



REVIEW OF THE PROVISION OF TRIPS ARTICLE 27.3(B)

RESPONSES TO THE CHECKLIST OF QUESTIONS¹

UKRAINE

The present document contains responses to the Checklist of Questions which the Secretariat has received from the delegation of Ukraine on 1 July 2019.

Introduction

I. RESPONSES TO THE ILLUSTRATIVE LIST OF QUESTIONS PREPARED BY THE SECRETARIAT (DOCUMENT IP/C/W/122)

A. Patent Protection of Plant and Animal Inventions

1. To what extent are inventions concerning plants or animals, whether products or processes, patentable under your country's law, if they meet the conditions for patentability stipulated in Article 27.1 of the TRIPS Agreement?

According to the Law of Ukraine of 15 December 1993 No. 3687-XII "On Protection of Rights to Inventions and Utility Models" (with amendments) legal protection is granted to any inventions, whether products or processes, in all fields of technology.

Under Article 6.2 of this Law, the following may be a subject-matter of an invention:

- a product (device, substance, micro-organism strain, plant or animal cells culture etc.);
- a process (method), as well as a new use of a known product or process.

An invention meets the conditions for patentability, if it is new, involves an inventive step and is capable of industrial application (Article 7 of this Law).

2. Where any such inventions are not patentable, even if they meet these conditions:

(i) To what extent is this due to per se exclusions from patentability?

(ii) To what extent is this based on other grounds (for example because conditions for patentability other than those stipulated in Article 27.1 are not met or in order to protect ordre public or morality (see Article 27.2 of the Agreement)?

The legal protection shall be granted to an invention that does not contradict *ordre public*, humanity and morality and complies with the requirements of patentability (Article 6.1 of mentioned Law).

¹ Documents IP/C/W/122 and IP/C/W/126.

3. Please describe any specific provisions, guidelines, final judicial decisions and administrative rulings of general application concerning the application of the conditions for patentability stipulated in Article 27.1 to subject matter addressed by Article 27.3(b).

According to Article 6.3 of the Law of Ukraine "On Protection of Rights to Inventions and Utility Models", the legal protection under this Law shall not extend to such subject-matters of technology as plant varieties and animal breeds; processes of the reproduction of plants and animals that are biological in its basis and do not belong to non-biological and microbiological processes.

Thus, this Law provides for patent protection for such products as micro-organism strain, plant or animal cells culture etc., and for non-biological and microbiological processes for the production of plants and animals, if they meet conditions of patentability.

Plant varieties protection is available under the Law of Ukraine of 21 April 1993 № 3116-XII "On Protection of Plant Variety Rights" (with amendments).

As of today, there are no legislative acts on protection of animal breeds in Ukraine.

4. Where plant varieties are not as such patentable subject matter under your country's law, please indicate the extent to which the scope of protection under patents for inventions concerning plants can nevertheless embrace plant varieties or a botanical taxon whose plants express a trait covered by the claims of a patent.

Article 6.3 of the Law of Ukraine "On Protection of Rights to Inventions and Utility Models" states that the legal protection under this Law shall not extend to such subject-matters as plant varieties.

5. Please provide any definitions used under your country's law with regard to subject matter specifically excluded from patentability or specifically patentable (e.g. micro-organisms, microbiological processes, non-biological processes, plant varieties).

The Law of Ukraine "On Protection of Plant Variety Rights" provides for the definition of "plant variety". It means a particular group of plants (clone, line, F1 hybrid, population) within the lower of the known botanical taxons (genus, type, species) irrespective of whether it satisfies the conditions of legal protection (Article 1).

6. To what extent is subject matter that is identical to what occurs in nature patentable under your country's law?

An invention is patentable if it meets the conditions for patentability stipulated in Article 7 of the Law of Ukraine "On Protection of Rights to Inventions and Utility Models".

7. Explain the requirements under your country's law for ensuring adequate disclosure of the patentable inventions referred to above.

Under the Law of Ukraine "On Protection of Rights to Inventions and Utility Models", the description of an invention shall be represented according to established procedure and shall disclose the subject-matter of an invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art. Invention claims shall disclose the subject-matter of an invention, be based on the description and be clearly and concisely represented according to established procedure (paragraphs 7 and 8 of Article 12).

8. What rights are conferred upon owners of the patents referred to above? Are product and process patents subject to the same rules as other patents? Do they benefit from the same protection as stipulated in Article 28 of the TRIPS Agreement?

Under Article 28.2 of the Law of Ukraine "On Protection of Rights to Inventions and Utility Models", a patent confers on its owner the exclusive right to use an invention at his discretion if such a use does not infringe rights of other owners of patents.

The use of an invention encompasses:

- manufacturing a product using a patented invention, usage of a product, offering for sale, including via the Internet, selling, importing and other means of its introduction into the commercial distribution, as well as storing a product for defined purposes;
- use of the patented process or offering its use on the territory of Ukraine, if the person making such offer knows that the use of the process without the owner's consent is prohibited or, given the circumstances, it is obvious.

According to Article 28.5 of the above-mentioned Law, the patent gives to its owner the exclusive right to prevent other persons from using the invention without the authorization, excluding the cases when according to this Law such use is not considered to be the infringement of rights granted by a patent.

The patent owner may transfer, by the contract, the property right to an invention to any person, which becomes his legal successor (Article 28.6 of the Law of Ukraine "On Protection of Rights to Inventions and Utility Models").

Article 28.7 stipulates that the patent owner has the right to grant the permission (a license) for the use of an invention to any person based on a license contract.

9. Are there any specific exceptions to these rights (affecting the scope or duration of the patents referred to above)? To what extent are exceptions, available in respect of plant variety rights (e.g. those referred to under B.4(i) below), available in respect of rights conferred upon patent owners?

According to Article 31.2 of the Law of Ukraine "On Protection of Rights to Inventions and Utility Models" the use of the patented invention shall not be considered to be the infringement of rights, deriving from a patent, provided that it is used:

- without any commercial purpose;
- for scientific or experimental purposes;
- in situations of emergency (natural disaster, accident, epidemic etc.) with the notification of the patent owner as soon as possible and with the paying a relevant compensation to him.

The exceptions to the patent owner's right, such as acts done for non-commercial, scientific or experimental purposes are similar with the exceptions, available in respect of plant variety rights, set out by Article 47 of the Law of Ukraine "On Protection of Plant Variety Rights".

10. Are there any specific provisions under your country's law for compulsory licensing in respect of the patents referred to above?

With the objective of public health protection, state defense, ecological safety and other public interests, the Cabinet of Ministers of Ukraine may grant permission to use the patented invention by a defined person without the consent of the patent owner (in accordance with conditions, stipulated in Article 30.3 of the Law of Ukraine "On Protection of Rights to Inventions and Utility Models").

In addition, Article 43 of the Law of Ukraine "On Protection of Plant Variety Rights" regulates the issuance of the compulsory licensing for the use of the plant variety without the consent of the patent holder.

B. Protection of Plant Varieties

1. Does your country's law provide for the protection of plant varieties by plant breeder's rights, plant patents or any other sui generis system for the protection of plant varieties?

The Law of Ukraine of 21 April 1993 No. 3116-XII "On Protection of Plant Variety Rights" (with amendments) provides for the protection of intellectual property rights to plant varieties.

- 2. (a) If your country is a party to the International Convention for the Protection of New Varieties of Plants (UPOV), please indicate which Act or Acts of the UPOV Convention your country has signed; which it has ratified; to which it has acceded; and to the standards of which its law conforms but to which it has not (yet) adhered.**

Ukraine has acceded to the International Convention for the Protection of New Varieties of Plants of December 2 1961, as revised by the Additional Act of 1972, the 1978 Act and the 1991 Act (according to the laws of Ukraine of 2 June 1995 No. 209/95-BP and of 2 August 2006 No. 60-V).

- (b) If your country is not a party to the UPOV Convention, does the protection offered to plant varieties under your country's law conform to the standards of any of the Acts of the UPOV Convention and, if so, which?**

- 3. Please indicate whether concurrent protection under your country's plant variety protection law and its patent law is available (see also question A.4 above).**

Plant varieties protection is available under the Law of Ukraine of 21 April 1993 No. 3116-XII "On Protection of Plant Variety Rights" (with amendments).

Article 6.3 of the Law of Ukraine "On Protection of Rights to Inventions and Utility Models" of 15 December 1993 (with amendments) stipulates that the legal protection under this Law shall not extend to such objects as plant varieties.

- 4. Please provide the following details of your country's sui generis system for the protection of plant varieties:**

- (a) the relevant laws and regulations and, if they have been notified to the Council for TRIPS, a reference to the relevant WTO documents;**

The legislation of Ukraine on the protection of plant varieties is based on the Constitution of Ukraine and consists of the Law of Ukraine "On Protection of Plant Variety Rights" (hereinafter – the Law), the Civil Code of Ukraine, international treaties and agreements on protection of plant variety rights consented by the Verkhovna Rada of Ukraine as binding. The Procedure for Maintaining the Register of Patents on Plant Varieties is approved by the Resolution of the Cabinet of Ministers of Ukraine of 19 September 2018 No. 755.

The Law was notified to the TRIPS Council (the WTO document IP/N/1/UKR/P/2). In addition, pursuant to Article 63.2 of the TRIPS Agreement Ukraine has notified the laws and regulations pertaining to the subject-matter of this Agreement, including plant varieties, in the WTO document IP/N/1/UKR/1.

- (b) the definition of "plant variety";**

According to Article 1 of the Law, the definition of "plant variety" means a particular group of plants (clone, line, F1 hybrid, population) within the lower of the known botanical taxons (genus, type, species) irrespective of whether it satisfies the conditions of legal protection.

- (c) the conditions required for protection;**

Article 11 of the Law stipulates criteria of variety suitability for the acquisition of intellectual property rights to such variety.

Under Article 11.2 of the Law, a variety shall be deemed suitable for the acquisition of a right to it as an intellectual property subject, if, following its characteristics originating from a particular genotype or a particular combination of genotypes, it is new, distinct, uniform and stable.

- (d) the extent to which subject-matter that is already known to the public or identical to what occurs in nature is protectable under your country's sui generis system for the protection of plant varieties;**

According to Article 11.6 of the Law, a variety complies with condition of distinctiveness, if, following its characteristics, it is clearly distinguished from any other variety, generally known prior to the date, on which the application is deemed to be filed.

A variety, which is opposed to the applied one, shall be deemed generally known if:

- a) it is widespread on a particular territory within any country;
- b) information about its characteristics has become known globally, in particular through its descriptions in any publicly disclosed publications;
- c) it is presented as a sample in public collection;
- d) it is under legal protection and/or included in official plant variety register of any country, being herewith deemed generally known from the date of application for granting the right or entering to the register.

Article 19¹ of the Law states that any person may apply for the acquisition of intellectual property right to dissemination of the variety, referred to as generally known, without acquisition of the intellectual property rights to such variety confirmed by a patent.

(e) the extent to which protection can be based on characteristics of germplasm, as opposed to characteristics of plant varieties derived from such germplasm;

A plant variety can be protected if it is new, distinct, uniform and stable, following its characteristics originating from a particular genotype or a particular combination of genotypes (Article 11.2 of the Law).

(f) who is entitled to the rights;

The author(s) of a plant variety or other persons, that have acquired intellectual property rights to a plant variety according to the contract or under the Law, are entitled to intellectual property rights to a plant variety (Article 3¹ of the Law).

(g) the procedure for the acquisition of rights, including the authority in charge of administering the rights;

Section III of the Law establishes the procedure for the acquisition of intellectual property rights to plant varieties. It includes such stages as filing an application to the Competent Authority, examination of the application and state registration of rights. The Competent Authority is the Ministry of Agrarian Policy and Food of Ukraine, responsible for developing and implementing the national policy on plant variety rights protection. The Ministry may authorize companies, institutions and organizations to exercise some specific powers, related to plant variety rights protection, if they meet the requirements, stipulated in Article 9.1 of the Law.

(h) the rights conferred;

According to Article 10 of the Law, the following variety rights may be acquired:

- personal non-property rights of intellectual property to a plant variety (it shall be confirmed by a certificate of plant variety authorship);
- intellectual property rights to a plant variety (it shall be confirmed by a plant variety patent; the scope of legal protection to variety, for which a patent is granted, is determined by the total characteristics, included in the variety description in the Register of Patents);
- intellectual property rights to plant variety dissemination (it shall be confirmed by a certificate of state registration of a plant variety).

The above rights to variety shall be acquired according to the procedure established by this Law.

- (i) exceptions to the rights conferred, such as**
- **acts performed for research or experimental purposes;**
 - **acts performed to develop new varieties of plants;**
 - **acts performed to commercialize such newly developed varieties;**
 - **any "farmer's privilege" (e.g. acts performed by a farmer on his own land in respect of seed saved from the previous harvest);**
 - **acts done privately and for non-commercial purposes;**
 - **compulsory licensing.**

According to Article 47 of the Law, intellectual property rights to plant variety shall not extend to:

- acts done privately and for non-commercial purposes;
- acts performed for experimental purposes;
- acts performed to develop new varieties of plants.

Article 43 of the Law establishes the possibility of granting compulsory licensing for the use of the variety without the consent of the patent holder. Such compulsory license may be only non-exclusive, with specification of variety use scope, term of permission validity, amount and procedure for remuneration to the patent holder. It may be granted by the Cabinet of Ministers of Ukraine and by the court.

(j) the duration of protection;

The duration of protection shall be 35 years, counted from the 1st January of the year following the year of state registration of intellectual property rights to a plant variety for trees and shrubs and grape; 30 years – for other varieties (Article 41.2 of the Law).

(k) transfer of rights;

According to Article 40 of the Law, a patent holder may transfer its property rights to a variety to any natural or legal person, which becomes its legal successor, under the licensing contract. In addition, transfer of rights may be performed through inheritance.

(l) enforcement of the rights

Any actions in respect of the protected variety, performed without the authorization of the owner of intellectual property rights to such plant variety, shall be deemed to constitute an infringement of intellectual property rights to a plant variety (Article 53.2 of the Law). Ukrainian laws establish the responsibility for infringement of plant variety rights.

According to Article 53.4 of the Law, the person whose variety rights have been violated may claim the following:

- ceasing the actions that violate or predetermine the infringement of its rights as compared to the situation that existed before such infringement;
- indemnification for the caused damage, including the lost profit;
- compensation for non-pecuniary damage;
- taking other measures on variety rights protection provided for by laws of Ukraine.

The person, entitled to use the variety under the license contract, may also claim the restoration of the violated patent holder`s rights, unless otherwise is provided for by the contract.

Under Article 53.5 of the Law, at the request of the right holder, the infringer shall cease the infringement of the rights and indemnify for the caused damage.

Article 54 of the Law provides for provisions concerning settlement of disputes on variety rights in the course of court proceedings. It stipulates that person, whose variety rights have been violated, may apply to the court for remedy.

The responsibility related to the infringement of variety rights is set out in Article 55 of the Law. The court is entitled to render a judgment on the following:

- compensation for non-pecuniary (non-property) damage, caused by the infringement of the variety rights, with specification of the amount of compensation;
- compensation for the damage, caused by the infringement of intellectual property rights to a plant variety;

- recovery of profit, received in the result of variety rights infringement, including the lost patent holder`s profit;
- recovering the compensation, defined by the court in amount from 10 to 50,000 minimum salaries, with due consideration of whether the infringement was intended or not, instead of compensation for the damage or recovery of profit;
- ceasing the act that predetermines the infringement of variety rights.

The court may render a judgment to impose a fine on the infringer amounted to 10% of the charge, judged in favour of the claiming party (Article 55.2 of the Law). Furthermore, the court may render a judgment on the following:

- withholding from commercial distribution or seizing any variety materials and product, obtained with using such variety, which have been illegally received by the infringer (the variety materials and product, acquired by other persons in good faith, shall not be subject of seizure);
- withholding or seizing the materials and/or equipment, which have been extensively used for the illegal production of variety materials (Article 55.3 of the Law).

II. RESPONSES TO REPRESENTATIVE QUESTIONS FOR TRIPS 27.3(B) REVIEW SUBMITTED BY THE DELEGATIONS OF CANADA, THE EUROPEAN UNION (FORMERLY EUROPEAN COMMUNITIES), JAPAN AND THE UNITED STATES (DOCUMENT IP/C/W/126)

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:

- Does your patent system exclude entire plants or animals as inventions? If it does, please cite the legal basis for this.**
- 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.**
- 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 patent claim that is not limited to a specific plant or animal variety.**
- A patent claim that is expressly limited to a plant or animal variety.**
- 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.**
- 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?
