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RELATIONS BETWEEN VARIETY DENOMINATIONS AND TRADEMARKS

Document prepared by the Office of the Union

This document contains a comparative survey of the provisions of the laws of member States on the relations between variety denominations and trademarks. The survey is intended to serve as a basis for the discussions at the sixth session of the Administrative and Legal Committee.

INTRODUCTION

1. At its first session, the Subgroup of the Administrative and Legal Committee considered that the discussions to be devoted by the Administrative and Legal Committee, at its sixth session, to the question of variety denominations should concentrate on the relations between variety denominations and trademarks, and more specifically on the legislative provisions that ensured that "no rights in the designation registered as the denomination of the variety shall hamper the free use of the denomination in connection with the variety" (see Annex II to document CAJ/VI/4, under 10). The relations in question have to be governed by rules, as the UPOV Convention provides that the denomination of a protected variety must be used in connection with any marketing of propagating material of the variety, even after the expiry of protection (see Article 13(7) of the original 1961 text of the Convention, and also of the 1978 Revised Text; in the latter text, however, the obligation to use the denomination is confined to marketing in the State in which the variety is or has been protected). The attainment of this objective of the Convention could be prejudiced by the simultaneous existence of other rights, notably trademark rights, in the designation that constitutes or should constitute the variety denomination: the owner of the trademark would be able to prohibit the use of the variety denomination by virtue of his trademark rights. It is for that reason that the Convention and, pursuant to the Convention, the laws of member States contain provisions designed to govern relations between trademarks and variety denominations that consist of the same designation or of potentially confusing designations. Article 13 of the UPOV Convention, in its currently applicable version (the 1961 text), contains detailed rules that apply directly to trademarks; on the other hand, the Revised Text of 1978 contains merely a general obligation on member States to ensure that the free use of the denomination in connection with the variety is not hampered by concurrent rights of another kind relating to the designation in question. Although in fact all of them are based on the 1961 text of the UPOV Convention, the relevant provisions of the laws of member States differ greatly. The differences stem not only from different interpretation of the provisions of the Convention but also, in a great number of cases, from differences in the original legal infrastructures (different laws, different case law, different doctrine).

Chapter I

PROVISIONS DESIGNED TO PREVENT OR SETTLE CONFLICT BETWEEN THE PROPOSED DENOMINATION AND THE TRADEMARK OF THE APPLICANT FOR VARIETY PROTECTION

A. General

2. This chapter deals only with the provisions designed to prevent or settle conflicts between the proposed variety denomination and the trademark of the applicant for variety protection. It does not deal with conflicts between variety denominations and the trademarks of third parties.

B. Systems Adopted to Prevent or Settle Conflict Between Denomination and Trademark

3. Member States have adopted four different basic systems for preventing or settling conflict between a variety denomination and a trademark. The first two basic systems use the method of preventing concurrent registrations of one and the same designation, or of two designations likely to be confused, as both denomination and trademark. The other two allow concurrent registrations, but remove the possibility of a conflict arising by neutralizing the trademark.

4. First Basic System. The applicant for protection of the variety cannot propose as a denomination a designation that already enjoys trademark protection: Denmark: (Section 11(2) of the Law and Section 1(4) of the Order of August 5, 1970, on the Naming of New Plant Varieties); Israel (Section 31(a) of the Law); United Kingdom (Regulation 18(2)(d) of the Plant Breeders' Rights Regulations 1978); Sweden (Section 8(vi) of the Law). In some of these countries the applicant can, in practice, propose a designation that has been registered as a trademark, on condition that at the same time he provides proof of the cancellation or limitation of the trademark. The proposed designation is then in fact no longer a trademark.

5. Second Basic System. The applicant may propose as a denomination a designation that enjoys trademark protection, on condition that he undertakes to renounce the trademark: South Africa (Section 10(4) of the Law); Belgium (Section 27(3) of the Royal Decree of July 22, 1977, on the Protection of New Plant Varieties); Italy (Section 6(2) of Decree No. 974 of August 12, 1975); Netherlands (Section 21(3) of the Law).

6. Third Basic System. The applicant has to undertake to renounce enforcement of trademark rights: Federal Republic of Germany (Section 37(2) of the Law); France (Section 9(6) of the Law and Section 6(2) of Decree No. 71-764 of September 9, 1971); Switzerland (Section 15(3) of the Ordinance of May 11, 1977). With regard to France, the Law states that the denomination may be the subject of a trademark application as a precautionary measure, and the Decree states that renunciation does not affect the validity of the trademark filing itself (Section 6(4)).

7. Fourth Basic System. The impossibility of enforcing the trademark derives from a legal provision: Federal Republic of Germany (Section 9(2) of the Law); Spain (Section 14(2) of the Law); Italy (Section 6(3) of Decree No. 974 of August 12, 1975); Switzerland (Section 7(2) of the Law).

8. Reasons for the Adoption of the Third and Fourth Basic Systems. The third and fourth basic systems rely mainly on the second sentence of Article 13(3) of the original text of the Convention. They derive also from laws enacted prior to the plant variety protection legislation based on the Convention, especially in the Federal Republic of Germany (Law of June 27, 1953, on the Protection of New Plant Varieties and on the Seeds of Cultivated Plants), and also from customs that used to be current--and may still be current in countries that do not grant protection *sui generis* to new plant varieties--whereby varieties were marketed under a trademark, which clearly had a potential for attraction vis à vis the public. The trademark was, or was not, guaranteed against the risk of its becoming generic by the introduction of a designation or registration, which latter did have to be generic. These

customs were moreover recognized up to a point by case law. ¹

9. It was moreover also to allow breeders to obtain trademark protection for their denominations more readily, by an international registration under the Madrid Agreement, and thus to acquire means of protection against certain abuses in countries that do not accord protection to new plant varieties or have not extended that protection to the species concerned, that the systems whereby the trademark can be retained provided that it is not used were introduced: an international trademark registration has to be preceded by a national registration in the country of origin, and the goods and services to be covered by the international registration have to be covered by the national registration.

10. These systems also allow the breeder to prohibit, by virtue of his trademark rights, the use of his denomination as a denomination for another variety of a species that is not similar, or its use as a designation for a product similar to the products of his variety or of a product distributed to the same clientele. It should be noted, however, that these options remain available to the applicant under the laws that have adopted one of the first two basic systems when the list of products that the trademark may not cover is sufficiently limited, for instance when the products are plants of the same or a similar species.

11. Hybrid Systems. A certain number of States have adopted hybrid systems that combine two basic systems. These systems are the following:

(i) First Hybrid System. Spain (Section 14(2) of the Law) and Italy (Section 6(2) and (3) of Decree No. 974 of August 12, 1975) have adopted the combination specified in the Convention: the breeder has to renounce the trademark (second basic system) and, if he does not do so, he may no longer, by law, assert his trademark rights (fourth basic system).

(ii) Second Hybrid System. The Federal Republic of Germany and Switzerland have provided in their laws (Section 9(1) and Section 7(2) respectively) that trademark rights may not continue to be asserted after the designation concerned has been registered as a variety denomination (fourth basic system). Such a provision may only be enacted, if the principle of territoriality is adhered to, in relation to territorial jurisdiction; it is moreover only there that it can be applied with full effectiveness. Another provision was therefore added to it. That provision is that the applicant has to undertake no longer to assert his trademark rights in certain foreign countries (third basic system) (Section 37(2) of the Law and Section 15(3) of the Ordinance of May 11, 1977, respectively).

¹ In France for instance, the Cour de Cassation ruled in 1964 (Boret v. Sève) that the denomination "Superproduction Sève" could no longer be appropriated exclusively as a trademark owing to its having been entered in the Catalogue of Species and Varieties of Cultivated Plants, and because its use had become legally obligatory to designate seeds of the variety concerned that were transported with a view to sale, placed on sale or sold. The Paris Court for its part had held in 1963 (Société les Grandes Roseraies du Val de Loire v. Delbard) that a trademark consisting of the denomination "Stark Earliest" was a valid one for designating apples and apple trees.

C. Territorial Scope of the Systems

12. Article 13 of the original text of the Convention provides that, if a denomination is to be registered in a member State, a certain number of conditions have to be met, not only in that member State but also in the others. This is true of paragraph (3) in particular. The same Article, and especially its paragraph (7), provides also that the registration of a denomination in one member State also has consequences in the others. For those reasons, the great majority of member States have extended the systems adopted by them in order to prevent or settle conflict between the denomination and the trademark so that they cover trademarks owned by the applicant for protection in other States. Four cases may be distinguished.

(i) The legislation of the State does not specify the territorial scope of the system adopted by it in order that the variety denomination may be freely used: Denmark (Section 11(2) of the Law and Section 1(4) of the Order of August 5, 1970, on the Naming of New Plant Varieties); United Kingdom (Regulation 18(2)(d) of the Plant Breeders' Rights Regulations 1978; Sweden (Section 8(vi) of the Law). As for Denmark, Section 2(3) of the Order mentioned above gives the Plant Nomenclature Board some leeway, providing that the Board may refuse to approve a denomination if it is identical or similar to a trademark registered in another country. The Board does, however, have to pronounce refusal if the competent authority of another country with which Denmark has entered into an agreement on the denomination of varieties informs it that the proposed denomination is unacceptable in that country. The Board may override this provision in specific cases, however. As for the United Kingdom, the Controller also has some latitude, as he "may reject a name proposed" if he considers it unsuitable. However, in the Guide to Plant Breeders' Rights, it is stated that the rule on denominations identical or similar to a trademark either registered or pending in the United Kingdom applies also to the case where the trademark has been registered in "any country or territory outside the United Kingdom."

(ii) The legislation of Israel limits the system provided for in Section 31(a) to the State of Israel alone. The case of trademarks owned by the applicant abroad can nevertheless be settled, practically at the discretion of the Registrar, under Section 31(b)(7) of the Law, which provides that a denomination may not be registered if "it does not conform to accepted international rules regarding denominations of varieties."

(iii) The systems of the Federal Republic of Germany (Sections 9(1) and 37(2) of the Law), France (Section 6(2) of Decree No. 71-764 of September 9, 1971) and Switzerland (Sections 7(2) of the Law and 15(3) of the Ordinance of May 11, 1977) apply to the State concerned and, in addition, to other member States that protect the species concerned. The terminology is slightly different, however: in the case of the Federal Republic of Germany and Switzerland, it is a question of States that grant titles of protection for varieties of the species concerned, whereas in France renunciation extends to States in which the variety may be protected by legislative enactments pursuant to the Convention. Interpreted literally therefore, the latter can relate to fewer States than the former, as in that case renunciation does not cover States in which the variety can no longer be protected, for instance for want of novelty as a result of an act of marketing. With regard to France, it should be noted that Section 9(6) of its Law provides for renunciation of the effects of the trademark in all member States.

(iv) The systems of South Africa (Section 10(3) of the Law), Belgium (Section 27(3) of the Royal Decree of July 22, 1977, on the Protection of New Plant Varieties), Spain (Section 14(2) of the Law), Italy (Section 6(1) of Decree No. 974 of August 12, 1975) and the Netherlands (Section 21(3) of the Law) cover all member States. South Africa and Spain have provided for extension to States with which agreements have been concluded on the protection of new plant varieties. Spain has in addition made a proviso in favor of international agreements providing otherwise in the clause that bars continued exercise of the rights deriving from the trademark.

13. On the subject of the territorial scope of the systems, the following should be noted.

(i) Where an application for protection is filed in more than one member State, the applicant ultimately has to comply with whichever of the systems is the strictest, and therefore cannot benefit from the possibilities offered by the others.

(ii) In practice, it seems difficult to apply and enforce the systems in relation to foreign trademarks. The member State in which the denomination has been proposed has to rely on the applicant and on the other States when it wishes to determine what foreign trademarks are identical to the denomination, and above all what are confusingly similar to it. Moreover, a member State which by virtue of its legislation has created a certain situation in another State has no means of ensuring the permanency of that situation and, apart from exceptional cases (see paragraph 35 below), the other State has not introduced provisions in its own law to guarantee on its own territory the free use of a denomination registered in the first State.

(iii) With some exceptions, the systems adopted by member States to prevent or settle conflict between the denomination and the trademark in other States fail to fulfill their role in the case of extension of the application of the Convention, either through the adherence of new States to the Union or through the extension of protection to other species by a member State.

14. It will be recalled that the 1978 Diplomatic Conference adopted an interpretation of the new paragraph (1) of Article 13 to the effect that it does not determine the geographical sector in which or the conditions under which the variety denomination becomes a generic designation. It was also agreed that it was for member States to determine the extent to which they wished to apply the provisions of the second sentence--in other words ensure the free use of a denomination--with respect to denominations registered in other member States.

15. Table 1 summarizes the systems adopted by each member State, and the territorial scope of each.

Table 1

Trademark of Applicant for Variety Protection:
Nature and Territorial Scope of the Systems Adopted by Member States
to Prevent or Settle Conflict Between Trademark and Denomination*

System \ Territories covered	State itself	Member States in which		All member States	Not stated in the law, but in practice:	
		the variety is protectable	the species is protected		all member States	all States
Impossible to propose trademark as denomination	IL				DK S	UK
Undertaking to renounce trademark				ZA B E (X) I (X) NL		
Undertaking no longer to invoke trademark		F	D (+) CH (+)			
Impossible to invoke trademark	D (+) CH (+)			E (X) I (X)		

* The States mentioned where a line and a column meet are those that cover the territories mentioned at the head of the column according to the system mentioned at the beginning of the line. The (+) sign means that the State concerned has adopted another system for other territories. The (X) sign means that the State concerned has adopted two systems, one of which applies in the event of non-compliance with the other.

D. Products Covered by the Trademark

16. Article 13(3) of the original text of the Convention refers to trademarks that apply to "products which are identical or similar within the meaning of trade mark law." As this expression is open to interpretation, it has given rise to some very different provisions in national legislation.

17. Some States have chosen not to define the products which, when they are covered by a trademark owned by the applicant and are identical or similar to the proposed denomination, cause one of the systems mentioned in Part B above to operate. Those States refer, either explicitly or implicitly, to trademark law. They are the following:

(i) Belgium, which, in Section 27(2) of the Royal Decree of July 22, 1977, on the Protection of New Plant Varieties, repeats the expression appearing in the Convention: "products which are identical or similar within the meaning of trade mark law."

(ii) Spain (Section 14(2) of the Law), France (Section 6(2) of Decree No. 71-764 of September 9, 1971) and the Netherlands (Section 21(3) of the Law), which use the expression "identical or similar products."

18. The other States have adopted a formulation that seems more precise at first sight--but may also call for interpretation in the light of trademark law--which introduces two concepts:

- (i) the nature of the products;
- (ii) the origin of the products, or the coverage of the plant kingdom.

Table 2 shows, in simplified form, how the products covered by the trademark have been defined according to the above two criteria.

19. With regard to the nature of the products, the following categories are found: plants (Denmark - Section 12(2) of the Law); material of a plant variety or goods of a similar kind (Sweden - Section 8(vi) of the Law); propagating material or the use in connection therewith or in connection with a product thereof (South Africa - Section 10(2)(d) of the Law); propagating material of any kind or produce or products of the plant variety in respect of which the application is made or of another variety of the same class of species--produce or products being defined more precisely in the guide to Plant Breeders' Rights as being agricultural, horticultural and forestry produce (not being propagating material) and manufactured or processed products derived from such produce --(United Kingdom - Regulation 18(2)(d) of the Plant Breeders' Rights Regulations 1978). Another category should be added to these, namely "varieties": Federal Republic of Germany (Sections 9(1) and 37(2) of the Law); Israel (Section 31(a) of the Law); Italy (Section 6 of Decree No. 974 of August 12, 1975, especially its paragraph (3)); Switzerland (Sections 7(2) of the Law and 15(3) of the Ordinance of May 11, 1977). In Switzerland, however, the bar on the exercise of a right derived from the trademark applies only "within the limits of the protection resulting from the variety denomination" (Section 7(2) of the Law).

20. With regard to the origin of the products, South Africa and Sweden do not specify it, which means therefore that the products can come from anywhere in the plant kingdom. In the United Kingdom the system extends to the plant kingdom in its entirety, as far as propagating material is concerned, and to the class of species for variety denomination purposes to which the variety belongs, as far as other products are concerned. This class concept is identical with the concept of "the same and similar species", which is found in the laws of the Federal Republic of Germany, Denmark, Italy, and Switzerland. Finally, in Israel, the system applies only to the species concerned, as it refers to "agricultural crops of the same species" (for references to the legislative provisions concerned, see the preceding paragraph).

Table 2

Trademark of Applicant for Variety Protection: Products Which, Being Covered by the Trademark, Cause the Systems Adopted by Member States to Prevent or Settle Conflict Between Trademark and Denomination to Operate*

<u>Nature of products</u> <u>Origin within the plant kingdom</u>	Plants	Material of a variety and similar products	Reproductive or vegetative propagating material	Products other than reproductive or vegetative propagating material	Varieties
Entire plant kingdom		S	ZA (+) UK (+)	ZA (+)	
Same and similar species	DK			UK (+)	D I CH
Same species					IL

* Belgium, Spain, France and the Netherlands have adopted a very general formulation on the lines of "identical or similar products."

The (+) sign means that the member State concerned has adopted a hybrid system in respect of the nature and the origin of the products.

E. Formulation of References to Trademarks

21. It is mainly on account of the sheer diversity of the trademark laws of the various member States that different formulations for references to trademarks are found in their plant variety protection laws, and account has to be taken of the differences in any attempt to achieve harmonization in that area. Trademark rights can be acquired in different ways: in some States they come into being by the mere fact of the filing of the trademark for registration; in others the trademark is registered on application, without any examination being made with respect to form or substance, in which case trademark rights come into being only on registration; in still other States, provision is also made for a trademark application and for the examination of the claims of the applicant, the latter therefore preceding registration, and varying in scope from one State to the next; finally, trademark rights may be acquired by use; in certain States the right to have the mark registered is contingent on its use. The provisions of member States mainly rely on national trademark law in national situations. When reference has to be made to the situation in other countries, they are sometimes obliged to use a more general formulation.

22. In the following States, the rules on the relations between the variety denomination and the trademark of the applicant for protection relate to protected trademarks, and the expressions used may be such as "designation already protected as a trademark" or "designation enjoying protection as a trademark": South Africa (Section 10(3)(a) of the Law); Federal Republic of Germany (Section 37(2) of the Law)--referring to other States; Denmark (Section 11(2) of the Law); Spain (Section 14(2) of the Law); Italy (Section 6(1) of Decree No. 974 of August 12, 1975); Sweden (Section 8(vi) of the Law) and Switzerland (Section 15(3) of the Ordinance of May 11, 1977)--referring to other States.

23. For the following States, the relevant trademarks are registered trademarks: Federal Republic of Germany (Section 9(1) of the Law)--in relation to its own territory; Belgium (Section 27(2) of the Royal Decree of July 22, 1977, on the Protection of New Plant Varieties); Israel (Section 31(a) of the Law); Netherlands (Section 21(3) of the Law); United Kingdom (Regulation 18(2)(d) of the Plant Breeders' Rights Regulations 1978); Switzerland (Section 7(2) of the Law)--in relation to its own territory.

24. France refers to designations in respect of which an application for a trademark has been made (Section 9(6) of the Law and Section 6(2) of Decree No. 71-764 of September 9, 1971. Belgium also refers to trademarks applied for ("marques déposées"). The United Kingdom considers, in addition to registered trademarks, designations that are the subject of an application for trademark protection.

25. France moreover takes account of trademarks of which the applicant has the use (Section 6(2) of Decree No. 71-764 of September 9, 1971), but only where the trademarks concerned are liable to be confused with the proposed denomination. Italy provides the reverse, namely that the applicant has to declare, on filing his application for protection--and submitting the denomination--that he renounces any trademark that he may be using, if it is identical with the proposed denomination (Section 5(6) of the Implementing Regulations of Decree No. 974 of August 12, 1975). It should be noted that the case of the trademark of a third party of which the applicant has the use can also be covered--and in practice often is--by the rules on the relations between the proposed denomination and the trademarks of third parties.

26. Finally, a certain number of States have provided for the assimilation of international trademarks registered under the Madrid Agreement to national trademarks. This is true of the Federal Republic of Germany (Section 9(3) of the Law), Belgium (Section 27(2) of the Royal Decree of July 22, 1977, on the Protection of New Plant Varieties), France (Section 6(3) of Decree No. 71-764 of September 9, 1971) and Switzerland (Section 15(2) of the Ordinance of May 11, 1977). Of these countries, only Belgium expressly applies the rule of assimilation to international trademarks that cover territories other than its own. Assimilation is not absolutely necessary, especially when the rule on relations between the trademark and the proposed denomination applies to "protected" trademarks.

27. Table 3 summarizes the differences mentioned above.

Table 3

Trademark of Applicant for Variety Protection:
Formulation of References to Trademarks*

<u>Territorial coverage</u> <u>Formulation</u>	State Itself	Other States
Protected trademark, designation benefiting from trademark rights, etc.	ZA DK E I S	ZA D(+) DK E I S CH(+)
Registered trademark	D(+) B(X) IL NL UK(X) CH(+)	B(X) NL UK(X)
Trademark filed for registration	B(X) D(X)	B(X) F(X)
Designation embodied in an application for trademark protection	UK(X)	UK(X)
Trademark of which the applicant has the use	F I	F I
Assimilation of international to national trademarks	D B F CH	B

* See table 1 for the meaning of the (+) sign. The (X) sign means that the State concerned uses various formulations.

F. Key Dates in the Application of the Second and Third Basic Systems, Which Provide for an Undertaking to Renounce Either the Trademark Itself, or its Effects

28. There are two key dates: the date on which the undertaking has to be made and the date on which the renunciation comes into effect.

29. The undertaking has to be made at the time of submitting the variety denomination in the following States: South Africa (Section 2(2)(ii) of the Regulations of October 28, 1977, Regarding Plant Breeders' Rights); Federal Republic of Germany (Section 37(2) of the Law); Belgium (Section 27(3) of the Royal Decree of July 22, 1977, on the Protection of New Plant Varieties); Spain (Section 14(2) of the Law); Italy (Section 5(6) of the Implementing Regulations of Decree No. 974 of August 12, 1975); Netherlands (Section 21(3) of the Law); Switzerland (Section 15(3) of the Ordinance of May 11, 1977). In France the undertaking has to be made before the title of protection is issued, according to Section 9(6) of the Law. It should be noted that in Italy the applicant has to declare, in an annex to the application for protection--and for a variety denomination--that he renounces any trademark that he may be using if it is identical with the proposed denomination and undertakes to sign an official deed of renunciation of the trademark before the patent is issued.

30. The reduction in the scope of the trademark comes into effect on the date of grant of the title of protection in the following States: South Africa (Section 10(4) of the Law); Federal Republic of Germany (Sections 9(1) and 37(2) of the Law); Spain (Section 14(2) of the Law); France (Sections 6(2) of Decree No. 71-764 of September 9, 1971); Switzerland (Sections 7(2) of the Law and 15(3) of the Ordinance of May 11, 1977). In Belgium, account is taken of the fact that the denomination may be approved and entered in the register of [protected] varieties before the new plant variety certificate is issued, and it is on the date of such entry that the renunciation of the trademark comes into effect (Section 27(3) of the Royal Decree of July 22, 1977, on the Protection of New Plant Varieties). In Italy, the renunciation of the trademark comes into effect on the date of its entry in the register of marks (Section 6(2) of Decree No. 974 of August 12, 1975). If the denomination has been registered without any renunciation, the trademark may no longer be enforced, under Section 6(3) of the same Decree, as from a date that is not specified but which is implicitly that of the grant of the patent. The date of effectiveness of renunciation is not specified in the Netherlands either, but Section 21(3) of the Law provides that a copy of the deed of renunciation is sent to the industrial property office of the Netherlands and to the Office of the Union as soon as registration of the denomination has taken place.

31. Table 4 summarizes, in tabulated form, the various situations resulting from the systems adopted by the States to prevent or settle conflict between trademarks and denominations and from the key dates. It also takes account of the first and fourth basic systems.

Table 4

Trademark of Applicant for Variety Protection: Key Dates for the Application of the Systems Adopted by Member States to Prevent or Settle Conflict Between the Trademark and the Denomination*

<div>Key dates</div> <div>System</div>	Undertaking (if any)		System comes into effect				
	on filing application for variety denomination	before issue of title of protection	on filing application for variety denomination	on grant of title of protection	on recording of denomination in register of varieties	on recording of renunciation in register of trade marks	not specified
Impossible to propose trademark as denomination			DK IL UK S				
Undertaking to renounce trademark	ZA B E(X) I(X)			ZA E(X)	B ¹	I	NL ¹
Undertaking no longer to invoke trademark	D(+) NL CH(+)	F		D(+) F CH(+)			
Impossible to invoke trademark				D(+) E(X) CH(+)			I ²

* See Table 1 for the meaning of the (+) and (X) signs.

¹ The Law provides that a copy of the deed of renunciation is sent to the authorities concerned as soon as the denomination has been registered.

² The date of effectiveness is by implication the date of grant of the patent.

G. Miscellaneous Provisions

32. Transitional Rules Concerning the Relationship Between Variety Denominations and Trademarks. The Federal Republic of Germany (Section 52(4) and (5) of the Law) and Italy (Section 6(4) and (5) of Decree No. 974 of August 12, 1975) have introduced provisions corresponding to Article 36 of the 1961 text of the Convention.

33. In the Federal Republic of Germany, the provisions applied to varieties protected under the Law on Seeds of June 27, 1953, as last amended by the Second Amending Law of December 23, 1966. It should be noted that they applied to variety denominations protected as trademarks, as provided in Article 36 of the Convention, and to designations protected as trademarks and liable to be confused with the denomination. Moreover, in the event of a change in denomination, the owner of the protection could not prohibit the use of the former denomination, which enjoyed trademark protection, until the expiry of a period of one year from the registration of the new denomination, such prohibition applying not only to persons obliged to use the former denomination, as provided in Article 36(2) of the Convention, but also to persons authorized to use it.

34. In Italy, the provisions apply to all denominations that are identical or liable to create confusion with the trademark protected in one of the member States, and not merely to denominations identical with a trademark protected in Italy.

35. Trademark Owned in a State by a Person Applying for Protection of a Variety in Another Member State. Whereas all member States have provided rules on the relations between the denomination proposed and the trademark owned by the applicant for protection of a variety that operate when the application is filed with their own authorities, only the Federal Republic of Germany (Section 9(1) of the Law) and Switzerland (Section 7(1) of the Law and 15(1) of the Ordinance of May 11, 1977) have provided rules that operate on their territories when the application has been filed abroad. In each of these countries, the owner of a title of protection granted him abroad may not, as from the time of grant of the title of protection, assert his rights under the trademark protected within the country when the trademark is identical or liable to cause confusion with the registered denomination, and when the protected variety belongs to a genus or species enjoying protection in that country.

36. Possibility of Claiming Trademark Priority for a Variety Denomination. Section 9(2) of the Law of the Federal Republic of Germany provides the possibility of claiming the filing date of the application for registration of a trademark as the decisive date for the variety denomination if the trademark is identical with the proposed denomination and if it covers the same products. The applicant for variety protection has, on pain of lapse of the priority claim, to produce, within three months following the application for protection, a certificate of registration or of application for registration of the trademark, depending on the stage the procedure has reached. The priority claim can also lapse if, before the grant of the title of protection of the variety, the trademark is cancelled or the application for registration is rejected or withdrawn.

37. This provision allows a breeder to accumulate a stock of designations usable as variety denominations, on which he may draw whenever the need arises. It should be noted, however, that this possibility exists in other member States also : it is sufficient for a breeder to have a designation registered as a trademark in order to appropriate it until such time as he proposes it as a variety denomination.

Chapter II

PROVISIONS TO PREVENT OR SETTLE CONFLICT BETWEEN THE PROPOSED DENOMINATION AND SIGNS OTHER THAN TRADEMARKS BELONGING TO THE APPLICANT FOR VARIETY PROTECTION

A. General

38. Other signs exist alongside trademarks which, if they are identical or similar to the registered variety denomination, may prevent or hamper the free use of the denomination. This is particularly true of trade names, which are now mentioned in Article 13(8) of the 1978 Revised Text of the Convention. Other signs do exist however, such as surnames and names of areas and also signs that do not belong solely to the applicant for protection but in which he and certain other persons enjoy exclusive rights. Examples of these are appellations of origin, collective marks, quality certificates and agricultural labels.

39. For many of these signs, conflict with an identical or similar variety denomination is prevented by the laws governing their use. But the plant variety protection laws also allow conflict between such signs and the variety denomination to be prevented or settled either by way of provisions specially designed to that end or by provisions of a more general character.

B. Provisions Designed Expressly to Prevent or Settle Conflict Between the Proposed Denomination and Signs Other Than Trademarks

40. Assimilation of Certain Signs to Trademarks. Only the Netherlands and the United Kingdom have assimilated certain signs to trademarks. The United Kingdom, for instance, provides that the proposed denomination must not be "the same as, or likely to be confused with a trademark... or a trade name used in respect of reproductive material of any kind or with produce or products of the plant variety in respect of which the application is made or of another plant variety of the class to which such plant variety belongs" (Regulation 18(2)(d) of the Plant Breeders' Rights Regulations 1978). This rule applies also to trade names registered outside the United Kingdom. The Netherlands have adopted a vaguer formula, which allows account to be taken of a greater variety of signs: the applicant has to "renounce any right accruing to him in any member State of the Union with respect to that [the proposed] denomination for identical or similar products in the event of the denomination suggested being registered" (Section 21(3) of the Law). According to the interpretation given to this provision, the rights referred to are not only trademark rights, but also rights in a trade name.

41. It should be noted that Sweden has provided, in Section 8(v) of the Law, that the proposed denomination must not be liable to be confused with a trademark, name, trade name or other designation for which a person other than the applicant enjoys protection and which would constitute an obstacle to the registration of the variety denomination as a trademark for material of a plant variety or for goods of a similar kind.

42. Provisions Based on Article 4 of the Guidelines for Variety Denominations. Article 4 of the Guidelines for Variety Denominations, adopted by the UPOV Council at its seventh session in October 1973, has been written into the legislations of Belgium (Section 25(4) of the Royal Decree of July 22, 1977, on the Protection of New Plant Varieties), Spain (Section 13(2)(f) of Royal Decree No. 1674/1977 of June 10, 1977) and France (Section 5 of the Order of March 14, 1974, concerning the denominations of plant varieties in respect of which either an entry has been made in the Catalogue of Species and Varieties of Cultivated Plants, or a plant variety certificate has been issued). The Article in question provides that the denomination may not embody any element which, on expiry of the term of protection of the variety, would prevent or hamper the free use of such denomination or would prevent the free commercialization of the variety. France, however, has not included the phrase "on expiry of the term of protection of the variety."

C. Provisions that may be Invoked to Prevent or Settle Conflict Between the Proposed Denomination and Signs Other than Trademarks

43. Provisions Specifying that the Denomination is the Generic Designation of the Variety. For the following States, a convenient basis for preventing or settling conflict between the denomination and a sign, other than a trademark, in which the applicant has or shares exclusive rights is the provision specifying that the denomination is the generic designation of the variety: Denmark (Sections 1(2) and 4(1) of the Order of August 5, 1970, on the Naming of New Plant Varieties); Spain (Section 13(1) of the Law); Italy (Section 5(3) of Decree No. 974 of August 12, 1975). France could be added to this list in that Section 9(1) of its Law provides that the new plant variety certificate names the new plant variety in such a way that it may be identified, without confusion or ambiguity, in all member States of UPOV.

44. It should be noted that Denmark, Spain and Italy do not specify the territorial scope of the rule that makes the denomination generic, whereas France has introduced a rule that covers all member States of the Union.

45. Provisions Making Use of the Denomination Mandatory. The following States can invoke the provision for mandatory use of the denomination: South Africa (Section 35 of the Law); Federal Republic of Germany (Section 10(1) of the Law); Denmark (Section 4(1) and (4) of the Order of August 5, 1970, on the Naming of New Plant Varieties); Italy (Section 5(3) of Decree No. 974 of August 12, 1975); Netherlands (Section 80(1) of the Law); Sweden (Section 22 of the Law); Switzerland (Section 8(1) of the Law). In other States the obligation to use the denomination derives from the construction of the laws concerned.

46. Provisions Whereby the Denomination has Under Certain Circumstances to Meet Conditions not Laid Down by Law. South Africa (Section 10(3)(f) of the Law) provides that the proposed denomination has to meet other conditions--not specified in the Law itself--which may be laid down by the Registrar. In Denmark the denomination must not be contrary to accepted practices in the naming of plants (Section 1(3)(c) of the Order of August 5, 1970, on the Naming of New Plant Varieties). In Spain denominations have as a general rule to conform to international conventions to which Spain is party and, to that end, the Ministry of Agriculture is empowered to enact the necessary provisions (Sections 13(2) of the Law and 13(3) of Royal Decree No. 1674/1977 of June 10, 1977). Israel provides in Section 31(b)(7) of the Law that the denomination has to conform to accepted international rules concerning the naming of varieties. The same is true of the United Kingdom (Regulation 18(2)(c) of the Plant Breeders' Rights Regulations 1978).

Table 5

Signs Other than Trademarks in Which the Applicant for Protection is
Entitled to Exclusive Rights: Provisions Whereby Conflict Between
Such Signs and the Denomination May Be Prevented or Settled

	ZA	D	B	DK	E	F	IL	I	NL	UK	S	CH
Express provision (assimilation to trademark)									X	X		
Provision whereby denomination may not include any element liable to obstruct the free use of the denomination			X		X	X						
Provision specifying that the denomination is the generic designation of the variety, or implying its generic character				X	X	X		X				
Provision making use of the denomination mandatory in connection with the variety	X	X		X		X	X	X	X		X	X
Provision whereby criteria not specified by law may be taken into account	X			X	X		X			X		

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