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GENEVA

ADMINISTRATIVE AND LEGAL COMMITTEE

Eleventh Session
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UPOV RECOMMENDATIONS ON VARIETY DENOMINATIONS

RECOMMENDATION 6

Document prepared by the Office of the Union

Introduction

1. At its tenth session, the Administrative and Legal Committee (hereinafter referred to as "the Committee") adopted the UPOV Recommendations on Variety Denominations, as given in document CAJ/X/9, subject to reexamination at its eleventh session of the questions raised by Recommendation 6. This Recommendation is worded as follows:

"Recommendation 6"

"(1) A variety denomination is liable to mislead and therefore not suitable if there is a risk of it conveying a wrong impression as to the identity of the breeder.

Examples: See the examples given for Recommendation 4(2)(ii), where the names of historical figures, characters in literature or public figures are identical with the names of well-known breeders or owners of varieties. Misleading geographical names forming part of a variety denomination may also be precluded under this paragraph.

"(2) Where a breeder uses the same verbal component in the denominations of his varieties, third parties may be prohibited from using that component if, under the circumstances of the individual case, such use is liable to mislead.

Examples: A breeder might use the component "Kit" at the beginning of the denominations of varieties filed by him, for instance "Kitchen," "Kittykat" or "Kitbag."

2. Discussions at the tenth session of the Committee concerned two major questions, dealt with in detail below:

(i) Should series of denominations composed of a fancy word varying from one denomination to another and of a word that is common to all the denominations in the series, intended to identify the breeder, be again accepted, such word being typically (but not exclusively) a geographical designation such as the name of a place, a region, a road or an estate ("Maris," "Pentland," "Abed," etc.)?

(ii) Where a breeder creates a series of denominations all comprising the same root (typically: one syllable of his name or company name), can and should a denomination of the same type proposed by another breeder be accepted?

A Word Common to a Series of Denominations Intended to Identify the Breeder ("Distinctive Word")

3. The use of a distinctive word by the breeder was prohibited as a result of the Guidelines for Variety Denominations adopted by the UPOV Council in 1973. This prohibition was particularly attributed to the fact that the distinctive word was in the nature of a trade name and therefore capable, on expiry of protection, of preventing or hindering the free use of the denomination or of preventing the free marketing of the variety. It is indeed telling that these words were referred to as "house names" by the plant breeding stations in the United Kingdom which traditionally used them and which protested at their prohibition (see, for example, Annexes 4 to 6 to document C/VII/2).

4. On the other hand, the use of a distinctive root in denominations whose other elements are syllables chosen at random has been tolerated and one can in fact currently claim that they constitute an established practice for certain species or for certain breeders.

5. The possibility of using distinctive roots has now been explicitly recognized in Recommendation 6(2). In addition, the Council confirmed at its fifteenth session, in 1981, the agreement reached by the Committee at its eighth session, according to which "in future, combinations of letters and figures--in that order--should be accepted in the case of species for which this type of denomination is an established international practice [...]" and "this also applies to series of denominations comprising the same alphabetical component, whereby it is understood that no breeder would have an exclusive right to such a component"* (document C/XV/8, paragraph 5(i)). This decision thus gives the breeder the possibility of using a common alphabetical component for all his denominations, which would therefore be distinctive for that breeder by very reason of the fact that the other breeders would refrain from using it. As regards the question concerned here, it may therefore be noted that a combination of letters that is common to a series of denominations differing only in the figures following it would have the same effect as a distinctive word followed by a fancy word.

6. Breeders also have other possibilities of making known to the public the fact that they have bred a particular variety or at least of endeavoring to do so. Thus, some of them incorporate in their denominations two syllables taken from their name or their company name--that is to say practically the whole of that name. Others add to their denominations a trademark, trade name or a similar designation capable of serving to identify the breeder. Others again associate to each of their denominations a sign of the above-mentioned kind chosen in such a way as to identify also the variety concerned (for example, a combination of letters that are characteristic of the firm and of figures), whereby advertising is centered on those signs, with the result that the denomination recedes into the background or even completely escapes the notice of the public.

7. In view of this situation, particularly the step taken by Recommendation 6 and by the Council decision referred to in paragraph 5 above, it would seem reasonable to withdraw the prohibition on distinctive words, on the understanding that each of the denominations made on the basis of such a word would have to meet the requirements for registration and free use in respect of the variety concerned.

8. In practice, the wording of the Recommendations does not prevent the use of such words, as was noted at the tenth session of the Committee. At that session, a majority of delegations pronounced in favor of withdrawing the prohibition or at least felt it was necessary in view of recent developments.

9. One delegation, however, drew the Committee's attention to the following problems arising from the use of a distinctive word:

* As regards the validity of this restriction, see paragraphs 12 et seq. below.

(i) such a word is liable to take on the characteristics of a sign such as a trade name and thus cast a doubt on its belonging to the denomination;

(ii) a distinctive word is a source of confusion as regards the origin of the propagating material and, where the title of protection is assigned or expires, also as regards the identity of the owner of protection (in the latter case, the assignee or person continuing to maintain the variety and produce propagating material might indeed legitimately claim a modification of the denomination on the grounds that it is not his task to provide advertising for the breeder).

10. These comments are perfectly valid but, nevertheless, it must be admitted that the other systems of breeder identification also raise the same difficulties or similar ones. Thus, adding to a variety denomination a trademark, a trade name or a similar designation raises the same doubts, as to the respective purpose of the signs, as those mentioned in paragraph 9(i) above. The same uncertainty exists in respect of the distinctive alphabetical components of the combinations of letters and figures and could also exist for denominations composed of a root and three other syllables chosen at random where the whole is divided into two words of two syllables each, the first of which being common to a number of denominations. Further, the difficulties referred to in paragraph 9(ii) above also arise with other types of breeder-distinctive denominations referred to above, as also with series of "subject" denominations (names of birds, of volcanoes, of battles, etc.). In other words, if it is wished to prohibit distinctive words on the grounds set out in the preceding paragraph, logically it would be necessary also to prohibit all other systems for identifying the breeder in variety denominations.

A Root Common to a Series of Denominations Intended to Identify the Breeder (Distinctive Root)

11. As already noted in paragraph 4 above, the use of distinctive roots has become an established practice in certain areas. People aware of the existence and operation of the system will therefore automatically relate the variety to its breeder, subject to being able to identify the distinctive root (which is not always at the beginning of the denomination) and to recognize the relationship between this root and the name or company name of the breeder. A denomination created in accordance with the system adopted by a breeder and comprising his distinctive root could therefore be "liable to mislead or to cause confusion concerning [...] the identity of the breeder" (Article 13(2) of the Convention) if given to a variety which has not been created by that breeder, with the result that the authority to which it is proposed could find itself obliged to refuse registration under Article 13(3). This is the reasoning behind the wording of Recommendation 6(2). Since the same reasoning also applies to other systems for identifying the breeder in variety denominations, it would be useful to reword Recommendation 6(2) in a more general way should the principle it sets out be definitively adopted.

12. The principle that has applied since the adoption of the Guidelines for Variety Denominations in 1973 is that a breeder cannot claim exclusive use of a distinctive root and, by extension, any other element of a denomination or system of denomination intended to identify him. This principle has indeed been enshrined in the recent Decree on variety denominations promulgated in France (see document CAJ/X/6). At first sight, this principle counters the reasoning set out in the preceding paragraph, but in fact this would not seem to be the case since, although a breeder cannot claim a monopoly, he may legitimately oppose registration of a proposed denomination--in the same way as any other party involved, in particular the plant variety protection office--on the grounds that the denomination is misleading as to the identity of the breeder. Consequently, although he cannot claim a right to a monopoly, use may constitute a de facto monopoly.

13. The question that arises is therefore what "circumstances of the individual case" would prevent another person from using the breeder's distinctive root and therefore from using a denomination breaking in a system which identifies or is supposed to identify a breeder. Four initial comments must be made:

(i) It would be unreasonable, or even impossible, to draw up detailed rules giving an answer in each individual case.

(ii) Any rules that could be drawn up could not be placed in the Recommendations since they themselves are of a general nature.

(iii) It would be perfectly possible to refrain from drawing up such rules since the cases are rare.

(iv) It would be useful to recommend member States' authorities to submit any cases to the Committee so that a concerted decision could be reached, in view of the fact that assessing such cases is always subject to a large margin of arbitrary judgment which could result in widely differing practices developing in the various States.

14. When evaluating the circumstances under which a proposed denomination is liable to mislead or to cause confusion as to the identity of the breeder, the following aspects should be taken into account:

(i) Does the denomination form part of a system set up by another breeder? At the tenth session of the Committee, it was said that a denomination having a pre-existing meaning and containing a breeder's distinctive root--in the relevant place--would not form part of the series of denominations set up by that breeder if the latter fabricated his denominations by joining arbitrary syllables to the root (for example, "coral," "coronation" and "corollary" would not be part of the series "coralba," "corberi," "corsal," etc.). This reasoning may be accepted--the majority of member States would seem to favor this approach--but it may also not be adopted.

(ii) Does the denomination system set up by a breeder identify that breeder? The answer is undisputably yes where the system under consideration is by its very principle an established practice for the species in question and the system specific to the breeder has been applied to a large number of varieties. The answer is still the same where the breeder has announced, through advertising for example, the relationship that exists between himself and the denomination system. It is less evident in other cases. The problem is that the setting of a lower limit is tantamount to establishing a guaranteed income situation for those breeders who already use such a system and that not fixing the limit could lead to a proliferation of such systems and, consequently, reserved areas resulting from these de facto monopolies.

(iii) What should be the size of the circle of people in the know, that is to say those aware of the existence and operation of the denomination system? Paradoxically, it is in those cases where the denomination systems involved are most widespread that the problem is in fact the least acute. Indeed, to take the example of ornamental plants, the variety denomination is in fact eclipsed by the trademark at the stage of public marketing and serves solely to identify the variety--according to the spokesmen for the trade circles in the controversy that has taken place as regards the respective parts played by the denomination and the trademark--in relations between the breeder and his licensed propagators, that is to say in perfectly informed circles. It may justifiably be considered that errors are very unlikely in these circles, even if the risk is great, in view of their experience. Incidentally, a large part of that experience derives from the fact that whereas identification of the breeder is easy, the trade circles must make an effort to memorize the relationship between varieties and owners of protection (where these are not the breeders). The number of people in the know is small where the number of varieties marketed on a truly significant scale--either in total or in a given growing area--is too small for it to be expected that users relate the denomination system to the breeder. On the other hand, the link is very easy to make in some cases (where the breeder's distinctive element reproduces almost the whole of his name or refers to a well-known feature such as the name of the place where he has his headquarters or his estate, advertising, etc.). As in the preceding case, the fact of setting down exact criteria may have undesirable consequences.

(iv) To which species would a breeder's de facto monopoly be limited? It is obvious that such a monopoly cannot extend to species in which the breeder has no activity. It is, however, open to question whether it extends to species on which he is working but has not yet produced any varieties named in accordance with the system in question.

15. To summarize, the Office of the Union feels that Recommendation 6(2) sets out a principle which is required by Article 13(2) of the Convention, although in a somewhat limited manner since it does refer to distinctive roots only and also rather restrictively since it prohibits the use of a root whereas in fact it is the registration of a denomination containing such a root which is to be excluded. On the other hand, this principle offers a very broad margin of tolerance in dealing with each individual case in view of the highly varied evaluation that may result from the circumstances of that case.

Conclusion

16. Should the Committee share the points of view expressed above, the following wording is proposed for Recommendation 6:

"(1) A variety denomination is liable to mislead and therefore not suitable if there is a risk of it conveying a wrong impression as to the identity of the breeder. [Unchanged]

"(2) Paragraph (1) would preclude the following designations, in particular:

(i) Designations that are identical or similar to the name of a well-known breeder or owner of a variety.

(ii) Designations forming part of a series of denominations established by another breeder in such a way that those denominations enable the other breeder to be identified when, taking into account the circumstances of the individual case, those designations are liable to give the impression that the varieties concerned have been bred by the other breeder.

Examples: A breeder might use the letters K I T at the beginning of the denominations he files, for example "Kitaba," "Kitibu" or "Kitobri." In view of the circumstances, a designation "Kittiara" proposed by another person for a variety of the same species could well be precluded."

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