Intellectual Property Rights for Plant Varieties: South Africa and the UPOV Convention

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I. Introduction

The International Convention for the Protection of New Varieties of the Plants (hereinafter referred to as UPOV) creates an intellectual property right in new varieties of plants.\(^1\) UPOV aims to benefit society by providing an effective system of plant variety protection while encouraging the development of new varieties.\(^2\) The UPOV Convention was first adopted in Paris in 1961.\(^3\) Subsequently, the convention was revised in 1972, 1978, and 1991.\(^4\)

South Africa is a state party to UPOV Acts of 1961, revised in 1972 and 1978 and 1991. On October 7, 1977, South Africa deposited its instrument of accession to UPOV that was signed in 1961 and 1972.\(^5\) Then on July 21, 1981 South Africa deposited its instrument of ratification of UPOV of 1962 that was revised in 1972 and 1978.\(^6\) South Africa passed The Plant Breeder’s Rights Act, Act No. 15 of 1976 to comply with UPOV 1961.\(^7\) South Africa has signed the UPOV Act revised in 1991. On March 19, 1991, South Africa became a signatory state to UPOV as revised in 1991.\(^8\) In 1996, South Africa amended the Plant Breeder’s Rights Act to meet the requirements of UPOV as revised in 1991.\(^9\) Currently, South Africa has met all of the requirements of UPOV 1991, except for extending its list of plant species qualifying for protection to all plant species.\(^10\) South Africa has not indicated intent to be bound by UPOV 1991.\(^11\) South Africa has not deposited its instrument of accession to UPOV 1991.\(^12\)
This e-brief examines the law in South Africa regarding plant breeder’s rights as well as the minimum requirements established by UPOV. The paper compares the internal legislation passed by South Africa to the requirements of UPOV. Specifically this e-brief outlines South Africa’s approach to: the scope of plant breeder’s rights, the exceptions to plant breeder’s rights, the application process for plant breeder’s rights, objections to granting plant breeder’s rights, licensing, and the procedure to appeal decisions of the registrar.

II. Scope of Plant Breeder’s Right

According to Section 25(4)(b) of the South African Patents Act No. 57 of 1978 a patent may not be granted for any variety of plant not being a micro-biological process or the product of such a process. Therefore it is possible to obtain a patent for a plant as long as that plant is a micro-biological process or product of such a process. Primarily, rights of plant breeders are granted under the Plant Breeder’s Rights Act. The Plant Breeders' Rights Act No. 15 of 1976 has been amended five times by Amendment Acts No. 5 of 1980, No. 14 of 1981, No. 38 of 1983 and No. 15 of 1996 and Transfer of Powers and Duties of the State President Act, No. 97 of 1986. The Plant Breeder’s Rights Act is the internal implementing legislation for the UPOV convention. Both UPOV as revised in 1991 and The Plant Breeder’s Rights Act require a plant variety to be new, distinct, uniform and stable to qualify for protection.

Under South African law, a plant variety is new if propagating material or harvested material has not been sold or otherwise disposed of by the breeder for the purposes of exploitation of the variety in South Africa for one year before filing the application for a plant breeder’s right. A plant variety is distinct if at the date of filing the application it
is distinguishable from any other variety of the same kind of plant, which is a matter of common knowledge.\textsuperscript{18} A plant variety is \textit{uniform} if it is sufficiently uniform with regard to the characteristics of the variety in question.\textsuperscript{19} Finally, a plant variety is \textit{stable} if the characteristics of the plant variety remain unchanged after repeated propagation, or in the case of a particular cycle of propagation, at the end of such cycle.\textsuperscript{20}

South Africa grants to the holder of a plant breeder’s right legally protected exclusive rights for a period of 25 years with respect to vines and trees\textsuperscript{21} and 20 years for all other varieties.\textsuperscript{22} South Africa, and UPOV both require the right holder’s authorization for the production or reproduction,\textsuperscript{23} conditioning for the purpose of propagation,\textsuperscript{24} sale or marketing,\textsuperscript{25} exporting,\textsuperscript{26} importing,\textsuperscript{27} or stocking for the purposes of production, reproduction, and importing of propagating material.\textsuperscript{28} The Plant Breeder’s Right’s Act also requires the breeder’s authorization for these acts with regard to harvested materials.\textsuperscript{29} Additionally, both South Africa and UPOV give the holder exclusive rights over varieties that are 1) essentially derived from the protected variety, 2) not distinguishable from the protected variety, or 3) whose production require the repeated use of a protected variety.\textsuperscript{30}

Both UPOV and the Plant Breeder’s Right Act provide provisional protection, which protects the breeder during the period between filing for a plant breeder’s right and the grant of that right. UPOV requires, at a minimum, Contracting parties to make provision to the holder of a right of equitable compensation against persons who commit acts that would require the breeder’s permission once the right is granted.\textsuperscript{31}

The Plant Breeder’s Rights Act defines provisional protection as protecting the breeder as though the right had been granted from the date the application is filed in
South Africa until the date the right is either granted or denied. Provisional protection creates a cause of action for anything that would constitute an infringement of a plant breeder’s right once the right is granted. The Registrar issues provisional protection only at the request of the applicant of a breeder’s right and only if the applicant has given a written undertaking to the Registrar that he or she shall not sell or consent to sell in South Africa any reproductive material of the variety in question. In other words, the breeder agrees not to commercially exploit the variety during the time the application is pending and in exchange ensures that others cannot do so either.

Provisional protection is temporary protection during the period of time that the application for the plant breeder’s right is pending. Provisional protection has the same effect as a granted plant breeder's right. Therefore, anything that would constitute infringement of a plant breeder’s right is actionable once a plant breeder’s right is granted.

The Plant Breeder’s Rights Act mandates that provisional protection terminate on the date in which the breeder’s right is either granted or denied. The Act also allows withdrawal of the provisional protection on an earlier date if the Registrar determines that the circumstances justify such withdrawal. The Act mandates withdrawal of provisional protection at an earlier date by the registrar if it is determined that either the holder has failed to fulfill the terms of an undertaking, or has given an undertaking, whether enforceable by law or not, to another person such that the holder is deprived the right to institute an action for damages with respect to an infringement of a plant breeder’s right.
III. Exceptions to Plant Breeder’s Rights

UPOV mandates compulsory exceptions to the breeder’s right for

1) Acts done privately for non-commercial purposes,

2) Acts done for experimental purposes, and

3) Acts done for the purpose of breeding other varieties.

South Africa has incorporated these exceptions into the Plant Breeder’s Rights Act. The Plant Breeder’s Rights Act states that a person shall not infringe the plant breeder’s right if the propagating material was obtained in a legitimate manner and if he or she

1. Uses propagating material for private or non-commercial purposes;

2. Uses propagating material for research; or

3. Uses or multiplies propagating material in the development of a different variety.

Additionally, UPOV allows an optional exception for farmers using the protected variety for propagating purposes, the product of the harvest, which they have obtained by planting on their own holdings. South Africa makes the farmer’s exception a mandatory one, stating a farmer who uses a protected variety for propagating purposes on his or her own holding does not infringe on the plant breeder’s right.

South Africa also includes exceptions to infringements of plant breeder’s right not mentioned in UPOV including as long as that person obtained the propagating material in a legitimate manner and:

1) If he or she resells that propagating material, or
2) Sells the propagating material for purposes other than further propagating or multiplication.  

IV. Application for Plant Breeder’s Right

UPOV requires the establishment of an authority to examine applications to ensure compliance with conditions required by the convention. The Plant Breeder’s Rights Act calls for the Minister of Agriculture to designate an officer in the Department of Agriculture as the Registrar of Plant Breeder’s Rights. The Registrar must maintain a register of all holders of plant breeder’s rights. The Register serves as prima facie evidence that a plant breeder’s right has been granted and can be submitted in any court.

Persons who may apply for a plant breeder’s right, according to the Plant Breeder’s Rights Act, include the breeder, who is a citizen of South Africa or another convention country or a person who has a registered office in South Africa or a convention country. An applicant for a plant breeder’s right in South Africa must submit an application with the appropriate application fee, appropriate documents and include an address in the Republic where communications can be sent. Persons not residing or having a registered office in South Africa must submit an application through an agent.

The Plant Breeder’s Right Act grants a right of priority for a period of 12 months if the applicant has first, notified the registrar that a prior application has been filed in a Contracting state; second, the application is accompanied by a claim of the right of priority; and third, if it is accompanied by the prescribed application fee.

Varieties granted protection must be designated by a denomination. UPOV requires that the denomination allow the variety to be identified and not consist only of
numbers unless that is an established practice. Additionally, UPOV directs that denominations not be confusing or misleading concerning the characteristics, value, or identity of the breeder. Both UPOV and the Plant Breeder’s Rights Act require a variety to consistently be designated by the approved denomination in all Contracting states. Denominations may be altered or supplemented by the Registrar if:

1) it is court ordered upon application of a person who has a legally preferred claim to the use of the designation in question,

2) at the request of the holder of a plant breeder’s right in that variety,

3) if information submitted by the applicant was incorrect and the Registrar is of the opinion that such denomination would not have been approved had the Registrar known it was incorrect, or

4) if new information is available that would have resulted in refusal of such denomination had the registrar known.

The Registrar may reject an application for a plant breeder’s right if the registrar determines that the application does not comply with the provisions of the Plant Breeder’s Rights Act including the requirement that the plant variety be new, distinct, uniform, and stable. Additionally, an application can be rejected if the Registrar concludes that the applicant is not entitled to make the application. Persons entitled to make an application for a breeder’s right are those either a citizen or domiciled in South Africa or a convention or agreement country or those having a registered office in South Africa or a convention or agreement country. Other reasons for rejecting an application include instances where the applicant misrepresents a material fact, the application fraudulently affects the rights of the holder of a plant breeder’s rights or
someone who has obtained provisional protection, the description of the variety fails to
describe the variety, and where a previous application in another contracting state by
the same applicant for the same variety has a differing description. A defect in the form
of any document included in the application shall not invalidate the document if the
requirements and meaning are substantially and intelligibly set forth.

Once the Registrar decides that an application is not subject to rejection, the
Registrar publishes the application in the Gazette, including application details. The
Government Gazette is the official South African Government Publication that publishes
regulations, subordinate legislation issued by government ministers, and draft bills. An
applicant for the grant of a plant breeder’s right may amend the application at any time
before the application is published. If the Registrar determines that the amendment is
material, the registrar may change the date of application to the date of the amendment or
keep the original application date. In either case, the Registrar shall republish the
application in the amended form in the Gazette.

The Registrar shall consider every application that has been published in the
Gazette to determine if it complies with the requirements of the Plant Breeder’s Rights
Act. The Registrar must determine if a variety qualifies for protection by conducting
tests and trials, as he or she deems necessary. The Registrar may use the results of these
tests and trials obtained from a convention or agreement country related to the same
variety. The applicant shall pay the appropriate examination fee for such tests and
trials, as well as the costs involved with obtaining the results of tests obtained from
another convention or agreement country. The applicant shall furnish the Registrar with
propagating material, specimens of plants of the variety or of parts of such plants, and other information in connection with the variety that the Registrar may require.

Before the Registrar may grant a plant breeder’s right, he or she must determine whether the application conforms to the requirements of the Plant Breeder’s Rights Act, including:

- the applicant is entitled to make the application,
- the variety is new, distinct, uniform, and stable, and
- the applicant has paid all prescribed fees.

Once a right is granted the Registrar shall issue a certificate of registration to the person who applied for the right. Additionally, the Registrar shall enter applicable details into the register. Finally, the Registrar shall publish such details in the Gazette. Conversely, if the Registrar refuses to grant a right he or she shall communicate this in writing to the applicant and publish the details of the refusal in the Gazette.

IV. Objections and Appeals to Decisions of the Registrar

The Plant Breeder’s Rights Act allows any person to object to the decision of the Registrar to grant a plant breeder’s right. This means that a person can object to the Registrar’s decision whether or not that person is a citizen or domiciled in South Africa or a convention or agreement country. Objections can be raised based on either procedural defects or substantive deficiency. Procedural defects include defects in application or failure to pay application fees, while substantive defects include whether the variety is new, distinct, uniform and stable. The applicant may respond to such an objection with a counter-statement. The Registrar must set the date and inform the parties of the date that the objection will be heard. The Registrar has the authority to
summon witnesses and documents, require an oath from persons called as witnesses, and call any person present at the hearing as a witness. The Registrar shall communicate objection-hearing decisions in writing to both the person objecting and the person that applied for the plant breeder’s right. The Registrar shall include the grounds for the decision in the written opinion. Although the opinion itself is not published, if the Registrar upholds an objection to an application, such application shall lapse and such information shall be reported in the Gazette.

A person who feels aggrieved by any decision or action taken by the Registrar may appeal such decision or action to the Minister. The Minister must initiate an investigation and appoint members to an appeal board. The Board is composed of one person designated as chairman and two persons with expert knowledge of the subject matter on appeal. The Board members cannot have a personal interest in the outcome of an appeal or they will be disqualified as board members. The chairman may summon witnesses, administer an oath or accept an affirmation, and call any person present at the hearing as a witness. The decision of the Board is final and there is no appeal. After the hearing of an appeal, the Board may confirm, set aside or vary the relevant action of the Registrar or order the Registrar to execute the decision of the board. Board decisions must be in writing and sent to the Registrar, the appellant and any other parties. These opinions are available upon request to the Registrar.

V. Licensing

The holder of a plant breeder’s right may grant a license to a person who has submitted a written request to him or her. Such a license may authorize the licensee to undertake any activity referred to in section 23(1), including: produce or reproduce,
condition for the purpose of propagation, sale or market, export, import or stock for any aforementioned purpose. Licenses can include conditions such as time limits, royalties and any other matter agreed on by the parties. The holder of a plant breeder’s right shall notify the Registrar of licenses granted by him or her and provide Registrar with a copy of each license. Copies of licenses are matters of public record and can be viewed by contacting the Registrar and paying the required fees.

Once a plant breeder’s right is granted, the Minister of Agriculture shall prescribe a period for the exercise of sole rights. This means that the holder of a plant breeder’s right shall have the sole right to undertake any activity referred to in Section 23(1) for a period of five to eight years, depending on the type of variety of plant. During the period of sole rights, the Registrar shall not issue a compulsory license. However, after the period of sole rights ends, a person may apply to the Registrar for a compulsory license. If a person believes the holder has unreasonably refused a license to him or her or that the holder granted the license with unreasonable conditions, that person may apply to the Registrar for a compulsory license. The holder of the plant breeder’s right can reply with a counter-statement to the Registrar. The Registrar then establishes the date and time the claim will be heard and will notify the parties in writing. If the Registrar determines that a license was unreasonably withheld or was granted with unreasonable conditions, the Registrar may issue a compulsory license.

VI. Conclusion

South Africa’s primary form of protection for plant breeder’s is a plant breeder’s right. South Africa has met the minimum requirements to be in compliance with UPOV
as revised in 1991. Additionally, South Africa has set up a system for objections and appeals to the grant of rights as well as a system for licensing.

3 Id.
4 Id.
9 IP Strategy Today No. 13-2005, page 20
10 Id.
For example, if a cotton farmer purchases cottonseed and then changes his or her mind and decides to plant maize, that farmer would be permitted to resale the cottonseed without infringing on the plant breeder’s right.

For example, a farmer could purchase cottonseed, plant it, and sale the harvested cotton without infringing on the plant breeder’s right.

52 UPOV/Article 12 and UPOV/Article 30(1)(ii)
53 Plant Breeder’s Rights Act/Section 1 Definition of “Minister”
54 Plant Breeder’s Rights Act/Section 1 Definition of “department”
55 Plant Breeder’s Rights Act/Section 3(1)
56 Plant Breeder’s Rights Act/Section 4(1)
57 Plant Breeder’s Rights Act/Section 5
The right of priority exists to protect one who has applied for a plant breeder’s right in another convention country, but has not filed in South Africa. If the right of priority did not exist, someone in South Africa could see that an application had been submitted in another convention country and then apply in South Africa for a plant breeder’s right. The right of priority means that a person who has previously filed an application in another convention country can claim the date of the prior application in South Africa when applying for a plant breeder’s right for the same variety.

“The Registrar shall consider every application for the grant of a plant breeder’s right published under section 13(1) and all documents and any other proof submitted to him in connection therewith in order to ascertain whether the application complies with the requirements of this act.”

“The registrar shall, in order to enable him or her to determine whether a variety qualifies for the grant of a plant breeder’s right under section 2 –

(a) undertake or cause to be undertaken such tests and trials as he or she may deem necessary with a variety in respect of which an application is be considered under subsection (1); or

(b) use the results of the tests and trials obtained from the appropriate authority in a convention country or an agreement country in terms or an agreement referred to in section 5A.”
The Plant Breeder’s Rights Act/Section 19(3)(a)
The Plant Breeder’s Rights Act/Section 19(4)(a)
The Plant Breeder’s Rights Act/Section 19(3)(b)(i)
The Plant Breeder’s Rights Act/Section 19(3)(b)(ii)
The Plant Breeder’s Rights Act/Section 19(3)(b)(iii)
The Plant Breeder’s Rights Act/Section 20(1)(a)
The Plant Breeder’s Rights Act/Section 20(1)(b)
The Plant Breeder’s Rights Act/Section 2
The Plant Breeder’s Rights Act/Section 20(1)(d) and The Plant Breeder’s Rights Act/Section 19 – Prescribed fees including the prescribed examination fee and costs involved with obtaining the results of tests and trials required under Section 19(2)(b)
The Plant Breeder’s Rights Act/Section 20(2)(a)
The Plant Breeder’s Rights Act/Section 20(2)(b)
The Plant Breeder’s Rights Act/Section 20(2)(c)
The Plant Breeder’s Rights Act/Section 20(3)(a)
The Plant Breeder’s Rights Act/Section 17(1)
The Plant Breeder’s Rights Act/Section 17(2)
The Plant Breeder’s Rights Act/Section 18(1)
The Plant Breeder’s Rights Act/Section 18(3)(a)
The Plant Breeder’s Rights Act/Section 18(3)(b)
The Plant Breeder’s Rights Act/Section 18(3)(c)
The Plant Breeder’s Rights Act/Section 18(6)
Id.
The Plant Breeder’s Rights Act/Section 18(7)
The Plant Breeder’s Rights Act/Section 42(1)
The Plant Breeder’s Rights Act/Section 42(2)(a)
The Plant Breeder’s Rights Act/Section 42 (2)(a)(i)
The Plant Breeder’s Rights Act/Section 42 (2)(a)(ii)
The Plant Breeder’s Rights Act/Section 42(2)(b)
The Plant Breeder’s Rights Act/Section 42 (3)(b)(i)
The Plant Breeder’s Rights Act/Section 42 (3)(b)(ii)
The Plant Breeder’s Rights Act/Section 42(3)(b)(iii)
The Plant Breeder’s Rights Act/Section 42(7)(b)
The Plant Breeder’s Rights Act/Section 42(6)(a)
The Plant Breeder’s Rights Act/Section 42(6)(b)
The Plant Breeder’s Rights Act/Section 42(7)(a)
The Plant Breeder’s Rights Act/Section 25(1)
Id.
The Plant Breeder’s Rights Act/Section 25(2)(d)
The Plant Breeder’s Rights Act/Section 25(2)(g)
The Plant Breeder’s Rights Act/Section 25(2)(h)
The Plant Breeder’s Rights Act/Section 25(3)
The Plant Breeder’s Rights Act/Section 25(4)
The Plant Breeder’s Rights Act/Section 25(5)
Id.
The Plant Breeder’s Rights Act/Section 25(6)
The Plant Breeder’s Rights Act/Section 25(7)
The Plant Breeder’s Rights Act/Section 25(8)
The Plant Breeder’s Rights Act/Section 25(9)
The Plant Breeder’s Rights Act/Section 26(1)
The Plant Breeder’s Rights Act/Section 26(1)
The Plant Breeder’s Rights Act/Section 26(4)
The Plant Breeder’s Rights Act/Section 27(1)
142 Plant Breeder’s Rights Act/Section 27(3)