



Association for Plant Breeding for the Benefit of Society

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Ms. Kitisri Sukhapinda,
President of the Council
UPOV

Mr. Francis Gurry
Secretary General
UPOV

Mr. Peter Button,
Vice Secretary-General
UPOV

UPOV Council Document (C(EXTR.)/31/2: Examination of the Conformity of the Draft ARIPO Protocol for the Protection of New Varieties of Plants with the 1991 Act of the UPOV Convention

Dear Sir/Madam,

Please find attached Comments by APBREBES on UPOV Council Document (C(EXTR.)/31/2: Examination of the Conformity of the Draft ARIPO Protocol for the Protection of New Varieties of Plants with the 1991 Act of the UPOV Convention.

The Comments are based on the Legal Opinion of Prof. Thomas Cottier from the World Trade Institute, Switzerland and seriously questions the conformity of the proposed decision in paragraph 42 of C(Extr.)/31/2 with the 1991 Act. The Legal Opinion is also attached.



We would also request that you share our Comments and the Legal Opinion with the members of the Consultative Committee and the Council.

Sincerely,

A handwritten signature in black ink, appearing to read 'S. Gura', written in a cursive style.

Susanne Gura
Coordinator
Association for Plant Breeding
for the Benefit of Society (APBREBES)





**COMMENTS ON UPOV COUNCIL DOCUMENT (C(EXTR.)/31/2:
EXAMINATION OF THE CONFORMITY OF THE DRAFT ARIPO
PROTOCOL FOR THE PROTECTION OF NEW VARIETIES OF PLANTS
WITH THE 1991 ACT OF THE UPOV CONVENTION**

The Secretary-General of ARIPO Mr. Fernando dos Santos, Director General of the African Regional Intellectual Property Organization (ARIPO) has requested the examination of the Draft ARIPO Protocol for the Protection of New Varieties of Plants (hereinafter referred to as the “Draft Protocol”), for conformity with the 1991 Act of the UPOV Convention.

In paragraph 42 of C(Extr.)/31/2, the UPOV Council is invited to take a decision on the Draft ARIPO Protocol. There are 3 elements in the decision text in paragraph 42:

- (i) to take a positive decision on the conformity of the Draft ARIPO Protocol with UPOV 1991;
- (ii) once the Draft Protocol is adopted with no changes and the Protocol is in force, to allow ARIPO to deposit its instrument of accession to the 1991 Act;
- (iii) once the Draft Protocol is adopted with no changes and the Protocol is in force, to allow Contracting Parties to the Protocol to deposit its instrument of accession to the 1991 Act.

We are of the view that the proposed decision before the UPOV Council contravenes provisions of UPOV 1991 for the reasons mentioned below.

1. Article 34 (1)(b) lists 3 requirements for an intergovernmental organization (IGO) to become a party to UPOV 1991. A basic requirement is that the IGO should have its own legislation that is “binding on *all* its member states”. ARIPO as an IGO does not fulfill this requirement as the Draft Protocol is only binding on those member states that ratify the Protocol **and does not bind all its member states as required by Article 34(1)(b)**. Article 1(viii) defines “territory” as “where the Contracting Party is an intergovernmental organization, the territory in which the *constituting treaty* of that intergovernmental organization applies.

The constituting treaty of ARIPO is the Lusaka Agreement and currently about 18 countries are members of the Lusaka Agreement. The Draft Protocol is not binding on these 18 countries. It is only binding on countries that ratify the Draft Protocol. The Draft Protocol comes into force after four States ratify or accede to the Protocol (Article 41 of the Draft Protocol).

On this point the attached opinion of Prof. Thomas Cottier from the World Trade Institute (WTI) under the heading of “Membership not including all ARIPO Member



States” also concludes that “Membership of ARIPO on the basis of the Protocol and thus selected Membership is not compatible with the requirements of the UPOV Convention”.

2. Article 34 (1)(b)(iii) of the 1991 Act also requires that the IGO provides evidence/information that it “has been ***duly authorized, in accordance with its internal procedures***, to accede to this Convention”. There is nothing in C(Extr.)/31/2 that provides such evidence or information. It is mandatory for ARIPO to provide information/evidence that it has been authorized to submit the Draft Protocol for assessment of conformity with the 1991 Act and that it has the legal basis and authority to become a Contracting Party to UPOV 1991.

3. Article 30(2) of the 1991 Act states that “It shall be understood that, on depositing its instrument of ratification, acceptance, approval and accession, as the case may be, **each State or intergovernmental must be in a position, under its laws, to give effect to the provisions of this Convention**”.

Article 30 (1) of the 1991 Act lists the measures that are necessary for the implementation of the Convention i.e.

- (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.

In the attached opinion Prof. Thomas Cottier states “While the items (ii) and (iii) can be delegated to the ARIPO Office...each Member of UPOV is obliged under (i) to provide home legal remedies for the enforcement and implementation of rights”. Prof Cottier stresses that “Unless a country can show that by means of granting direct effect to the UPOV Convention and as established in constitutional and domestic case law, effective and sufficient protection is granted under general procedural rules applicable to intellectual property rights, the requirements cannot be met short of domestic legislation prepared in the process of joining the Convention”.

Prof. Cottier further adds “ARIPO, comprising the territory of all its Member States, needs demonstrating that these requirements are met by ***all*** its Member States, either by domestic legislation or by granting direct effect to UPOV Convention rights. The same requirements need to be met by individual Members as a prerequisite for individual UPOV membership. They either need to prepare legislation or demonstrate that Convention rights are otherwise given domestic effect.”

Prof Cottier argues that a prerequisite for UPOV membership is that both ARIPO and each individual member state of ARIPO demonstrates that it is in a position to give effect to the provisions of UPOV 1991.



It is worth noting that except for Tanzania (which has an enforceable law which UPOV has concluded is in conformity with UPOV 1991) and Kenya, which has ratified the act of UPOV 1978), no other ARIPO country has enforceable laws that give effect to the UPOV Convention as obligated by Article 30.

Further ARIPO itself has not demonstrated that it can fulfill the conditions of Article 30. Prof Thomas Cottier thus concludes “ARIPO as an Organization therefore is not in a position to comply with the requirements of Article 30(2) of the UPOV Convention under the draft Protocol of Accession” since “Basic requirements of UPOV membership are not fulfilled”.

4. Article 34(3) of the 1991 Act requires that “Any State which is not a member of the Union....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”.

The rationale for Article 34(3) presumably is to ensure that only a State, which is able to give effect to the provisions of UPOV 1991 as envisaged by Article 30(2), becomes a member of UPOV 1991.

Further one could also easily envisage a scenario whereby a State is a Contracting Party to the ARIPO Draft Protocol and yet has a national PVP that is inconsistent with UPOV 1991. The ARIPO Draft Protocol does state in Article 39 that the Protocol “shall be without prejudice to the right of the Contracting States to grant national plant breeders rights for plant varieties”.

The decision point (para 42) suggests that Contracting states of the Draft Protocol can accede UPOV 1991 bypassing Article 34(3). This would result in inconsistency with the basic requirement for UPOV membership (Article 30(2) i.e. that “each State must be in a position to give effect to the provisions of this Convention”.

Conclusion

It is clear that approval by the Consultative Committee and the Council of the decision point in paragraph 42 will result in a violation of or be inconsistent with a number of provisions of the 1991 Act in particular Article 34(1)(b)(ii) and (iii), Article 34 (3) and Article 30(2).

For UPOV to be able to assess the conformity of the ARIPO Draft Protocol with UPOV 1991 and for ARIPO as an IGO to join the 1991 Act as a Contracting Party, provisions of Article 34(1)(b)(ii) and (iii) as well as Article 30(2) have to be satisfied. As argued above, these provisions have not been satisfied.

For any Contracting Party to the ARIPO Draft Protocol to become a UPOV member, it has to satisfy Article 30(2) in connection with Article 34(3).

The proposed decision before the Council has therefore to be rejected in its entirety.



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Declaration
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Bern, April 3, 2014

The Accession of ARIPO to the Union of the Convention for the Protection of New Varieties of Plants (UPOV)

Dear Mr Meienberg:

Thank you for recently submitting three questions relating to the impending accession of ARIPO to the UPOV Convention. They may be summarized as follows:

1. Is ARIPO, as a Regional Intellectual Property Organization eligible as an intergovernmental organization as described in the UPOV Convention?
2. What is the implication that membership will be only binding upon four ARIPO Member States (out of currently 18 States)?
3. Is it possible that Member States of ARIPO can deposit their instruments of accession to the UPOV Convention without having national legislation in place in accordance with the UPOV Convention?

We are pleased to address these questions briefly below. The answers were prepared in cooperation and with support of Mr Hojjat Khademi, doctoral student at the World Trade Institute.

Related Materials

1. International Convention for the Protection of New Varieties of Plants (UPOV) of December 2, 1961, as Revised at Geneva on November 10, 1972, on October 23, 1978, and on March 19, 1991.
2. Lusaka Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO Agreement) adopted by the Diplomatic Conference for the adoption of an Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO) at Lusaka (Zambia) on December 9, 1976, and amended by the Administrative Council of ARIPO on December 10, 1982, December 12, 1986, November 27, 1996, November 21, 2003 and November 26, 2004 and as amended by the Council of Ministers on August 13, 2004.
3. Draft Legal Framework of ARIPO Protocol for the Protection of New Varieties of Plants (ARIPO Protocol) adopted by 14th Session of the ARIPO Council of the Ministers which was held in Kampala, Uganda from November 28 to 29, 2013.

Eligibility of ARIPO

The UPOV Convention requires that intergovernmental organizations may become a party to the Convention if they are duly authorized, in accordance with respective internal procedures, to accede to this Convention.¹ We briefly examine whether ARIPO meets the qualifications of a proper international organization under international law and whether internal procedures to accede to the UPOV Convention have been followed.

Members of ARIPO are States and thus in line with normal membership of International Organizations under international law.² The Organization came into life and force by the

¹ International Convention for the Protection of New Varieties of Plants, 24 April 1998, 1861 UNTS 281 [UPOV Convention] at art 34(1)(b)(iii).

² See Vienna Convention on the Law of Treaties, 27 January 1980, 1155 UNTS 331 [VCLT] at art 2(i); Vienna Convention on the Representation of States in their Relations with International Organizations of a Universal Character, DocA/CONF67/16 [Vienna Convention on the Representation of States in their Relations with International Organizations of a Universal Character] at art 1; Vienna Convention on Succession of States in respect of Treaties, 6 November 1996, 1946 UNTS 3 [VCSST] at art 2; Vienna Convention on the Law of

Lusaka Agreement.³ It is subject to international law and thus responds to the necessary requirements.⁴ ARIPO moreover possesses legal personality and is represented by proper organs.⁵

ARIPO complies with all the necessary qualifications of an international organization under international law. It therefore, in its own rights, is eligible to join other Organizations to the extent that those allow doing so. Whether or not ARIPO qualifies for membership to the UPOV Convention thus depends upon the terms of the UPOV Convention, and not of ARIPO.

Membership not including all ARIPO Member States

The Consultative Committee of UPOV discussed three options in view of the accession of ARIPO. The first one entails all the Member States. The second one is limited to those Member States which sign up to the present Draft Legal Framework of ARIPO Protocol for the Protection of New Varieties of Plants (ARIPO Protocol). The third one was based upon the Harare Protocol on Patents and Industrial Designs. It was decided to proceed on the basis of the second option.

The UPOV Convention stipulates that any intergovernmental organization may become a party to the Convention⁶ if it has its own legislation providing for the grant and protection of breeders' rights binding on all its member States.⁷ There would be no problem with the first

Treaties between States and International Organizations or between International Organizations, 25 ILM 543 (1986) [VCLT-IO] at art 2.

³ Lusaka Agreement on the Creation of the African Regional Intellectual Property Organization (ARIPO), 9 December 1976 [Lusaka Agreement] at art IV – Membership: Membership of the Organization shall be open to the States members of the United Nations Economic Commission for Africa or the African Union.

⁴ International Law Commission, “Draft articles on the responsibility of international organizations” (2011), online: <http://legal.un.org/ilc/texts/9_11.htm> at art 2(a).

⁵ Lusaka Agreement, supra note 3 at art IX – Status, Privileges and Immunities: (1) The Organization shall in the territories of the members of the Organization enjoy international legal personality and shall have the legal capacity required for the performance of its functions and to acquire or dispose of movable or immovable property.

⁶ UPOV Convention, supra note 1 at art 1(vii): “Contracting Party” means a State or an intergovernmental organization party to this Convention.

⁷ Ibid at art 34 (1)(b)(ii).

option as it entails all the Members of ARIPO and will submit them to the same set of rights and obligations under the UPOV Convention. The second and selective option for Membership causes inconsistencies with the UPOV Convention. While ARIPO will be a Member of UPOV, not all its Member States are bound by the instrument. Membership in essence is defined by means of the Protocol which is limited in its effects to those Members of ARIPO which signed the instrument and for which it is in force. At the same time, ARIPO as an international organization is a Member to UPOV in its own rights. The constellation is in contradiction with the requirement that the Convention is bound to apply to the entire territory of the Member. As Article 1(viii) stipulates: “Territory in relation to an intergovernmental organization means the territory in which the constituting treaty of that intergovernmental organization applies.”

We therefore conclude that Membership of ARIPO on the basis of the Protocol and thus selected Membership is not compatible with the requirements of the UPOV Convention.

Membership without the Existence of Implementing Legislation

According to Article 30 UPOV Convention, Contracting Parties 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.”

These requirements can be summarized to comprise the essential tools for the realization of breeders’ rights under the Convention, entailing the means of effective enforcement and legal remedies, operating an authority entrusted to grant rights, and making available the necessary tools for publication of the applications and approved denominations. While the items (ii) and (iii) can be delegated to the ARIPO Office or in fact to other Members, each Member of UPOV is obliged under (i) to provide at home legal remedies for the enforcement and implementation of rights. Art. 30(2) UPOV Convention states:

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.

Normally, such effect and protection can only be granted and realized by domestic legislation established in the course of introducing plant breeders' rights. Unless a country can show that by means of granting direct effect to the UPOV Convention and as established in constitutional and domestic case law, effect and sufficient protection is granted under general procedural rules applicable to intellectual property rights, the requirements cannot be met short of domestic legislation prepared in the process of joining the Convention.

ARIPO, comprising the territory of all its Member States, needs demonstrating that these requirements are met by all its Member States, either by domestic legislation or by granting direct effect to UPOV Convention rights. The same requirements need to be met by individual Members as a prerequisite for individual UPOV membership. They either need to prepare legislation or demonstrate that Convention rights are otherwise given domestic effect.

ARIPO as an Organization therefore is not in a position to comply with the requirements of Article 30(2) of the UPOV Convention under the draft Protocol of Accession. Basic requirements of UPOV membership are not fulfilled.

Kind regards

World Trade Institute



Prof Thomas Cottier
Managing Director