

WORLD TRADE ORGANIZATION

RESTRICTED

IP/C/W/126
5 February 1999

(99-0435)

**Council for Trade-Related Aspects
of Intellectual Property Rights**

Original: English

REVIEW OF THE PROVISIONS OF ARTICLE 27.3(b)

Communication from Canada, the European Communities, Japan and the United States

At its meeting of 1 and 2 December 1998, the Council for TRIPS agreed to invite those Members that were already under an obligation to apply Article 27.3(b) of the TRIPS Agreement to provide information on how the matters addressed in that provision were presently treated in their national law. It was also agreed that while it would be left to Members to provide information as they saw fit, the Secretariat would be requested to prepare an illustrative list of questions relevant in that regard in order to assist Members in preparing their contributions. In this context, Mexico suggested that the illustrative list take certain points into account.

The European Communities, the United States, Japan, and Canada have reviewed the Secretariat's questionnaire and thank the Secretariat for its helpful contribution to this exercise. We discovered, in preparing our submissions, that because of the significant amount of detailed technical information involved, it would be useful to organize the information in a manner that would solicit simple answers initially yet also provide for the inclusion of all appropriate background information. We believe that presenting our information in this manner will assist Members in comparing relevant elements of patent and plant variety systems in WTO Members, and thereby facilitate the review process. We have asked the Secretariat to circulate the format we developed and invite interested Members to be guided by this format in completing their responses, if they so desire.

Representative Questions for TRIPS 27.3(b) Review

Note: These questions have been designed to facilitate the preparation of a synoptic table that compares key features of WTO Member state patent and plant variety systems that are pertinent to Article 27.3(b). We encourage use of this set of questions to structure your country's response to the WTO Secretariat's informal questionnaire on 27.3(b).

A. PATENT SYSTEM QUESTIONS

1. In your territory, is there *any* basis for denying a patent on an invention consisting of an entire plant or animal that is novel and involves an inventive step?
2. If the answer to question 1 is yes, please respond to the following questions:
 - (a) Does your patent system exclude entire plants or animals as inventions? If it does, please cite the legal basis for this.
 - (b) If your patent system does recognize entire plants and animals as inventions, does it exclude all such inventions from being patentable subject-matter, or does it only exclude certain types of plants or animals? If it excludes all, please cite the legal basis for their exclusion (e.g. lack of industrial applicability). If it excludes only certain types, please identify the categories or characteristics of inventions that are excluded and cite the legal basis for their exclusion.
 - (c) Is there any other basis in your law that precludes the grant of a patent on any categories of plant or animal inventions that otherwise are novel, involve an inventive step and are capable of industrial application? If so, please cite the legal basis for that exclusion from patent eligibility.
3. Other than with respect to subject-matter you defined as being ineligible to be patented under question (2), is it possible in your territory to obtain a patent claim defined in any of the following ways?
 - (a) A patent claim that is *not limited* to a specific plant or animal *variety*.
 - (b) A patent claim that is *expressly limited* to a plant or animal *variety*.
 - (c) A patent claim that is expressly limited to a group of plants or animals, where the group is defined through reference to a shared characteristic such as incorporation of a particular gene.
 - (d) If the answers you provide to question (3)(a) to (c) vary, please provide the definitions of a "plant variety" and an "animal variety" that are used by your examining authority.
4. Is it possible to obtain a patent in your territory on a microorganism that is novel, involves an inventive step and is capable of industrial application? If not, please identify the legal basis under which these inventions are deemed ineligible to be patented.
5. Is it possible to obtain a patent in your territory on an essentially biological process for the production of a plant or animal (i.e. a process limited to those acts that are necessary for sexual or asexual reproduction of a plant or animal)? If not, please identify the legal basis under which a patent on such a process would be denied.

6. Is it possible to obtain a patent in your territory covering subject-matter that is identical to that found in nature (e.g. a plant or animal in its natural state)?

B. PLANT VARIETY PROTECTION SYSTEMS

7. Do the laws applicable to your territory provide for a *sui generis* form of protection for a new plant variety?

8. If the answer to question 7 is "yes", does that protection conform to the standards defined in one of the Acts of the International Convention for the Protection of New Varieties of Plants (UPOV)?

9. If the answer to question 8 is "yes", please specify the Act of the UPOV Convention upon which your legislation is based (i.e. the 1991 Act, the 1978 Act or the 1961/1972 Act).

10. If *sui generis* protection for plant varieties is provided in your territory, would any of the following acts require the prior authorization of the right holder:

- (a) acts performed for research or experimental purposes, or to develop new varieties of plants;
- (b) acts performed to commercially exploit a variety distinct from the protected variety but sharing its essential characteristics;
- (c) acts performed by a farmer of harvesting seed from his planting of a protected variety legitimately obtained, storage of that seed, and replanting of that seed on the farmer's land.

If prior authorization is not required for any of the above examples of activities, is there any requirement that the party undertaking the specified actions provide the right holder with remuneration in any form?

11. Can protection be obtained for a plant variety that was known to the public, or was publicly available, prior to the application for *sui generis* protection for that plant variety, and, if so, under what conditions (i.e. what are the time-limits during which public disclosure or availability will not preclude the grant of protection).

12. Can protection be predicated on identification of an unexpressed gene, on an unexpressed set of genes present in the genome of the plant variety, or on the characteristics of germplasm, rather than the *expressed characteristics* of plant varieties derived from such genes or germplasm?
