

**Information Notice Systems and  
the *Plant Breeder's Rights Act 1994* (Cth)**

Hamish MacDonald and Brad Sherman  
TC Beirne School of Law  
The University of Queensland  
Brisbane QLD 4072 Australia

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## Table of contents

1. Enforcement and acquisition of evidence .....	4
2. What is the UK information notice system? .....	4
3. An information notice system for Australia? .....	6
4. Possible Australian scheme.....	8
4.1 Who should be able to issue an information notice? .....	8
4.2 What are the circumstances in which a notice may be issued?.....	8
4.3 Who can an information notice be issued to? .....	8
4.4 What criteria must be met before a person can issue an information notice?.....	9
4.5 What type of information can be requested in an information notice?.....	10
4.6 What are the consequences of not meeting the notice requirement? .....	11
4.7 How can the presumption of guilt be rebutted? .....	12
4.8 How can the defendant show that they had a reasonable excuse for not supplying the information? .....	13
4.9 How can abuse of the information notice system be avoided? .....	14
Appendix 1 .....	18
PART 1 PRESCRIBED PARTICULARS.....	18
PART 2 SPECIFIED MATERIAL .....	18
PART 3 PRESCRIBED INFORMATION .....	18
Appendix 2.....	19

## 1. Enforcement and acquisition of evidence

One of the most consistent and longstanding concerns in relation to plant breeder's rights in Australia has been the challenges PBR owners face in collecting evidence to identify and prove infringement. These difficulties are widely seen as one of the major impediments to the enforcement of PBR, undermining the effectiveness of the PBR system.

At present, PBR owners have three main options for obtaining evidence which is not publicly available. These are: (i) seeking an Anton Piller order from a court to inspect a property to seize any relevant information;<sup>1</sup> (ii) applying for a court order that compels a person to provide any document that would assist the applicant to decide whether they have a cause of action;<sup>2</sup> and (iii) obtaining access to a property under the terms of a contract.

While in some situations and for some PBR owners the existing mechanisms are sufficient, many PBR owners argue that it is too difficult or expensive to obtain evidence of infringement under the current provisions. Specifically, some stakeholders argue that the requirements of Anton Piller orders make them too difficult to obtain for most PBR owners. While Federal Court rules allow PBR owners to obtain documents and information, they do not enable the collection of plants, seeds, or other biological materials, which are often more important pieces of evidence for proving PBR infringement. These legalistic mechanisms usually require PBR owners to engage lawyers, the cost of which can be prohibitive. While in some situations contracts have proved to be an effective way of getting access to a property to inspect for evidence of infringement, this only works where there is a pre-existing contractual relationship between the PBR owner and the alleged infringer.

Over time, a number of different solutions have been mooted to deal with the enforcement issues facing PBR owners. Here, we focus on the suggestion that Australia should adopt a system similar to the United Kingdom's information notice system.<sup>3</sup>

## 2. What is the UK information notice system?

The UK information notice system is established under sections 14 and 15 of the UK's *Plant Varieties Act 1998* and accompanying regulations.<sup>4</sup> In essence, the scheme allows PBR owners to ask someone who they suspect of infringing their PBR rights for information about the origin and consignment size of the infringing PBR variety. If the person fails to provide the necessary information within 21 days, this gives rise to a rebuttable legal presumption that they are infringing PBR.

The UK information notice system operates in two situations. The first is in proceedings for the infringement of plant breeders' rights in *harvested material* (section 14). Using a prescribed

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<sup>1</sup> An Anton Piller Order is an order issued by a court, allows applicants onto the property of a defendant/respondent in order to seize evidence subject to the order. In *Anton Piller KG v Manufacturing Processes Ltd & Ors* [1976] 1 Ch 55 it was stated that such an order "should only be made where it is essential that the plaintiff should have inspection so that justice can be done between the parties: and when, if the defendant were forewarned, there is a grave danger that vital evidence will be destroyed, that papers will be burnt or lost or hidden, or taken beyond the jurisdiction, and so the ends of justice be defeated: and when the inspection would do no real harm to the defendant or his case."

<sup>2</sup> *Federal Court Rules* (2011) (as amended), rules 7.21- 7.29.

<sup>3</sup> Advisory Council on Intellectual Property, *A review of enforcement of Plant Breeder's Rights: Final Report* (January 2010), Recommendations 17, 3.

<sup>4</sup> *The Plant Breeders' Rights (Information Notices) Regulations* (1998 SI No 1024) (in force 8th May 1998) (UK).

form (see Appendix 1),<sup>5</sup> the UK scheme enables PBR owners to request certain information from people. The PBR owner is required to include certain information in the information notice when making the request:<sup>6</sup>

- (a) the registered name of the variety;
- (b) the species of the variety;
- (c) the date on which plant breeders' rights were granted in the variety;
- (d) confirmation that the rights were granted under the Act;
- (e) the name and address of the holder of rights;
- (f) the name and address of the agent of the holder of rights, if one has been appointed;
- and
- (g) the date on which the information notice was served.

The PBR owner is able to ask the person who they serve the notice on for information in relation to<sup>7</sup>:

- (a) the name and address of the recipient of the information notice;
- (b) the name and address of the person from whom the recipient of the information notice acquired possession of the material specified in the information notice;
- (c) the date on which the recipient of the information notice acquired possession of the material specified in the information notice; and
- (d) the size of the consignment of which the material specified in the information notice formed part.

Failure to provide the requested information gives rise to a legal presumption in proceedings for the infringement of plant breeders' rights as respects harvested material that unauthorised use has been made of propagating material of the protected variety. Specifically, if the person on whom the notice has been issued does not provide the required information within 21 days, and cannot subsequently demonstrate a reasonable excuse for not supplying the information or prove non-infringement, it will be presumed by the courts that:

- The harvested material was obtained through unauthorised use of propagating material,<sup>8</sup> and
- the PBR holder did not have a reasonable opportunity to exercise their rights in relation to the material.<sup>9</sup>

The second situation where the information notice operates is in proceedings for the infringement of plant breeders' rights in *products made directly from harvested material* (section 15). While section 15 is similar to section 14 in terms of the information the PBR owner needs to provide and the questions they are able to ask in the information notice, they differ in terms of the presumptions that arise. Section 15 provides that if the person on whom the notice has been issued does not provide the required information within 21 days it will be presumed, unless the contrary is proved or the defendant shows that they had a reasonable excuse for not supplying the information, that:

- the harvested material from which the product was made was obtained through unauthorised use of propagating material,

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<sup>5</sup> UK information notices need to be in the form prescribed by the *Plant Breeders Rights (Information Notices) Regulations 1998* (SI No 1024 of 1998) (UK). See Appendix 1 for the form.

<sup>6</sup> *Plant Breeders Rights (Information Notices) Regulations* (SI No 1024 of 1998), Regulation 3(2) (UK).

<sup>7</sup> *Plant Breeders Rights (Information Notices) Regulations* (SI No 1024 of 1998), Regulation 3(3) (UK).

<sup>8</sup> *Plant Varieties Act 1997*, s 14(3)(a) (UK).

<sup>9</sup> *Plant Varieties Act 1997*, s 14(3)(b) (UK).

- the holder did not have a reasonable opportunity before the harvested material was obtained to exercise his rights in relation to the unauthorised use of the propagating material, and
- no relevant act was done, before the product was made, as respects the harvested material from which it was made<sup>10</sup>.

In its 2010 review of enforcement of Plant Breeder's Rights, ACIP noted that there was no evidence that the information notice system had been used in the UK. It seems that little has changed since the ACIP report was published. Indeed, we have only found one instance where the information notice system was used in litigation in the UK.<sup>11</sup> There are several possible explanations for this lack of use. One reason may be the UK farmer's privilege laws provide PBR owners with sufficient information and control over protected propagating material<sup>12</sup>. Another possibility is that use of information notice system is not being documented, as the information notice system is used to encourage parties to negotiate (much like with compulsory licensing schemes in intellectual property generally) and uses of the system are not approved or recorded. As a result, the lack of recorded use of the UK information notice system does not mean that a suitably modified system would not have a positive impact for Australia.

### 3. An information notice system for Australia?

While ACIP recommended in its 2010 report that an information notice system based on the UK information notice system should be introduced into the PBR Act,<sup>13</sup> this was not implemented. At the time, ACIP noted that there was considerable support for the UK Information Notice system to be introduced in Australia amongst stakeholders. There was also opposition to the information notice system from PBR users because it reverses the onus of proof.<sup>14</sup>

Enforcement issues generally, and gathering evidence of infringement specifically, remain issues that stakeholders believe need to be addressed as a matter of priority. Many stakeholders noted that even with some evidence of infringement, such as a tip-off or discovery that a protected variety is being sold without authorisation, gathering sufficient evidence for court action is costly and difficult. Particular issues faced in gathering evidence include the onerous requirements of alternative evidentiary routes, the need to engage expensive lawyers, and the possibility that supply chain intermediaries will not cooperate by providing information relating to the infringement.

Many PBR owners feel that the adoption of a UK-style information notice system in Australia would play an important role in alleviating some of the evidential issues facing PBR owners.

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<sup>10</sup> *Plant Varieties Act 1997*, s 15(4) (UK).

<sup>11</sup> *Irish Potato Marketing v. Gordon A Reid Partnership*, Court of Session, Scotland (21 Oct 2005) (defendant admitted liability, matter settled before trial). Irish Potato Marketing claimed that the defendants had infringed their Community plant variety right in the potato variety 'Rooster'. Irish Potato Marketing had not supplied the defendant with seed for production of a seed crop nor authorized production of this crop, Irish Potato Marketing argued that the harvested material must have been obtained through the unauthorised use of 'Rooster'. Irish Potato Marketing served an information notice on Reid requiring him to provide certain information about the seeds he used within 21 days. The matter was settled before trial when Reid admitted liability.

<sup>12</sup> The UK *Plant Breeders' Rights (Farm Saved Seed) (Specified Information) Regulations* (1998 No. 1026) prescribe the information plant breeders must give to farmers and seed processors and which farmers and seed processors must give to plant breeders.

<sup>13</sup> Advisory Council on Intellectual Property, *A review of enforcement of Plant Breeder's Rights: Final Report* (January 2010), Recommendations 17, 3.

<sup>14</sup> *Ibid*, 105.

It is also thought that such a system would provide PBR owners with a useful and practical enforcement mechanism, which would balance the legitimate interests of PBR owners and growers. PBR users, however, expressed some concerns about the use of the information notice system: particularly in terms of the way it reverses the onus of proof.

The introduction of an information notice system would affect PBR stakeholders in different ways. PBR owners (and managers) would have increased powers to pursue infringements, with the ability to legally demand information from both suspected infringers and participants in supply chains dealing with protected material. This would place PBR owners and managers on a stronger footing in enforcing their rights, particularly in relation to parties with whom they do not have a contractual relationship.

An information notice system places a corresponding burden on those who must comply with the information notice, who must provide the required information or face a presumption of guilt. As such, it is important that any information notice system is designed in such a way as to minimise the potential for oppressive or vexatious use, and with adequate safeguards in place to allow intervention if necessary. It is also crucial that the requestable information is not overly onerous for the information notice recipient to produce.

While there is widespread stakeholder support for the introduction of an information notice system in Australia based on the UK scheme, there is very little understanding about the scope and nature of the UK scheme. PBR owners expressed a general desire for methods of obtaining evidence which were less legalistic and more cost-effective, rather than a desire to implement the UK system specifically. The problem that PBR owners in Australia want fixed is the difficulty they face in collecting evidence for infringement actions. At a general level, two types of evidence are sought for infringement actions. The first is information for identifying infringement, such as information about who materials were obtained from. The second is plant material that can be used to prove infringement.

Impacts on growers and supply chain intermediaries could include the time and effort required to comply with information notices, detriments caused by a presumption of guilt if the information notice is not responded to, and problems caused by vexatious or oppressive use of information notices. Our view is that the potential negative consequences of an information notice system can be largely mitigated if appropriate measures and safeguards are in place. These include limiting the information that can be demanded, circumscribing the situations in which information notices can be given, making any presumption of guilt rebuttable, providing sufficient time for notice recipient to produce information, requiring registration of information notices, and amending section 57A to include vexatious use of information notices. With these safeguards in place, an information notice system would provide a valuable tool for legitimate enforcement. The administrative burden placed on IP Australia would also be minimal, as they would not be required to closely monitor information notices unless alerted of an issue.

While we agree that an information notice system should be introduced in Australia, there are a number of problems with the UK system. As such, while we believe that Australia should build on the general idea of the UK information notice system, the system should be modified to maximise its positive impact while minimizing any negative outcomes in Australia.

**Recommendation:**

We suggest that an Australian information notice system could operate in a similar manner to the UK information notice system. The notice recipient would have a prescribed period of time

to provide the information requested. A failure to respond within a specified period would result in a reversal of the burden of proof, creating a rebuttable legal presumption that the recipient had infringed PBR rights.

Because of limitations with the UK scheme (which are detailed below), we believe that Australia should not simply copy the UK scheme directly. Rather, an information notice system should be specifically designed for Australian needs.

## 4. Possible Australian scheme

### 4.1 Who should be able to issue an information notice?

The UK information notice scheme authorises “the holder of rights in a variety” to issue information notices. The “holder of rights in a variety” is defined to mean the holder of plant breeders' rights in that variety.

As a declaration of essential derivation extends existing plant breeder’s rights to cover a derived variety, the owner of an initial variety would be able to issue an information notice with respect to a derived variety. Given that the owner of an initial variety already has the power to legally enforce their right, we do not anticipate this causing issues or significantly broadening use of information notices.

#### **Recommendation:**

Information notices in Australia should only be able to be issued by grantees, including grantees by essential derivation, or by grantees’ exclusive licensees.

### 4.2 What are the circumstances in which a notice may be issued?

The UK information notice system only operates in infringement actions for *harvested material* (section 14) and *products made directly from harvested material* (section 15). If the Australian system was limited in this way, it would mean that important areas where evidence of potential infringement was needed would not be covered, particularly where the infringement is in relation to propagating materials. Further, the line between harvested and propagating material is often ambiguous, as much harvesting material can be treated as propagating material through techniques such as tissue culture. We therefore see no reason to limit the operation of the presumption to litigation in this way.

#### **Recommendation:**

The information notice system should operate to allow evidence gathering in relation to any PBR infringement claim. That is, it would operate in situations where infringement was in relation to propagating material, harvested material, and products made from the harvested material. We also believe that the information notice system should operate where someone is making a claim that a variety is essentially derived.

### 4.3 Who can an information notice be issued to?

There are no limitation or restrictions in UK law in terms of who a PBR owner can give an information notice to. When the law was being discussed in UK Parliament, it seems that it was intended that the information notice would only be issued in respect to transactions which were ‘in the normal course of business’<sup>15</sup> within the horticultural industry (although what this meant was never clarified). It was also presumed that information notices could be issued to a

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<sup>15</sup> UK *Plant Varieties Bill* HL Deb 23 October 1997 vol 582, 838 (Baroness Anelay of St. Johns).



sequence of people until the source of the infringement was found. As Baroness Anelay of St. Johns said, ‘the information provided by the first person approached would enable the plant breeder to serve a similar questionnaire on the person who had been the supplier to that person, and so on, until the chain was established’.<sup>16</sup>

The intention of the legislature was that there “should be no question of plant breeders laying siege to local church fetes and bring-and-buy sales—and presumably car boot sales—demanding information on the source of plants on the plant stall. That would be Big Brother.”<sup>17</sup> It was also said that “the clauses do not permit plant breeders to serve notices on private individuals growing plants in their own gardens, for their own private and non-commercial purposes”.<sup>18</sup>

Despite this, there are no restrictions on who an information notice can be given to in the UK PBR Act. This creates unnecessary uncertainty, and the potential for vexatious use of the notices. We believe that if an information notice scheme was introduced in Australia that it would be important to make it clear who the notices could be given to. In some ways this issue could be resolved by stipulating that an information notice could only be issued in prescribed circumstances (such as where the PBR owner has a reasonable suspicion that someone is infringing their PBR).

It might also be helpful to stipulate that information notices could not be issued to:

- private individuals growing plants in their own gardens for their own private and non-commercial purposes; and
- people using protected varieties purely for experimental or breeding purposes.

#### **Recommendation:**

A PBR owner should only be able to issue an information notice where the PBR owner reasonably suspects that their rights are being infringed. The PBR owner should only be able to issue a notice to someone who they reasonably believe is infringing their right, or to someone who they reasonably believe has information that will allow the PBR owner to identify who the infringer is. This would mean that an information notice could be issued to a grower who believes they have obtained the material legally, where the PBR owner is trying to determine whether the seller was actually selling the material lawfully. In this case, the PBR owner may wish to issue an information notice to the grower to identify the source of the material so they can then go after an infringing seller/distributor.

#### **4.4 What criteria must be met before a person can issue an information notice?**

When the UK information notice system was introduced, it was assumed that the person issuing the notice would only do so when they had a strong suspicion that the information notice recipient was infringing their rights.<sup>19</sup> Despite this, there are no criteria or thresholds that a PBR owner needs to meet in the UK system before they can issue an information notice. This risks the possibility of information notice being used vexatiously.

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<sup>16</sup> Ibid, 834 (Baroness Anelay of St. Johns).

<sup>17</sup> Ibid, 838 (Baroness Anelay of St. Johns).

<sup>18</sup> Ibid.

<sup>19</sup> “If the seller refuses to provide information on where he obtained the plants—and those who knowingly trade in illicitly-produced protected varieties will almost certainly refuse to do so—then the breeder is left with a strong suspicion that his rights are being infringed, but nothing more”. Plant Varieties Bill HL Deb 23 October 1997 vol 582, 837 (Baroness Anelay of St. Johns).

To prevent the system being abused, we recommend that criteria be set for when an information notice could be issued. One possibility is that an information notice only be allowed where the PBR owner has prima facie evidence of infringement.<sup>20</sup> A less onerous option would be to stipulate that a person could only issue an information notice when they had reasonable grounds for believing that someone was infringing their PBRs.

Interviews showed that PBR owners can become aware of potential infringements in several ways. We believe that these factors could constitute reasonable grounds for believing that someone was infringing their PBRs. Genetic testing of harvested or derived products (fruit sold in a supermarket, for instance) can be used to identify PBR protected varieties. To prevent ongoing infringement, the PBR owner would then need to determine who had provided the protected varieties. Chemical fingerprinting can similarly be used to identify the source of a variety through unique ratios of stable isotopes and trace elements. This may simply indicate that infringement has occurred (a result similar to that achieved by genetic testing) but may additionally provide information about the geographical origin of the infringing variety, with one stakeholder suggesting that this technology was accurate “down to the block where it might have been growing”. PBR owners can also receive direct tip-offs that infringement of a PBR protected variety is occurring. Whether it would be reasonable to rely on a tip off would depend on the circumstances.

#### **Recommendation:**

Information notices should only be issuable when the PBR owner has reasonable grounds for believing that someone is infringing their exclusive PBR rights. These grounds should be stated on the information notice. If this suggestion is adopted, we think that IP Australia should issue examples of situations that would and would not be reasonable for believing that someone was infringing PBR. Reasonable grounds for suspicion would include genetic evidence, evidence from chemical fingerprinting, and non-anonymous tip-offs.

#### **4.5 What type of information can be requested in an information notice?**

One of the notable things about the UK Information Notice System is that it is very limited in its scope. The reason for this is that the UK system was designed to deal with a specific problem in a specific sector (namely, illegal propagation of ornamental flowers in the UK). It presupposes a situation where there are many potential places where the PBR protected plants can be obtained and that the plant may be traded many times before it reaches the consumer.<sup>21</sup> In this situation the problem is not so much whether the person is selling the PBR protected variety, so much as whether they have purchased them from a legitimate source. As Baroness Anelay of St. Johns said when discussing the introduction of the information notice system in the UK:

“Illicit propagation, where no royalty is paid, enables less scrupulous traders to undercut those who are operating legitimately and gives them an unfair advantage. Plants which have been produced through illicit propagation are the same as those

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<sup>20</sup> Advisory Council on Intellectual Property, *A review of enforcement of Plant Breeder's Rights: Final Report* (January 2010), 105.

<sup>21</sup> “Ornamental plants are traded to the public through a wide range of retail outlets, including garden centres, supermarkets and by mail order. Ornamental plants, by their very nature, are easy to multiply through, for example, taking cuttings or using modern tissue-culture techniques. The products—for example, rose bushes or pot plants—which have been produced legitimately and on which royalty has been paid, can easily be diverted from their proper end use and used for further propagation, without the breeder's authority, as they are traded through a chain to the final consumer.” UK *Plant Varieties Bill* HL Deb 23 October 1997 vol 582, 837 (Baroness Anelay of St. Johns).

produced by authorised propagation—it is, after all, a condition of protection that plants reproduce true to type. A plant breeder cannot therefore identify infringing material by looking at the plants. He needs to know the source of the plants on sale”.<sup>22</sup>

The UK Information Notice System is specifically designed to elicit information about the source of the propagating material. It does not seek to deal with other scenarios that may arise. While we believe that it is important that an Australian information notice system allow questions to be asked about the source of propagating material, we do not think that it should be limited to this. The reason for this is that it would not deal with situations where the PBR owner was finding it difficult to ascertain whether someone was improperly propagating their PBR variety, or whether they had supplied propagating material. We believe that this situation could be remedied by including a question in the information notice that asks whether the person was propagating or otherwise dealing with the named variety in way that infringes the PBR owner’s rights, and a question that asks who the propagating material had been supplied to, if anyone.

**Recommendation:**

We recommend that in addition to the types of information that can be collected under the UK information notice scheme (the name and address of the recipient of the information notice, the name and address of the person who provided the recipient with the infringing material, the date on which the recipient of the information notice acquired possession of the material, and the size of the consignment), PBR owners should also be allowed to ask whether the recipient possesses or has possessed material of the PBR protected variety in any form. They should also be able to ask whether propagating material had been supplied to anyone else.

**4.6 What are the consequences of not meeting the notice requirement?**

It was sometimes incorrectly assumed by stakeholders that the UK Information Notice System allows PBR owners to enter the suspected infringer’s property and seize sample evidence while under the guidance of a legal officer without the need for obtaining a court order. There is nothing in the UK scheme that deals with anything other than the collection of information about the source of material. While this is important, it does not help PBR owners when they want to access physical material to prove infringement.

While this should be less of a problem if an information notice system was introduced in Australia, some problems may remain. Difficulties might arise in situations where the recipient states that they have not infringed PBR (or that they do not possess infringing material) but the rights holder nonetheless still believes that they are infringing. While introducing an offense for the knowing provision of false, inaccurate, or misleading information in section 75 would provide some assistance, the PBR owner may still need to get access to physical material to show that a declaration was false, inaccurate, or misleading.

One possibility would be to allow PBR owners to ask the notice recipient to deliver up samples of varieties, so that the notice issuer could test to see whether they are infringing varieties. This would impose some burdens on notice recipients. This solution would also not assist where the recipient claims that they do not have any infringing varieties, but could be helpful where the identity of the variety is in question. Another potential issue is that the notice recipient could simply deliver up non-infringing varieties (while keeping the infringing plant material).

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<sup>22</sup> Ibid.

Despite these problems, we believe that so long as certain conditions are met that a request for delivery-up could be a viable option. The first is that a request for delivery up could only occur after the PBR owner has received the completed information notice form, or after the information notice recipient has failed to deliver the required information. Given that supplying material is more onerous than merely supplying information, we feel that there would need to be very clear guidance as to when the PBR owner could seek delivery up. IP Australia may also need to play a role in vetting requests for delivery up. The provision would be strengthened by modifying the PBR Act to impose penalties for the provision of false information, including failure to honestly deliver up varieties. A party requesting delivery up would also be required to pay all other parties' reasonable costs (including legal fees) in the event that it turns out they were not infringing.

Another possible solution is to provide PBR owners with a right to inspect the alleged infringer's property for evidence of infringement. This prospect raises a number of concerns related to privacy, health and safety, biosecurity, the potential for abuse, and the possibility of escalating a potentially volatile situation. While there may be some situations where PBR owners wish to access a property to obtain physical samples, we do not believe that an information notice system should be used as a trigger to allow access to a property. So long as there were clear consequences for falsifying information (discussed below), we believe that this would be enough of an incentive for parties to supply the requisite information. We believe that it important that the courts have the ability to decide whether a PBR owner should be able to access someone's property.

#### **Recommendation:**

We suggest that following a notice recipient's failure to provide the information requested in an information notice, a rebuttable legal presumption should arise that the recipient has infringed PBR.

In addition, we also recommend that PBR owners be able to request for a delivery up samples of varieties. To avoid abuse, the request for delivery-up should be subject to strict requirements. This could include specifying the timeline for delivery-up, the amount that can be requested, and that the person asking for delivery up will pay reasonable costs.

#### **4.7 How can the presumption of guilt be rebutted?**

Under the UK system, failure to respond to an information notice within 21 days gives rise to a presumption that the person who received the notice was infringing 'unless the contrary is proved'. In this situation the onus is on the recipient to prove that they were not infringing. One of the problems is that it very difficult to prove a negative. That is, how can a recipient prove that they are not doing something? One option would be to allow the PBR owner or third party to inspect the property. While some might see this as an invasion of privacy, if this occur at the request of the land owner, this should not be a problem. A notice recipient could alternatively rebut the presumption of guilt by proving that the variety was being grown legally under one of the exemptions in the Plant Breeder's Rights Act. Namely that they were undertaking:

- acts done privately and non-commercial purposes;
- acts for experimental purposes; or
- acts for the purpose of making a new variety (the breeder's exemption).

In rare situations, a person may not be able to supply the required information due to circumstances outside of their control. For instance, if information was destroyed or obtaining that information would cause unreasonable hardship. Proving a reasonable excuse for not supplying the requested information should operate to rebut a presumption of guilt.

**Recommendation:**

Once a presumption of guilt arises, it may be rebutted by proving that infringement was not occurring. This could be through proving a valid defence, or by allowing access to the property where the offence is alleged to have occurred. Any other reasonable proof that there was no infringement of plant breeder's rights could also be accepted.

Alternatively, a person may show that they had a reasonable excuse for not supplying the requested information.

**4.8 How can the defendant show that they had a reasonable excuse for not supplying the information?**

Under the UK system, failure to respond to an information notice within 21 days gives rise to a presumption that the person who received the notice was infringing unless the person who received the notice can show 'that they had a reasonable excuse for not supplying the information'.

While it is ultimately for the courts to decide whether an excuse is reasonable, given that one of the aims of the information notice system is to reduce legal costs and interaction with the formal legal system, we believe that it is important that there be clear guidance about the types of things that may or may not qualify as reasonable excuses.

**(i) Valid excuses**

*Where the information was not known by the person*

In some situations, a person may not know that have PBR protected varieties growing on their property. This could happen, for example, where they inherit or purchase a property that has PBR protected varieties growing on it. While in this situation a person may have a valid reason for not providing information, there may be situations where this is not reasonable or at least harder to show. This would be the case, for example, where a person suspects or has reason to suspect that the plants growing on the land they were about to purchase are PBR protected but they decide not to ask so as to remain ignorant.

*Where records are accidentally destroyed*

Another situation where a person may have a reasonable excuse for not supplying the information is where records have been damaged or destroyed accidentally (for example in a flood or fire) or by the actions of a third party (such as a burglar). While given that many records are now sent electronically there is a chance that the records may still be salvageable, there may still be situations where this would not be the case.

*Where people cannot get access to the records*

In some situations, a person may also not be able to get access to their records within the specified time period. This could arise as a result of natural disasters such as floods. It could also arise because of government travel restrictions (such as during Covid lockdowns). In these situations, a person would have a reasonable excuse for not supplying the information within the specified time frame. This excuse would end however once the impediment to access ended.

### *Personal reasons*

In some situations, a person may have valid personal reasons for not supplying the information. The most obvious examples would be their ill-health, or the ill-health of family or close friends.

### **(ii) Invalid excuses**

#### *Commercial-in-confidence*

We do not think that it would be reasonable for a person who receives an information notice to refuse to respond on the basis that the information was commercial-in-confidence. This is subject to the proviso (discussed below), that PBR owners should only be able to use the information they receive by way of a completed information notice for the purposes of bringing an infringement action. That is, PBR owners should treat the information in confidence.

#### *Time constraints*

We do not think that it would be reasonable for a person who receives an information notice to refuse to respond on the basis that they are too busy to do so. While it is important to acknowledge that at certain times (such as harvesting or picking) that a person may be very busy, we believe that this could be taken into account when deciding on the type and detail of information that someone needs to provide and also the time period in which they have to respond.

### **Recommendation:**

We suggest that IP Australia provide examples like the above, clarifying what would be reasonable excuses for not providing the requesting information.

## **4.9 How can abuse of the information notice system be avoided?**

One of the strongest criticisms made of an information notice system relates to the fact that it operates to reverse the burden of proof. As the Victorian Farmers Federation said in response to the ACIP inquiry ‘Under no possible circumstance should there be a presumption of guilt. Presumption of guilt is unfair, unethical, and contrary to every fibre of the judicial system.’<sup>23</sup>

In thinking about this issue, it is important to note as the Australian Law Reform Commission made clear in its 2015 report on *Traditional Rights and Freedoms* that there are many situations where the burden of proof has been reversed in Australian law. These include criminal laws for terrorism, drug offences, child sex offences outside Australia, trafficking in plastic explosives, certain tax offences, and criminal offences in relation to breach of copyright.<sup>24</sup> Reversals of the burden of proof also occur in civil contexts, notably in copyright law (which contains presumptions intended to ‘assist copyright owners and reduce costs in the litigation process’).<sup>25</sup> Defences are another common means by which the burden of proof is reversed in practice, and these are found across various civil law domains.

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<sup>23</sup> Advisory Council on Intellectual Property, *A review of enforcement of Plant Breeder’s Rights: Final Report* (January 2010), 103.

<sup>24</sup> See Australian Law Reform Commission *Traditional Rights and Freedoms: Encroachments by Commonwealth Laws* (ALRC Report 129, Dec 2015), 71-284. In its submission to the ACIP Inquiry, the Law Council of Australia noted that a precedent for this existed in s.121A of the Patents Act 1990. This provision effectively reverses the onus of proof in certain circumstances in order to overcome the difficulties of obtaining evidence of infringement of process patents. Advisory Council on Intellectual Property, *A review of enforcement of Plant Breeder’s Rights: Final Report* (January 2010), 103.

<sup>25</sup> Australian Law Reform Commission *Traditional Rights and Freedoms: Encroachments by Commonwealth Laws* (ALRC Report 129, Dec 2015), 277.

We reiterate the findings of the Law Reform Commission that while reversing the burden of proof is needed in some situations, it is essential that this only be done in very carefully defined circumstances. As the Australian Law Reform Commission stated, “Offences that reverse the legal burden of proof on an issue essential to culpability arguably provide the greatest interference with the presumption of innocence, and their necessity requires the strongest justification.”<sup>26</sup>

The upshot is that in thinking about introducing an information notice system in Australia it is important that the scope and operation of the scheme is clearly defined and that potential avenues for misuse are cut off. It is very important when thinking about what an Australian information notice system might look like that consideration is given to ensuring that the system is not open to abuse. While specifying who information notices can be issued to and the circumstances in which this can occur will help to minimise misuse, additional changes are needed to ensure that the system is not abused.

#### **(i) False information**

For the information notice system to operate effectively it is important that PBR owners should be able to trust the accuracy of the information they receive in a completed information notice. One of the problems with the UK information notice system is that there are no penalties or consequences for the provision of incorrect information in response to an information notice. To ensure that people who receive information notices are incentivised to provide accurate information, it is important that if an Australian information notice system is introduced that there are penalties or consequences for the provision of incorrect information.

While it has been suggested that the knowing provision of incorrect information may be a breach of trade practices legislation, we believe that to ensure that the information notice system is effective it is important that specific penalties are introduced within the PBR Act. The most obvious way this could be done would be to amend section 75 of the Plant Breeder’s Rights Act 1994 to make the knowing provision of false, inaccurate, or misleading information a non-infringing offence. Another option would be to specify that where a person knowingly made false, inaccurate, or misleading claims in an information notice that this open them up to flagrant or exemplary damages in the event that the matter is litigated.

#### **Recommendation:**

We suggest that a two-pronged approach would be desirable. Providing flagrant or exemplary damages for the provision of false information allows PBR owners a recourse through private litigation, while including a specific offence under section 75 for the knowing provision of false, inaccurate or misleading information would empower the state to prevent dishonesty without requiring civil litigation.

#### **(ii) Misuse of the information that has been collected**

One of the potential objections to an information notice system is that while the disclosure of information pertaining to a potential infringement may be valid, the PBR owner could use the information disclosed for other purposes. One possible way of dealing with this problem is to stipulate that where a PBR owner obtains information pursuant to an information notice, the PBR owner owes an obligation of confidence to the person who supplies that information. Information could be disclosed for the purposes of establishing whether PBR had been

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<sup>26</sup> *Traditional Rights and Freedoms: Encroachments by Commonwealth Laws* (ALRC Report 129, Dec 2015), 271, [9.64].

infringed or as part of PBR infringement proceedings. As Baroness Anelay of St. Johns said when discussing the information notice system in the UK Parliament, ‘the breeder should “treat the information obtained in a notice as confidential, except where he uses it to establish whether his rights have been infringed, or in infringement proceedings. If the breeder breaches this obligation of confidentiality, the person who supplied the information will be able to bring an action for breach of a duty of confidentiality.”<sup>27</sup>

One of the problems with relying on breach of confidence as a way of remedying wrongful disclosure by the PBR owner is that it may require potentially costly and lengthy legal proceedings to get a result. To avoid this problem, we think that the best way to prevent wrongful disclosure is to make it a non-infringing offence under section 75. At the same we also think that to prevent a disclosure from anticipating a patent by the person who supplies that information that the PBR Act should also be amended to clarify that the information obtained from an information notice was confidential. Stipulating that the information obtained from an information notice was confidential would help to ensure that disclosure by the PBR owner would not jeopardise the novelty of any related patents.

### **Recommendation:**

We recommend that it be specified that all information obtained via an information notice is confidential, and that a section 75 offence be introduced for misuse of information obtained via an information notice.

### **(iii) Vexatious use of the notice**

One of the concerns that was raised with us was that there was a risk that the information notice system could be misused. Given the ease by which notice could be issued, there is a risk that PBR owners could use the system for things other than gathering evidence. The information notice could be used, for example, to find out information about competitors or to harass competitors. There is also a chance that the threat of litigation that is implicit in the notice could be used to lever or bully people. There are a number of ways that this might be prevented.

One option is to make it a non-infringing offence under section 75 for a PBR owner to issue an information notice if they didn’t have reasonable grounds for doing so.

Another option would be to amend the PBR Act section 57A to clarify that the existing provision in relation to unjustified threats also applies in the case of information notices. Currently section 57A of the PBR Act provides that if a person is threatened by another person with proceedings for infringement of PBR in a plant variety, or other similar proceedings, an aggrieved person may apply to the Federal Court or Federal Circuit Court for a declaration that the threats are unjustified; an injunction against the continuance of the threats; and the recovery of any damages sustained by the applicant as a result of the threats. To prevent misuse of the information notice system, it would be helpful to amend section 57A to expressly cover information notices.

Another option would be for IP Australia to monitor use of information notices. One possibility here, which was suggested in the past, was that IP Australia issue the notices.<sup>28</sup> We believe that

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<sup>27</sup> UK *Plant Varieties Bill* HL Deb 23 October 1997 vol 582, 837 (Baroness Anelay of St. Johns).

<sup>28</sup> In its submission to ACIP inquiry, Grandiflora Nurseries argued that the PBRO (now IP Australia) should issue the notice so as to create a body between the PBR owner and its customer and to encourage ADR. Advisory Council on Intellectual Property, *A review of enforcement of Plant Breeder’s Rights: Final Report* (January 2010), 105.



this would not be an appropriate role for IP Australia. Another option would be people issuing notices to be required to send them to IP Australia before-hand. Here IP Australia's role could vary from merely collating the information notices through to taking a more proactive role (such as confirming the accuracy of the information).

**Recommendation:**

We suggest that all information notices sent must be lodged with IP Australia. This would allow them to monitor for potentially vexatious use of information notices. This could be coupled with the ability for IP Australia to ban a person from issuing information notices, to be used only in extreme circumstances such as if someone repeatedly issued vexatious information notices.

We further recommend that 57A be amended to make it clear that information notices may constitute threats under section 57A if they are issued flagrantly, vexatiously, or without reasonable grounds for believing that their PBR rights are being infringed.

**(iv) Concerns that meeting the information notice system will be onerous**

One of the complaints made about the information notice system is that it will impose onerous and unjustified obligations on the party who receives the notice. In line with this it might be argued that the information notice system has the potential to place an unreasonable administrative burden on growers, who could be required to keep extensive records of the source of all the plant materials they obtain.

As Baroness Anelay of St. Johns said in discussing the UK Information Notice System, "The information to be provided will not be onerous. I envisage that it will basically be details of the supplier and the amount of material supplied by him. It is reasonable to suppose that anyone selling plants, for example, will know who he bought them from and how many he bought."<sup>29</sup>

In developing an information notice system for Australia, it is important to keep in mind the impact that a notice will have on the people receiving it. This is particularly the case when thinking of the type of information that a PBR can ask for. To assist it might be useful, where possible, for PBR owner to be asked to use non-scientific names as well as official variety and scientific names in their information notices. Some of the potential problems created by an information notice system could also be ameliorated by ensuring that parties would not need to supply information if they could demonstrate a reasonable excuse.

**Recommendation:**

In addition to limiting what information can be requested in an information notice, we suggest that breeders only be required to keep records that would reasonably be kept in the usual course of business, having regard to the plant species and industry. Lack of information which would not typically be held (for example, the provenance of a variety from a long time ago) would be a reasonable excuse for not complying with an information notice.

We further recommend that educational and informational materials covering the use of information notices be published. These should inform potential notice issuers and recipients how the notices operate, and what best practices should be followed. Best practices should include the use of clear communication (such as including variety synonyms), and a general obligation to act in good faith.

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<sup>29</sup> UK *Plant Varieties Bill* HL Deb 23 October 1997 vol 582 , 837 (Baroness Anelay of St. Johns).

## **Appendix 1**

The Plant Breeders' Rights (Information Notices) Regulations (1998 SI No 1024) (UK).

### **SCHEDULE**

#### **INFORMATION NOTICE—HARVESTED MATERIAL**

When Parts 1 and 2 of this notice are completed, it constitutes an information notice for the purposes of section 14(2) of the Plant Varieties Act 1997.

Failure to supply the information specified in Part 3 within 21 days of service of this notice will have the consequences set out in section 14 of the Plant Varieties Act 1997.

#### **PART 1 PRESCRIBED PARTICULARS**

1. Registered name of the variety.
2. Species of the variety.
3. Date on which plant breeders' rights were granted in the variety.
4. Confirmation that the plant breeders' rights were granted under the Plant Varieties Act 1997.
5. Name and address of holder of rights in the variety.
6. Name and address of agent of holder of rights in the variety, if one has been appointed.
7. Date on which this notice was served.

#### **PART 2 SPECIFIED MATERIAL**

Specify in this Part of the notice the material to which the information notice relates:

#### **PART 3 PRESCRIBED INFORMATION**

1. Your name and address.
2. Name and address of person from whom you acquired ownership of the material specified in Part 2 of this Notice.
3. Date on which you acquired possession of the material specified in Part 2 of this Notice.
4. Size of the consignment of which the material specified in Part 2 of this Notice formed part.

## Appendix 2

### UK Plant Varieties Act 1997

#### **Section 14: Presumptions in proceedings relating to harvested material.**

- (1) This section applies to any proceedings for the infringement of plant breeders' rights as respects harvested material.
- (2) If, in any proceedings to which this section applies, the holder of the plant breeders' rights proves, in relation to any of the material to which the proceedings relate—
  - (a) that it has been the subject of an information notice given to the defendant by or on behalf of the holder, and
  - (b) that the defendant has not, within the prescribed time after the service of the notice, supplied the holder with the information about it requested in the notice, then, as regards the material in relation to which the holder proves that to be the case, the presumptions mentioned in subsection (3) below shall apply, unless the contrary is proved or the defendant shows that he had a reasonable excuse for not supplying the information.
- (3) The presumptions are—
  - (a) that the material was obtained through unauthorised use of propagating material, and
  - (b) that the holder did not have a reasonable opportunity before the material was obtained to exercise his rights in relation to the unauthorised use of the propagating material.
- (4) The reference in subsection (2) above to an information notice is to a notice which—
  - (a) is in the prescribed form,
  - (b) specifies the material to which it relates,
  - (c) contains, in relation to that material, a request for the supply of the prescribed, but no other, information, and
  - (d) contains such other particulars as may be prescribed.
- (5) In this section, "prescribed" means prescribed by regulations made by the Ministers.

#### **Section 15: Presumptions in proceedings relating to products made from harvested material**

- (1) This section applies to any proceedings for the infringement of plant breeders' rights as respects any product made directly from harvested material.
- (2) If, in any proceedings to which this section applies, the holder of the plant breeders' rights proves, in relation to any product to which the proceedings relate—
  - (a) that it has been the subject of an information notice given to the defendant by or on behalf of the holder, and
  - (b) that the defendant has not, within the prescribed time after the service of the notice, supplied the holder with the information about it requested in the notice, then, as regards the product in relation to which the holder proves that to be the case, the presumptions mentioned in subsection (3) below shall apply, unless the contrary is proved or the defendant shows that he had a reasonable excuse for not supplying the information.
- (3) The presumptions are—
  - (a) that the harvested material from which the product was made was obtained through unauthorised use of propagating material,

- (b) that the holder did not have a reasonable opportunity before the harvested material was obtained to exercise his rights in relation to the unauthorised use of the propagating material, and
  - (c) that no relevant act was done, before the product was made, as respects the harvested material from which it was made.
- (4) An act is relevant for the purposes of subsection (3)(c) above if it is mentioned in section 6(1) above and is—
- (a) done with the authority of the holder, or
  - (b) one in relation to the doing of which he has a reasonable opportunity to exercise his rights.
- (5) The reference in subsection (2) above to an information notice is to a notice which—
- (a) is in the prescribed form,
  - (b) specifies the product to which it relates,
  - (c) contains, in relation to that product, a request for the supply of the prescribed, but no other, information, and
  - (d) contains such other particulars as may be prescribed.
- (6) In this section, “prescribed” means prescribed by regulations made by the Ministers.