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## **Intellectual Property, Taiwan**

### **Approved characteristics used to assess plant variety right infringement in war of the roses**

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#### **Introduction**

Article 40 of the Plant Variety and Plant Seed Act provides that plant variety rights holders or exclusive licensees may:

- request the cessation of any infringement
- request the prevention of any threat of infringement; and
- claim damages against any parties that intentionally or negligently infringe on their plant variety rights. Facts

On 24 September 2020 the Taiwan Intellectual Property Court (IPC) rendered a civil judgment (2020 Min Zhi Shang Zi 1) that specifically indicates how to determine whether an allegedly infringing plant is an infringing variety.

The plaintiff, a floral company, claimed that the defendant, a floral supplier, had planted the plaintiff's Advance+ (Lexjori) rose plants without a licence. The plaintiff further claimed that the plants had been sold on the market by another defendant, a floral company, under the name 'Avalanche', and that the defendants had therefore jointly infringed the plant variety rights of the Advance+ (Lexjori) roses. However, the defendants argued that the Advance+ (Lexjori) plant and the Avalanche plant were of different varieties, so they had not infringed the plaintiff's plant variety rights by planting or selling the Avalanche roses.

#### **Decision**

The IPC held that the allegedly infringing plant was not the same variety as the plaintiff's Advance+ (Lexjori) plant and therefore concluded that the defendants had not committed infringement. The logic of the judgment is summarised as follows.

When the plaintiff applied for rights to the Advance+ (Lexjori) plant, the Woody and Other Floral Plant Variety Evaluation Committee of the Council of Agriculture (COA) selected the Avalanche rose, which was released in the market in 2005, as the control variety, because its characteristics were closest to those of the Advance+ (Lexjori) plant. As seven distinctive characteristics were found – based on the characteristic identification results of the Advance+ (Lexjori) variety against the control variety Avalanche – the plant variety right was granted.

Plant variety rights protect not only the plant seeds held by the owner, but also:

- any plant seeds that express the characteristics of the variety noted in the table of characteristics that is approved and published by the competent authority; and
- the plant seeds of any varieties that are not clearly distinguishable from the subject variety.

There were up to 20 distinguishable characteristics between the subject of the plaintiff's application for plant variety rights and the allegedly infringing plants. Consequently, the allegedly infringing plants should have been clearly distinguishable from the plaintiff's plant.

In the first-instance trial, plant samples from both parties were sent to the Seed Improvement and Propagation Station for a comparison of their cultivation and characteristics. The conclusion was that the two plants were not distinct. However, the plants provided by the plaintiff at trial did not have the

seven distinctive characteristics noted in the Advance+ (Lexjori) plant variety right that the plaintiff had originally obtained and therefore could not be proved to be identical to the Advance+ (Lexjori) plants.

The identification results revealed that the characteristics of the plants provided by the plaintiff were closer to those of the Avalanche roses. Therefore, the plants provided by the plaintiff may have been of the Avalanche variety, not the Advance+ (Lexjori) variety. Alternatively, the Advance+ (Lexjori) variety may have lost its uniformity and stability over time, thereby resulting in grounds for cancelling the subject plant variety right. The characteristics identification report was insufficient to prove that the allegedly infringing plants were of the same variety as the Advance+ (Lexjori) plants.

Although the plaintiff motioned to compare the allegedly infringing plants with the Advance+ (Lexjori) rose plants that it had used to apply for the subject plant variety right, which were still alive, the IPC pointed out that the scope of plant variety rights refers to the characteristics of the subject plant variety right granted by the COA. In this way, plant variety rights are similar to granted claims of invention patents. Consequently, to determine whether a plant variety right has been infringed, the allegedly infringing plant should be compared with the characteristics of the plant variety right granted by the COA, rather than any living plants or any plants that have survived since the application for the subject plant variety right was filed, because these may not be of the same variety.

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