

QUESTION 93

Biotechnology (Relationship between patent protection and biotechnological inventions and plant variety protection; Patentability of animal breedings)

Yearbook 1988/II, pages 221 - 223
Executive Committee of Sydney, April 10 - 15, 1988

Q93

Question Q93

Biotechnology

RESOLUTION

Relationship between protection by means of patents for biotechnological inventions and protection for plant varieties: Patentability of animal breeds.

After having considered the working guidelines, the reports of the National Groups (Yearbook 1987/V) and after re-consideration of the Resolution of Rio de Janeiro on Question 82. (Yearbook 1985/III, p. 312)

AIPPI

Re-affirms the principle that inventions relating to living organisms, be they microorganisms, plants, animals or parts thereof, or to other biological material or to processes for obtaining or using them should be patentable on the sole condition that they comply with the usual criteria of patentability. The Resolution of Rio de Janeiro, which laid down this principle has been well accepted and has had a positive influence on the ongoing work in WIPO.

Three years after Rio de Janeiro there is no reason to introduce any limitation whatsoever into this principle which should be applied in its generality. In particular, the notion of biotechnological inventions should not be limited to certain specific techniques.

The positive effects of patent protection for technological, economic and social progress together with the existing experience with patent protection for chemicals, pharmaceuticals, microorganisms and foodstuffs convince AIPPI that patent protection will be equally beneficial in fostering the much needed innovation in the fields of plant and animal production. The remedies against abuse of patent rights which exist under national laws are viewed as being sufficient and satisfactory. The need for patent protection in this

field is re-inforced by the fact that wide differences in the number of species protected by individual member countries of the UPOV Convention results in a lack of protection by plant breeders rights for many species in particular countries.

The moral or ethical problems which could arise from the application of new techniques in biotechnology should be primarily regulated by laws specifically dealing with those issues, to which the patent laws of nearly all countries refer in excluding from patentability inventions contrary to morals or public order.

AIPPI

Expresses its desire to recognise all the consequences following from this fundamental principle, in particular:

a) All prohibitions on the patentability of living things, be they plants, animals or other organisms, or of processes for obtaining them which exist in national laws and international treaties, especially the European Patent Convention, should be abolished as soon as possible.

Since such a change will take time to achieve, during the interim period the present provisions should be interpreted so as to provide the minimum limitation on patent protection. AIPPI endorses the proposals of WIPO in suggested Solutions 1 and 9 of Document BIOT/III/2, dated 8th April 1987, which are to the effect that patent protection should be allowed for all plants or animals when produced by patentable processes and for plants, plant material or animals other than plant or animal varieties as such; it being understood that the effects of such patents are not affected by any existing exclusion of plant or animal varieties from patent protection.

b) It is necessary to approve firmly the position expressed at Rio de Janeiro that the prohibition on double protection by patent and by plant breeders rights, where it still exists, in particular in Art. 2(1) of the UPOV Convention, and in the laws of the Member States, should be abolished. Full freedom should be restored, i. e. not only the right to choose the form of protection, patent or plant breeders right, but also the possibility to have the same subject matter protected by a patent and by a plant breeders right if and when the requirements of the pertinent law are complied with.

The possibility of protection being provided by both the patent and plant breeders rights systems may result in different parties having rights covering the same subject matter. In the event that it becomes necessary to obtain a licence in order to avoid infringement of the rights of a party, either between the parties as such or other interested parties, AIPPI considers usual commercial agreement between the parties as the means appropriate for the resolution of licensing matters.

c) The importance and value of the protection of plant varieties under the UPOV

Convention is recognised. Such protection should be strengthened in order to provide better protection for those innovations which do not comply with the criteria for patentability and to enable the holders of such protection to take part effectively in commercial negotiations. In particular, Article 5(3) which permits the free utilisation of a protected variety as an initial source for breeding new varieties should be amended to provide, at least, for a royalty in the case of commercial exploitation of that new variety. The existence of Article 5(4) which provides for protection of end products is noted and

AIPPI would encourage member States to take advantage in their national laws of this provision at least in respect of ornamental plants.

AIPPI

Is of the opinion that in relation to patent protection for self-replicable materials the matter of exhaustion of the patent right in relation to the replication or differentiation of, or derivation from, the patented product or the product of a patented process is uncertain in many countries. AIPPI considers the solution as being an evolving one which may require resolution by legislative and judicial means, but in the meantime supports the Suggested Solutions Nos. 12, 13 and 14 proposed by WIPO in Document BIOT/III/2, dated 8th April 1987, which are to the effect that the protection granted should in principle extend to the products of replication, differentiation or derivation.

AIPPI

Decides to continue study of improvements and amendments to be made to the UPOV Convention and invites Committee 51 to prepare a corresponding report for presentation at the occasion of the Congress of Amsterdam in June 1989.

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Question Q 93

Biotechnology- Relationship between patent protection and biotechnological inventions and plant variety protection; Patentability of animal breedings

Resolution

Yearbook 1992/II, page 346

Q93

Council of Presidents of Lucerne, September 15 - 19, 1991

The Council of Presidents decides that the study of Q 93 on Biotechnology and Plant Varieties will include in particular the following matters:

1. the total removal of the ban on double protection of plant varieties in national legislations on the plant breeder's rights;
2. the removal of all provisions relating to the unpatentability of plant and animal varieties in the patent laws;
3. the scope of patent protection for biotechnological product and process inventions concerning self-replicable material encompasses subsequent generations and material wherein the inventive characteristics are expressed, except when the reproduction is an inevitable consequence of the intended use of a material marketed by the patentee;
4. an invention should not be considered a discovery or lacking in novelty merely because it forms part of a pre-existing material.

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Question Q 93

Biotechnology - Relationship between patent protection - and biotechnological inventions and plant variety protection; Patentability of animal breedings

Resolution

Yearbook 1992/III, pages 276 - 278
Executive Committee of Tokyo, April 5 - 11, 1992

Q93

AIPPI,

taking into account the reports of the national groups (Annuaire 1991/III) and the Summary Report (Annuaire 1992/I, 63);

having reviewed recent developments in the field and in particular the revision of the UPOV Convention for the Protection of New Varieties of Plants and certain proposals for domestic and international legislation;

reaffirming its resolutions of Rio de Janeiro of 1985 (Annuaire 1985/III, 312) and of Sydney of 1988 (Annuaire 1988/II, 221), and in particular referring to the possibility that inventions in biotechnology might cause moral or ethical problems, recalls its statement in the Sydney resolution that: "The moral or ethical problems which could arise from the

application of new techniques in biotechnology should be primarily regulated by laws specifically dealing with those issues, to which the patent laws of nearly all countries refer in excluding from patentability inventions contrary to morals or public order";

and noting that the new UPOV Act of 1991 fulfils most of the wishes expressed in the Rio de Janeiro and Sydney resolutions:

Resolves:

1. Generally:

- 1.1 that there should be abolition of any domestic or international provision such as Art. 53 b of the European Patent Convention of 1973 which prohibits protection by means of a patent for plant or animal varieties and for essentially biological processes for the production of plants or animals;
- 1.2 that there should be no future domestic or international legislation such as the proposed Patent Harmonisation Treaty and the proposed Community Directive on the Protection of Biotechnological Inventions that would have the effect of any such or similar prohibition;
- 1.3 that in particular, and following the lead of the new UPOV Act the proposed Regulation on Community Plant Variety Rights should not involve provisions which would be in conflict with the possibility of double protection or with the option of protecting plant varieties either by means of a patent or by means of a plant variety certificate;

- 1.4 that it is desirable that biotechnology patents, which relate to a generic technological advance, and plant variety certificates, which relate essentially to specific varieties, should co-exist and offer the possibility of strong, full and complementary protection;
- 1.5 that such protection is in the best long-term interests of inventors, breeders, farmers and consumers alike.

2. Concerning the extent of protection of biotechnological patents

- 2.1 that such patents should offer the same scope of protection as any other patent;
- 2.2 that the scope of such protection:
 - for product patents extends to successive generations of claimed material
and,
 - for process patents, includes naturally-reproduced successive generations as direct products of the process;
- 2.3 that existing doctrines of exhaustion should apply but may need adjustment in view of the nature of the patented material, and that in particular there is no present justification for a so-called "farmers' privilege";
- 2.4 that provision should be made for the possibility of deposits of biological material relating to macrobiological inventions in line with those for microbiological inventions.

3. Concerning the extent of protection of plant variety certificates:

- 3.1 recommends that national legislators should only in exceptional cases make use of the option offered in Art. 15(2) of the new UPOV Act for "farmers' privilege" under a plant variety rights scheme, and that if such option be adopted it should be with the strict safeguarding of the legitimate interests of the breeder, without whom improvements would not be made;
- 3.2 in view of the extended scope of protection provided for plant variety certificates in the new UPOV Act, improved mechanisms for ensuring public availability of the protected variety need to be studied.

4. Concerning the interrelationship between the rights:

- 4.1 it is reaffirmed that the possibility of protection being provided by both the patent and plant breeders rights systems may result in different parties having rights covering the same entity. In the event that it becomes necessary to obtain a licence in order to avoid infringement of the rights of a party, either between the parties as such or other interested parties, AIPPI considers usual commercial agreement between the parties as the primary means appropriate for the resolution of licensing matters;
- 4.2 favours provisions allowing that an application for one right may provide a basis for a claim to priority for an application for the other right; in particular that plant variety certificates should be included in Art. 4A of the Paris Convention of 1883.

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