner of the protected variety, however, who must bring suit in such cases. USDA will not take that action.

**Current public crop database in a searchable format:**

Lettuce http://www.ars-grin.gov/~dbmuqs/pvpo.html

Soybean http://probe.nal.usda.gov:8300/cgi-bin/browse/PVPSoy

Wheat http://probe.nal.usda.gov:8300/cgi-bin/browse/PVPWheat

**Current public crop databases available for download:**

Lettuce ftp://probe.nalusda.gov/pub/pvpo/lettuce

Maize ftp://probe.nalusda.gov/pub/pvpo/corn

Sorghum ftp://probe.nalusda.gov/pub/pvpo/sorghum

Soybean ftp://probe.nalusda.gov/pub/pvpo.soybean

Wheat ftp://probe.nalusda.gov/pub/pvpo/wheat

**For more information on Plant Variety Protection contact:**

**Cheryl Sultzer, Webmaster**
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10301 Baltimore Avenue, Room 500
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## THE JORDANIAN PLANT VARIETY PROTECTION LAW (DRAFT)

# Draft
# Law No. ( ) for the Year 2000
# The Law for the Protection of New Varieties of Plants

**Article (1)**

This Law shall be known as (The Law for the Protection of New Varieties of Plants for the Year 2000), and shall come into force thirty days after the date of its publication in the Official Gazette.

Definitions

**Article (2)**

**THE FOLLOWING WORDS AND PHRASES, WHEREVER MENTIONED IN THIS LAW SHALL HAVE THE MEANINGS DESIGNATED HEREUNDER, UNLESS OTHERWISE INDICATED BY CONTEXT:**

Ministry: Ministry of Agriculture.

Minister: Minister of Agriculture.

Plant Variety: The hierarchy of the plants in the Plants Kingdom shall be from the grouping, to the rank, to the family, to the genus, to the specie, to the variety.

Variety: Any plant grouping within a single botanical taxon of the lowest known rank, irrespective of whether the conditions for the grant of the protection right are fully met, and is defined by the expression of the characteristics resulting from a genotype or combination of genotypes, distinguished from any other plant grouping by the expression of at least one of the said characteristics, and considered as one unit with regard to its suitability for being propagated without changing any of its characteristics.

The Protected Variety: The variety that is registered according to the provisions of this Law.

**Breeding:** **To breed, or to discover and develop, a new plant variety.**

Breeder: The person who bred, or discovered and developed, a new plant variety, or his successor in title.

The Registrar: The New Plant Variety Registrar, nominated by the Minister.

The Register: The New Plant Variety Register.

**Article (3)**

The provisions of this Law shall apply on varieties thereunder plant genera or species, which shall be specified in the Regulation issued in accordance with the provisions of this Law.

**Article (4)**

A- A Register named "The New Plant Variety Register" shall be established at the Ministry, under the supervision of the Registrar, in which records shall be maintained of all information related to the new plant varieties, their denominations, names and addresses of their breeders, registration certificates, and any changes thereto resulting from procedures and legal acts including the following:

1- Any assignment, transfer of ownership, or license in respect of its use granted by the owner to others, subject to the confidentiality provisions in the licensing contract.
2- The hypothecation or attachment placed upon the protected variety or any restriction on its use.

B- The Register and the documents related to the rights granted for the breeder shall be available for the public. The growing tests and any other necessary tests provided for in this Law shall also be available for the public, in accordance with the Instructions issued by the Minister for this purpose, which shall be published in the Official Gazette.

C- The Ministry may maintain computerized records for the registration of varieties and the related data thereto, such data and documents retrieved therefrom and certified by the Registrar shall be valid proof against others, unless the interested party proves otherwise.

**Registration of New Plant Varieties**

**Article (5)**

The variety may be registered if the following conditions are met:

A- 1- If it is new, in the sense that, at the date of filing the application or the priority date stated in paragraph (A) of Article (9) of this Law, as the case may be, propagating or harvesting material of the variety has not been sold or otherwise transferred to others, by or with the consent of the breeder, for purposes of exploitation of the variety according to the following:

- For more than a year inside the Kingdom, and for more than four years outside the Kingdom.
- For more than six years outside the Kingdom, in the case of trees and vines.

2- The variety does not lose its novelty if it is sold or transferred to others for the purpose of research and development, or if it is transferred to others as a result of an infringement upon the breeder's right.

B- If it is distinct, in the sense that, it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the date of filing of the application. In particular, the filing of an application for registering another variety, or for registration thereof in an official register of varieties in any country, shall be deemed to render that other variety a matter of common knowledge from the date of the application, provided that the application leads to the registration of the variety and to accord the right therein to the breeder.

C- If it is uniform, in the sense that, it is sufficiently uniform in its relevant characteristics, subject to the variation that may be expected from the particular features of its propagation.

D- If it is stable, in the sense that, its relevant characteristics remain unchanged after repeated propagation, or in case of a particular cycle of propagation, at the end of each such cycle.

**Article (6)**

The right to register the variety shall be as follows:

A- To the breeder or to whom the variety right passes thereafter.

B- To the persons participating in its breeding, if it is the result of their joint efforts, provided that it is registered equally and jointly between them, unless agreed otherwise.

C- To the first breeder to file an application, if the breeding is independently made by more than one person.

D- To the employer, if the breeding is a result of an employment contract, which requires the employee to carry out such breeding, unless otherwise stipulated by contract.

**Article (7)**

The registration of a variety shall be as follows:

A- An application for registration shall be filed with the Registrar, on the form designated for this purpose, stating the botanical taxon of the variety, the suggested denomination, and any other issues or data specified in the Regulation issued in accordance with the provisions of this Law.

B- The application shall be limited to one variety, which shall be subject to the payment of the prescribed fees.

4th- If the application is filed by a non-national person in the Kingdom or a non-resident, the breeder shall have to appoint a legal representative in the Kingdom.

**Article (8)**

A- The date the Registrar receives the application shall be considered the date of filing, provided that the application fulfills all the legal requirements, and attached thereto all the data indicating the identity of the applicant and a sample of the variety subject to registration.

B- Where the Registrar finds that the application has not fulfilled the requirements stated in paragraph (A) of this Article, he shall invite the applicant to fulfill such requirements, or to make the necessary amendments within thirty days of notification, and shall record the date of fulfilling such requirements as the date of filing of the application. Otherwise, the Registrar shall have the right to issue a decision that would deem the applicant to have abandoned the application. His decision may be appealed to the High Court of Justice within sixty days of its notification.

**Article (9)**

A- 1- The applicant of a variety may claim priority in the application, for an application submitted by him and filed on a prior date in a country with which the Kingdom is a party to a treaty to protect intellectual property, provided that the application is filed in the Kingdom within a period not exceeding twelve months, calculated from the day following the date of filing of the first application.

2- If the application for registration includes a priority right, according to clause (1) of this paragraph, the Registrar may request the applicant within three months from the date of filing of an application, to submit a copy of the documents which constitute the first application certified to be a true copy by the office with which it is filed. The Registrar may also request the applicant, within the period stated, to submit any samples or evidence to prove that the variety which is the subject matter of both applications is the same. In such case, the date of filing of the application for registration shall be the same date in which the application was filed in the other country.

B- If the applicant fails to prove the priority right according to paragraph (A) of this Article, the application shall be registered as of the date of filing with the Registrar.

C- The applicant may request for an additional period of two years after the expiration of the priority period, to provide the Registrar with the information, documents and materials required according to the Law, for the purpose of examination according to Article (10) of this Law, provided that, if the first application is rejected or withdrawn in the other country, the applicant shall be given six months from the date of rejection or withdrawal of the application, to submit the information, documents, and material required for the examination.

**Article (10)**

A- The variety shall undergo a technical examination to verify the following:

3. It belongs to the botanical taxon stated in the application for registration.
4. It fulfills the requirements of distinction, uniformity and stability stated in paragraphs (B, C and D) of Article (5) of this Law.

B- The examination provided for in clause (2) of paragraph (A) of this Article shall be made under the supervision of the Ministry in one of the following methods:

3. To rely on growth and germination examinations, and any other essential exams or tests, made by a technical authority inside or outside the Kingdom, if such tests or exams are carried out in environmental circumstances consistent with the environmental circumstances in the Kingdom; or,
4. The Ministry may carry out the tests and exams stated in clause (1) of this paragraph by itself, or through any authority on its behalf and on the breeder's expense.

C- A Technical Committee of experts shall be formed by virtue of Instructions issued by the Minister to verify the results of the tests and exams stated in paragraph (B) of this Article, in order to conclude the procedures of the registration of the variety, provided that such Instructions determine the other tasks of the Committee, including the way it functions, makes its decisions, and all other matters related thereto.

**Article (11)**

A- The Registrar may request the applicant to furnish all the related information, documents, and required materials to carry out the technical examination provided for in Article (10) of this Law, within the period determined in the Regulation issued according to this Law. If such information, documents and materials are not furnished, the Registrar shall have the right to issue a decision that would deem the applicant to have abandoned his application. The Registrar's decision in this regard may be appealed to the High Court of Justice within sixty days of its notification.

B- The examination provided for in Article (10) of this Law is for the purpose of approving of the registration. The examination may also be carried out after the

registration for the purpose of verifying the stability and uniformity of the variety.

**Article (12)**

A- If the application fulfilled all the conditions and requirements provided for in this Law, the Registrar shall announce its acceptance, and shall grant the applicant with a preliminary approval, which shall be published in the Official Gazette after collecting the prescribed fees. The announcement shall include the plant variety and denomination thereof.

3rd- Any person shall be entitled to object the registration of any new plant variety at the Registrar within ninety days of the publication of the preliminary approval in the Official Gazette.

C- The period for publication, information to be published, objection procedures on preliminary approval for accepting the registration, conditions for extending the periods of objection, notifications, and other matters related thereto, shall be determined in the Regulation issued in accordance with the provisions of this Law.

**Article (13)**

The applicant shall be entitled to a temporary protection between the period of the publication of the application in the Official Gazette and the date of the registration of the variety. The applicant may use the variety within such period, and take procedures to prove any infringement thereof.

**Article (14)**

If no objection on the registration of the variety is submitted, or if it is rejected, the Registrar shall register the variety and grant the breeder a certificate for this purpose after collecting the prescribed fees.

**Protection of the Variety**

**Article (15)**

Subject to the provisions of Articles (16) and (17) of this Law:

A- The breeder, after registration thereof, shall have the right to protect the variety, by preventing others not having his consent from doing the following, in respect of the propagating material of the protected variety for commercial purposes:

1- Production or reproduction (multiplication).
2- Conditioning for the purpose of propagation.
3- Offering for sale.
4- Selling or other marketing activities.
5- Exporting.

6- Importing.
7- Stocking for any of the purposes mentioned in this paragraph.

B- The acts referred to in paragraph (A) of this Article in respect of harvested or reaped material, including entire plants or parts of the plants, obtained through the unauthorized use of propagating material of the protected variety shall require the authorization of the breeder, unless the breeder has had reasonable opportunity to exercise his right in relation to the said propagating material.

C- The provisions of paragraphs (A) and (B) of this Article shall also apply on the following varieties:

4. Varieties, which are essentially, derived from the protected variety where the protected variety is not itself an essentially derived variety. A variety shall be deemed to be essentially derived from another variety if the following conditions are met:
   - if it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety,
   - if it is clearly distinguishable from the initial variety,
   - if except for the differences, which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.
5. Varieties, which are not clearly distinguishable in accordance with, paragraph (B) of Article (5) of this Law from the protected variety.
6. Varieties whose production requires the repeated use of the protected variety.

D- In particular, essentially derived varieties may be obtained as a result of the selection of natural or induced mutants, or the selection of a variant individual from plants of the initial variety, backcrossing, or transformation by genetic engineering.

E- Any person committing any of the acts stated in paragraphs (A) and (B) of this Article, shall be considered committing an act of infringement upon the rights of the breeder of the protected variety, and shall be subject to legal liability, if he knew or if he should have known that he is infringing upon the breeder's rights of the protected variety.

**Article (16)**

Notwithstanding what is stated in Article (15) of this Law, the breeder's right shall not extend to the following:

A- Acts done privately for non-commercial purposes, for experimental purposes, or for the purpose of breeding new varieties.

B- Restriction of farmers from using for propagating purposes, on their own lands, the product of the harvest which they have obtained by planting any protected

variety, or any variety as stated in clauses (1) and (2) of paragraph (C ) of Article (15) of this Law.

**Article (17)**

A- The breeder's right does not extend to the acts related to the materials of the protected variety, or the materials of any variety stated in paragraph (C ) of Article (15) of this Law, or any materials derived from the said material, which the breeder had sold or marketed in any other mean in the Kingdom by himself or with his consent, unless such acts:

1. Involve further propagation of the variety in question, or
2. Involve exportation of the material of the variety, which enables the propagation of the variety, into a country, which does not protect varieties of the plant genus, or species to which the variety belongs, unless the exportation is for consumption purposes.

B- For purposes of paragraph (A) of this Article, "*material*" means propagating material of any kind and harvesting material, including entire plants or parts of plants.

**Article (18)**

The term of protection for the protected variety shall be for twenty years beginning from the date of filing of an application for registration. As for trees and vines the term of protection shall be for twenty-five years.

**Transfer of Ownership, Hypothecation, and Attachment of the Variety**

**Article (19)**

A- The breeder's rights may be transferred, completely or partially, with or without consideration, and may be subject to hypothecation or attachment.

5th- Rights in a protected variety may pass by succession.

6th- The procedures of the transfer of ownership of the protected variety, its hypothecation, attachment and all other legal acts related thereto, shall be determined in Instructions issued by the Minister for this purpose, which shall be published in the Official Gazette.

7th- Transfer of ownership of a variety and its hypothecation shall not be effective against others prior to the date of its recording in the Register, which shall be published in the Official Gazette.

**Licensing to Exploit the Variety**

**Article (20)**

The breeder may grant others license to exploit the protected variety, by virtue of a written contract to be recorded with the Registrar.

**Article (21)**

A- The Minister may, upon the Registrar's recommendation, grant to other than the breeder, and without his consent, a license to exploit the variety for the public interest. In such case, the breeder shall have an adequate remuneration taking into consideration the economic value of the license.

B- The Minister may, upon his own initiative, or upon the breeder's request, cancel the compulsory license if the licensee violates any of the conditions thereof, or if the reasons for granting it are no longer applicable. This cancellation shall not affect the related rights of others having interest in the license.

Nullification and Cancellation of the Registration of the Variety

**Article (22)**

The registration of a variety shall be considered null in any of the following cases:

A- If it is proved that the variety is not new, or distinct at the date of filing of the application, or the priority date, as the case may be.

B- If it is proved that the variety is not uniform or stable at the date of filing of the application or the priority date, as the case may be, where the registration had been essentially based upon information and documents furnished by the breeder on the said date.

C- If the registration is made for a person other than the breeder contrary to the provisions of this Law.

**Article (23)**

A- The Registrar may cancel the registration of a variety in any of following cases:

1. If the stability and uniformity of the variety is not available anymore.
2. If the breeder does not provide the Registrar with the information, documents or materials deemed necessary for verifying the maintenance of the variety.
3. If the breeder fails to pay the annual prescribed fees.
4. If the breeder does not propose, where the denomination of the variety is cancelled after the registration, a suitable denomination for the protected variety.

B- For purposes of implementing clause (2), (3), and (4) of paragraph (A) of this Article, the Registrar shall notify the breeder of the cancellation, provided that the cancellation takes place after the lapse of the period determined in the Regulation issued in accordance with this Law.

**Article (24)**

The Registrar shall record in the Register, the decision of the nullification of the registration of the variety or cancellation thereof, and such shall be published in the Official Gazette.

**Article (25)**

All the Registrar's decisions may be subject to appeal to the High Court of Justice within sixty day from the date of its notification.

## The Variety Denomination

**Article (26)**

A- Each variety shall be registered with a denomination, which shall be considered its designation. The denomination may consist of a word, combination of words, combination of words and figures, or combination of letters and figures, with or without an existing meaning. It may not consist solely of figures except where this is an established practice for designating varieties, provided that the denomination enables the variety to be identified in all cases.

B- If the denomination had already been used for the variety in the Kingdom, or in any country, or proposed or registered in any other country, no other denomination may be used for the purpose of registration, unless there is ground for the refusal of the denomination, and another denomination shall be registered for the variety in the Register.

C- It is prohibited to use, or register any denomination identical or similar to another denomination which designates the variety, in a manner that might cause confusion in relation to an existing variety of the same plant species or a closely related species, whether such denomination is registered or known in the Kingdom, or any other country. Such prohibition shall remain even after the expiration of the exploitation of the variety, if the denomination acquired a certain connotation in relation to the variety.

D- Subject to paragraph (E) of this Article, any person who offers for sale, sells or otherwise markets propagating material of a protected variety shall be obliged to use the denomination of the variety, even after the expiration of the protection period.

E- Prior rights of others shall not be affected, by reason of the use of a denomination of a variety, in such a case, the Registrar shall require the breeder to propose another denomination for the variety.

F- When a variety is offered for sale or marketed, the use of the variety denomination in association with a trademark, trade name, or other similar indication shall be permitted, subject to the denomination remaining easily recognized.

**Article (27)**

A denomination of a variety may not be registered if:

A- It is contrary to the provisions of the Law.

B- It is contrary to the public order and mortality.

C- It is liable to mislead or to cause confusion with respect to the characteristics, value, identity, or geographical origin of the variety, or the identity of the breeder.

**Article (28)**

The suggested denomination of the variety shall be specified in the application. The registration of denominations, publication thereof, and periods related thereto, shall be determined in a Regulation issued according to the provisions of this Law.

**Provisional Measures and Penalties**

**Article (29)**

A- The breeder of a protected variety, when filing a civil lawsuit to prevent the infringement on his rights in the protected variety, or during the course of the hearings, may petition the competent Court for the following, provided that the petition is attached with a bank guaranty or a cash deposit accepted by the Court:

**1- CEASE THE INFRINGEMENT.**

**2- PLACE A PROVISIONAL SEIZURE ON THE VARIETY, SUBJECT MATTER OF THE INFRINGEMENT, WHEREVER FOUND.**

**3- PRESERVE RELEVANT EVIDENCE TO THE INFRINGEMENT.**

B-1. The breeder of a protected variety may, prior to filing a lawsuit, petition the Court to take any of the measures provided for in paragraph (A) of this Article, provided that the petition is attached with a bank guarantee or a cash deposit accepted by the Court, without notifying the counter-party. The Court may approve the petition if the breeder proves any of the following:

- That his rights had been infringed upon,
- That such infringement is imminent and is likely to cause damages of irreparable harm,
- That there is a demonstrable risk of evidence being disappeared or destroyed.

2. If the breeder of the protected variety fails to file the lawsuit within eight days from the date the Court approves his petition, all measures taken in this regard shall be nullified.
3. The counter-party may appeal the court's decision in taking the provisional measures to the Court of Appeal within eight days of notification or acknowledgment thereof. The decision of the Court of Appeal in this regard shall be final.
4. The counter-party may claim compensation for damages he suffered, if it is proven that the petitioner was unlawful in his petition to take provisional measures, or if the petitioner failed to file his lawsuit within the period determined in clause (2) of this paragraph.

C- The defendant may claim compensation for damages he suffered, if the Court decides that the plaintiff's claims are invalid.

D- The Court may seek, in all cases, experts opinion.

E- The Court may order the seizure of the variety the subject matter of infringement, tools, and materials mainly used in the infringement upon the protected variety. The Court may also order destruction of such variety, tools and materials, or use of such outside the channels of commerce.

## General Provisions

**Article (30)**

A- The Council of Ministers shall issue the necessary Regulations for implementing the provisions of this Law, including determining the annual fees for the renewal of registration, and other fees that should be collected in accordance with the provisions of this Law.

B- Instructions referred to in this Law shall be published in the Official Gazette.

**Article (31)**

The Prime Minister and the Ministers shall be responsible for implementing the provisions of this Law.

# JORDANIAN PLANT VARIETY PROTECTION REGULATIONS

(Annotations are in CAPITALS for greater assistance with final formulation / implementation )

# PLANT VARIETY PROTECTION (PVP) REGULATIONS

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**Scope** **FOR NOTES**

Sec. 1 General.

Certificates of protection are issued by the Plant Variety Protection office for new, distinct, uniform, and stable varieties of sexually reproduced or tuber propagated plants. Each certificate of plant variety protection certifies that the breeder has the right, during the term of the protection, to prevent others from selling the variety, offering it for sale, reproducing it, importing or exporting it, conditioning it, stocking it, or using it in producing a hybrid or different variety from it, as provided by the Act.

[THIS FORM OF INTELLECTUAL PROPERTY USUALLY HAS TO FIT WITH OTHER
FORMS OF IP PROTECTION SUCH AS PATENT LAW THAT ORIGINALLY COVERED ONLY ASEXUALLY MULTIPLIED PLANTS. MANY JURISDICTIONS NOW ALLOW PLANT PATENTING. IN JORDAN PATENTING OF PLANTS IS CURRENTLY EXCLUDED.]

**Definitions**

Sec. 2 Meaning of words used in these Regulations.

Words used in the regulations in this part in the singular form will import the plural, and vice versa, as the case may demand. The definitions of terms contained in the Act shall apply to such terms when used in this part. As used throughout the regulations in this part, unless the context requires otherwise, the following terms will be construed to mean:

Abandoned application. An application which has not been pursued to completion within the time allowed by the Office or has been voluntarily abandoned.

Act. The Jordanian Plant Variety Protection Act

Applicant. The person who applied for a certificate of plant variety protection.

Application. An application for plant variety protection under the Act.

Assignee. A person to whom an owner assigns his/her rights in whole or in part.

Board. The Plant Variety Protection Board appointed by the Minister.

Certificate. A certificate of plant variety protection issued under the Act by the Office.

Certified seed. Seed which has been determined by an official seed certifying agency to conform to standards of genetic purity and identity as to variety, which standards have been approved by the Minister.

Decision and order. Includes the Minister's findings of fact; conclusions with respect to all material issues of fact and law, as well as the reasons or basis thereof; and order.

Examiner. An employee of the Plant Variety Protection Office who determines whether a certificate is entitled to be issued. The term shall, in all cases, include the Registrar.

Foreign application. An application for plant variety protection filed in a foreign country.

Hearing Officer. An Administrative Law Judge duly assigned to preside at a hearing held pursuant to the rules of this part.

Office or Plant Variety Protection Office. The Plant Variety Protection Office.

Official Journal. The ``Official Journal of the Plant Variety Protection Office, or the Official Gazette."

Owner. A breeder who developed or discovered a variety for which plant variety protection may be applied for under the Act, or a person to whom the rights to such variety have been assigned or transferred.

Person. An individual, partnership, corporation, association, government agency, or other business or governmental entity.

Minister. The Minister of Agriculture of the Kingdom of Jordan or any other officer or employee of the Ministry of Agriculture, to whom authority has heretofore been delegated, or to whom authority may hereafter be delegated to act in his or her stead.

Registrar. The Examiner in Charge of the Office.

Seed certifying agency. It shall be defined as set forth in the Appropriate Seed Acts

Sale for other than seed purposes. The transfer of title to and possession of the seed by the owner to a grower or other person, for reproduction for the owner, for testing, or for experimental use, and not for commercial sale of the seed or the reproduced seed for planting purposes.

[AS WITH OTHER AREAS OF LAW, ANY TERM NOT SPECIFICALLY DEFINED HERE WILL BE GIVEN ITS PLAIN MEANING. BLACK'S LEGAL DICTIONARY MAY BE USED IN THIS MATTER.]

**Administration**

Sec. 3 Plant Variety Protection Board.

(a) The Plant Variety Protection Board shall consist of 8 members appointed for a 3-year term. The Board shall be appointed every 3 years and shall consist of individuals who are experts in various areas of variety development. The membership of the Board, which shall include farmer representation, shall be drawn approximately equally from the private or seed industry sector and from the government or public sector. No member shall be eligible to act on any matter involving any appeal or questions in which the member or his or her employer has a direct financial interest.

(b) The functions of the Board are to:

(1) Advise the Minister concerning adoption of rules and regulations to facilitate the proper administration of the Act;

(2) Make advisory decisions on all appeals from the examiner or Registrar;

(3) Advise the Minister on the declaration of a protected variety open to use in the public interest; and

(4) Advise the Minister on any other matters under the regulations in this part.

(c) The proceedings of the Board shall be conducted in accordance with the appropriate Jordanian Government Administrative Rules.

[IT IS ADVISABLE FOR THE CRITERIA OF BOARD MEMBERSHIP TO BE DESCRIBED IN A POSITION DESCRIPTION. A FORMAL PROCESS OF APPLICATION AND NOMINATION SHOULD BE ESTABLISHED WITH FIXED DATES FOR CLOSURE OF APPLICATIONS. A PROCESS FOR REVIEW
AND SUBMISSION OF APPLICANTS TO THE MINISTER MUST BE ESTABLISHED.
THE MINISTER SHOULD HAVE FINAL AUTHORITY ON NAMING MEMBERS OF THE PANEL]

## The Application

Sec. 4 General requirements.

(a) Protection under the Act shall be afforded only as follows:

(1) Nationals and residents of the Kingdom of Jordan shall be eligible to receive all of the protection under the Act.

(2) Nationals and residents of Member States of the International Union for the Protection of New Varieties of Plants (including states which are members of an intergovernmental organization which is a UPOV member) shall be eligible to receive the same protection under the Act as is provided to nationals of the Kingdom of Jordan.

(3) Persons who are not entitled to protection under paragraph

(a)(1) or (2) of this section, and who are nationals of a foreign state which is not a member of the International Union for the Protection of New Varieties of Plants, shall be entitled to only so much of the protection provided under the Act, as is afforded by such foreign state to nationals of the Kingdom of Jordan, for the same genus and species under the laws of such foreign state in effect at the time that the application for protection under the Act is filed, except where further protection under the Act must be provided in order to avoid the violation of a treaty to which the Kingdom of Jordan is a party.

(b) Applications for certificates shall be made to the Plant Variety Protection Office. An application shall consist of:

(1) A completed application form, except that the section specifying that seed of the variety shall be sold by variety name only, as a class of certified seed, need not be completed at the time of application.

(2) A completed set of the exhibits, as specified in the application form, unless the examiner waives submission of certain exhibits as unnecessary, based on other claims and evidence presented in connection with the application.

(3) Language and legibility: (i) Applications and exhibits may be in the Arabic or English language and legibly written, typed or printed.

(ii) Any inter-lineation, erasure, cancellation, or other alteration must be made in permanent ink before the application is signed and shall be clearly initialed and dated by the applicant to indicate knowledge of such fact at the time of signing.

(4) To determine the extent of reciprocity of the protection to be provided under the Law, persons filing an application for plant variety protection in the Kingdom of Jordan under the provisions of paragraph (a)(3) of this section shall, upon request furnish the Plant Variety Protection Office with a copy of the current plant variety protection laws and regulations for the country of which the applicant is a national, and an accurate Arabic or English translation of such laws and regulations.

(a) Copies and translations of foreign laws and regulations will be requested only if they are not in the files of the Plant Variety Protection Office.

(b) Applicants may learn whether such a request will be made by writing to the address given in paragraph (c) of this section.

(c) Application and exhibit forms shall be issued by the Registrar.

(d) Effective the date of these regulations and rules of practice, the signature of the applicant, or his or her agent or attorney on any affidavit or other statement filed pursuant to these regulations and rules constitutes a certification by the applicant. The signature certifies that all information relied on in any affidavit or statement filed in the course of the proceeding is knowingly correct and false claims have not been made to mislead.

Sec. 5 Application for certificate.

(a) An application for a plant variety protection certificate shall be signed by, or on behalf, of the applicant.

(b) The application shall state the full name, including the full first name and the middle initial or name, if any, and the capacity of the person executing it.

(c) The fees for filing an application, and search or examination, shall be submitted with the application in accordance with Sections. 175 through 178.

(d) The applicant shall submit with the application:

(1) At least 2,500 seeds of the viable basic seed required to reproduce the variety;

(2) With the application for a tuber propagated variety, verification that a viable cell culture has been deposited in a public depository approved by the Registrar and will be maintained for the duration of the certificate; or

(3) With the application for a hybrid from self-incompatible

parents, verification that a plot of vegetative material for each parent has been established in a public depository approved by the Registrar and will be maintained for the duration of the certificate.

Sec. 6 Specimen requirements.

(a) The applicant may be required by the examiner to furnish representative specimens of the variety, or its flower, fruit, or seeds, in a quantity and at a specified stage of growth, as may be necessary to verify the statements in the application. Such specimens shall be packed and forwarded in conformity with instructions furnished by the examiner. If the applicant requests the examiner to inspect plants in the field before a final decision is made, all such inspection costs shall be borne by the applicant by payment of fees sufficient to reimburse the Office for all costs, including travel, per diem or subsistence, and salary.

(b) Plant specimens submitted in support of an application shall not be removed from the Office except by an employee of the Office or other person authorized by the Minister.

(c) Plant specimens submitted to the Office shall, except as provided below, and upon request, be returned to the applicant at his or her expense after the specimens have served their intended purpose. The Registrar, upon a finding of good cause, may require that certain specimens be retained in the Office for indefinite periods of time. Specimens which are not returned or not retained as provided above shall be destroyed.

Sec. 7 Drawings and photographs.

(a) Drawings or photographs submitted with an application shall disclose the distinctive characteristics of the variety.

(b) Drawings or photographs shall be in color when color is a

distinguishing characteristic of the variety, and the color shall be described by use of Nickerson's or other recognized color chart.

(c) Drawings should be sent flat, or may be sent in a suitable mailing tube, in accordance with instructions furnished by the Registrar.

(d) Drawings or photographs submitted with an application shall be retained by the Office as part of the application file.

Sec. 8 Parts of an application to be filed together.

All parts of an application, including exhibits, should be submitted to the Office together, otherwise, each part shall be accurately and clearly referenced to the application.

Sec. 9 Application accepted and filed when received.

(a) An application, if materially complete when initially submitted, shall be accepted and filed to await examination.

(b) If any part of an application is so incomplete, or so defective that it cannot be handled as a completed application for examination, as determined by the Registrar, the applicant will be notified. The application will be held a maximum of 3 months for completion. Applications not completed at the end of the prescribed period will be considered abandoned. The application fee in such cases will not be refunded.

Sec. 10 Number and filing date of an application.

(a) Applications shall be numbered and dated in sequence in the order received in the Office. Applicants will be informed in writing as soon as practicable of the number and effective filing date of the application.

(b) An applicant may claim the benefit of the filing date of a prior foreign application .
A certified copy of the foreign application shall be filed upon request made by the examiner. If a foreign application is not in the English or Arabic language, an Arabic or English translation, certified as accurate by a sworn or official translator, shall be submitted with the application.

Sec. 11 When the owner is deceased or legally incapacitated.

In case of the death of the owner or if the owner is legally incapacitated, the legal representative (executor, administrator, or guardian) or heir or assignee of the deceased owner may sign as the applicant. If an applicant dies between the filing of his or her application and the granting of a certificate thereon, the certificate may be issued to the legal representative, heir, or assignee, upon proper intervention.

Sec. 12 Joint applicants.

(a) Joint owners shall file a joint application by signing as joint applicants.
(b) If an application for certificate is made by two or more persons as joint owners, when they were not in fact joint owners, the application shall be amended prior to issuance of a certificate by filing a corrected application, together with a written explanation signed by the original applicants. Such statement shall also be signed by the assignee, if any.
(c) If an application has been made by less than all the actual joint owners, the application shall be amended by filing a corrected application, together with a written explanation, signed by all of the joint owners. Such statement shall also be signed by the assignee, if any.

(d) If a joint owner refuses to join in an application or cannot be found after diligent effort, the remaining owner may file an application on behalf of him or herself and the missing owner. Such application shall be accompanied by a written explanation and shall state the last known address of the missing owner. Notice of the filing of the application shall be forwarded by the Office to the missing owner at the last known address. If such notice is returned to the Office undelivered, or if the address of the missing owner is unknown, notice of the filing of the application shall be published once in the Official Journal. Prior to the issuance of the certificate, a missing owner may join in an application by filing a written explanation. A certificate obtained by less than all of the joint owners under this paragraph conveys the same rights and privileges to said owners as though all of the original owners had joined in an application.

Sec. 13 Assigned varieties and certificates.

In case the whole or a part interest in a variety is assigned, the application shall be made by the owner or one of the persons identified in Sec. 11. However, the certificate may be issued to the assignee, or jointly to the owner and the assignee, when a part interest in a variety is assigned.

Sec. 14 Amendment by applicant.

An application may be amended before or after the first examination and action by the Office, after the second or subsequent examination or reconsideration as specified in Sec. 107, or when and as specifically required by the examiner. Such amendment may include a specification that seed of the variety be sold by variety name only as a class of certified seed, if not previously specified or if previously declined. Once an affirmative specification is made, no amendment to reverse such

a specification will be permitted unless the variety has not been sold and labeled or publication made in any manner that the variety is to be sold by variety name, only as a class of certified seed.

Sec. 15 Papers of completed application to be retained.

The papers submitted with a completed application shall be retained by the Office except as provided in Sec. 23(c). After issuance of a certificate of protection the Office will furnish copies of the application and related papers to any person upon payment of the specified fee.

Sec. 16 Applications handled in confidence.

(a) Pending applications shall be handled in confidence. Except as provided below, no information may be given by the Office respecting the filing of an application, the dependency of any particular application, or the subject matter of any particular application. Also, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority of the applicant, or his or her assignee or attorney or agent. Exceptions to the above may be made by the upon a finding that such action is necessary to the proper conduct of the affairs of the Office.

(b) Abandoned applications shall not be open to public inspection. However, if an abandoned application is directly referred to in an issued certificate and is available, it may be inspected or copies obtained by any person on written request, and with written authority received from the applicant. Abandoned applications shall not be returned.

(c) Decisions of the Registrar on abandoned applications not otherwise open to public inspection (see paragraph (b) of this section) may be published or made available for publication at the Registrar's discretion. When it is proposed to release such a decision, the

applicant shall be notified directly or through the attorney or agent of record, and a time, not less than 30 days, shall be set for presenting objections.

[THIS PROVISION IS VERY IMPORTANT. ADEQUATE SECURITY ARRANGEMENTS, SUCH AS COMPUTER PASSWORDS AND DOOR LOCKS ON FILING CABINETS ARE NEEDED TO ENSURE ONLY AUTHORIZED ACCESS TO THE FILES IN THE PVP OFFICE.]

Sec. 17 Publication of pending applications.

Information relating to pending applications shall be published in the Official Journal periodically as determined by the Registrar to be necessary in the public interest. With respect to each application, the Official Journal shall show:

(a) Application number and date of filing;

(b) The name of the variety or temporary designation;

(c) The name of the kind of seed; and

(d) Whether the applicant specified that the variety is to be sold by variety name only as a class of certified seed, together with a limitation in the number of generations that it can be certified.

Additional information, such as the name and address of the applicant or a brief description of the distinctive features of the variety, may be published only upon request or approval received from the applicant, at the time the application is filed or at any time before the notice of allowance of a certificate is issued.

[ AGAIN, NOTE THE NEED FOR PRIOR INFORMED CONSENT FROM THE OWNER OF THE MATERIAL BEFORE PUBLICATION OF MATERIAL OF A PROPRIETARY NATURE]

Sec. 18 Abandonment for failure to respond within the time limit.

(a) Except as otherwise provided in Sec. 104, if an applicant fails to advance actively his or her application within 30 days after the date when the last request for action was mailed to the applicant by the Office, or within such longer time as may be fixed by the Registrar, the application shall be deemed abandoned. The application fee in such cases will not be refunded.

(b) The submission of an amendment to the application, not responsive to the last request by the Office for action, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When the applicant makes a bona fide attempt to advance the application, and is in substantial compliance with the request for action, but has inadvertently failed to comply with some procedural requirement, opportunity to comply with the procedural requirement shall be given to the applicant before the application shall be deemed abandoned. The Registrar may set a period, not less than 30 days, to correct any deficiency in the application.

[STRICT ADHERENCE TO TIME AND NOTICE REQUIREMENTS IS NEEDED FOR THE EFFECTIVE FUNCTIONING, AND RESPECT FOR THE PVP OFFICE]

Sec. 19 Extension of time for a reply.

The time for reply by an applicant to a request by the Office for certain action, shall be extended by the Registrar only for good and sufficient cause, and for a specified reasonable time. A request for extension and appropriate fee shall be filed on or before the specified time for reply. In no case shall the mere filing of a request for extension require the granting of an extension or state the time for reply.

[REFER TO RELATED AREAS OF LAW TO DETERMINE WHAT ARE REASONABLE CAUSES FOR EXTENSION]

Sec. 20 Revival of an application abandoned for failure to reply.

An application abandoned for failure on the part of the applicant to advance actively his or her application to its completion, in accordance with the regulations in this part, may be revived as a pending application within 3 months of such abandonment, upon a finding by the Registrar that the failure was inadvertent or unavoidable and without fraudulent intent. A request to revive an abandoned application shall be accompanied by a written statement showing the cause of the failure to respond, a response to the last request for action, and by the specified fee.

Sec. 21 Voluntary withdrawal and abandonment of an application.

(a) An application may be voluntarily withdrawn or abandoned by submitting to the Office a written request for withdrawal or abandonment, signed by the applicant or his or her attorney or agent of record, if any, or the assignee of record, if any.

(b) An application which has been voluntarily abandoned may be revived within 3 months of such abandonment by the payment of the prescribed fee and a showing that the abandonment occurred without fraudulent intent.

(c) An original application which has been voluntarily withdrawn shall be returned to the applicant and may be reconsidered only by re-filing and payment of a new application fee.

Sec. 22 Assignee.

The assignee of record of the entire interest in an application is entitled to advance actively or abandon the application to the exclusion

of the applicant.

[THIS IS BECAUSE UPON ASSIGNMENT THE ASSIGNEE BECOMES THE TRUE FULL OWNER OF THE MATERIALS]

**Examinations, Allowances, and Denials**

Sec. 100 Examination of applications.

Examinations of applications shall include a review of all available documents, publications, or other material relating to varieties of the species involved in the application, except that if there are fundamental defects in the application, as determined by the examiner, the examination may be limited to an identification of such defects and notification to the applicant of needed corrective action. However, matters of form or procedure need not, but may, be raised by an examiner until a variety is found to be new, distinct, uniform, and stable and entitled to protection.

[THE REVIEW OF ALL PRIOR ART IS ALWAYS A DIFFICULT AND CONTENTIOUS AREA. THE OFFICE SHOULD HAVE ACCESS TO GOOD QUALITY ON-LINE COMPUTER SEARCH CAPACITY. THE BURDEN IS IN THEORY ON THE BREEDER TO DISCLOSE PRIOR ART, BUT IN REALITY THE EXAMINER MUST PERFORM A RIGOROUS CHECK OF PRIOR PUBLICATIONS]

Sec. 101 Notice of allowance.

If, on examination, it shall appear that the applicant is entitled to a certificate, a notice of allowance shall be sent to the applicant or his or her attorney or agent of record, if any, calling for the payment of the prescribed fee, which fee shall be paid within 1 month from the date of the notice of allowance. Thereafter, a fee for delayed payment shall be made as required under Sec. 175.

[THE TIME FRAME HERE IS SHORT, BUT ADHERENCE TO IT IS ESSENTIAL. THIS ALLOWS CLOSURE ON THE MATTER.]

Sec. 102 Amendments after allowance.

Amendments to the application, after the notice of allowance is issued, may be made, if the certificate has not been issued.

Sec. 103 Issuance of a certificate.

(a) After the notice of allowance has been issued, the prescribed fee is received by the Office, and the applicant has clearly specified whether or not the variety shall be sold by variety name only as a class of certified seed, the certificate shall be promptly issued. Once an election is made and a certificate issued specifying that seed of the variety shall be sold by variety name only as a class of certified seed, no waiver of such rights shall be permitted by amendment of the certificate.

(b) The certificate shall be delivered or mailed to the owner.

Sec. 104 Application or certificate abandoned.

(a) Except as provided in paragraph (c) of this section, if the fee specified in the notice of allowance is not paid within 1 month from the date of the notice, the application shall be considered abandoned.

(b) Upon request by the Office, the owner shall replenish the viable basic seed sample of the variety. Upon request, the sample of seed which has been replaced shall be returned to the owner, otherwise it shall be destroyed. Failure to replenish viable basic seed within 3 months from the date of request shall result in the certificate being regarded as

abandoned. No sooner than 1 year after the date of such request, notices of abandoned certificates shall be published in the Official Journal, indicating that the variety has become open for use by the public and, if previously specified to be sold by variety name as ``certified seed only," that such restriction no longer applies.

(c) If the allowance fee, the viable basic seed sample or the fee for delayed payment are submitted within 9 months of the final due date, it may be accepted by the Registrar as though no abandonment had occurred. For good cause, the Registrar may extend for a reasonable time the period for submitting a viable basic seed sample before declaring the certificate abandoned.

(d) A certificate may be voluntarily abandoned by the applicant or his or her attorney or agent of record or the assignee of record by notifying the Registrar in writing. Upon receipt of such notice, the Registrar shall publish a notice in the Official Journal that the variety has become open for use by the public, and if previously specified to be sold by variety name as ``certified seed only," that such restriction no longer applies.

[MODELS ARE AVAILABLE OF OTHER CERTIFICATES FROM OTHER PVP OFFICES. THERE SHOULD BE SOME ARTISTIC VALUE TO THE CERTIFICATE].

Sec. 105 Denial of an application.

(a) If the variety is found by the examiner to be not new, distinct, uniform, and stable, the application shall be denied.

(b) In denying an application, the examiner shall cite the reasons the application was denied. When a reason involves the citation of certain material which is complex, the particular part of the material relied on shall be designated as nearly as practicable. The pertinence of each reason, if not obvious, shall be clearly explained.

(c) If prior domestic certificates are cited as a reason for denial,

their numbers and dates and the names of the owners shall be stated. If prior foreign certificates or rights are cited, as a reason for denial, their nationality or country, numbers and dates, and the names of the owners shall be stated, and such other data shall be furnished, as may be necessary to enable the applicant to identify the cited certificates or rights.

(d) If printed publications are cited as a reason for denial, the author (if any), title, date, pages or plates, and places of publication, or place where a copy can be found shall be given.

(e) When a denial is based on facts known to the examiner, and upon request by the applicant, the denial shall be supported by the affidavit of the examiner. Such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

(f) Abandoned applications may not be cited as reasons for denial.

[THIS IS A CONTENTIOUS AREA. THE PROBLEMS IN THE OFFICE USUALLY BEGIN TO APPEAR ONCE SOMEBODY IS GIVEN A DENIAL. THE KEY TO SUCCESS IN THIS MATTER IS PROCESS AND TRANSPARENCY.
SO LONG AS THE PROCESS IS CLEAR AND THE APPLICANT KNOWS HIS RIGHTS THEN IT SHOULD BE ABLE TO MOVE THROUGH THIS ACTION. IT MAY BE USEFUL FOR STAFF TO RECEIVE SOME TRAINING IN CONFLICT MANAGEMENT AS PART OF A GENERAL TRAINING ON OFFICE PROCESS AND MANAGEMENT.]

Sec. 106 Reply by applicant; request for reconsideration.

(a) After an adverse action by the examiner, the applicant may respond to the denial and may request a reconsideration, with or without amendment of his or her application. Any amendment shall be responsive to the reason or reasons for denial specified by the examiner.

(b) To obtain a reconsideration, the applicant shall submit a request for reconsideration in writing and shall specifically point out

the alleged errors in the examiner's action. The applicant shall respond to each reason cited by the examiner as the basis for the adverse action. A request for reconsideration of a denial based on a faulty form or procedure may be held in abeyance by the Registrar until the question of the variety being new, distinct, uniform, and stable is settled.

(c) An applicant's request for a reconsideration must be a bona fide attempt to advance the case to final action. A general allegation by the applicant that certain language which he or she cites in the application or amendment thereto establishes the variety is new, distinct, uniform, and stable without specifically explaining how the language distinguishes the alleged new, distinct, uniform, and stable variety from the material cited by the examiner shall not be grounds for a reconsideration.

Sec. 107 Reconsideration and final action.

If, upon reconsideration, the application is denied by the Registrar, the applicant shall be notified by the Registrar of the reason or reasons for denial in the same manner as after the first examination. Any such denial shall be final unless appealed by the applicant to the Minister within 60 days from the date of denial. If the denial is sustained by the Minister on appeal, the denial shall be final subject to appeal to the Courts.

[THE MORE THAN CAN BE DONE TO CLEARLY INDICATE TO THE APPLICANT THE BASIS FOR THE DENIAL, AND THE BACKGROUND LEGAL AND TECHNICAL ARGUMENTS, THE LESS LIKELY THE APPLICANT IS TO PERSIST IN A MINISTER LEVEL APPEAL FOR RECONSIDERATION]

Sec. 108 Amendments after final action.

(a) After a final denial by the Registrar, amendments to the

application may be made to overcome the reason or reasons for denial. The acceptance or refusal of any such amendment by the Office and any proceedings relative thereto shall not relieve the applicant from the time limit set for an appeal or an abandonment for failure to reply.

(b) No amendment of the application can be made in an appeal proceeding. After decision on appeal, amendments can only be made to carry into effect a recommendation.

**Correction of Errors in Certificate**

Sec. 120 Corrected certificate--office mistake.

When a certificate is incorrect because of a mistake in the Office, the Registrar may issue a corrected certificate stating the fact and nature of such mistake, without charge, to be issued to the owner and recorded in the records at the Office.

[THIS IS BASIC SENSE. IF THE OFFICE MESSED IT UP, THEY SHOULD STRAIGHTEN IT OUT AT NO COST TO THE APPLICANT]

Sec. 121 Corrected certificate--applicant's mistake.

When a certificate is incorrect because of a mistake by the applicant of a clerical or typographical nature, or of minor character, or in the description of the variety (including, but not limited to, the use of a misleading variety name or a name assigned to a different variety of the same species), and the mistake is found by the Registrar to have occurred in good faith and does not require a further examination, the Registrar may, upon payment of the required fee and return of the original certificate, correct the certificate by issuing a corrected certificate, in accordance with the Act. If the mistake requires a reexamination, a correction of the

certificate shall be dependent on the results of the reexamination.

## Re-issuance of Certificate

Sec. 122 Certified seed only election.

When an owner elects after a certificate is issued to sell the protected variety by variety name only as a class of certified seed, a new certificate may be issued upon return of the original certificate to the Office and payment of the appropriate fee.

## Assignments and Recording

Sec. 130 Recording of assignments.

(a) Any assignment of an application for a certificate, or of a certificate of plant variety protection, or of any interest in a variety, or any license or grant and conveyance of any right to use of the variety, may be submitted for recording in the Office.

(b) No instrument shall be recorded which is not in the Arabic or English language or which does not identify the certificate or application to which it relates.

(c) An instrument relating to title of a certificate shall identify the certificate by number and date, the name of the owner, and the name of the variety as stated in the certificate. An instrument relating to title of an application shall identify an application by number and date of filing, the name of the owner, and the name of the variety as stated in the application.

(d) If an assignment is executed concurrently or subsequent to the filing of an application, but before its number and filing date are ascertained, the assignment shall identify the application by the date of the application, the name of the owner, and the name of the variety.

[THE RECORDING OF ASSIGNMENTS IS A CRITICAL PART OF EFFICIENT OFFICE RUNNING AS IT ALLOWS CLEAR AND TIMELY KNOWLEDGE OF WHO IS THE TRUE OWNER OF THE MATERIAL]

Sec. 131 Conditional assignments.

Assignments recorded in the Office are regarded as absolute assignments for Office purposes until canceled in writing by both parties to the assignment or by a decree of a court of competent jurisdiction. The Office shall not determine whether conditions precedent to the assignment, such as the payment of money, have been fulfilled.

Sec. 132 Assignment records open to public inspection.

(a) Assignment records relating to original or amended certificates shall be open to public inspection and copies of any recorded document may be obtained upon payment of the prescribed fee.

(b) Assignment records relating to any pending or abandoned application shall not be available for inspection except to the extent that pending applications are published .
Copies of assignment records and information on pending or abandoned applications shall be obtainable only upon written authority of the applicant or his or her assignee, or attorney or agent of record. An order for a copy of an assignment shall give the proper identification of the assignment.

[THE PUBLIC HAS A RIGHT TO KNOW WHO OWNS THE MATERIAL. THIS IS BECAUSE, AMONG OTHER MATTERS, THE OWNER MAY USE THE PROPERTY AS A WAY OF BORROWING MONEY. I.E. COLLATERAL]

## Marking or Labeling Provisions

Sec. 140 After filing.

Upon filing an application for protection of a variety and payment of the prescribed fee, the owner, or his or her designee, may label the variety or containers of the seed of the variety or plants produced from such seed, substantially as follows: ``Unauthorized Propagation Prohibited--(Unauthorized Seed Multiplication Prohibited)—Jordanian Variety Protection Applied For.

Sec. 141 After issuance.

Upon issuance of a certificate, the owner of the variety, or his or her designee, may label the variety or containers of the seed of the variety or plants produced from such seed substantially as follows: ``Unauthorized Propagation Prohibited--(Unauthorized Seed Multiplication Prohibited)—Jordanian Protected Variety.

Sec. 142 For testing or increase.

An owner who contemplates filing an application and releases for testing or increase, seed of the variety or reproducible plant material of the variety, may label such plant material or containers of the seed or plant material substantially as follows: ``Unauthorized Propagation Prohibited--For Testing (or Increase) Only."

Sec. 143 Certified seed only.

(a) Upon filing an application, or amendment thereto, specifying seed of the variety is to be sold by variety name only as a class of certified seed, the owner, or his or her designee, may label containers of seed of

the variety substantially as follows: ``Unauthorized Propagation Prohibited--Jordanian Variety Protection Applied for Specifying That Seed of This Variety Is To Be Sold By Variety Name Only as a Class of Certified Seed."

(b) An owner who has received a certificate specifying that a variety is to be sold by variety name only, as a class of certified seed, may label containers of the seed of the variety substantially as follows: ``Unauthorized Propagation Prohibited--To Be Sold By Variety Name Only as a Class of Certified Seed –Jordanian Protected Variety."

Sec. 144 Additional marking or labeling.

Additional clarifying information that is not false or misleading may be used by the owner, in addition to the above markings or labeling.

**Attorneys and Agents**

Sec. 150 Right to be represented.

An applicant may actively advance an application or may be represented by an attorney or agent authorized in writing.

[IT MAY BE ADVISABLE FOR THE OFFICE TO SET STANDARDS OF WHO IS PERMITTED TO ACT AS AN AGENT OR ATTORNEY IN THESE MATTERS, OR MAINTAIN A LIST OF APPROVED AGENTS]

Sec. 151 Authorization.

Only attorneys or agents specified by the applicant shall be allowed to inspect papers or take action of any kind, on behalf of the applicant, in any pending application or proceedings.

Sec. 152 Revocation of authorization; withdrawal.

An authorization of an attorney or agent may be revoked by an applicant at any time, and an attorney or agent may withdraw, upon application to the Registrar. When the authorization is so revoked, or the attorney or agent has so withdrawn, the Office shall inform the interested parties and shall thereafter communicate directly with the applicant, or with such other attorney or agent as the applicant may appoint. An assignment will not of itself operate as a revocation of authorization previously given, but the assignee of the entire interest may revoke previous authorizations and be represented by an attorney or agent of his or her own selection.

Sec. 153 Persons recognized.

Unless specifically authorized as provided in Sec. 151, no person shall be permitted to file or advance applications before the Office on behalf of another person.

Sec. 154 Government employees.

Officers and employees of the Kingdom of Jordan who are disqualified from practicing as attorneys or agents in proceedings or other matter before government departments or agencies, shall not be eligible to represent applicants, except officers and employees whose official duties require the preparation and prosecution of applications for certificates of variety protection.

[CONFLICT OF INTEREST PREVENTS CURRENT EMPLOYEES OF THE GOVERNMENT FROM ACTING AS AGENTS IN THIS MATTER. IT IS USUAL TO INCLUDE A PROVISION THAT EMPLOYEES OF THE PVP OFFICE SHALL NOT ACT AS AGENTS OR ATTORNEYS FOR A PERIOD OF 3 YEARS AFTER THEY LEAVE EMPLOYMENT FROM THAT OFFICE. THEY SHALL NOT WORK AS AN AGENT OR ATTORNEY ON

ANY MATTER WITH WHICH THEY HAD DIRECT RESPONSIBILITY WHILE THEY WERE ACTING AS AN EMPLOYEE IN THE PVP OFFICE].

Sec. 155 Signatures.

Every document filed by an attorney or agent representing an applicant or party to a proceeding in the Office shall bear the signature of such attorney or agent, except documents which are required to be signed by the applicant or party.

[CONSIDERATION SHOULD BE GIVEN FOR THE PVP AND OTHER GOVERNMENTAL AGENCIES AS TO THE VALIDITY OF ELECTRONIC SIGNATURES].

Sec. 156 Addresses.

Attorneys and agents practicing before the Plant Variety Protection Office shall notify the Office in writing of any change of address. The Office shall address letters to any person at the last address received.

[SHOULD THE ATTORNEY OR AGENT MOVE THEY WILL SEND SEPARATE LETTERS FOR EACH APPLICATION THEY HAVE SUBMITTED]

Sec. 157 Professional conduct.

Attorneys and agents appearing before the Office shall conform to the standards of ethical and professional conduct, generally applicable to attorneys appearing before the courts of the Kingdom of Jordan.

[FAILURE TO MAINTAIN THIS STANDARD SHALL LEAD TO DISCIPLINARY HEARINGS AND REMOVAL FROM THE LIST

OF APPROVED PRACTITIONERS BEFORE THE PVP OFFICE.]

Sec. 158 Advertising.

(a) The use of advertising, circulars, letters, cards, and similar material to solicit plant variety protection business, directly or indirectly, is forbidden as unprofessional conduct, and any person engaging in such solicitation, or associated with or employed by others who so solicit, shall be refused recognition to practice before the Office or may be suspended, excluded, or disbarred from further practice before the Office.

(b) The use of simple professional letterheads, calling cards, or office signs, simple announcements necessitated by opening an office, change of association, or change of address, distributed to clients and friends and insertion of listings in common form (not display) in a classified telephone or city directory, and listings and professional cards with biographical data in standard professional directories, shall not be considered a violation of this section.

## Fees and Charges

Sec. 175 Fees and charges.

The following fees and charges apply to the services and actions specified below:

{**Amount of Fees to be determined, but see notes**}

(a) Filing the application and notifying the public of filing.

(b) Search or examination..... .

(c) Allowance and issuance of certificate and notifying public of issuance.....

(d) Revive an abandoned application.....

(e) Reproduction of records, drawings, certificates, exhibits or printed material (copy per page of material).....

(f) Authentication (each page).....

(g) Correcting or re-issuance of a certificate.....

(h) Recording assignments (per certificate/application).....

(i) Copies of 8 x 10 photographs in color.....

(j) Additional fee for reconsideration.....

(k) Additional fee for late payment.....

(l) Additional fee for late replenishment of seed.....

(m) Appeal to Minister (refundable if appeal overturns the Registrar's decision).....

(n) Granting of extension for responding to a request.....

(o) Field inspections by a representative of the Plant Variety Protection Office made at the request of the applicant shall be reimbursable in full (including travel, per diem or subsistence, and salary) in accordance with Customary Government Travel Regulations.

(p) Any other service not covered above will be charged for at rates prescribed by the Registrar.

[FEES ARE INTENDED TO COVER THE COST OF OPERATION OF THE OFFICE. REGULATIONS OF UPOV AND WTO PRECLUDE THE USE OF THESE FEES IN A TAX REVENUE MODE. THE FEE STRUCTURE SHOULD BE REVIEWED REGULARLY TO ENSURE ADEQUATE AND APPROPRIATE LEVELS OF COST RECOVERY. COST RECOVERY CAN INCLUDE SALARIES AND OVERHEADS.]

Sec. 176 Fees payable in advance.

Fees and charges shall be paid at the time of making application or at the time of submitting a request for any action by the Office for which a fee or charge is payable and established in this part.

Sec. 177 Method of payment.

Checks or money orders shall be made payable to the Ministry of Agriculture. Remittances from foreign countries must be payable and immediately negotiable in the Kingdom of Jordan for the full amount of the prescribed fee. Money sent by mail to the Office shall be sent at the sender's risk.

Sec. 178 Refunds.

Money paid by mistake or excess payments shall be refunded, but a mere change of plans after the payment of money, as when a party decides to withdraw an application or to withdraw an appeal, shall not entitle a party to a refund. However, the examination or search fee shall be refunded if an application is voluntarily abandoned before a search or examination has begun.

Sec. 179 Copies and certified copies.

(a) Upon request, copies of applications, certificates, or of any records, books, papers, drawings, or photographs in the custody of the Office and which are open to the public, will be furnished to persons entitled thereto, upon payment of the prescribed fee.

(b) Upon request, copies will be authenticated by imprint of the seal of the Office and certified by the official, authorized by the Registrar upon payment of the prescribed fee.

**Availability of Office Records**

Sec. 190 When open records are available.

Copies of records, which are open to the public and in the custody of the Office, may be examined in the Office during regular business hours upon approval by the Registrar.

## Protest Proceedings

Sec. 200 Protests to the grant of a certificate.

Opposition on the part of any person to the granting of a certificate shall be permitted while an application is pending and for a period not to exceed 5 years following the issuance of a certificate.

Sec. 201 Protest proceedings.

(a) Opposition shall be made by submitting in writing a petition for protest proceedings, which petition shall be supported by affidavits and shall show the reason or reasons for opposing the application or certificate. The petition and accompanying papers shall be filed in duplicate. If it appears to an examiner that a variety involved in a pending application or covered by a certificate may not be or may not have been entitled to protection under the Act, a protest proceeding may be permitted by the Registrar.

(b) One copy of the petition and accompanying papers shall be served by the Office upon the applicant or owner, or his or her attorney or agent of record.

(c) An answer, by the applicant or owner of the certificate, or his or her assignee, in response to the petition, may be filed with the Registrar within 60 days after service of the petition, upon such person. If no answer is filed within said period, the Registrar shall decide the matter on the basis of the allegations set forth in the petition.

(d) If the petition and answer raise any issue of fact needing proof, the Registrar shall afford each of the parties a period of 60 days in which to file sworn statements or affidavits in support of their respective positions.

(e) As soon as practicable after the petition or the petition and answer are filed, or after the expiration of any period for filing sworn

statements or affidavits, the Registrar shall issue a decision as to whether the protests are upheld or denied. The Registrar may, following the protest proceeding, cancel any certificate issued and may grant another certificate for the same variety to a person who proves to the satisfaction of the Registrar, that he or she is the breeder or discoverer.

Sec. 205 Definition; when declared.

A priority contest may be instituted by the Minister, on his or her own motion, or upon the request of any person who has applied for protection on the same variety, for which an adverse certificate has been issued, for the purpose of determining the question of priority between two or more parties claiming development or discovery of the same novel variety; Provided, however, That any person shall have forfeited his or her right to assert priority when an adverse certificate has been issued, if he or she fails to make a request for the institution of a priority contest within 1 year of the publication in the Official Journal of issuance of the adverse certificate by the Minister, or if he or she fails to make the request within the period for taking action after refusal of the application on the basis of the adverse certificate.

Sec. 206 Preparation for priority contest between applicants.

(a) Before a priority contest will be handled by the Office, an examiner must determine that the same novel variety is involved in separate applications filed by two or more parties and apparently certifiable to each of the parties, subject to the determination of the question of priority.

(b) The fact that a certificate has been issued will not prevent a priority contest.

Sec. 207 Preparation of priority papers and declaration of priority contest.

(a) When a priority question is found to exist, the examiner shall forward the pertinent files to the Registrar, together with a written statement showing the reason for the contest.

(b) The Registrar shall institute and declare the priority contest by forwarding a notice to each of the applicants involved. Each notice shall include the name and residence of each of the other applicants or those of his or her attorney or agent, if any, and of any assignee, and will identify the application of each opposing party by number and filing date, or in the case of a certificate, by the number and date of the certificate. The notice shall specify the basis of the priority contest. The notice shall specify a time, not to exceed 2 months, for filing preliminary statements.

(c) When a notice is returned to the Office undelivered, or when one of the parties resides abroad and his or her agent in the Kingdom of Jordan is unknown, notice may be given once by publication in the Official Journal.

Sec. 208 Burden of proof.

The parties to a priority contest will be presumed to have developed their varieties in the chronological order of the filing dates of their applications for certificates involved in the priority contest, and the burden of proof will rest upon the party who last filed an application.

Sec. 209 Preliminary statement on novel variety developed in the Kingdom of Jordan.

(a) Each party to the priority contest is required to file on or before a date fixed by the Office, a concise preliminary statement giving the facts and dates relating to the development of his or her

alleged novel variety. The preliminary statement must be signed by the owner; Provided, however, That in appropriate circumstances, as when the owner is dead or legally incapacitated, or a showing is made of inability to obtain a statement from the owner, the preliminary statement may be made by the assignee or by someone authorized or entitled to make the statement, having knowledge of the facts.

(b) Preliminary statements shall be filed with the Office in duplicate. A copy shall be forwarded to each opposing party by the Office as soon as practicable after both parties have filed their statements within the requisite period.

(c) In filing a preliminary statement each party must show the following information:

(1) The date upon which the first determination of the novel variety was made.

(2) The date upon which the first written description of the novel variety was made. If a written description of the novel variety has not been made prior to the filing date of the application, it must be so stated.

(3) The date of the first act or acts susceptible of proof (other than making a written description or disclosing the novel variety to another person), which, if proven, would establish determination of the novel variety, and a brief description of such act or acts. If there have been no such acts, it must be so stated.

(4) The date of the actual production of the novel variety. If the novel variety had not been actually produced before the filing date of the application, it must be so stated.

(d) When an allegation as to the first written description is made, a copy of such written description shall be attached to the statement.

(e) If a party intends to rely on a prior application, domestic or foreign, the preliminary statement shall clearly identify such prior application. Copies of the cited application and related documents will be served by the Office, upon all interested parties to the contest. In

the case of an application filed in a foreign country, Arabic or English translations shall be served to all interested parties by the party relying on the application filed in the foreign country.

Sec. 210 Preliminary statement on novel variety developed in a foreign country.

When the novel variety was developed in a foreign country, the preliminary statement must show (a) the information specified in Sec. 209 (c) through (e) and (b) whether, and if so, when and under what circumstances the novel variety was introduced into the United States by or on behalf of the party.

Sec. 211 Statements sealed before filing.

The preliminary statement shall be submitted in a sealed envelope bearing the name of the party filing it and the number and title of the priority contest as shown on the notice issued by the Office. The envelope should be enclosed in an outer mailing envelope marked ``To Be Opened Only by the Registrar."

Sec. 212 Correction of a statement on motion.

In case of material error arising through inadvertence or mistake, a preliminary statement may be corrected upon a satisfactory showing to the Registrar that the correction is of material significance. Correction of the statement must be made as soon as practicable after the discovery of the error.

Sec. 213 Failure to file statements.

If any party to a priority contest fails to file a preliminary statement, he or she shall be restricted to his or her earliest

effective filing date.

Sec. 214 Access to preliminary statements.

The preliminary statements shall be open to the inspection of any party after the date set for the filing of preliminary statements (Sec. 207(b)), but shall not be open to inspection prior to that time.

Sec. 215 Dissolution at the request of the Registrar.

If during a priority contest, information is submitted or found which, in the opinion of the Registrar, may render the variety ineligible for a certificate, the priority contest may be suspended by the Registrar and referred to an examiner for consideration of the matter. The parties will be notified of the reason for the suspension. Arguments of the parties regarding the suspension will be considered, if filed within 60 days of the notification. The suspension will then be continued, modified, or dismissed, in accordance with the determination by the Registrar.

Sec. 216 Concession; abandonment.

(a) An applicant or a certificate holder involved in a priority contest may, at any time, file a written concession of priority, or abandonment of the certificate, signed by him or her. Upon the filing of such an instrument by any party, the decision shall be rendered against the interested party by the Registrar.

(b) A concession of priority may not be made by an assignee of a part interest.

Sec. 217 Affidavits and exhibits.

Affidavits and exhibits, including official records and any special matter contained in a printed publication, pertinent to the issue involved in the contest, may be introduced as evidence in a priority contest by any party to the contest. In the case of official records and printed publications, the party introducing the evidence shall specify the record or the printed publication, the page or pages to be used, indicate generally its relevancy, and submit to the Registrar the record or authenticated copy, or the printed publication, or a copy. Copies of affidavits and exhibits, including any record or publication, shall be served by the Registrar on each of the other interested parties.

Sec. 218 Matters considered in determining a priority.

In determining priority, the Registrar will consider only priority of development based on the evidence submitted. Questions of novelty generally will not be considered in the decision on priority. The Registrar may refer proposed findings of fact, conclusions, and notice of priority to the Board for an advisory decision.

Sec. 219 Recommendation by the Registrar.

The Registrar may, either before or concurrently with a decision on the question of priority, but independently of such decision, direct the attention of the examiner to any matter not relating to priority which may come to the Registrar's attention, and which in his or her opinion establishes the fact that there has been an irregularity which amounts to a bar to the granting of a certificate to either of the parties. The Registrar may suspend the priority contest and remand the case to the examiner for further consideration of the matters, to which attention has been directed.

Sec. 220 Decision by the Registrar.

(a) When a priority contest is concluded on the basis of preliminary statements, or proposed findings of fact, conclusions and notice of priority shall be issued by the Registrar to the interested parties, giving them a specified period, not less than 30 days, to show cause why such proposed findings of fact, conclusions, and notice of priority should not be made final. Any response made during the specified period will be considered by the Registrar. Additional affidavits or exhibits will not be considered, unless accompanied by a showing of good cause acceptable to the Registrar. Thereafter, final findings of fact, conclusions, and notice of priority shall be issued by the Registrar.

(b) The decision shall be entered by the Registrar against a party whose preliminary statement alleges a date of determination later than the filing date of the other party's application.

Sec. 221 Status of claims of defeated applicant.

Whenever a final notice of priority has been issued by the Registrar in a priority proceeding, and the time limit for an appeal from such decision has expired, the claim or claims constituting the issue of the priority stand finally disposed of without further action by the Registrar.

Sec. 222 Second priority contest.

A second priority contest between the same parties shall not be entertained by the Registrar for the same novel variety.

[THE ENTIRE PRECEDING SECTION IS AGAIN FOCUSED ON CONTENTIOUS INTERACTIONS BETWEEN THE PARTIES AND THE PVP OFFICE. THE BEST PRACTICE ON THIS FRONT IS TO BE AS CLEAR AND TRANSPARENT AS POSSIBLE ON THE STEPS INVOLVED.

WHERE TWO PARTIES ARE DISPUTING A PVP APPLICATION IT IS IMPORTANT FOR THE OFFICE TO REMAIN IMPARTIAL ON THE MATTER.]

**Appeal to the Minister**

Sec. 300 Petition to the Minister.

(a) Petition may be made to the Minister from any final action of the Registrar denying an application or refusing to allow a certificate to be issued, or from any adverse decision of the Registrar .

(b) Any such petition shall contain a statement of the facts involved and the point or points to be reviewed, and the actions requested.

(c) A petition to the Minister shall be filed in duplicate and accompanied by the prescribed fee (see Sec. 175).

(d) Upon request, an opportunity to present data, views, and arguments orally, in an informal manner or in a formal hearing, shall be given to interested persons. If a formal hearing is requested, the proceeding shall be conducted in accordance with the Rules of Practice for administrative hearings as prescribed by the Minister .

(e) Except as otherwise provided in the rules in this part, any such petition not filed within 60 days from the action complained of shall be dismissed as untimely.

[THE MINISTER IS GOING TO LOOK TO THE OFFICE UNDER THESE CIRCUMSTANCES FOR CLEAR AND WELL REASONED ADVICE. GOOD DOCUMENTATION AND WELL DEFINED PROCESS STEPS ARE INDISPENSABLE.]

Sec. 301 Registrar's answer.

(a) The Registrar may, within such time as may be directed by the Minister, furnish a written statement to the Minister in answer to the appellant's petition, including such explanation of the reasons for the action as may be necessary and supplying a copy to the appellant.

(b) Within 20 days from the date of such answer, the appellant may file a reply statement directed only to such new points of argument as may be raised in the Registrar's answer.

Sec. 302 Decision by the Minister.

(a) The Minister, after receiving the advice of the Board, may affirm or reverse the decision of the Registrar, in whole or in part.

(b) Should the decision of the Minister include an explicit statement that a certificate be allowed, based on an amended application, the applicant shall have the right to amend his or her application in conformity with such statement and such decision shall be binding on the Registrar.

Sec. 303 Action following the decision.

(a) Copies of the decision of the Minister shall be served upon the appellant and the Registrar in the manner provided in Sec. 403.

(b) When an appeal petition is dismissed, or when the time for appeal to the courts pursuant to the Act has expired and no such appeal or civil action has been filed, proceedings in the appeal shall be considered terminated as of the dismissal or expiration date, except in those cases in which the nature of the decision requires further action by the Registrar. If the decision of the Minister is appealed or a civil action has been filed pursuant to the Act, the decision of the Minister will be stayed pending the outcome of the court appeal or civil action.

**General Procedures in Priority, Protest, or Appeal Proceedings**

Sec. 400 Extensions of time.

Upon a showing of good cause, extensions of time not otherwise provided for may be granted by the Registrar or, if an appeal has been filed by the Minister for taking any action required in any priority, protest, or appeal proceeding.

[LOOK TO OTHER RELATED AREAS OF LAW TO DETERMINE WHAT IS A SHOWING OF GOOD CAUSE. SIMPLY FORGETTING IS NOT GOOD CAUSE!]

Sec. 401 Miscellaneous provisions.

(a) Petitions for reconsideration or modification of the decision of the Registrar in priority or protest proceedings shall be filed within 20 days after the date of the decision.

(b) The Registrar may consider on petition any matter involving abuse of discretion in the exercise of an examiner's authority, or such other matters as may be deemed proper to consider. Any such petition, if not filed within 20 days from the decision complained of, may be dismissed as untimely.

[USE RELATED AREAS OF LAW IN RELATION TO DAY COUNTING AND PROVIDING FOR WEEKENDS AND HOLIDAYS]

Sec. 402 Service of papers.

(a) Every paper required to be served on opposing parties and filed in the Office in any priority, protest, or appeal proceeding, must be served by the Minister in the manner provided in Sec. 403.

(b) The requirement in certain sections that a specified paper shall be served includes a requirement that all related supporting papers

shall also be served. Proof of such service upon other parties to the proceeding must be made before the supporting papers will be considered by the Registrar or Minister.

Sec. 403 Manner of service.

Service of any paper under this part must be on the attorney or agent of the party if there be such, or on the party if there is no attorney or agent, and may be made in any of the following ways:

(a) By mailing a copy of the paper to the person served by registered mail, with the date of the return receipt controlling the date of service;

(b) By leaving a copy at the usual place of business of the person served with someone in his or her employ;

(c) When the person served has no usual place of business, by leaving a copy at his or her home with a member of the family over 21 years of age and of discretion; and

(d) Whenever it shall be found by the Registrar or Minister that none of the above modes of serving the paper is practicable, service may be by notice, published once in the Office Journal.

[AGAIN, LOOK TO RELATED AREAS OF LAW TO DETERMINE WHAT ARE REASONABLE NOTICE AND DELIVERY STANDARDS]

**Review of Decisions by Court**

Sec. 500 Appeal to Jordanian Courts

Any applicant dissatisfied with the decision of the Minister on appeal may appeal to the Jordanian Court holding jurisdiction over these matters. In such cases, the appellant or plaintiff shall give notice to the Minister, state the reasons for appeal or civil action, and obtain a certified copy of the record. The certified copy of the

record shall be forwarded to the Court by the Plant Variety Protection Office on order of, and at the expense of the appellant or plaintiff.

## Public Use Declaration

Sec. 700 Public interest in wide usage.

(a) If the Minister has reason to believe that a protected variety should be declared open to use by the public in accordance with section 44 of the Act, the Minister shall give the owner of the variety appropriate notice and an opportunity to present views orally or in writing, with regard to the necessity for such action to be taken in the public interest.

(b) Upon the expiration of the period for the presentation of views by the owner, as provided in paragraph (a) of this section, the Minister shall refer the matter to the Plant Variety Protection Board for advice, including advice on any limitations or rate of remuneration.

(c) Upon receiving the advice of the Plant Variety Protection Board, the Minister shall advise the owner of the variety, the members of the Plant Variety Protection Board, and the public, by issuance of a press release, of any decision to declare a variety open to use by the public. Any decision not to declare a variety open to use by the public will be transmitted only to the owner of the variety and the members of the Plant Variety Protection Board.

## Publication

Sec. 800 Publication of public variety descriptions.

Voluntary submissions of variety descriptions of ``public varieties" on forms obtainable from the Office will be accepted for publication in the Official Journal. Such publication shall not constitute recognition that the variety is, in fact, distinct, uniform,

and stable.

[THIS PUBLIC STATEMENT SHOULD BE VIEWED CAREFULLY,

IT DOES NOT CONSTITUTE PVP RIGHTS]

# APPENDICES : FORMS

Following are the basic forms used in the PVP process

- Plant Variety Protection Application Form
- Plant Variety Protection Fees Form
- Plant Variety Protection Attachment A form (Origin & Breeding History)
- Plant Variety Protection Attachment B form (Uniformity, Distinctness, Stability Declaration)
- Plant Variety Protection Attachment C form (Description of Variety)
- Plant Variety Protection Sample Deposit Form

**APPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE**
Ministry & Agriculture; Amman Jordan

| | |
|---|---|
| E OF OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) |

| | |
|---|---|
| RESS OF OWNER. | 4. PHONE No. |
| | 5. FACSIMILE No. |
| | 6. E MAIL ADDRESS. |
| R IS NOT A PERSON, THEN NAME OF CORPORATION OR HIP. | 8. DATE OF INCORPORATION (day / month/ year) |

ADDRESS OF OWNERS REPRESENTATIVES

DE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10.

FOR OFFICIAL USE ONLY

| | DATE OF FILING (day/month/year) | FILING FEE PAID |
|---|---|---|
| & SPECIES OF | 12. BOTANICAL FAMILY NAME. | 13. COMMON NAME OF PLANT. |
| VARIETY A FIRST ON HYBRID? ☐ No | 15. DOES SEED NEED TO BE SOLD AS CERTIFIED SEED? ☐ Yes ☐ No | 16. HAS THE VARIETY BEEN SOLD, DISPOSED OF, TRANSFORM OR USED IN JORDAN OR OTHER COUNTRY? ☐ Yes ☐ No |

MENTS ARE (Check appropriate box).

gin and Breeding History.
tement of Distinctness.
scription of Variety.
tement of Ownership.

| | |
|---|---|
| JRE | 19. DATE (day/month/year) |

| | | |
|---|---|---|
| **PLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE (FEES FORM)**<br>Ministry & Agriculture; Amman Jordan | | |
| F OWNER. | 6. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| S OF OWNER. | | 8. PHONE No. |
| | | 5. FACSIMILE No. |
| | | 6. E MAIL ADDRESS. |
| ER IS NOT A PERSON, THEN NAME OF CORPORATION OR ERSHIP. | | 17. DATE OF INCORPORATION (day / month / year) |
| ADDRESS OF OWNERS REPRESENTATIVES | | |
| IDE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| | DATE OF FILING (day/month/year) | FILING FEE PAID |

| SUBJECT MATTER | | CHECK APPROPRIATE BOX | FEES |
|---|---|---|---|
| e application and notifying the public of filing. | ☐ | | |
| r examination. | ☐ | | |
| ce and issuance of certificate and notifying public of issuance. | ☐ | | |
| n abandoned application. | ☐ | | |
| ction of records, drawings, certificates, exhibits or printed material r page of material) | ☐ | | |
| cation (each page) | ☐ | | |
| ng or re-issuance of a certificate. | ☐ | | |
| ng assignments (per certificate/application) | ☐ | | |
| f 8 x 10 photographs in color. | ☐ | | |
| al fee for reconsideration | ☐ | | |
| al fee for late payment | ☐ | | |
| al fee for late replenishment of seed | ☐ | | |
| o Minister (refundable if appeal overturns the Registrar's decision) | ☐ | | |
| of extension for responding to a request. | ☐ | | |
| pections by a representative of the Plant Variety Protection Office made quest of the applicant shall be reimbursable in full (including travel per subsistence, and salary) in accordance with Customary Government egulations. | ☐ | | |
| er service not covered above will be charged for at rates prescribed by strar. | ☐ | | |

| | | |
|---|---|---|
| **PPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE (EXHIBIT A)**<br>Ministry & Agriculture; Amman Jordan | | |
| OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| OF OWNER. | | 4. PHONE No. |
| | | 5. FACSIMILE No. |
| | | 6. E MAIL ADDRESS. |
| R IS NOT A PERSON, THEN NAME OF CORPORATION OR HIP. | | 8. DATE OF INCORPORATION (day / month/ year) |
| DDRESS OF OWNERS REPRESENTATIVES | | |
| DE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| | DATE OF FILING (day/month/year) | FILING FEE PAID |

| | | |
|---|---|---|
| | EXHIBIT A: ORIGIN & BREEDING | |
| | | |

& BREEDING HISTORY (SEE TECHNICAL GUIDE BY CROP FOR MORE DETAILS

| | |
|---|---|
| URE | 22. DATE (day/month/year) |

| | | |
|---|---|---|
| **PPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE (EXHIBIT B)**<br>Ministry & Agriculture; Amman Jordan | | |
| OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| OF OWNER. | | 4. PHONE No. |
| | | 5. FACSIMILE No. |
| | | 6. E MAIL ADDRESS. |
| R IS NOT A PERSON, THEN NAME OF CORPORATION OR HIP. | | 8. DATE OF INCORPORATION (day / month/ year) |
| DDRESS OF OWNERS REPRESENTATIVES | | |
| DE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| | DATE OF FILING (day/month/year) | FILING FEE PAID |
| | EXHIBIT B: STATEMENT OF | |

| | | |
|---|---|---|
| | DISTINCTIVENESS, UNIFORMITY AND STABILITY | |
| | | |

ENT OF DISTINCTNESS, UNIFORMITY & STABILITY. SEE UPOV TECHNICAL GUIDE BY
MORE DETAILS.

| | |
|---|---|
| JRE | 13. DATE (day/month/year) |

| | | |
|---|---|---|
| **PPLICATION FOR PLANT VARIETY PROTECTION CERTIFICATE (EXHIBIT C)**<br>Ministry & Agriculture; Amman Jordan | | |
| OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| OF OWNER. | | 4. PHONE No. |
| | | 5. FACSIMILE No. |
| | | 6. E MAIL ADDRESS. |
| R IS NOT A PERSON, THEN NAME OF CORPORATION OR HIP. | | 8. DATE OF INCORPORATION (day / month/ year) |
| DDRESS OF OWNERS REPRESENTATIVES | | |
| DE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| | DATE OF FILING (day/month/year) | FILING FEE PAID |
| | EXHIBIT C: DESCRIPTION OF | |

| | | |
|---|---|---|
| | VARIETY | |
| | | |

'TION OF VARIETY. (SEE UPOV TECHNICAL GUIDE BY CROP FOR MORE DETAILS) Il
LAIMED AS A CHARACTER SUPPLY 3 COPIES OF COLOR PHOTOGRAPHS

| | |
|---|---|
| JRE | 13. DATE (day/month/year) |

| | | |
|---|---|---|
| **ATION FOR PLANT VARIETY PROTECTION CERTIFICATE (SAMPLE DEPOSITION)**<br>Ministry & Agriculture; Amman Jordan | | |
| OWNER. | 2. NAME OF VARIETY (OR TEMPORARY DESTINATION) | |
| OF OWNER. | | 4. PHONE No. |
| | | 5. FACSIMILE No. |
| | | 6. E MAIL ADDRESS. |
| R IS NOT A PERSON, THEN NAME OF CORPORATION OR HIP. | | 8. DATE OF INCORPORATION (day / month/ year) |
| ADDRESS OF OWNERS REPRESENTATIVES | | |
| DE OF KINGDOM OF JORDAN, NAME LOCAL IN 9 AND INTERNATIONAL IN 10. | | |
| FOR OFFICIAL USE ONLY | | |
| | DATE OF FILING (day/month/year) | FILING FEE PAID |

| | | |
|---|---|---|
| EPOSITION FORM | | |
| NAME | | |
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www.worldseed.org
WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)
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# MODEL LAW

# on

# THE PROTECTION OF NEW VARIETIES OF PLANTS

# International Union for the Protection of New Varieties of Plants

Geneva 1996

# MODEL LAW

on

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# INTRODUCTION

## Background

0.1 In 1980, the International Union for the Protection of New Varieties of Plants (UPOV) published a Model Law on the Protection of New Varieties of Plants, based on the 1978 Act of the Convention.

0.2 The Convention has since been revised and a new Act was adopted on March 19, 1991. The objective of the revision was mainly:

(d) to clarify certain provisions in the light of the experience gained by the member States of UPOV in applying the Convention since the previous revision;

(e) to strengthen the protection granted to breeders in certain specific ways so as to maintain the capacity of the protection system to promote investment in the plant variety and seed sector;

(f) to reflect technological changes.

It was therefore considered necessary to draw up a new Model Law.

0.3 This Model Law has been drawn up on the basis of the work done by the Administrative and Legal Committee of UPOV at its thirty-fourth and thirty-fifth sessions in November 1994 and April 1995, in which observers from a number of non-member States took an active part. Discussions at the thirty-fifth session had been prepared by a group of four experts acting in a personal capacity.

## Nature of the Model Law

0.4 As its name suggests, the Model Law is only a model. The form of national legislation and the terminology it uses vary according to legal traditions, administrative and governmental structures and other factors. Nevertheless, as far as possible, efforts have been made to propose model provisions that can be incorporated in a national law without any major changes.

0.5 In particular, the national law should be adapted to the laws governing related areas, notably seed and seedling legislation and patent laws. It is in fact possible to accommodate the protection of new plant varieties in either type of law; with regard to the former, however, it should be noted that plant variety protection covers all categories of plants, not only those usually covered by the laws on seeds and seedlings.

## Assistance by the Office of the Union

0.6 Any national government or competent authority of a regional intergovernmental organization may, on request, obtain assistance from the Office of

the Union in drafting legislative texts and defining and establishing the necessary administrative and regulatory structures.

0.7 Article 34(3) of the 1991 Act provides as follows: "Any State which is not a member of the Union and any intergovernmental organization shall, before depositing its instrument of accession, ask the Council to advise it in respect of the conformity of its laws with the provisions of this Convention. If the decision embodying the advice is positive, the instrument of accession may be deposited." It is strongly recommended that the Office of the Union be consulted at an early stage so that a draft law that is consistent with the 1991 Act may be put before the legislative power of the State or the organization envisaging accession to the Union.

Layout of this Document

0.8 The text of the Model Law is given on the odd-numbered (right-hand) pages. The commentary is on the even-numbered (left-hand) pages.

# TEXT OF THE MODEL LAW

# AND

# COMMENTARY

# COMMENTARY ON ARTICLE 1

Structure

1.1 This Article deals with two issues that can be divided up.

Paragraph (1)

1.2 This paragraph states the purpose of the Law in general terms. The proposed text is based on Article 1(1) of the 1978 Act of the Convention.

1.3 *Purpose of the law.* - The inclusion of a provision of this type in a national law is mainly a matter of legal tradition.

1.4 The Office of the Union can provide detailed documentation on the effects of protection.

1.5 *Form of protection.* - The Model Law already uses the term "breeder's right" in Article 1(1), in conformity with the 1991 Act of the Convention. Article 2 of the Convention sets out the basic obligation of the Contracting Parties as follows: "Each Contracting Party shall grant and protect breeders' rights."

1.6 The practice in the majority of States currently members of UPOV is to recognize the rights by issuing a special title of protection (for example, a "new plant variety certificate") on the basis of a special law. Protection can also be granted by entering the variety in a "register of protected varieties." Where protection is governed by patent legislation, reference is often made to "plant patents."

1.7 Whatever the name of the medium used for the recognition of breeders' rights, a law based on the Model Law is a "*sui generis* system" for the protection of varieties within the meaning of Article 27.3(b) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), which constitutes Annex 1C to the Agreement Establishing the World Trade Organization (WTO). That Article states that "Members shall provide for the protection of plant varieties either by patents or by an effective *sui generis* system or by any combination thereof."

Paragraph (2)

1.8 Paragraph (2) contains two types of definition: definitions that simplify the remainder of the text and definitions as such.

1.9 *Subsidiary legislative instruments.* - The Model Law refers to "regulations" for reasons of simplification. States will make use of one or other secondary legislative

# PART I

# PURPOSE AND SCOPE OF THE LAW

## Article 1

## Purpose of the Law and Definitions

**(1) The purpose of this Law is to recognize and to ensure to the breeder of a new plant variety or to his successor in title a right, to be known as a "breeder's right," under the conditions hereinafter defined.**

**(2) For the purposes of this Law:**

**(xii) "Council" means the Plant Breeders' Rights Council referred to in Article 25;**

**(xiii) "Office" means the Plant Breeders' Rights Office referred to in Article 26;**

**(xiv) "Minister" means the Minister for ... [the Minister who has responsibility for the protection of new varieties of plants];**

**(xv) "Regulations" means the implementing regulations made under this Law;**

**(xvi) "Convention" means the International Convention for the Protection of New Varieties of Plants;**

**(xvii) "Union" means the International Union for the Protection of New Varieties of Plants;**

**(xviii) "Contracting Party" means a State (other than *the State*[11]) or intergovernmental organization party to the Convention;**

**(xix) "Authority of a Contracting Party" means the Authority entrusted with the implementation of the law on the protection of new varieties of plants of that Party;**

**(xx) "breeder" means the person who has bred, or discovered and developed, a variety;**

**(xxi) "applicant" means the person who has filed an application for the grant of a breeder's right;**

**(xxii) "holder" means the holder of a breeder's right;**

[11] In this particular context, this State is the one deemed to have adopted the Model Law. The phrase "the State" has the same meaning throughout the Model Law.

instrument as required (decree, order, regulation, etc.), or several, in order to specify and complete the provisions of the law.

1.10 *Persons affected by the law.* - Whereas the UPOV Convention uses the word "breeder" in all the substantive provisions (thus assimilating entitled persons or successors in title to the breeder), the Model Law draws a distinction between the breeder, the applicant and the holder. In many cases—but not always—these will be the same person. The status of breeder is a matter of fact, independent of the existence of an application or breeder's right; the status of applicant and the status of holder are matters of both fact and law.

1.11 Consequently, the definition of the breeder given in subparagraph (ix) is simplified in comparison with that contained in Article 1 of the 1991 Act. The missing elements are dealt with in Article 10 of the Model Law.

1.12 It must be emphasized that the applicant is the person by whom or on whose behalf an application is made (by a procedural representative—see Article 4), and to whom the breeder's right will be granted.

1.13 *Variety and protected variety.* - The definition of the variety given in subparagraph (xii) corresponds to that given in Article 1(vi) of the 1991 Act.

1.14 The main purpose of the definition given in the 1991 Act and repeated in the Model Law is to emphasize that the concept of "variety" should not be assimilated to that of "protected variety" or "protectable variety." In particular, when a variety that is the subject of an application for a breeder's right is examined, it should also be compared with material that is not uniform enough to be protected but enough to be defined individually as a variety.

1.15 The definition of "protected variety" is accompanied by re ferences to subsequent Articles. It is proposed that a variety should be defined both by the description and by the sample; such flexibility is useful for instance in infringement cases, where the circumstances may dictate reference to one or other of the two elements.

1.16 *Propagating material and harvested material.* - No attempt has been made in the Model Law to define these terms. Drafting definitions capable of covering all possible situations satisfactorily is probably a risky endeavor; it is preferable to rely on common sense and case law.

1.19 "Propagating material" undoubtedly means parts of plants used to produce new plants (for example seeds, cuttings and grafts), as well as whole plants used for planting (for example, rooted cuttings, runners and young plants grown from seed). Their end-use is a matter of fact but also of intention on the part of those concerned (producer, seller, buyer, user): the production of beet seeds is seed production, whereas bean seeds can be used for consumption or sowing.

**(xiii) variety" means a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a breeder's right are fully met, can be**

- **defined by the expression of the characteristics resulting from a given genotype or combination of genotypes,**
- **distinguished from any other plant grouping by the expression of at least one of the said characteristics and**
- **considered as a unit with regard to its suitability for being propagated unchanged;**

**(xv) "protected variety" means the variety that is the subject of a breeder's right; it shall be defined by the description established pursuant to Article 37(1)(iii) and by the official sample referred to in Article 49(1)(i), and identified by the denomination referred to in Article 5(1)(v);**

**(xvi) "notice" means, unless the context requires otherwise, a communication by the Office to a party to proceedings before the Office.**

# COMMENTARY ON ARTICLE 2

2.1 According to Article 3 of the 1991 Act, protection should be provided for all plant genera and species; States are however allowed gradually to extend the scope of the law within a period of five or ten years, according to whether they are already members or new members. The Model Law utilizes this possibility from the point of view of a State about to become a member of UPOV.

2.2 The Model Law suggests that the plant genera and species should be specified in the Regulations—so that Parliament does not have to pronounce on the list—and that the essential elements of the timetable should be set out in the law. For the purposes of this provision, the term "plant genera and species" means a taxon (a unit of botanical classification) of any rank that corresponds to a cultivated plant and is usually provided with a common name. If the protection system is applied gradually, it should start with the genera and species that are the most important to the domestic economy.

2.3 A scope of application that encompasses all plant genera and species—the whole of the plant kingdom—does not mean that the national Plant Breeders' Rights Office will receive applications for thousands of species: applications will only concern a relatively small number of cultivated species on which breeding work is being done and which are potentially deserving of protection. For example, the Netherlands—one of the States with the highest level of plant variety protection activity—had protected varieties in 232 taxa on December 31, 1994. As the example of several member States shows, it is perfectly possible to introduce a system of protection that applies to the whole of the plant kingdom from the outset.

2.4 Some States may wish to have the concept of "plant genera and species" defined. This concept should as a minimum cover all vascular plants and fungi and also algae where appropriate.

## Article 2

## Scope of the Law

**(1) This Law shall be applied to the plant genera and species specified in the Regulations.**

**(2) This Law shall be applied on the date of its coming into force to at least 15 plant genera and species, and by the expiration of a period of ten years from the said date at the latest, to all plant genera and species.**

## COMMENTARY ON ARTICLE 3

3.1 This Article corresponds to Article 4 of the 1991 Act.

3.2 Many national laws limit the possibility of acquiring a breeder's right according to the applicant's nationality or place of residence (in the case of a natural person) or registered office (in the case of a legal entity).

3.3 Some States have not introduced such restrictions. This approach is particularly recommended in the light of developments in international relations, especially the TRIPS Agreement. At the time of writing, there are differences of opinion on whether or not Article 27.3(b) of the Agreement (quoted in paragraph 1.7 above) includes the obligation to apply its Articles 3 (national treatment) and 4 (most-favored-nation treatment) in the context of a *sui generis* system. It needs only be mentioned that, as protection becomes more widespread, the interest of a provision on national treatment and reciprocity diminishes accordingly.

3.4 Paragraph (1)(i) and (ii), as completed by paragraph (2), restates the provisions of Article 3 of the 1991 Act in the abbreviated form that the general context of a national law permits. Paragraph (1)(iii) sets out the generally recognized principle of reciprocity with non-member States that possess legislation on the protection of new plant varieties and are themselves prepared to apply reciprocity.

3.5 The internationalization of trade relations and the growing complexity of company law have made the concept of "registered office" difficult to apply. The Model Law proposes completing it with the word "establishment." It should be mentioned that the Paris Convention for the Protection of Industrial Property uses the expression "real and effective industrial or commercial establishments."

3.6 Paragraph (3) entrusts the Office with the task of determining the existence of reciprocal protection. A simple procedure like the one proposed is advisable in view of the limited effect of reciprocity.

## Article 3

## Nationality, Place of Residence or Registered Office

**(1) The rights conferred by this Law may be acquired by**

**(iv) nationals of *the State* and persons having their place of residence or registered office [or an establishment] in *the State,***

**(v) nationals of Contracting Parties and persons having their place of residence or registered office [or an establishment] in the territory of a Contracting Party, and**

**(vi) nationals of any State which, without being a Contracting Party, grants effective plant variety protection to the nationals of *the State,* and persons having their place of residence or registered office [or an establishment] in that State.**

**(2) For the purposes of paragraph (1)(ii), "nationals" means, where the Contracting Party is a State, the nationals of that State and, where the Contracting Party is an intergovernmental organization, the nationals of the States that are members of that organization.**

**(3) For the purposes of paragraph (1)(iii), the Office shall determine whether the plant variety protection offered by a State is effective.**

## COMMENTARY ON ARTICLE 4

4.1 The rule written into Article 4 is widely used. The appointment of a procedural representative makes for easier handling of breeders' rights at the administrative level and where necessary at the judicial level. In general, member States do not require the procedural representative either to be approved by the Patent Office or to be a legal adviser. On the contrary, experience shows that many foreign breeders enter into commercial relations with a local partner (breeder or producer of seeds and seedlings) and appoint him as their procedural representative.

4.2 The proposed provision implies that a procedural representative is not required for an application filed by a person who has his residence or registered office or an establishment in the State in question.

4.3 The power of attorney must be given in writing and signed by the procedural representative as well as by the principal. It may be useful to provide a special form for this.

4.4 The obligation to appoint a procedural representative may be replaced by an obligation to elect domicile in the State concerned for the purposes of procedures relating to the protection of the variety in question.

## Article 4

## Procedural Representative

**Persons having neither residence nor a registered office [nor an establishment] in *the State* may be parties to proceedings instituted pursuant to this Law and assert rights deriving therefrom only if they have a procedural representative who is resident or has an office in *the State*. The representative shall be given the power to act on his principal's behalf before the Office and in legal proceedings relating to the protection of new varieties of plants.**

# COMMENTARY ON ARTICLE 5

## Basis in the Convention

5.1 This Article corresponds to Article 5 of the 1991 Act.

## Paragraph (1)

5.2 The condition of novelty is essentially a legal one; in con tent it is very different from the novelty condition in patent law.

5.3 The conditions of distinctness, uniformity and stability are basically technical. They must be met before any particular plant material can constitute a variety; they must be met according to the criteria set out in Articles 7 to 9 (and the rules adopted for their application) before a variety can be protected.

5.4 The conditions of distinctness, uniformity and stability are assessed on the basis of the general criteria laid down by UPOV—especially those in the General Introduction to Test Guidelines and in the documents on the statistical exploitation of biometric data—and the specific criteria contained in the Test Guidelines drawn up for each species.

## Paragraph (2)

5.5 Paragraph (2) is not indispensable in national legislation because the implementing texts would never derogate from the provisions of the law. It does however add a detail that is useful when the implementing texts are written.

5.6 In particular, protection cannot be based on the criteria of value for cultivation and use that often apply to the national catalogue of varieties approved for trade (where such a catalogue exists). As far as legal principles are concerned, the object of the protection system is to recognize an intellectual property right, and so the notion of value in use has no place in such a system. At the practical level, value is also a concept that varies in time and space, so it is not a suitable condition of protection.

# PART II

# SUBSTANTIVE LAW

## CHAPTER I

## CONDITIONS FOR THE GRANT OF A BREEDER'S RIGHT

### Article 5

### Conditions of Protection

**(1) The breeder's right shall be granted where the variety is**

**(vi) new,**

**(vii) distinct,**

**(viii) uniform,**

**(ix) stable and**

**(x) the subject of a denomination established pursuant to the provisions of Article 44.**

**(2) The grant of a breeder's right shall not be made subject to any further or different conditions provided that the applicant complies with the formalities established by this Law and pays the required fees.**

# COMMENTARY ON ARTICLE 6

Paragraph (1)

6.1 *Relation to the 1991 Act.* - Paragraph (1) corresponds to Article 6(1) of the 1991 Act. The provision contained in Article 6(2) of the Act has been converted into a model provision in Article 56 of the Model Law.

6.2 A particular feature of this provision is the expression "or, where relevant, at the priority date" added after "the date of filing of the application." It thus states one of the effects of priority, which are restated in Article 34(4) *(a)*.

6.3 Another distinguishing feature of the proposed provision is the addition of "or his successor in title" to the "breeder." This is partly due to the choice of terminology (see the commentary on Article 1(2) above).

Paragraph (2)

6.4 When the 1991 Act was adopted, it was agreed that certain commercial acts carried out in relation to the variety should not be prejudicial to its novelty. The negotiators also agreed, however, not to deal with this issue—which can be left to case law—in the Convention itself.

6.5 For the sake of legal clarity, the Model Law proposes the listing of six cases that explain or complete paragraph (1).

(e) Subparagraph (i) (abuse to the detriment of the breeder) is an explanatory provision: an abusive act of trade can only be carried out without the consent of the breeder;

(f) Subparagraph (ii) (transfer of the rights in the variety) is also explanatory: if the underlying principle is not accepted, any combined transfer of the rights and propagating material in a given State must be followed by the filing of an application in that State within the year;

(g) Subparagraph (iii) (propagation of the variety prior to marketing) is a provision that completes paragraph (1). Its aim is to allow breeders to undertake clearly-defined transactions that are necessary for the subsequent commercial exploitation of the variety before filing an application. This provision places on an equal footing "small" breeders—who do not have the means with which to do the pre-marketing propagation themselves—and "large" breeders—who do not need outside assistance in that respect;

(h) Subparagraph (iv) (tests) is also a complementary provision based on the same type of consideration as the preceding subparagraph;

## Article 6

## Novelty

**(1) The variety is new if, at the date of filing of the application or, where relevant, at the priority date, propagating material or harvested material of the variety has not been sold or otherwise disposed of to others, by or with the consent of the breeder or his successor in title, for purposes of exploitation of the variety,**

**(iii) in the territory of *the State* for longer than one year and,**

**(iv) in a territory other than that of *the State* for longer than four years or, in the case of trees and grapevine, for longer than six years.**

**(2) Novelty shall not be lost as a result of any sale or disposal to others**

**(vii) that is the result of an abuse to the detriment of the breeder or his successor in title,**

**(viii) that forms part of an agreement for the transfer of the rights in the variety,**

**(ix) that forms part of an agreement under which a person multiplies propagating material of the variety concerned on behalf of the breeder or his successor in title, provided that the property in the multiplied material reverts to the breeder or his successor in title, and provided that the multiplied material is not used for the production of another variety,**

**(x) that forms part of an agreement under which a person undertakes field tests or laboratory trials, or small-scale processing trials, with a view to evaluating the variety,**

**(xi) that forms part of the fulfillment of a statutory or administrative obligation, in particular concerning biological security or the entry of varieties in an official catalogue of varieties admitted to trade, or**

**(xii) that involves harvested material being a by-product or a surplus product of the creation of the variety or of the activities referred to in items (iii) to (v) of this Article, provided that the said material is sold or disposed of without variety identification for purposes of consumption.**

(e) Subparagraph (v) is basically explanatory. It is usual practice for a breeder to start by fulfilling certain obligations prior to commercial exploitation of a variety and only to file an application for protection once the commercial prospects are known; this practice also allows savings to be made in the administrative management of the protection system;

(f) Subparagraph (vi) is mixed. It deals with a practical reality but also lays down strict conditions.

Special Case of Varieties Whose Production Requires the Repeated Use of One or More Other Varieties

6.6 This case can be illustrated by the production of hybrid seed. Such seed is "propagating material" of the hybrid variety concerned. At the same time it can be the "harvested material" of the lines used for the hybrid formula or may be considered such; in the case of an $F_1$ hybrid, for example, the seeds are taken from the female line while the male line has been grown only to pollinate the female line for the purpose of obtaining the seeds. It is the view in some countries that the sale or transfer of hybrid seed to third parties for the purposes of exploiting the hybrid variety is a relevant act for the evaluation of the novelty of the lines used in the formula of the hybrid.

6.7 If this point needs to be developed further, the following provision can be inserted into the national law:

> "(3) Where the production of a variety requires the repeated use of one or more other varieties, the sale or transfer to third parties of the propagating material or the harvested material of that variety shall be relevant to the novelty of the other variety or varieties."

# COMMENTARY ON ARTICLE 7

## Basis in the Convention

7.1 This Article corresponds to Article 7 of the 1991 Act.

7.2 Regarding the addition of the words "or, where relevant, at the priority date," see the commentary on the preceding Article.

7.3 Paragraph (3) provides an illustration of the circumstances that make a variety—or cause it to be considered—a matter of common knowledge. It is based on Article 6(1)(a) of the 1978 Act.

## Distinctness as Such

7.4 The concept of distinctness raises two questions:

(c) What makes one variety distinct from another?

(d) How should one variety be distinguished from another?

7.5 *Important or relevant characteristics.* - The 1961 and 1978 Acts replied as follows to the first question: "by one or more important characteristics." This explanatory clause was deleted from the 1991 Act to eliminate a source of error and confusion, not to change administrative and technical practice (there is a tendency among, in particular, patent practitioners to interpret "important characteristic" as a characteristic conferring an additional value to the variety).

7.6 Distinctness is therefore based on an examination of the characteristics of the variety, usually taken in isolation.

7.7 Not all the characteristics are taken into account, only those qualified as "important" (or "relevant" in Articles 8 and 9). The word "important" does not call for any assessment of the value conferred on the variety by the characteristic in question or of the practical usefulness of the characteristic. It has consistently been interpreted as meaning "important for distinguishing varieties."

7.8 The characteristics taken into account when distinctness is examined are ideally characteristics that are independent of the effects of environment and enable varieties of the species in question to be described easily, both in the sense of ease of observation or measurement and in terms of cost. They are defined in the Test Guidelines drawn up by UPOV (which do not contain restrictive lists, however); the Test Guidelines are recommendations; they are periodically revised in the light of experience and technical and economic developments.

## Article 7

## Distinctness

**(1) The variety is distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of the filing of the application or, where relevant, at the priority date.**

**(2) The filing, in any country, of an application for a breeder's right or for entry in a catalogue of varieties admitted to trade shall be deemed to render the variety being the subject of the application a matter of common knowledge from the date of the application, provided that the application leads to the grant of the breeder's right or the entry in the catalogue, as the case may be.**

**(3) Common knowledge may also be established by reference to various factors such as: exploitation of the variety already in progress, entry of the variety in the register of varieties kept by a recognized professional association, or inclusion of the variety in a reference collection.**

7.9 Characteristics that affect the value of the variety for cultivation and use are usually taken into account when distinctness is examined, provided that this remains reasonable, as mentioned above. In addition, there are characteristics of purely agrobotanical interest, which usually have the advantage of being precise and not prone to fluctuation.

7.10 *Clear distinction.* - The three Acts of the Convention require the distinction to be "clear."

Priority Among Breeders of the Same Variety

7.11 The effect of Article 7 is to determine priority among persons who—independently of each other—appear to have created, or discovered and developed, the same variety or two varieties that are not clearly distinguishable: the right to protection in a given country belongs to the first person who made "his" variety a matter of common knowledge in any country. Paragraph (2) means that the filing of an application makes the variety a matter of common knowledge (even if it is actually known only to the breeder and the official authority) as from the date of the application, provided that the application is granted. In the course of normal plant breeding activities, a variety enters the commercial network through the filing of an application, so in practice these provisions mean that in the majority of cases there is a system of first-to-file priority that could extend worldwide.

7.12 It should be emphasized here that this system is different from the one usually applicable under patent law. The fact that a variety is a matter of common knowledge does not prevent it from being protected (whereas the disclosure of an invention in principle blocks the grant of the corresponding patent).

## COMMENTARY ON ARTICLE 8

8.1 This Article corresponds to Article 8 of the 1991 Act.

8.2 The uniformity requirement is not absolute, but depends rather on the characteristics of the sexual reproduction or vegetative propagation of the variety in question. Special criteria are defined according to those characteristics, representing a compromise between the uniformity that can be achieved and that which may reasonably be required, with the needs of users being also taken into account.

8.3 At one extreme there are varieties propagated by vegetative means and varieties where the model is the pure line, obtained from self-pollinating plants; in that case, the level of uniformity required may be—and is—very high. At the other extreme there are varieties of strictly cross-fertilized plants, which are necessarily heterogeneous; there, the required level of uniformity is measured in relation to that found in comparable varieties.

## Article 8

## Uniformity

**The variety is uniform if, subject to the variation that may be expected from the particular features of its propagation, it is sufficiently uniform in its relevant characteristics.**

## COMMENTARY ON ARTICLE 9

9.1 This Article corresponds to Article 9 of the 1991 Act.

## Article 9

## Stability

**The variety is stable if its relevant characteristics remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.**

# COMMENTARY ON ARTICLE 10

## Paragraph (1) and General Principles

10.1 Paragraph (1) lays down the basic principle according to which entitlement to the breeder's right belongs to the breeder; by referring to his successor in title, it acknowledges that the right is assignable and transferable. "Entitlement to the breeder's right" means the right to file an application and be granted the breeder's right. Certain issues related to assignment and transfer are dealt with in Article 18.

10.2 National legislation may contain provisions relating to three special cases, namely:

(d) where the same variety has been bred independently by two persons;

(e) where the same variety has been bred jointly by two persons;

(f) where the variety has been bred by an employee.

10.3 The commentary on Article 7 refers to the first case: this is governed by the provisions on distinctness.

10.4 In the other two cases, each State will have to consider in the light of its own legal traditions—taking into account in particular what has been done for patents—whether or not provisions should be included in the plant variety protection law and, if so, to define the contents of those provisions.

## Paragraph (2)

10.5 Paragraph (2) as proposed should basically be treated as a checklist item. The first sentence states a fact; the second proposes a rule for sharing rights in the absence of any contractual solution.

## Paragraph (3)

10.6 Paragraph (3) should also be treated as an item in a checklist.

10.7 Some States have very detailed regulations on inventions by employees, either in their patent legislation or in a special law or in texts governing labor law; these regulations deal not only with the question of whether the employer or the employee has the right to the patent, but also with related issues, foremost among which is the right to remuneration in favor of the employee (when the patent right belongs or accrues to the employer) and the right to a license to work the invention (when the patent right belongs to or is left to the employee). Those States would probably find it beneficial to extend the provisions applicable to inventions by employees to new varieties bred by employees.

# CHAPTER II

# PERSONS ENTITLED

## Article 10

## Principles

**(1) Entitlement to the breeder's right shall vest in the breeder or his successor in title.**

**(2) Where two or more persons have bred, or discovered and developed, a variety jointly, entitlement to protection shall vest in them jointly. Subject to any agreement to the contrary between the joint breeders, their shares shall be equal.**

**(3) Where the breeder is an employee, entitlement to the breeder's right shall be determined by the employment relationship in the context of which the variety was bred, or discovered and developed and in accordance with the law applicable to that relationship.**

10.8 States that do not have any special provisions for the purposes of patents, thus allowing the question to be resolved by the parties under contractual law (and case law), will probably find it in their interest to do the same for breeders' rights.

10.9 In addition to being a checklist item, paragraph (3) proposes that the law applicable to new varieties bred by employees should basically be the law of the country in which the variety has been bred. This aspect is particularly important from the point of view of any payment that might be made, in the form of premiums for example, to employees under incentive systems to encourage inventive activity: such a system should apply only to nationals of the country in question.

# COMMENTARY ON ARTICLE 11

Paragraph (1)

11.1 Paragraph (1) states the principle according to which the applicant is presumed entitled to protection. It follows that the Office does not have to verify that the applicant is in fact authorized to file the application.

11.2 It does however have to be possible to invalidate that presumption if it can be shown that the applicant is not entitled to the breeder's right. The Model Law proposes a system whereby the application is published, and third parties are given the possibility of filing objections (Article 39) which, if accepted, will result in rejection of the application (Article 41). In addition, the person entitled may bring an action (in court) for assignment to him of an application or breeder's right (Article 12). Lastly, where a breeder's right has been improperly granted, the procedure for annulment of the right may be resorted to (Article 22).

Paragraph (2)

11.3 It is proposed that the successor in title should prove his title. This provision will apply in cases of assignment (including those between an employee and his employer) or succession. Only "sufficient proof" is required, however.

## Article 11

## Presumption of Title

**(1) The applicant shall be considered entitled to protection, in the absence of proof to the contrary.**

**(2) However, where the application is made by a successor in title, it shall be accompanied by sufficient proof of the successor's title.**

# COMMENTARY ON ARTICLE 12

## General remark

12.1 The provisions that might be adopted by a State on the basis of this Article should be adapted to its general legal rules and, where relevant, to the provisions of the Patent Law. This Article proposes solutions that are applied by many member States.

## Paragraph (1)

12.2 Article 12 affords the lawfully entitled person a means of asserting his rights when a person not entitled to protection (for example, a third party who has unlawfully appropriated propagating material of the variety concerned) has filed an application or even obtained a breeder's right. The other means available is the filing of objections (Article 39); where a right has been improperly granted, it is also possible to have it annulled under Article 22.

12.3 The remedy provided for in Article 12 is a judicial remedy. The proposal in the Model Law is based on the fact that it is a question of settling a dispute (under private law, so before the civil courts) relating to ownership of an object. Where necessary, the competent jurisdiction will have to be defined. The remedy could also be administrative; it would then be up to the Office to decide. The solution can be considered as the rejection of an application (filed by the unlawful applicant) followed by the filing of a new application (by the lawfully entitled person), or as the cancellation of the breeder's right granted followed by the grant of a new right.

12.4 An applicant who wins his case will in principle take over the application procedure at the point at which it was left. The national law or its implementing texts could provide that the action must be notified to the Office and that the latter will defer any decision on the application until a final decision has been taken on the case.

## Paragraph (2)

12.5 Action for assignment should be tied to a time limit when the defendant (applicant or entitled person) has acted in good faith. This is necessary for reasons of legal security both for the defendant and for users of the variety. On the other hand, the Model Law proposes that action may be brought at any time against a defendant who has acted in bad faith.

## Paragraph (3)

12.6 This paragraph proposes that, where the action for assignment is successful, the applicant acquires a right that is in principle completely unencumbered. All licenses and pecuniary rights granted by the defendant to third

parties lapse; this rule also applies to the exclusive licenses mentioned in Article 19(3)*(a)*.

## Article 12

## Judicial Assignment of the Application for a Breeder's Right or of the Breeder's Right

**(1) Where an application for a breeder's right has been filed by a person not entitled to protection, the entitled person may bring an action for the assignment to him of the application or, if already granted, of the breeder's right.**

**(2) Such action shall be barred after five years from publication of the grant of the breeder's right. An action brought against a defendant who has acted in bad faith shall not be subject to any limitation.**

**(3)*(a)* Where the action succeeds, any rights granted by the defendant to third parties [*Alternative A, linked to Alternative A for Article 17(2)*: on the basis of the application or, where relevant, the breeder's right] [*Alternative B, linked to Alternative B for Article 17(2)*: on the basis of the breeder's right] shall become null and void.**

***(b)* However, the holder of any exploitation rights acquired in good faith who has taken genuine and effective measures with a view to exercising his rights before the date of the notification of the action or, failing such notification, of the decision may perform or continue to perform the acts of exploitation resulting from the measures taken, subject to payment of equitable remuneration to the entitled person.**

12.7 It would however be unfair for a person who has acquired an exploitation license in good faith to lose the benefit of the investment made with a view to exploiting the variety concerned. Subparagraph *(b)* allows him to pursue his activities within the prescribed limits.

12.8 Paragraph (3)*(a)* comprises two alternatives linked to the text proposed for Article 17. The first is linked to provisional protection giving the applicant the possibility of concluding license agreements on the basis of the application, and the second to provisional protection giving the applicant the sole right to receive equitable remuneration from any person who exploits the variety during the period when the application is under consideration.

# COMMENTARY ON ARTICLE 13

## General remark

13.1 This Article corresponds to Article 14 of the 1991 Act, the text of which is reproduced almost without change. It can be expected that many States will in turn reproduce the Convention wording of this and the following Articles when defining the rights granted to a breeder at the national level. By using the text contained in the 1991 Act for a national law, the State concerned will be able to take advantage of the case law of other States based on the same text.

## Paragraph (1)

13.2 *General remarks*. - This paragraph defines the fundamental right conferred by the grant of a breeder's right. The right is subject to some exceptions (Article 14) and to the principle of exhaustion (Article 15).

13.3 *General nature of the right*. - This right is similar to that conferred by a patent to the extent that the authorization of its owner is required in order to carry out certain acts of exploitation. In other words, it is a right to prohibit and not an exclusive—positive—right to do.

13.4 The holder may exercise his righ t in two principal ways: either by retaining the exclusive right to exploit the variety, or by granting licenses.

13.5 *Acts of exploitation*. - Paragraph (1) lists seven acts of exploitation that can be grouped in three categories: production, trading, stocking.

13.6 Acts of production—in the broad sense—are dealt with in subparagraphs (i) and (ii). It should be emphasized that "propagating material" means, in particular, the parts of the plant intended for the production of new plants, for example seeds, and that certain parts of plants may be used for either consumption or sowing. The holder may therefore authorize the growing of his variety with a view to the production of seeds; in that case, it would be a prior authorization under subparagraph (i) and, because of the continuity aspect, under subparagraph (ii).

13.7 It could happen, however, that a variety is grown for consumption but, during the growing period or after the harvest, it is decided that the harvested material will be used as seed, after "conditioning for the purpose of propagation." The main object of subparagraph (ii) is to allow the holder to intervene at the conditioning stage, especially in cases of infringement. This subparagraph does not therefore imply an extension of the right conferred by a breeder's right but is basically aimed at facilitating the exercise of the right.

# CHAPTER III

# THE RIGHTS OF THE HOLDER

## Article 13

## Scope of the Breeder's Right

**(1) Subject to Articles 14 and 15, the following acts in respect of the propagating material of the protected variety shall require the authorization of the holder:**

**(viii) production or reproduction (multiplication),**

**(ix) conditioning for the purpose of propagation,**

**(x) offering for sale,**

**(xi) selling or other marketing,**

**(xii) exporting,**

**(xiii) importing,**

**(xiv) stocking for any of the purposes mentioned in (i) to (vi), above.**

**(2) Subject to Articles 14 and 15, the acts referred to in items (i) to (vii) of paragraph (1) in respect of harvested material, including entire plants and parts of plants, obtained through the unauthorized use of propagating material of the protected variety shall require the authorization of the holder, unless the holder has had reasonable opportunity to exercise his right in relation to the said propagating material.**

**(3) [*Alternative A*] Where so provided in the Regulations in respect of varieties of a specified plant genus or species and subject to Articles 14 and 15, the acts referred to in items (i) to (vii) of paragraph (1) in respect of products made directly from harvested material of the protected variety falling within the provisions of paragraph (2) through the unauthorized use of the said harvested material shall require the authorization of the holder, unless the holder has had reasonable opportunity to exercise his right in relation to the said harvested material.**

**[*Alternative B*: no paragraph]**

13.8 The above explanation is also applicable to offering for sale (subparagraph (iii)) in connection with selling or other marketing (subparagraph (iv)), and to stocking (subparagraph (vii)) in connection with other acts of exploitation.

Paragraph (2)

13.9 A variety can be exploited in the country in which it is protected by a breeder's right without this taking the form, in that country, of production of propagating material or of a trade act related to such material, in other words, without the owner of the breeder's right being able to exercise his right under paragraph (1). This is the case, for example, when the harvested material is imported. The aim of paragraph (2) is to give the holder the possibility of exercising his right in relation to the harvested material under the circumstances defined in this particular paragraph.

13.10 Special attention should be paid to the wording of this provision if it is decide d not to use the text of the Convention: the text proposed in the Model Law implies that, in any action for infringement, the defendant will have to prove that the plaintiff (the holder of the right) could reasonably have exercised his right at an earlier stage.

Paragraph (3)

13.11 Like the preceding Acts, the 1991 Act defines the minimum scope of the breeder's right and indicates that this may be extended in a particular direction: according to paragraph (3) of Article 14 of this Act, the Contracting Parties may give a breeder the possibility of exercising his right in respect of products made directly from the harvested material if, briefly stated, he has not had a reasonable opportunity to exercise his right at an earlier stage. Such a possibility will be of particular interest for species in which the product sold is a processed product; this is the case, for example, for pharmaceutical plants and plants for perfumes.

13.12 Paragraph (3) as proposed must essentially be treated as a checklist item . It mentions the possibility of extending the basis of the right ( *Alternative A*) or of not providing for such an extension ( *Alternative B*). In the former case, it also mentions that the area is one in which it would be wise to state the principle in the law and provide for its application in the regulations (or any other implementing text), according to need.

13.13 The 1991 Act also provides for the possibility of extending a breeder's right to acts other than those mentioned in subparagraphs ( i) to (vii) of paragraph (1) of the Model Law. This possibility is not mentioned in the Model Law itself.

Paragraph (4)

13.14 This paragraph corresponds to Article 14(1) *(b)* of the 1991 Act. Naturally, the conditions and limitations should conform to the general principles of law and more particularly those of competition law.

**(4)[12] The holder may make any authorization granted pursuant to [paragraph (1), (2) or (3)][13] subject to conditions and limitations.**

**(5) *(a)*[14] The provisions of [paragraphs (1) to (4)][15] shall also apply in relation to**

**(iv) varieties which are essentially derived from the protected variety, where the protected variety is not itself an essentially derived variety,**

**(v) varieties which are not clearly distinguishable in accordance with Article 7 from the protected variety and**

**(vi) varieties whose production requires the repeated use of the protected variety.**

***(b)* For the purposes of subparagraph *(a)*(i), a variety shall be deemed to be essentially derived from another variety ("the initial variety") when**

**(iv) it is predominantly derived from the initial variety, or from a variety that is itself predominantly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety,**

**(v) it is clearly distinguishable from the initial variety and**

**(vi) except for the differences which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.**

***(c)* Essentially derived varieties may be obtained for example by the selection of a natural or induced mutant, or of a somaclonal variant, the selection of a variant individual from plants of the initial variety, backcrossing, or transformation by genetic engineering.**

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12 "(3)" where Alternative B to the proposed paragraph (3) is adopted.

13 "Paragraphs (1) or (2)" where Alternative B to the proposed paragraph (3) is adopted.

14 "(4)*(a)*" where Alternative B to the proposed paragraph (3) is adopted.

15 "Paragraphs (1) to (3)" where Alternative B to the proposed paragraph (3) is adopted.

Paragraph (5)

13.15 *General remarks.* This paragraph corresponds to Article 14(5) of the 1991 Act.

13.16 This paragraph gives the holder full and comprehensive rig hts in relation to three categories of variety. In two cases however—provided for in subparagraphs (i) and (iii)—his right may coexist (be in competition) with another right. The holders concerned will then have to reach agreement so that the varieties in question can be exploited. Such interdependence of rights is common in the case of patents.

13.17 *Essentially derived varieties.* - The concept of essentially derived varieties is probably the most important innovation in the 1991 Act. It is dealt with in detail in an Annex to this document.

13.18 *Varieties not clearly distinguishable.* - Alleged infringers taken to court have sometimes argued that they did not (unlawfully) exploit the protected variety but rather material that was slightly, albeit not clearly, distinguishable from the protected variety (for many experts, such material would not be regarded as constituting another variety). The aim of subparagraph (ii) is to avoid this type of defense.

13.19 *Varieties produced by repeated use of the protected variety.* - Subparagraph (iii) reproduces a provision of the 1978 Act: the purpose of certain varieties is to be used as the parent for the commercial production of seeds of another variety to be exploited commercially among farmers and by them. This is typically the case of inbred lines used to develop hybrids. In order to be effective, the breeder's right in relation to the line should extend to the hybrid.

13.20 Hybrid seeds are produced within the framework of a system that is closely controlled by the breeder (or breeders) concerned. It is sometimes considered that breeders of hybrid varieties do not require legal protection because they have "biological" protection. Experience shows on the one hand that this "biological" protection is often very relative, and on the other that breeders of hybrid varieties see just as great an interest in legal protection as breeders of pure-line varieties.

# COMMENTARY ON ARTICLE 14

Basis in the Convention

14.1 This Article corresponds to Article 15 of the 1991 Act.

Paragraph (1)

14.2 This paragraph sets out the compulsory exceptions to breeders' rights.

14.3 The cases mentioned in subparagraphs ( i) and (ii) are customary in industrial property law. "Acts done privately and for non-commercial purposes" means exploitation of the variety concerned (the protected variety or, for example, an essentially derived variety) by a farmer in a subsistence production system (in order to meet his family's needs) or by an amateur gardener.

14.4 The case referred to in subparagraph (iii) is specific to the protection regime for new plant varieties based on the UPOV Convention. This provision—often called "breeder's exemption")—is in fact a cornerstone of the regime: in order to ensure the continuity of improvement breeding, it must be possible to use any variety freely as a genetic resource, and—with some exceptions—it must also be possible to exploit freely any variety produced subsequently as a result of the utilization, in other words without having to obtain the consent of the breeders of the original varieties. A breeder who has freely utilized a protected variety in order to create his own variety must, in return, agree to another breeder's use of his variety as a source of genetic variation in order to create a further variety.

14.5 The exceptions are the varieties referred to in the last subparagraph of Article 13(4), namely essentially derived varieties, varieties that are not clearly distinguishable and varieties whose production requires repeated use of the protected variety or a variety indirectly covered by the breeder's right; the latter case can be illustrated by the example of a single-cross maize hybrid: if it is protected, another breeder may not use the commercial seeds of the hybrid to produce double-cross hybrid seeds without the consent of the original breeder.

14.6 The exceptions do not concern use of the protected variety as an initial source of variation but only exploitation of the variety created as a result of that use. The aim of these exceptions is also to ensure the continuity of improvement breeding (see the Annex to this document).

Paragraph (2)

14.7 This provision is in square brackets to indicate that it is not proposed wording but basically a checklist item. Throughout the world farmers usually keep back part of their harvest as seed for the next crop ("farm-saved seed"). The 1991 Act allows Contracting Parties to adopt provisions on farm-saved seed. In view of the variety of circumstances that have to be taken into account, it simply states that the limitation of the breeder's right must be within reasonable limits and that the legitimate interests of the breeder must be safeguarded.

## Article 14

## Exceptions to the Breeder's Right

**(1) The breeder's right shall not extend to**

**(iv) acts done privately and for non-commercial purposes,**

**(v) acts done for experimental purposes and**

**(vi) acts done for the purpose of breeding other varieties, and, except where the provisions of [Article 13(5)][16] apply, acts referred to in [Article 13(1) to (3)][17] in respect of such other varieties.**

**[(2) The legislation may, within reasonable limits and subject to the safeguarding of the legitimate interests of breeders, restrict breeders' rights in relation to varieties of specified plant genera and species in order to permit farmers to use for propagating purposes, on their own holdings, the product of the harvest which they have obtained by planting, on their own holdings, a variety of any such plant genus or species that is the subject of a breeder's right or is covered by [Article 13(5)*(a)*(i) or (ii)][18].]**

16 "Article 13(4)" where Alternative B to the proposed Article 13(3) is adopted.

17 "Article 13(1) and (2)" where Alternative B to the proposed Article 13(3) is adopted.

18 "Article 13(4)*(a)*(i) or (ii)" where Alternative B to the proposed Article 13(3) is adopted.

14.8 Many States, including developing countries, apply such a provision and offer models in terms of both substance and drafting. The text in the Model Law suggests that the exception should apply only to genera and species specifically designated in the regulations. The Diplomatic Conference that adopted the 1991 Act also adopted a Recommendation according to which Article 15(2) of the 1991 Act "should not be read so as to be intended to open the possibility of extending the practice commonly called 'farmer's privilege' to sectors of agricultural or horticultural production in which such a privilege is not a common practice on the territory of the Contracting Party concerned."

14.9 Article 15(2) of the 1991 Act and also the text in the Model Law limit the exception to the breeder's right to the protected variety and any essentially derived varieties or varieties that are not clearly distinguishable, on the understanding that this exception does not apply to varieties whose production requires the repeated use of other varieties.

## COMMENTARY ON ARTICLE 15

15.1 *Basis in the Convention.* - This Article corresponds to Article 16 of the 1991 Act.

15.2 *The general principle and its effects.* - The rule of exhaustion, which is common in industrial property law, is aimed at ensuring that the holder of a breeder's right can only exercise his right—and receive remuneration—once in every production cycle. For example, if he has put some seeds on the market, he cannot prohibit their resale, their use to produce a harvest, the sale or processing of the harvest, etc. If technical and economic conditions allow him to exercise his right by granting production licenses for the harvested material—for example, cut flowers—he may not prohibit the resale of the cut flowers marketed by those holding licenses.

15.3 *Exceptions.* - There are two exceptions to the rule of exhaustion. First, the right is not exhausted when, for example, certified wheat seeds are sold to farmers so that they can produce wheat for consumption and are in fact used (outside the framework of the "farmer's privilege") to produce a new generation of seeds; the right is restored when harvested material sold for the purposes of consumption is used as seed. Secondly, export may be subject to a special authorization under the conditions specified in the text of the Model Law.

## Article 15

## Exhaustion of the Breeder's Right

**(1) The breeder's right shall not extend to acts concerning any material of the protected variety, or of a variety covered by the provisions of [Article 13(5)][19], which has been sold or otherwise marketed by the holder or with his consent in the territory of *the State*, or any material derived from the said material, unless such acts**

**(iii) involve further propagation of the variety in question or**

**(iv) involve an export of material of the variety, which enables the propagation of the variety, into a country which does not protect varieties of the plant genus or species to which the variety belongs, except where the exported material is for final consumption purposes.**

**(2) For the purposes of paragraph (1), "material" means, in relation to a variety,**

**(iv) propagating material of any kind,**

**(v) harvested material, including entire plants and parts of plants, and**

**(vi) any product made directly from the harvested material.**

[19] "Article 13(4)" where Alternative B to the proposed Article 13(3) is adopted.

## COMMENTARY ON ARTICLE 16

16.1 This Article corresponds to Article 18 of the 1991 Act and is basically a checklist item. The effect of the protection system is to create a right of ownership, and that right must be able to exist independently of the provisions regulating commerce; as for the exercise of the right, it of course is subject to those provisions.

16.2 In particular, where national legislation provides for an o fficial catalogue of varieties approved for trade, the grant of a breeder's right may not be conditional on the variety being included in the catalogue.

16.3 Reference should also be made in this connection to Article 10 of the 1991 Act, according to which a Contracting Party may not enact provisions restricting a breeder's freedom of choice of the Contracting Parties in which he wishes to have his variety protected or the order in which he wishes to file his applications.

## Article 16

## Measures Regulating Commerce

**The breeder's right shall be independent of any measure taken by *the State* to regulate within its territory the production, certification and marketing of material of varieties or the importing or exporting of such material.**

## COMMENTARY ON ARTICLE 17

17.1 *Basis in the Convention.* - This Article corresponds to Articles 19 and 13 of the 1991 Act.

17.2 *Duration of protection.* - The 1991 Act lays down the minimum periods of protection from the date of grant a breeder's right; those periods are reproduced in the Model Law, but in square brackets to indicate the possibility of adopting longer terms.

17.3 The Model Law proposes that protection expire at the end of a calendar year. This system has been adopted by several member States, so that the annual fees to keep a breeder's right in force fall due at the beginning of each year, for all varieties. This facilitates the administration of rights for holders and also for the Office. Such a system is provided for in Article 46.

17.4 *Provisional protection.* - The 1991 Act also provides a minimum in this respect, namely the possibility for a breeder (applicant) to obtain equitable remuneration later, once the breeder's right has been granted, for any exploitation of the variety that occurred while the application was pending and would have required his consent had the right already been granted. This possibility is provided for in *Alternative A*.

17.5 The 1991 Act, for example, allows the right to arise from the filing of the application or its publication, depending on national practice. These possibilities are set out in *Alternatives 1* and *2*. In addition, it is stated that a Contracting Party may provide that the holder of a breeder's right is only entitled to remuneration from a person to whom he has notified the filing of the application. This provision has not been included in the Model Law, because the rule in question very often derives from texts governing civil proceedings.

17.6 *Alternative A* does not allow the applicant to apply for a restraining injunction. In many cases the possibility of taking such a step is extremely important because it allows the breeder to put his variety on the market without any risk as soon as he has filed his application. Some States have therefore decided on provisional protection that gives the applicant all the rights available under the breeder's right, with restrictions regarding the exercise of those rights. This possibility is set out in *Alternative B*.

17.7 In a provisional protection system of this type, the applicant may enter into license agreements in accordance with the law; this possibility is mentioned in Article 19 of the Model Law.

## Article 17

## Duration of the Breeder's Right; Provisional Protection

**(1) The breeder's right shall expire at the end of the [twentieth] calendar year following the grant thereof; for trees and grapevine, it shall expire at the end of the [twenty-fifth] year.**

**(2) [*Alternative A*] In respect of the period between [*Alternative 1*: the filing] [*Alternative 2*: the publication] of the application and the grant of the breeder's right, the holder shall be entitled to equitable remuneration from any person who, during the said period, has carried out acts which, once the right has been granted, require the holder's authorization as provided in Article 13.**

**[*Alternative B*] The applicant shall enjoy all rights provided for in this Chapter as from the filing of the application.**

## COMMENTARY ON ARTICLE 18

18.1 This Article sets out some simple rules regarding breeders' rights as property. Taking into account the wide variety of socio-economic and legal situations, these rules can only serve as examples. It is generally preferable to align them as closely as possible on the corresponding provisions in texts governing such things as patent law.

18.2 In any event, these rules are applicable to a breeder's right that has been granted, to the right to be granted such a title and to the rights deriving from the application, due account being taken of the interconnectedness of these three types of property.

# CHAPTER IV

# THE BREEDER'S RIGHT AS AN ITEM OF PROPERTY

## Article 18

## Transfer of Ownership

**(1) The right to apply for the grant of a breeder's right, the rights under an application and the breeder's right shall be treated in all respects as items of [intangible personal] [moveable] [industrial] [intellectual] property, and the general law relating to such property shall, except where otherwise provided in this Law, be applicable thereto.**

**(2) Such items of property may be transferred to one or more successors in title. Any transfer by assignment shall be made in writing.**

**(3) Any act by which the right to apply for the grant of a breeder's right, the rights under an application or the breeder's right are transferred or modified shall not affect the rights acquired by third parties before the date of the act.**

**(4) Any act by which the rights under an application or a breeder's right are transferred or modified, including judicial assignment, shall not be binding on third parties until it has been entered in the Register of Applications or the Register of Rights, as the case may be.**

**(5) However, an act shall be binding before such entry on third parties who acquire rights after the date of the act with notice of the act.**

## COMMENTARY ON ARTICLE 19

19.1 Like the preceding Article, this Article sets out some simple rules to serve as examples in the light of the precedents set by other branches of intellectual property law.

19.2 It should be noted, however, that certain types of variety will often be exploited by a large number of operators working within a hierarchy of licenses and sublicenses (producers and sellers of seeds, seed producers). The provisions on administrative procedures, notably the registration of the license with the Office, must therefore not be too cumbersome. Consequently, the Model Law proposes that the registration of licenses, even exclusive licenses, be merely optional.

19.3 Article 19 gives two alternatives in paragraphs (1) an d (3)(*a*). These depend on the type of provisional protection adopted (the right to subsequent remuneration in the case of *Alternative A* and full rights in the case of *Alternative B*).

# CHAPTER V

# EXPLOITATION LICENSES

## Article 19

## Contractual Licenses

**(1) [*Alternative A, linked to Alternative A for Article 17(2)*: The holder] [*Alternative B, linked to Alternative B for Article 17(2)*: The applicant or the holder] may grant an exclusive or non-exclusive license relating to all or any of the rights provided for in Chapter III of this Part to any person.**

**(2) The license contract shall be in writing.**

**(3) *(a)* Any exclusive license may be entered in [*Alternative A, linked to Alternative A for Article 17(2)*: the Register of Rights] [*Alternative B, linked to Alternative B for Article 17(2)*: the Register of Applications or the Register of Rights, as the case may be], and a notice concerning it shall be published in the Gazette. A non-exclusive license may also be so entered, and the entry published at the request of either party to the contract.**

***(b)* An exclusive license shall not be binding on a third party who has acquired rights in the breeder's right in good faith unless it was so entered prior to the date of acquisition.**

# COMMENTARY ON ARTICLE 20

## Basis in the Convention

20.1 This Article is based on Article 17 of the 1991 Act, which authorizes Contracting Parties to restrict the free exercise of a breeder's right only in the public interest, and requires any compulsory license to contain a condition of equitable remuneration payable to the holder of the breeder's right.

20.2 The TRIPS Agreement is no doubt a second important source of obligations under international law. It will be necessary to provide for the possibility of bringing a case before the courts if there is disagreement on the grant or the conditions of a compulsory license. This possibility is provided for in general terms in Article 28 of the Model Law.

## General remarks

20.3 This is also an area in which some harmonization with other branches of intellectual property law is required, on the understanding however that the special characteristics of the subject matter of the breeder's right—the variety—may call for special solutions.

20.4 Experience in member States shows that compulsory licenses play a minor role in the area of plant varieties; nevertheless, the vast majority of States have legislated to allow their grant. The public interest can only be a factor with species that are indispensable to human or animal life and health. In addition, it is in the breeders' interest to market their varieties as widely as possible. Finally, the assortment of varieties is such that a user can always find an alternative.

20.5 There are two special cases, however: varieties essentially derived from the protected variety and varieties whose production requires repeated use of the protected variety. The provisions of the law should be so worded as to open the possibility of granting a compulsory license to allow the breeder of an essentially derived variety, for example, to exploit it. The Model Law achieves this by making no reference to the varieties concerned.

## Paragraph (1)

20.6 This paragraph sets out two principles: on the one hand, it deals with the public interest, and only applies if it is at stake; on the other, the safeguarding of the public interest is entrusted to economic entities and not to the authorities, which act as arbitrators (although it is possible to introduce a system that would entrust the initiative for action to the authorities alone or to them and to economic entities).

20.7 The public authority empowered to grant compulsory licenses may be the Office, a higher authority, for example the relevant ministry, or a court. The Model Law opts for the first solution. Of the three authorities, the Office is the one

that will be best acquainted with

## Article 20

## Compulsory Licenses

**(1) Any person may, by means of an application filed with the Office, seek the grant of a compulsory license in respect of the breeder's right. The Office shall grant the compulsory license only where this is necessary to safeguard the public interest.**

**(2) A compulsory license shall not be granted unless all the following conditions are fulfilled:**

**(v) The applicant for the grant of a compulsory license must be financially and otherwise able to exploit the breeder's right in a competent and efficient manner, and also willing to do so;**

**(vi) The holder has refused to grant the applicant a license or is not prepared to grant a license on reasonable terms;**

**(vii) [Three] years have elapsed between the date of the grant of the breeder's right and the date of the application for the grant of a compulsory license;**

**(viii) The applicant for the grant of a compulsory license has paid the fee prescribed in the Regulations for such grant.**

**(3) The compulsory license shall confer on the licensee a non-exclusive right to perform all or any of the acts referred to in Article 13, for the supply of the national market.**

**(4) When granting a compulsory license, the Office shall fix the equitable remuneration which the licensee shall pay to the holder. The licensee shall give the holder adequate security for the payment of the remuneration.**

**(5) The Office may require the holder to provide the licensee with as much propagating material as is necessary for reasonable use to be made of the compulsory license, against payment of adequate remuneration to the holder.**

**(6) The duration of the compulsory license shall be fixed by the Office. Only under exceptional circumstances shall the compulsory license be granted for less than [two] or more than [four] years. The term of the license may be extended where the Office is satisfied, on the basis of a new examination, that the conditions for the grant of the license continue to exist on the expiry of the first term.**

**(7) The Office shall withdraw the compulsory license where its owner has violated the conditions under which it was granted.**

**(8) Before granting a compulsory license, the Office may hear national professional organizations active in the field concerned.**

the economic sector. Under paragraph (8), the Office may also seek the advice of national professional organizations in the economic sector concerned; the relatively small size of the sector makes such concerted action possible.

Paragraph (2)

20.8 This paragraph sets out a series of conditions to be fulfilled prior to the grant of a compulsory license, indeed even to the consideration of an application for such a license. These conditions are additional to the prime condition, namely the need to safeguard the public interest. Subparagraph (iii) protects the holder of the right from untimely claims while he is developing a market after having been granted a breeder's right. "Three" is placed in square brackets to indicate that there is a choice.

Paragraph (3)

20.9 This paragraph prescribes the scope of the compulsory license. It may only be non-exclusive. The holder of a breeder's right may therefore exploit the variety himself and grant licenses. In general, the exploitation rights granted under the license must correspond to the public interest that has to be served. Only the need to supply the domestic market may give rise to the grant of a compulsory license.

20.10 The Model Law is silent on the question whether the licensee may transfer it or grant sublicenses. It is possible to imagine situations in which such a course of action should be allowed, for example, where the license concerns the exploitation of an essentially derived variety.

Paragraphs (4) to (6)

20.11 These paragraphs deal with various licensing conditions. In general, they will be equivalent to the conditions laid down for voluntary licenses granted under the same circumstances, except with regard to the duration of the license.

## COMMENTARY ON ARTICLE 21

21.1 Like other intellectual property rights deriving from registration, a breeder's right may be terminated prematurely. According to *Alternative A*, two cases may arise: surrender of the rights, which calls for a written declaration, and failure to pay the annual fee. In *Alternative B*, the holder of the breeder's right may not simply relinquish his right but must expressly surrender it.

# CHAPTER VI

# LAPSE OF THE BREEDER'S RIGHT

## Article 21

## Premature Termination

**[*Alternative A, linked to Alternative A for Article 46(1)*]**

**(1) The breeder's right shall terminate before the term provided in Article 17(1) expires**

**(iii) where the holder surrenders it in a written declaration addressed to the Office, or**

**(iv) where an annual fee has become due and has not been paid.**

**(2) In the first case, the date of termination shall be that specified in the declaration or, if none is specified, the date of receipt of the declaration. In the second case, it shall be the due date of the fee.**

**[*Alternative B, linked to Alternative B for Article 46(1)*]**

**The breeder's right shall terminate before the term provided in Article 17(1) expires where the holder surrenders it in a written declaration addressed to the Office. The date of termination shall be that specified in the declaration or, if none is specified, the date of receipt of the declaration.**

## COMMENTARY ON ARTICLE 22

22.1 This Article is based on Article 21 of the 1991 Act. It should be noted that the latter does not allow any grounds for nullity other than those set out in paragraph (1). Briefly, a breeder's right is declared null and void when it has been granted by mistake.

22.2 The result of nullity is that the breeder's right is deemed never to have been granted. In principle, therefore, nullity has a retroactive effect. The situation may be more complex in practice, however. Any person who has concluded a licensing agreement will certainly have had to pay royalties, but he will also have benefited from exclusive exploitation under the breeder's right granted by mistake. In this connection, reference may be made to the statute and case law applicable to patents. According to the circumstances, this aspect may be left out of the law (as it is in the Model Law), more detailed rules may be laid down or a reference to patent law may be made.

22.3 The Model Law proposes that the annulment procedure be initiated at the request of a person having a legitimate interest (it could also be started *ex officio*). In addition, competence in annulment matters has been given to the Office (it could also be given to the judiciary).

## Article 22

## Nullity

**(1) The Office shall declare a breeder's right null and void when it is established**

**(iv) that the variety was not new (Article 6) or distinct (Article 7) at the date of filing of the application or, where relevant, at the date of priority,**

**(v) that, where the grant of the breeder's right has been essentially based upon information and documents submitted by the applicant, the variety was not uniform (Article 8) or stable (Article 9) at the said date, or**

**(vi) that the breeder's right has been granted to a person who is not entitled to it and the entitled person has not brought an action for judicial assignment under Article 12 or has renounced the right to bring such an action.**

**(2) Subject to any provision to the contrary in this Law, the breeder's right that has been declared null and void shall be deemed never to have been granted.**

**(3) Any person having a legitimate interest may file a request for annulment with the Office.**

## COMMENTARY ON ARTICLE 23

23.1 This Article is based on Article 22 of the 1991 Act. Briefly, the holder may be deprived of his rights if he does not meet the obligations incumbent on him under Articles 45 and 47.

23.2 Article 23 does not mention non-payment of the annual fee, unlike Article 22 of the 1991 Act; this is covered by *Alternative A* of Article 21.

23.3 Cancellation does not have any retroactive effect: a title that has been rightfully granted simply ceases to exist on a given date.

## Article 23

## Cancellation

**(1) The Office shall cancel a breeder's right when it is established that the holder has failed to meet his obligation under Article 47(1) and that the variety is no longer uniform or stable.**

**(2) *(a)* Furthermore, the Office shall cancel a breeder's right when**

**(iii) the holder does not meet a request made by the Office under Article 47(2) for the purpose of verifying the maintenance of the variety, or**

**(iv) the Office proposes to cancel the existing denomination of the variety and the breeder does not propose a suitable denomination within the period prescribed by the Office (Article 45).**

***(b)* A breeder's right may only be canceled after the holder has been given notice of his obligation and allowed a reasonable period, specified in the notice, to comply therewith.**

**(3) The cancellation shall take effect on the date of its entry in the Register of Rights.**

## COMMENTARY ON ARTICLE 24

24.1 This Article is based on Article 30(1)(iii) of the 1991 Act. In general, it meets the need to inform the public.

## Article 24

## Publication of the Lapse

**The premature termination, nullity or cancellation of a breeder's right under Article 21, 22 or 23 and the ground for it shall be entered in the Register of Rights. They shall also be published in the Gazette.**

## COMMENTARY ON ARTICLE 25

25.1 This Article reflects a structure that has been adopted in some member States; it has the advantage of allowing the plant variety protection system to be managed jointly by all partners in the varieties and seeds sector.

25.2 Other States have even empowered this Council to decide on individual cases, such as on the grant of breeders' rights. The Council is in that case assisted by a Secretariat (General).

25.3 The majority of member States have made no provision for a Council.

25.4 The Model Law refers to a Council because it is easier, for a State wishing to draw inspiration from the Model Law, to lease out unwanted provisions.

# PART III

# ORGANIZATION AND PROCEDURE

## CHAPTER I

## ORGANIZATION, COMPETENCE AND GENERAL RULES OF PROCEDURE

### Article 25

### Plant Breeders' Rights Council

**(1) The Minister shall appoint a Plant Breeders' Rights Council composed of representatives of the various circles having an interest in the protection of plant varieties.**

**(2) The Council shall be presided over by a [Magistrate of the Court of Appeal of ...] [senior official of the Ministry].**

**(3) The conditions governing the appointment of the members of the Council and the operation of the Council shall be specified in Regulations.**

**(4) The Council shall give advice and make proposals to the Minister, assist through its advice the Office in the implementation of this Law and carry out the other tasks which are specifically entrusted to it by this Law.**

## COMMENTARY ON ARTICLE 26

26.1 This Article is based on Article 30(1)(ii) of the 1991 Act. It is basically a checklist item, and States will have to define the role, composition and form of operation, etc. of the Office in the light of their national circumstances.

26.2 The following are the principal options available:

(c) To create a new administrative structure;

(d) To entrust responsibility for administering the protection system to an existing structure, such as a department of the relevant ministry (in this particular case, it is usually the Ministry of Agriculture), to an administrative structure already active in the area of varieties and seeds (such as the department responsible for administering the catalogue of varieties approved for trade) or to the Patent Office if the plant patent option is chosen.

26.3 Administrative responsibilities can also be dissociated from technical work (examination of varieties). It is in fact highly desirable to call on all existing structures for examination, so as to make the protection system as cost-efficient as possible.

26.4 The present member States offer a wide diversity of model structures.

## Article 26

## Plant Breeders' Rights Office

**(1) The Plant Breeders' Rights Office is hereby established [as a public authority with legal personality].**

**(2) The Office shall be represented by its [President] who shall be appointed and may be removed from office by the Minister.**

**(3) Decisions of the Office shall be taken by or under the authority of the [President].**

## COMMENTARY ON ARTICLE 27

27.1 This Article sets out a general procedural principle as a checklist item.

## Article 27

## Right to be Heard by the Office

**(1) Any proposed decision of the Office adversely affecting a party to proceedings before it shall be communicated to that party with a statement of the reasons for the proposed decision.**

**(2) The said party shall be given an opportunity to submit comments orally or in writing within thirty days from the date of receipt of the notice.**

## COMMENTARY ON ARTICLE 28

28.1 This Article is based on Article 30(1)( i) of the 1991 Act and on a general principle of law.

28.2 Although this is basically a checklist item, as each State is responsible for writing its legislation to suit its national circumstances, two alternatives are offered. *Alternative A* is recommended for States expecting to have a relatively low volume of activity that would not justify having a first instance, while *Alternative B* provides for the setting up of an Appeal Board. Some States have decided on the Appeal Board of the Patent Office as the first instance.

## Article 28

## Appeals

*[Alternative A]*

**An appeal shall lie from any decision taken by the Office pursuant to this Law to the [Tribunal].**

*[Alternative B]*

**(1) An appeal shall lie from any decision taken by the Office pursuant to this Law.**

**(2) An Appeal Board shall be set up.**

**(3) A further appeal shall lie against the decisions of the Appeal Board to the [Tribunal].**

## COMMENTARY ON ARTICLE 29

29.1 This Article deals with a number of issues that have to be considered when a national law is drafted. From the point of view of overall policy, special attention should be paid to the question of access to information. The Model Law proposes that such access be restricted to persons having a legitimate interest, but with very extensive access being afforded to documents and tests.

29.2 One exception is provided however, mainly for hybrids. In view of the special nature of variety creation in that sector, breeders do not want the formulas of their hybrids to be disclosed. The proposed provision makes the protection system attractive for such breeders.

## Article 29

## Registers; Preservation of Files

**(1) The Office shall maintain a Register of Applications and a Register of Breeders Rights. The Registers shall be open to public inspection.**

**(2) Any person having a legitimate interest may inspect**

**(iv) the documents relating to applications,**

**(v) the documents relating to breeders' rights already granted, and**

**(vi) the growing tests and other necessary tests under Article 37 or Article 48.**

**(3) In the case of varieties the production of which requires repeated use of other varieties (components), the applicant may, when making his application, request that the documents and tests relating to the components be withheld from inspection.**

**(4) The Office shall preserve the originals or copies of the documents in the files until five years after the withdrawal or rejection of the application, or the lapse of the breeder's right, as the case may be.**

## COMMENTARY ON ARTICLE 30

30.1 This Article is based on Article 30(1)(iii) of the 1991 Act and on the general need to inform the public.

30.2 The Model Law refers only to "regular intervals." In practice, Gazettes are monthly, two-monthly or quarterly in member States, depending on the volume of the Office's activities.

30.3 UPOV has published a Model Plant Breeders' Rights Gazette. States that use the model present the information in a standardized form that serves to overcome a great many linguistic obstacles. UPOV is at present preparing another communication tool in the form of a database on a CD-ROM disc.

## Article 30

## Gazette

**The Office shall publish a Gazette at regular intervals. The Gazette shall record the following:**

**(xi) Applications for the grant of breeders' rights;**

**(xii) Applications for variety denominations;**

**(xiii) Registrations of new denominations for protected varieties;**

**(xiv) Withdrawals of applications for the grant of breeders' rights;**

**(xv) Rejections of applications for the grant of breeders' rights;**

**(xvi) Grants of breeders' rights;**

**(xvii) Changes in the persons (applicants, holders and procedural representatives);**

**(xviii) Lapses of breeders' rights;**

**(xix) Licenses;**

**(xx) Official announcements.**

## COMMENTARY ON ARTICLE 31

31.1 This Article is basically a chec klist item.

31.2 The main fees usually charged by member States are for the following acts: filing of the application (often with special fees if the priority of an application filed in another member State is claimed, or if an application is filed without a proposed variety denomination); examination of the variety (a fee per growing season or a fee equal to the amount invoiced by the relevant service in another member State where there has been cooperation in examination); issue of the title. In addition, an annual fee is generally paid for a breeder's right to remain in force. As mentioned in connection with Article 17(1), the Model Law suggests that annual fees should fall due on one and the same date; in this connection, see Article 46.

## Article 31

## Fees

**The administrative acts of the Office shall give rise to the payment of fees, in amounts and under conditions specified in the Regulations.**

## COMMENTARY ON ARTICLE 32

32.1 This Article is basically a checklist item. One could, in preference to the *restitutio in integrum* solution, provide for an additional time limit against payment of a surcharge.

## Article 32

### *Restitutio in integrum*

**(1) Where, in spite of having taken all due care in the particular circumstances, the applicant or the holder, or any other party to proceedings before the Office, has been unable to observe a time limit in dealings with the Office, his rights shall, on request, be restored if the loss of any right or means of redress provided for in this Law is directly attributable to his failure to observe the said time limit.**

**(2) The request shall be submitted within two months after the cause of non-compliance has ceased to operate and, in any event, within one year following the expiry of the unobserved time limit. The request shall be properly substantiated and shall be accompanied by the fee for *restitutio in integrum*.**

**(3) The department competent to decide on the omitted act shall decide upon the application.**

**(4) Where the request is granted, the petitioner shall be given a time limit equal to the unobserved time limit, starting on the date of receipt of notice of the decision, within which to perform the omitted act.**

**(5) Where the rights are restored, the petitioner may not assert his rights against any person who, in good faith, has engaged in, or taken genuine and effective measures with a view to, exploitation in the period between the loss of the rights and the publication of the notice on the restoration thereof.**

## COMMENTARY ON ARTICLE 33

33.1 This Article sets out certain principles applicable to the form and content of applications. UPOV has published a model application form which provides further details on this subject.

# CHAPTER II

# THE APPLICATION

## Article 33

## Form and Content of the Application

**(1) Any person wishing to have a variety protected shall file an application with the Office and pay the application fee.**

**(2) The application shall contain at least the following elements:**

**(viii) the name and address of the applicant and, where relevant, his procedural representative;**

**(ix) the name and address of the breeder, if he is not the applicant;**

**(x) the identification of the botanical taxon (Latin and common name);**

**(xi) the denomination proposed for the variety, or a provisional designation (breeder's reference);**

**(xii) where the priority of an earlier application is claimed, the Contracting Party with which the application was filed and the filing date;**

**(xiii) a technical description of the variety;**

**(xiv) proof of payment of the application fee.**

**(3) The detailed form and content of the application, and the documents to be attached, shall be specified in Regulations.**

## COMMENTARY ON ARTICLE 34

34.1 This Article is based on Article 11 of the 1991 Act.

34.2 Paragraph 3(*b*) allows the Office a degree of flexibility regarding the submission of translations. This is due to the fact that the standardization of national application forms based on the UPOV model form makes it easy to overcome language barriers.

## Article 34

## Priority

**(1) The applicant may avail himself of a right of priority based upon an earlier application that has been duly filed for the same variety, by himself or by his predecessor in title, with the Authority of a Contracting Party.**

**(2) *(a)* Where the application filed with the Office is preceded by several such applications, priority may be based only on the earliest application.**

***(b)* The right of priority shall be expressly claimed in the application filed with the Office. It may only be claimed within a period of twelve months from the date of filing of the earliest application. The day of filing shall not be included in the said period.**

**(3) *(a)* In order to avail himself of the right of priority, the applicant shall submit to the Office, within three months from the filing date referred to in Article 35(4), a copy of the first application, certified to be a true copy by the authority with which that application was filed.**

***(b)* The Office may request that a translation of the first application be produced within three months from the date of receipt of the request.**

**(4) *(a)* The effect of priority shall be that, with respect to the conditions of protection attaching to the variety, the application shall be deemed to have been filed at the date of filing of the first application.**

***(b)* The applicant shall moreover be entitled to request that the examination of the variety be deferred by up to two years from the date of expiry of the priority period (three years from the date of filing of the first application). However, where the first application is rejected or withdrawn, the Office shall be entitled to initiate the examination of the variety before the date specified by the applicant; in such case, it shall allow the applicant an appropriate period within which to furnish the information, documents or material required for the purpose of the examination.**

## COMMENTARY ON ARTICLE 35

35.1 This Article is the first in a series that describes each stage in the processing of an application.

35.2 The Model Law proposes that, from the administrativ e and legal point of view, the examination as to form and the substantive examination be dissociated, even if in most cases the two procedures can take place simultaneously.

35.3 The examination as to form makes it possible to eliminate applications that are obviously unacceptable (as long as the protection system applies to a restricted list of genera and species), to correct incomplete applications and to assign a filing date to applications that are in order.

35.4 Applications that have not been put in order are deemed not to have been filed, and so no decision is taken on them. In such cases the application fee is not refunded (this follows from the Model Law's silence on the subject in paragraph (3)); it should be mentioned that the Office has to have gone through the necessary procedural steps and invited the applicant to make good the defects.

# CHAPTER III

# PROCESSING OF THE APPLICATION

## Article 35

## Examination as to Formal Requirements; Filing Date

**(1) The Office shall examine whether the application satisfies the formal requirements for applications.**

**(2) Where the application is clearly unacceptable by reason of the botanical taxon to which the variety belongs (Article 2), the documents constituting the application shall be returned to the applicant, and the application fee shall be refunded.**

**(3) Where the application is incomplete or incorrect, the Office shall request the applicant to correct it within thirty days from the date of receipt of the request. Any application that is not corrected within the prescribed period shall be deemed not to have been filed.**

**(4) Any application that is complete and correct shall be given a filing date and shall be recorded in the Register of Applications. The date on which the information referred to in Article 33(2) is received by the Office shall be taken to be the filing date.**

## COMMENTARY ON ARTICLE 36

36.1 This Article is based on Article 12 of the 1991 Act and partly implements it. It refers to two points that are usually only verified from documents. Any irregularity results in a rejection decision. This decision may be the subject of an appeal under Article 28.

36.2 For obvious economic reasons, these points are usually verified before the variety undergoes examination (next Article).

## Article 36

## Examination of the Application as to Substance

**(1) The Office shall examine the application as to substance in order to verify, on the basis of the information given in the application, that the variety is new (Article 6) and that the applicant is entitled under Article 10.**

**(2) Where the examination reveals an obstacle to the grant of the breeder's right, the application shall be rejected.**

# COMMENTARY ON ARTICLE 37

## Basis in the Convention and general remarks

37.1 This Article is based on Article 12 of the 1991 Act. In the form of a very condensed legislative text, it sets out the objectives of technical examination and the various procedures involved. Its wording would be suitable for a State wishing to introduce a very flexible system that allows all available resources to be mobilized and costs a minimum to run.

## Paragraph (2)

37.2 Technical examination necessarily consists of growing tests or other tests, in particular trials carried out in laboratories. The question is who should carry out the tests, since the Office is not always equipped for the purpose and the tests must be tailored to each botanical genus or species. Paragraph (2)(*a*) starts by establishing the principle according to which the examination should be conducted under the supervision of the Office. This means that the Office should not blindly delegate responsibility for the tests.

37.3 Priority is then given to a particular form of cooperation in examination established within UPOV: tests that have been or are being undertaken and could provide the basis for a decision by the Office will not be duplicated unnecessarily. The system set up within UPOV allows the results of these tests to be obtained for a modest charge, which moreover can be passed on to the applicant (the scale of fees should take this possibility into account).

37.4 If necessary, the tests can be carried out by the Office itself or by "another institution." This wording is deliberately vague. It covers in particular institutions of the State that already examine varieties or could easily do so, for example because they have the necessary infrastructure, collections of reference varieties and know-how; this may be the service dealing with the catalogue of varieties approved for trade, research or extension institutes, universities, botanical gardens, etc., and possibly private companies.

37.5 The wording also covers services in other member States and related institutions, to which the Office may resort under another form of cooperation within UPOV. Here the Office agrees to entrust the office of another member State with tests on varieties of a given species; reciprocal agreements are also possible. Article 54 allows the Office to cooperate in examination.

37.6 Finally, the Office may entrust the applicant with the task of conducting the tests, more or less closely supervised by itself, and providing detailed biometric data to enable it to rule on the application. Such a regime can be provided for certain species only, or applied generally. It should be noted that the UPOV Council has adopted a declaration on the conditions to be met by such a system.

## Article 37

## Technical Examination of the Variety

**(1) The variety shall undergo a technical examination the purpose of which shall be**

**(iv) to verify that the variety belongs to the stated botanical taxon,**

**(v) to establish that the variety is distinct (Article 7), uniform (Article 8) and stable (Article 9), and**

**(vi) where the variety is found to meet the aforesaid requirements, to establish an official description of the variety.**

**(2) *(a)* The examination shall be undertaken under the supervision of the Office.**

***(b)* Where growing tests or other necessary tests have been or are being undertaken by the Authority of a Contracting Party, and where the results of those tests may be obtained by the Office and transposed to the agroclimatical conditions of *the State*, the examination may be based on the said results.**

***(c)* Where the examination is not based on results obtained under subparagraph *(b)*, the examination shall be based upon growing tests and other necessary tests made**

**(iii) by the Office or by another institution on its behalf, or**

**(iv) by the applicant at the request of the Office.**

**(3) The Office shall specify the practical conditions for the examination.**

**(4) The official description referred to in paragraph (1)(iii) may be subsequently extended or amended on the basis of developments in agrobotanical knowledge without the subject matter of protection being affected thereby.**

Paragraph (3)

37.7 The Office's supervision is particularly noticeable in the fact that it lays down the procedural details of the examination. These could be defined on the basis of the rules and guidelines established by UPOV.

Paragraph (4)

37.8 The technical examination has two essential purposes: to verify that the variety meets the technical conditions for protection and to provide an official description of the variety. Together with the sample referred to in Article 49(1)( i), the description will serve as a reference for exploitation of the variety on the one hand (for example, for the certification of seeds but also in any infringement action) and, on the other, for the examination of varieties developed subsequently. The protected variety will have become a matter of common knowledge and will therefore have to be taken into account when distinctness is examined.

37.9 There will subsequently be many occasions for subjecting the variety to further testing and for providing additional biometric data. Paragraph (4) states that the description drawn up in the course of the procedure for the grant of the breeder's right is not immutable and can be completed or even amended.

## COMMENTARY ON ARTICLE 38

38.1 This Article is also based on Article 12 of the 1991 Act.

38.2 A technical examination is only undertaken for varieties in respect of which an application has been validly filed; consequently, failure to submit the elements required is bound to result in rejection of the application. Paragraph (2) nevertheless gives the applicant one specific opportunity to avoid rejection; this possibility could be used, for example, when bad weather conditions have caused his test to fail.

## Article 38

## Information, Documents and Material Required for the Examination

**(1) The applicant shall submit to the Office all the information, documents or material requested by the Office for the purposes of the technical examination.**

**(2) Failure to submit the requested information, documents or material shall cause the application to be rejected, unless the applicant produces a valid explanation for his omission.**

## COMMENTARY ON ARTICLE 39

39.1 The main purpose of publication of the application is to inform the public; the filing of an application gives an applicant rights, starting with the rights deriving from provisional protection (Article 17(2)). Publication also forms part of the processing of the application, because the public is given the opportunity to submit comments and objections.

39.2 The information published is usually confined to the basic data contained in the application. Some States that make general use of the system of testing by the applicant also publish a detailed description of the variety.

## Article 39

## Publication of the Application; Objections to the Grant of the Breeder's Right

**(1) As a minimum, the elements of the application referred to in Article 33(2)(i) to (v) shall be published in the Gazette**

**(2) As from the publication of the application any person may, within a time limit set by the Office, file objections to the grant of a breeder's right with the Office.**

**(3) The objections shall be made in writing and substantiated. The documentary evidence shall be attached.**

**(4) The objections may only be based upon the allegation that the variety is not new (Article 6), distinct (Article 7), uniform (Article 8) or stable (Article 9), or that the applicant is not entitled to protection (Article 10).**

## COMMENTARY ON ARTICLE 40

40.1 This Article describes in detail the general procedur e to be followed when considering objections. Briefly, the procedure should bring together both parties, and the technical examination may be adapted; for example, if a third party alleges that the variety that is the subject of the application is not distinct from his own variety, the latter could be included in the test to permit direct comparison.

## Article 40

## Consideration of Objections

**(1) Objections to the grant of a breeder's right shall be communicated without delay to the applicant, who shall have a period of not less than three months within which to express his views on the objections and state whether he intends to maintain, amend or withdraw his application; the period may be extended on the basis of a properly substantiated request from the applicant.**

**(2) Where the applicant does not respond within the prescribed period, the application shall be deemed to have been withdrawn. Where he responds and seeks to maintain the application, with or without amendment, his response shall be communicated to the author of the objection, who shall have thirty days within which to express his views on the response and state whether he intends to maintain or withdraw his objection.**

**(3) *(a)* An objection that has been maintained shall be examined**

**(iii) independently of the normal processing of the application where it is based on the allegation that the variety lacks novelty or that the applicant is not entitled to protection, or**

**(iv) in the course of the technical examination of the variety where it is based on the allegation that the variety lacks distinctness, uniformity or stability.**

***(b)* The Office may modify the conditions of the technical examination of the variety in order to accommodate consideration of the objection.**

**(4) The author of an objection may be required to submit further information and documents in support of his objection, or such plant material as is necessary for the technical examination. Article 38 shall apply *mutatis mutandis*.**

## COMMENTARY ON ARTICLE 41

41.1 This Article is self-explanatory and does not call for any particular comment.

## Article 41

## Grant of the Breeder's Right; Rejection of the Application

**(1) Where it is satisfied as a result of the examination that the variety fulfills the requirements of Article 5 and that the applicant has fulfilled the other requirements set out in this Law, the Office shall grant the breeder's right.**

**(2) Where it is not so satisfied, the Office shall reject the application.**

**(3) The grant of the breeder's right, or the rejection of the application, shall be recorded in the Register of Applications and published in the Gazette.**

**(4) The grant of the breeder's right shall also be recorded in the Register of Breeders' Rights. The description of the variety may be included in the Register by reference to the technical files of the Office.**

## COMMENTARY ON ARTICLE 42

42.1 This Article and the following Articles in the same Chapter are based on Article 20 of the 1991 Act and on the Recommendations on Variety Denominations adopted by the UPOV Council. Article 42 sets out the general principles applicable in variety denomination matters.

# CHAPTER IV

# VARIETY DENOMINATION

## Article 42

## Purpose of the Denomination and Signs That May Constitute a Denomination

**(1) The denomination of a protected variety shall be its generic designation.**

**(2) The denomination may consist of any word, combination of words, combination of words and figures or combination of letters and figures, with or without an existing meaning, provided that such signs allow the variety to be identified.**

**(3) Where a denomination has already been used for the variety in *the State* or a Contracting Party, or proposed or registered in a Contracting Party, only that denomination may be used for the purposes of the procedure before the Office, unless there is a ground for refusal under Article 43. Any synonyms shall be recorded in the Register of Applications and the Register of Rights.**

**(4) *(a)* For as long as a variety is exploited, it shall be prohibited to use, in the territory of *the State* [or of a Contracting Party], a designation that is identical or confusingly similar to the denomination of that variety in relation to another variety of the same or a closely related species. The prohibition shall remain in force after the variety has ceased to be exploited where the denomination has acquired particular significance in relation to the variety.**

***(b)* The aforesaid prohibition shall also apply to denominations registered in Contracting Parties.**

**(5) Any person who offers for sale, sells or otherwise markets propagating material of a protected variety shall be obliged to use the denomination of that variety. This obligation shall also apply to the varieties referred to in [Article 13(5)*(a)*(ii)][20]**

**(6) The obligation to use a denomination shall not end with the breeder's right that gave rise to it.**

**(7) Prior rights of third parties shall not be affected.**

**(8) When a variety is offered for sale or otherwise marketed, the use of the registered variety denomination in association with a trademark, trade name or other similar indication shall be permitted, subject to the denomination remaining easily recognizable.**

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[20] "Article 13(4)*(a)*(ii)" where Alternative B to the proposed Article 13(3) is adopted.

## COMMENTARY ON ARTICLE 43

43.1 The denomination is proposed by the applicant and registered by the Office, unless the latter finds it unsuitable for some reason and rejects it.

43.2 The text proposed makes a distinction between two such reasons: those that are matters of essentially public concern and therefore under the direct jurisdiction of the Office, and those that are essentially related to the private rights of third parties and (in principle) will be cited by those third parties. This distinction is also reflected in the procedure (Article 44).

## Article 43

## Grounds for Refusal

**(1) *(a)* Without prejudice to the provisions of the Convention and the rules established by the Union, registration as the denomination of a variety shall be denied to a designation that**

**(vii) does not conform to the provisions of Article 42,**

**(viii) is not suitable for the identification of the variety, in particular owing to lack of distinctiveness or to linguistic unsuitability,**

**(ix) is contrary to public policy or morality,**

**(x) consists exclusively of signs or indications that may serve, in the plant varieties and seeds sector, to designate kind, quality, quantity, intended purpose, value, geographical origin or time of production,**

**(xi) is liable to mislead or to cause confusion as to the characteristics, value or geographical origin of the variety, or the links between the variety and persons such as the breeder or applicant, or**

**(xii) is identical with, or confusingly similar to a denomination that designates, in the territory of *the State* or a Contracting Party, an existing variety of the same or a closely related species, unless the existing variety is no longer exploited and its denomination has not acquired any particular significance.**

***(b)* The Office shall name the species that are closely related within the meaning of subparagraph *(a)*(vi), above.**

**(2) *(a)* Without prejudice to the provisions of the Convention and the rules established by the Union, registration as the denomination of a variety shall also be denied to a designation containing an element that hampers or is liable to hamper the free use of the denomination in connection with the variety, in particular an element that under trademark law would be denied registration as a trademark for products bearing some relation to the variety.**

***(b)* Such designations shall be refused if the holder of the rights in the element concerned has lodged with the Office a written objection to the proposed denomination.**

## COMMENTARY ON ARTICLE 44

44.1 The procedure proposed in this Article is classic.

44.2 It refers to cooperation among UPOV Contracting Parties in the examination of proposed variety denominations. That cooperation still takes place by means of the exchange of plant variety protection gazettes. At the time of writing, a computerized database is being developed for distribution in CD-ROM form.

44.3 There could be a risk of an applica nt using the tactic of proposing only unacceptable denominations to delay the processing of his application. Paragraph 6(*b)* allows the Office to force a close on the procedure.

## Article 44

## Registration Procedure

**(1)** ***(a)*** **The denomination proposed for a variety shall be submitted together with the application for protection.**

***(b)*** **Subject to payment of the prescribed fee and the inclusion of a provisional designation for the variety in the application, the applicant may have the procedure for the registration of the denomination deferred. In such a case, the applicant shall propose a denomination for the variety within thirty days from the date of receipt of a request addressed to him by the Office. If the applicant fails to submit a proposal within the prescribed period, the application shall be rejected.**

**(2) If the Office has found no ground for refusal under Article 43(1)*(a)* and knows of no ground for refusal under Article 43(2)*(a)* the proposed denomination shall be published in the Gazette. It shall also be communicated to the Authorities of the Contracting Parties.**

**(3) Any interested person may, in the three months following publication, file an objection to the registration of the denomination based upon any one of the grounds for refusal under Article 43. The Authorities of the Contracting Parties may submit observations.**

**(4) Objections and observations shall be communicated to the applicant, who shall have thirty days within which to reply.**

**(5)** ***(a)*** **The applicant may, on the basis of the objections and observations, submit a new proposal.**

***(b)*** **Where the proposed denomination does not conform to the provisions of Article 43, the Office shall request the applicant to submit a new proposal within thirty days from the date of receipt of the notice. Failure to submit a proposal within the prescribed period shall entail the rejection of the application.**

**(6)** ***(a)*** **The new proposal shall be subject to the examination and publication procedure provided for in this Article.**

***(b)*** **Where the new proposal does not conform to the provisions of Article 43, the Office may serve notice on the applicant to propose a denomination that does conform to the said provisions. Failure to respond shall cause the application to be rejected.**

**(7) Where objections or observations have been received, any decision of the Office shall be accompanied by a statement of its reasons for the decision; it shall be notified to the parties. The refusal of a proposed denomination shall likewise be accompanied by a statement of the reasons for the refusal.**

**(8) The denomination shall be registered at the same time as the breeder's right is granted.**

## COMMENTARY ON ARTICLE 45

45.1 It can happen that, in spite of all the investigative work, a denomination is registered and then proves unacceptable. This Article covers the procedure for canceling a denomination that is not acceptable and registering a new one.

45.2 It is based on Article 20(4) of the 1991 Act, but its scope is broader. It first establishes three grounds for cancellation. The third corresponds to the one provided for in the Convention. The first (an error) is self-evident.

45.3 The second is an alternative version of the third; it is indeed more practical for the owner of a right who realizes that he is vulnerable to request the modification of the denomination rather than await a legal decision.

45.4 The denomination has to be used in commercial transactions even after the breeder's right has expired. It can happen therefore that a denomination has to be canceled after the right has expired and that the owner of the expired breeder's right is not prepared to take part in the procedure. Paragraph (2) provides that a new denomination can then be proposed by the Office.

45.5 It should be noted that the owner of the right may have his right canceled if he does not cooperate in the procedure (Article 23(2)(*a)*(ii)).

## Article 45

## Cancellation of a Denomination and Registration of a New Denomination

**(1) The Office shall cancel a registered denomination**

**(iv) when it is established that the denomination has been registered despite the existence of a reason for refusal under Article 43(1)*(a)*,**

**(v) when the holder so requests and demonstrates a legitimate interest, or**

**(vi) when the holder or any other person produces a judicial decision prohibiting the use of the denomination in connection with the variety.**

**(2) The Office shall inform the holder of the intended cancellation and request him to propose a new denomination within thirty days from the date of receipt of the request. If the variety is no longer protected, the proposal for a new denomination may be made by the Office.**

**(3) The proposed new denomination shall be subject to the examination and publication procedure provided for in Article 44. The new denomination shall be registered and published once approved; the former denomination shall be canceled at the same time.**

## COMMENTARY ON ARTICLE 46

46.1 The vast majority of States have established a system of annual fees to keep breeders' rights in force. This Article provides for such a system with two alternatives. According to the first, non-payment of the fee leads to premature termination of the right (see *Alternative A* of Article 21); in the second, the holder is obliged to pay the fees due unless he specifically surrenders his right ( *Alternative B* of Article 21).

46.2 As already mentioned in connection with Article 17(1) and Article 31, the Model Law proposes a system under which all annual fees fall due on the same date, which facilitates their administration.

# CHAPTER V

# KEEPING THE BREEDER'S RIGHT IN FORCE

## Article 46

## Annual Fee

**(1) The holder shall pay an annual fee [*Alternative A*: to keep his breeder's right in force] [*Alternative B*: for the whole period of protection].**

**(2) The fee shall fall due at the beginning of the calendar year to which it relates. It shall be payable by January 31.**

## COMMENTARY ON ARTICLE 47

47.1 The obligation to maintain the variety (to carry out maintenance breeding) and the obligation to provide information, documents or material with a view to verifying the maintenance of the variety are provided for indirectly (in the form of penalties if this is not done) in Article 22 of the 1991 Act; the first obligation is in fact an essential feature of the protection system, because it is in fact the counterpart for the breeder's right. Article 47 of the Model Law makes express provision for both obligations. The penalties are specified in Article 23(1) and (2)(*a*)(i).

## Article 47

## Maintenance of the Variety

**(1) The holder shall be under an obligation to maintain the protected variety or, where relevant, its hereditary components for the whole duration of the breeder's right.**

**(2) At the request of the Office, he shall provide it or an authority designated by it, within the prescribed period, with the information, documents or material deemed necessary for verifying the maintenance of the variety.**

## COMMENTARY ON ARTICLE 48

48.1 This Article sets out the general principles applicable to verification o f the maintenance of the variety. According to paragraph (2), verification is not carried out systematically (there is no justification for that), but only if there is reason to believe that the variety is not being maintained.

## Article 48

## Verification of the Maintenance of the Variety

**(1) The Office shall verify that the variety and, where relevant, its hereditary components are maintained throughout the period of protection.**

**(2) Where it is suspected that a variety is not maintained and the suspicions are not removed by the information and documents submitted by the holder under Article 47(2), the Office shall order the verification of the maintenance of the variety under conditions specified by it. The verification shall include growing tests and other tests in which the material submitted by the holder is compared with the official description and the official sample of the variety.**

**(3) Where the verification suggests that the holder has failed to maintain the variety, the holder shall be heard before a decision to cancel the breeder's right is taken under Article 23(1).**

## COMMENTARY ON ARTICLE 49

49.1 Article 1(2)(xiii) provides that a variety that is the subject of a breeder's right is defined both by the description established during the technical examination and by an official sample; according to the circumstances, reference will be made to one or the other or even both. Article 49 provides for the mandatory establishment of an official sample; this may be deposited with the Office or with an authority designated by it (for example, a gene bank or research institute), or kept by the holder of the breeder's right.

49.2 Samples may also be required for the examination of new varieties (paragraph (1)(ii)).

## Article 49

## Supply of Samples

**(1) At the request of the Office, the holder shall provide the Office or any authority designated by the latter, within a prescribed period, with reasonable samples of the protected variety or, where relevant, of its hereditary components for the purpose of**

**(iii) establishing or renewing the official sample of the variety, or**

**(iv) undertaking the comparative examination of other varieties for the purposes of protection.**

**(2) At the request of the Office the holder shall maintain or preserve the official sample on behalf of the Office.**

## COMMENTARY ON ARTICLE 50

50.1 Article 30(1)(i) of the 1991 Act states that the Contracting Parties shall "provide for appropriate legal remedies for the effective enforcement of breeders' rights." The part of the TRIPS Agreement on the enforcement of intellectual property rights covered by the Agreement also constitutes a source of inspiration, if not actually a source of law.

50.2 This Article and the following Articles in Part IV are checklist items. In view of the diversity of national situations and the existence of national models, for example in the form of patent laws, no attempt has been made to propose model provisions.

50.3 Article 50 covers the following elements: first, there has to be protection under civil law; secondly, it must be possible to resort to that protection when there is a direct infringement of the breeder's right (subparagraph ( i)); thirdly, it is advisable for the protection also to be available when the infringement is committed in relation to the variety denomination (subparagraphs (ii) and (iii)); fourthly, the holder of the right must be able to claim the protection; and lastly, the holder of an exclusive license should also be able to claim it.

50.4 The Model Law does not describe the civil remedies available, but confines itself to specifying that they must be the same as those provided in similar fields; as a minimum, the measures should include cessation of the alleged act and elimination of the unlawful situation, and also damages.

# PART IV

# ENFORCEMENT

## Article 50

## Civil Remedies

**(1) Any person who**

**(iv) without being entitled to do so performs acts that require the authorization of the holder, under Article 13,**

**(v) uses a designation whose use is prohibited by Article 42(4), or**

**(vi) fails to use a variety denomination whose use is obligatory under Article 42(5)**

**may be sued by the holder or the holder of an exclusive license and all such relief shall be available to the latter as is available in any corresponding proceedings in respect of infringements of other proprietary rights.**

**(2) Subject to the provisions of this Law, the provisions of the law on the enforcement of rights under a [patent] shall apply *mutatis mutandis* to the enforcement of rights under a breeder's right.**

## COMMENTARY ON ARTICLE 51

51.1 The purpose of this Article is to show that there is a need to provide protection under criminal law. In general, such protection will be identical to that provided for patents. The object of paragraph (3) is to indicate that the applicable provisions for the protection of new plant varieties will usually be the same as for the protection of inventions.

## Article 51

## Criminal Penalties

**(1) Any infringing act committed with full knowledge of the infringement shall constitute an offense punishable with a fine of ... or imprisonment for a term of ...**

**(2) In the case of a second or subsequent offense, the penalties shall be ...**

**(3) The criminal procedures and penalties provided for in the [Patent Law] shall also be available.**

## COMMENTARY ON ARTICLE 52

52.1 Article 42 of the Model Law, conforming to Article 20 of the 1991 Act, imposes obligations regarding the use of variety denominations. Article 52 lays down the corresponding penalties, which may be limited to fines.

## Article 52

## Offenses in Relation to Variety Denominations

**(1) Any person who, in full knowledge of the facts, uses a designation whose use is prohibited by Article 42(4), or fails to use a variety denomination whose use is obligatory under Article 42(5), shall be liable to a fine of ...**

**(2) In the case of a second or subsequent offense, the fine may be doubled.**

## COMMENTARY ON ARTICLE 53

53.1 This Article does not call for any particular comment.

# PART V

# FINAL AND TRANSITIONAL PROVISIONS

## Article 53

## Regulations

**The Minister shall make regulations for the implementation of this Law.**

## COMMENTARY ON ARTICLE 54

54.1 To be used effectively, the system for cooperation in examination must be operated with minimum administrative constraints. It should be the responsibility of the Office to conclude the appropriate administrative agreements.

## Article 54

## Cooperation in Examination

**The Office shall be entitled to conclude administrative agreements for cooperation in the examination of varieties and the verification of the maintenance of varieties with the authorities of Contracting Parties or with their supervisory authorities.**

## COMMENTARY ON ARTICLE 55

55.1 This Article is included in the Model Law as a reminder; the texts that may need to be amended include the Patent Law and the Trademark Law, the Code of Civil Procedure, the Code of Criminal Procedure and the Criminal Code.

## Article 55

## Amendment of Other Provisions

...

## COMMENTARY ON ARTICLE 56

56.1 This Article is based on Article 6(2) of the 1991 Act, which is an optional provision.

## Article 56

## Protection of Known Varieties

**(1) Notwithstanding Article 6, a breeder's right may also be granted for a variety that is no longer new on the date of entry into force of this Law in respect of the relevant species, subject to the following conditions:**

***(a)*** **the application shall be filed within the year following the said date; and**

***(b)*** **the variety must**

**(iv) have been entered in the National Catalogue of Varieties Admitted to Trade or in a register of varieties held by a professional organization recognized by the Office, on the advice of the Council, for the purposes of this Article,**

**(v) have been the subject of a breeder's right in a Contracting Party, or be the subject of an application in a Contracting Party, provided that the application subsequently leads to the granting of the breeder's right, or**

**(vi) be the subject of proof acceptable to the Office concerning the date on which the variety ceased to be new under the provisions of Article 6.**

**(2) The duration of the breeder's right granted under this Article shall be calculated from the date of the entry referred to in paragraph (1)*(b)*(i), above, the date of the grant of the breeder's right referred to in paragraph (1)*(b)*(ii), above, or the date upon which the variety ceased to be new referred to in paragraph (1)*(b)*(iii), above. Where relevant, the earliest of those dates shall be used.**

**(3) Where a breeder's right is granted under this Article, the holder shall be under the obligation to grant licenses on reasonable terms in order to allow the continuation of any exploitation initiated in good faith by a third party before the said filing.**

## COMMENTARY ON ARTICLE 57

57.1 This Article does not call for any particular comment.

## Article 57

## Entry into Force

**This Law shall enter into force on ...**

# ANNEX

## THE CONCEPT OF ESSENTIALLY DERIVED VARIETIES

General Remarks

31. The concepts of "essentially derived variety" and "dependency" were written into the 1991 Act for one fundamental reason: to ensure that the plant variety protection system could continue to promote plant breeding activities and thereby provide farmers with varieties that were constantly being improved.

32. This fundamental reason may be divided into three aspec ts:

(d) the closing of a gap in the protection system based on the 1978 Act of the Convention;

(e) the establishment of equitable relations among breeders;

(f) the establishment of equitable relations between holders of breeders' rights and patent owners.

33. The system introduced by the 1991 Act of the Convention was welcomed by all interested parties, especially breeders and genetic engineering experts.

The Problem to Be Solved

*The provisions in the Convention*

34. The variety concept. - Simply put, a variety is a distinct, uniform and stable plant grouping.

35. Distinctness is established on the basis of characteristics, which may or may not have a bearing on the agronomic or technological value of the variety. It is only necessary to have a difference in one characteristic (qualifying as "important") in order to conclude that one variety is distinct from another.

36. "Breeder's exemption". - The protection system based on the UPOV Convention provides that a protected variety may be freely used to create other varieties (Article 5(3)) of the 1978 Act; Article 15(1)(iii) of the 1991 Act; Article 14(1)(iii) of the Model Law).

37. This provision is the cornerstone of the protection system: the essence of plant breeding—the creation of varieties—is to the crossing of two varieties and to selecting from their progeny a variety that will be better (more productive or better suited to prevailing agro-economic conditions).

38. The concept of the essentially derived variety has to do with the degree of similarity between one of the parent varieties (the "initial variety") and the derived

variety. For the derivation to be "essential," there must be a high degree of similarity and the number of characteristics inherited from the second parent (if there is one) must be very small; in an extreme case only one characteristic might be so inherited.

*The perverse effects of complete exemption*

39. Experience gained on the basis of the 1978 Act showed that in some circumstances the totally unqualified breeder's exemption was a source of problems, which are illustrated by the following theoretical examples—which are nevertheless based on specific cases encountered at the technical level. These are all typical examples of essentially derived varieties .

40. Vegetatively propagated varieties and mutation . - A breeder creates by crossing followed by selection a new carnation variety, for example, which is not only commercially attractive but also technically easier to grow. Competitors can obtain variants of this variety with little or no investment by looking for or inducing mutations within the variety.

41. Mutation is an abrupt change in genetic makeup; it is the resu lt of an error in the transmission of genetic information. In the case of a carnation this may for example affect the color of the flower: a plant with red flowers may suddenly produce a stem with white flowers, and one need only to take cuttings from that stem to obtain a new variety.

42. The white-flower mutation is of obvious commercial interest. On the other hand, the interest of a mutation that gives a slightly different shade of red will be more debatable; a competitor of the initial breeder could however exploit it without paying anything at all to the breeder and engage in an activity that could be described as plagiaristic.

43. Custom requires a color mutation of variety 'x' to be designated for example '[color x].' Carnations may therefore be 'Pierrot' and 'Dark Pierrot' or chrysanthemums 'Reagan,' 'Apricot Reagan,' 'Bronze Reagan,' 'Coral Reagan,' 'Dark Reagan,' 'Dark Yellow Reagan,' 'Orange Reagan,' 'Pearl Reagan,' 'White Reagan' or 'Yellow Reagan' (*source: List of Protected Varieties in the Netherlands*).

44. With roses, the practice is for the climbing version of bush rose 'y' to be designated 'climbing y,' for example 'Climbing Mme A. Meilland' or 'Climbing Ena Harkness.' If the vegetative characteristics are altered, the shape and color of the flowers—which give the variety its commercial interest—are exactly the same in the climbers as in the original varieties, although the flowers may be bigger.

45. The problem mentioned here arises, t o a greater or lesser degree, with almost all vegetatively propagated species.

46. Sexually reproduced varieties and backcrossing. - A breeder creates a new line of maize by crossing followed by selection, and it turns out to be an excellent parent for the creation of hybrid varieties (the seeds of which are sold to farmers).

Competitors may produce variants, with limited investment, by "converting" the line in a backcrossing program.

47. In this particular case, the program consis ts in crossing the line with a plant that has a simply-inherited different trait (for example silks—the filaments emerging from the ear—that are red and not yellow), then crossing the progeny with the same plant and repeating the exercise with subsequent progeny a certain number of times, always selecting the "red silk" characteristic. Eventually (possibly after self-fertilization), a line is obtained that is identical to the original line except for the color of the silk.

48. All varieties and genetic engineering. - Genetic engineering was relatively new at the time of the revision of the Convention. It offers the possibility of transforming a variety at will by inserting a special gene that confers a new characteristic on the variety.

49. Summary of the problem. - In these three cases, the problem can be summarized as follows:

(a) A breeder of a so-called initial variety has invested heavily in the creation of his variety. He will usually have been crossing and selecting plants for a number of years; he will also have been carrying out tests to assess the commercial value of the variety and define the conditions under which it can be grown.

(b) A second person (also a breeder) can, often at little cost, produce a new variety that will be considered an essentially derived variety. This will

(iii) possess almost all the characteristics of the initial variety, notably those that constitute the latter's commercial interest, and

(iv) differ from the initial variety only in one or a very limited number of characteristics.

(c) The second person makes a technical and economic contribution that may be:

(iii) nil (in the case of a carnation with a flower of a color slightly different from that of the original variety, a line of maize with silk that is red and not yellow or a variety that has been made resistant to a non-approved herbicide);

(iv) substantial (as with the climbing variety of a rose bush or a lettuce that has been made resistant to a disease prevalent in the production area).

(d) In any event, the second person takes full advantage of the investment made by the breeder of the initial variety, apart from being in direct competition with him, whatever the amount of his own investment and whatever his own technical and economic contribution.

50. In the case of genetic engineering that makes use of a patented process or product (for example, an entirely artificial antisense gene), relations between the breeder and the genetic engineer are unequal under the 1978 Act:

(c) the breeder may not use the patented process or product to transform (and improve) his variety without the consent of the patent owner;

(d) the patent owner, on the other hand, can freely use the protected variety to transform (and improve) it; he is also free to exploit the transformed (and improved) variety without paying any remuneration.

The Solution

51. The solution is contained in Article 14(5) of the 1991 Act and the last paragraph of Article 13 of the Model Law.

*The elements of the solution*

52. The solution can be broken down as follows:

(a) The "breeder's exemption" is retained in its entirety: any protected variety may be freely used, as in the past, to create new varieties, including essentially derived varieties.

(b) On the other hand, the exploitation of an essentially derived variety is made subject to authorization by the breeder of the initial variety; in other words, the breeder's right in the initial variety is "extended" to essentially derived varieties; and these are "dependent" on the initial variety.

(c) The conditions of this dependency are as follows:

(iv) the initial variety must be protected;

(v) the initial variety must not itself be an essentially derived variety (it must be the result of genuine variety creation work);

(vi) the essentially derived variety must meet the conditions laid down in Article 14(5)(b) of the 1991 Act, repeated word for word in the Model Law, namely:

- be genuinely derived from the initial variety,
- be sufficiently distinct to escape Article 14(5)(a)(ii) of the 1991 Act,
- be virtually consistent with the initial variety;

(ii) the essentially derived variety may be derived indirectly (from a variety that is itself essentially derived); derivation is indirect, for example, when a red chrysanthemum produces a yellow mutant and the latter in turn produces a white mutant: the white mutant is essentially derived, but indirectly, from the red variety.

(d) The method of derivation is immaterial. Nevertheless, the Convention gives examples of methods that frequently produce essentially derived varieties in order to illustrate the concept.

53. The underlying aim of the solution is therefore:

(a) to promote continued investment in "classical" plant breeding (crossing followed by selection, whether or not modern methods are used), which can be described as "innovative" breeding;

(b) to discourage unfair or parasitical activities without discouraging "improvement breeding";

(c) to establish a legal basis for balanced agreements between:

(iii) breeders of varieties resulting from "innovative breeding" and breeders of varieties resulting from "improvement breeding,"

(iv) breeders of varieties resulting from "innovative breeding" protected by breeders' rights and the inventors of processes or products protected by patents.

*Practical implementation of the solution*

54. All interested parties agree that the dependency relations should be handled by the breeders themselves, without the involvement of the authorities responsible for administering the plant variety protection system.

55. It therefore follows that the question of knowing

(c) whether variety B is essentially derived from variety A, and

(d) whether this derivation creates a dependency relationship

must in each case be settled by the breeders and, if they are unable to agree, by the courts in the course of infringement proceedings, for example.

56. The major national and international breeders' organizations are already drawing up recommendations regarding the practical situations in which a variety can be considered essentially derived.

57. In practice, the new system has created a framework within which interested parties can negotiate:

(d) A person who wishes to engage in "improvement breeding" (including transformation by genetic engineering) on a protected variety will conclude an agreement with the breeder of that variety before starting work (such agreements

have already been signed between genetic engineering companies and "traditional" breeders);

(e) If the breeding process unexpectedly produces an essentially derived variety, the two breeders will come to an agreement on its exploitation if it represents a genuine improvement; the price to be paid by the end-user will not be a double royalty but an amount determined by market forces (in other words by competition); if there is no improvement, either the breeder of the essentially derived variety will decide not to exploit it or the breeder of the initial variety will exercise his right to refuse the second breeder the right to exploit it;

(f) Breeders of varieties produced by "innovative" breeding and the inventors of products or processes leading to essentially derived varieties have rights that are more noticeably equal and are therefore encouraged to enter into balanced agreements.

The Concept of Essentially Derived Variety in the Intellectual Property Context

58. Protection of new plant varieties. - The effect of the new system is that the breeder of variety A may have a right that extends to variety B. Such an extension of rights is not new. It already existed in the case of lines and hybrids (second sentence of Article 5(3) of the 1978 Act).

59. Patent law. - One patent may be dependent on another patent. The dependent patent can only be worked if the principal patent is also worked.

60. Copyright. - The solution for essentially derived varieties is similar to that adopted in copyright for derived works (Article 2(3) of the Berne Convention).

**END**

***Part Three: The main elements of the Plant Variety Protection (PVP) process and its application in Jordan.***

# PLANT VARIETY PROTECTION (PVP):

## IT'S IMPORTANCE TO THE AGRICULTURAL AND ECONOMIC DEVELOPMENT OF JORDAN: WHAT IS IT, WHY SHOULD WE HAVE IT AND WHAT DOES IT DO?

Plants contribute to people's everyday life in the quantity, quality and cost of our requirements for food, fuel and fiber. In addition they also provide raw materials for industry, such as vegetable oils, rubber and pharmaceutical materials.

It has been estimated that by the year 2020, the Earth's population may reach 9 billion. Annual food production will have to go up to over 3,000 million metric tonnes from the current 1,800 million metric tonnes. At the same time, productive farmland is being and will continue to be increasingly diverted to non-farm uses, and water resources continue to be a substantial limiting factor in agricultural productivity.

In order to address this challenge we must develop improved plants that can produce more on less land with less water. Plant breeders are the trained professionals who will make a major contribution to meeting these challenges since the essence of their craft is to develop plants that are genetically equipped to produce higher yields of quality products while resisting pests and diseases, thus potentially reducing the need for large doses of fertilizers and crop protection chemicals in addition to conserving water resources.

The breeding of new plant varieties is thus an economically important activity which contributes in many different ways to the social and economic well being of society and which is in many cases essential for human survival.

Experience has shown that it is difficult for a breeder to recover his financial investment when he sells his initial supplies in the first years of a new variety's life. The breeder's competitors can secure supplies of propagating material and in a short time compete with him profiting from his many years of breeding effort. This initial phase of protection is critical as it may take between 10 and 20 years to develop new varieties in most plant species.

## WHAT IS PLANT VARIETY PROTECTION (PVP)?

The complexity of modern society and its needs for improved varieties adapted to a wide range of circumstances, for a varied diet and for a wide choice of ornamental and amenity plants need substantial investment. Accordingly, many countries, while continuing to invest in public sector plant breeding research, have established open free-market systems whereby exclusive rights of exploitation (in simple terms a patent-like protection) are granted to the breeders of new varieties of plants.

## WHY SHOULD WE HAVE PLANT VARIETY PROTECTION (PVP)?

These so called plant variety protection regimes are implemented in order to:

- Provide breeders (both Public & Private sectors) with an opportunity to receive a reasonable return on past investments,
- Provide an incentive for continued or increased investment in future breeding research.
- To recognize the legal right of the innovator to be recognized as such and his economic right to remuneration for his efforts.

In order to foster these laws and agreements within the global economy an International Union for the Protection of New Varieties of Plants (UPOV) has been formed through a Union of States that have agreed to grant exclusive rights of exploitation to the breeders of new plant varieties on an internationally harmonized basis and on an international level.

## WHAT DOES PLANT VARIETY PROTECTION (PVP) DO?

As part of its entry into the global economy though accession to the World Trade Organization, Jordan will implement legislation that is compatible to those of other WTO member counties. This should open the doors to investment in plant breeding, and related technologies, and the development of new markets for its innovative plant products within Jordan. This increased investment will spill over into overall agricultural sector economic growth and employment creation. It should also allow Jordanian consumers access to the best and most modern plants and plant products, increasing the competitive base of Jordan in both the regional and global economy.

## WHAT CONDITIONS NEED TO BE MET TO GET PLANT VARIETY PROTECTION?

In simple terms the variety coming out of your breeding program must be able to show the characteristics of:

- **Distinctness**
- **Uniformity**
- **Stability**

## HOW DO I PROCEED TO APPLY FOR PROTECTION?

Application forms / packages can be obtained from the PVP Office within the Ministry of Agriculture. These forms and the supporting documentation such as the UPOV crop guides will guide the applicant through the steps of describing the history and breeding origin, describing the variety, depositing seeds and paying the fees and if all is as required, obtaining a Plant Variety Protection Certificate.