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EXPLANATORY NOTES ON VARIETY DENOMINATIONS

UNDER THE UPOV CONVENTION

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*to be considered by the Working Group on Variety Denominations (WG-DEN)
at its first meeting to be held in Geneva on March 18, 2016*

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Note for Draft version

Footnotes will be retained in published document.

Endnotes and **highlighted boxes** are background information when considering this draft and will not appear in the final, published document.

EXPLANATORY NOTES ON VARIETY DENOMINATIONS
UNDER THE UPOV CONVENTION*Preamble*

1. The Council of the International Union for the Protection of New Varieties of Plants (UPOV) refers to the International Convention for the Protection of New Varieties of Plants (UPOV Convention), and in particular to Articles 5(2) and 20 of the 1991 Act, and Articles 6(1)(e) and 13 of the 1978 Act and the 1961 Convention, which provides that a variety must be given a suitable denomination which will be registered at the same time as the breeder's right is granted.

2. The Council recalls that, according to the relevant provisions of the UPOV Convention, a variety denomination must be suitable as a generic designation and must enable the variety to be identified; it must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder.

3. The Council emphasizes that the main purpose of these Explanatory Notes is to ensure that, as far as possible, protected varieties are designated in all members of the Union¹ by the same variety denomination, that the approved variety denominations establish themselves as the generic designations and that they are used in the offering for sale or marketing of propagating material of the variety, even after the expiration of the breeder's right.

4. Whilst noting that the only binding obligations for members of the Union are those contained in the UPOV Convention itself, the Council considers that the aim set out in paragraph 3 can only be achieved if the broadly worded provisions on variety denominations under the UPOV Convention are uniformly interpreted and applied by the members of the Union, and that the adoption of appropriate explanatory notes is therefore advisable. Those Explanatory Notes should not be interpreted in a way that is inconsistent with the UPOV Convention.

5. The Council considers that the adoption of such Explanatory Notes for the uniform interpretation and application of the provisions on variety denominations will be of assistance not only to the authorities² of members of the Union but also to breeders in their selection of variety denominations.

6. The Council, having regard to the UPOV Convention (Article 26(5)(x) of the 1991 Act and Article 21(h) of the 1978 Act and the 1961 Convention), under which it has the task of taking all necessary decisions to ensure the efficient functioning of the Union, and in the light of the experience acquired by members of the Union in connection with variety denominations, recommends that the authorities of the members of the Union,

(i) base their decisions on the suitability of proposed variety denominations on these Explanatory Notes;

(ii) take into account the guidance in these Explanatory Notes concerning the procedure for assessing the suitability of proposed variety denominations and the exchange of information;

(iii) provide comprehensive information concerning these Explanatory Notes, to assist breeders when selecting variety denominations.

Prior guidance on this matter, provided by the "Explanatory Notes on Variety Denominations under the UPOV Convention" (document UPOV/INF/12/3), is superseded by these Explanatory Notes.

¹ "Member of the Union" means a State party to the 1961 Convention/1972 Act, the 1978 Act or a State or intergovernmental organization party to the 1991 Act (Article 1(xi) of the 1991 Act).

² The "authority" means the authority entrusted with the task of granting breeders' rights (Article 30(1)(ii) of the 1991 Act and Article 30(1)(b) of the 1978 Act and 1961 Convention).

EXPLANATORY NOTES ON VARIETY DENOMINATIONS UNDER THE UPOV CONVENTION

The Explanatory Notes below correspond to the paragraph numbers within Article 20 of the 1991 Act and Article 13 of the 1978 Act and 1961 Convention, unless indicated otherwise.

Paragraph 1

(Paragraphs 1 and 3 of Article 13 of the 1961 Convention)

[Designation of varieties by denominations; use of the denomination] The variety shall be designated by a denomination which will be its generic designation. Each member of the Union shall ensure that, subject to paragraph (4), 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, even after the expiration of the breeder's right.

Explanatory Notes – Paragraph (1)

1.1 Article 5(2) of the 1991 Act and Article 6(1)(e) of the 1978 Act and the 1961 Convention require that the variety is designated by a denomination. Paragraph (1) provides for the denomination to be the generic designation of the variety, and subject to prior rights, no rights in the designation shall hamper the free use of the denomination of the variety, even after the expiration of the breeder's right. The obligation under paragraph (1) should be considered together with the obligation to use the variety denomination in respect of the offering for sale or marketing of propagating material of the variety (see paragraph (7)).

1.2 The obligation under paragraph (1) to allow for the use of the denomination in connection with the variety, even after the expiration of the breeder's right, is of relevance if the breeder of the variety is also the holder of a trademark which is identical to the variety denomination. It should be noted that where a name is registered as a trademark by a trademark authority, the use of the name as a variety denomination may transform the trademark into a generic name. In such cases, the trademark may become liable for cancellation³. In order to provide clarity and certainty in relation to variety denominations, authorities should refuse a variety denomination which is the same as a trademark in which the breeder has a right. The breeder may choose to renounce the trademark right prior to the submission of a proposed denomination in order to avoid its refusal.

³

WIPO Publication No 489 "WIPO Intellectual Property Handbook

Proper Use of Trademarks

"2.397 Non-use can lead to the loss of trademark rights. Improper use can have the same result, however. A mark may become liable for removal from the Register if the registered owner has provoked or tolerated its transformation into a generic name for one or more of the goods or services in respect of which the mark is registered, so that, in trade circles and in the eyes of the appropriate consumers and of the public in general, its significance as a mark has been lost.

2.398 Basically, two things can cause genericness: namely, improper use by the owner, provoking transformation of the mark into a generic term, and improper use by third parties that is tolerated by the owner. [...]

2.400 The basic rule is that the trademark should not be used as, or instead of, the product designation. [...]

2.404 However, it is not enough just to follow these rules: the trademark owner must also ensure that third parties and the public do not misuse his mark. It is specifically important that the trademark should not be used as or instead of the product description in dictionaries, official publications, journals, etc."

Paragraph 2

[Characteristics of the denomination] The denomination must enable the variety to be identified. It may not consist solely of figures except where this is an established practice for designating varieties. It must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder. In particular, it must be different from every denomination which designates, in the territory of any member of the Union, an existing variety of the same plant species or of a closely related species.

Explanatory Notes – Paragraph (2)

General comment by the European Union (CPVO) ^a

Articles 3, 4 and 7 of the CPVO Guidelines on variety denominations provide some more detailed guidance on this subject.

2.1 Identification

Provisions under paragraph (2) emphasize the “identification” role of the denomination. Bearing in mind that the main objective of the denomination is to identify the variety, sufficient flexibility should be given to incorporate evolving practices in designating varieties.

Proposal by the European Union (CPVO) ^a

It would be important to mention the difference between fancy names and codes.

Proposal by New Zealand ^b

Section 2.1 proposed examples: Identification now includes the use of Genus or species prefixes Agapanthus ‘Agapetite’, Lavender ‘Lavang12’.

2.2. Solely of figures

2.2.1 Paragraph (2) states that the denomination may not consist “solely of figures” except where this is an “established practice” for designating varieties. The expression “solely of figures” refers to variety denominations consisting of numbers only (e.g. 91150). Thus, denominations containing both letters and figures are not subject to the “established practice” requirement (e.g. AX350).

2.2.2 In the case of denominations consisting “solely of figures,” the following non-exhaustive elements may assist the authorities to understand what might be considered to be “established practice”:

(a) for varieties used within a limited circle of specialists, the established practice should reflect that specialist circle (e.g. inbred lines);

(b) accepted market practices for particular variety types (e.g. hybrids) and particular species (e.g. Medicago, Helianthus).

Proposal by WG-DST ^c

Section 2.2.2 (b) to read as follows:

“(b) accepted market practices for particular variety types (e.g. hybrids) and particular genera/species (e.g. Medicago, Helianthus).”

Proposal by CAJ-AG^d

To add a new paragraph (c) in Section 2.2.2 as follows:

“(c) ‘established practice’ is determined to be when registration has been accepted for one species or group, so that it can be used in other species which have not yet registered any variety whose denomination consists solely of figures.”

2.3. Liable to mislead or to cause confusion

Paragraph (2) states that the denomination must not be liable to “mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder.” These aspects are considered below:

Proposal by the European Union (CPVO)^a

In the draft proposal prepared by the CPVO for the revision of its own guidelines on VDs, we propose 3 criteria for assessment of similarity between VDs: visual, phonetic and conceptual; such criteria are especially considered for the assessment of similarity between trademark. We considered that the problematic is very similar in this other IP system and that this approach is the outcome of a huge experience with many court cases and judgements.

Proposal by the European Union (CPVO)^a

To include a section providing guidance on the assessment of similarity of variety denominations consisting of “first names”.

2.3.1 Characteristics of the variety

The denomination should not:

(a) convey the impression that the variety has particular characteristics which, in reality, it does not have;

Example: a variety denomination “dwarf” for a variety which is of normal height, when a dwarfness trait exists within the species, but is not possessed by the variety.

Proposal by New Zealand^b

Section 2.3.1 (a) covers the key point that a denomination should not misrepresent characters of the variety. Use of a range of words (e.g. hybrid, mixture, grex) should be avoided but it is doubtful whether specifically singling out descriptive terms (2.3.1 b) is the best approach.

(b) refer to specific characteristics of the variety in such a way that the impression is created that only the variety possesses them, whereas in fact other varieties of the species in question also have or may have the same characteristics; for example where the denomination consists solely of descriptive words that describe attributes of the variety that other varieties in the species may also possess.

Example 1: “Sweet” for a fruit variety;

Example 2: “Large white” for a variety of chrysanthemum.

Proposal by New Zealand^b

Section 2.3.1 (b): the section and examples to be reviewed, including possible deletion. The current wording implies that descriptive words (adjectives) are not acceptable. This is partially correct, but does not take account of descriptive word combinations and word orders that may be acceptable. If a variety has sweet fruit or has large white flowers then those descriptive words as part of a denomination may well be acceptable.

(c) convey the impression that the variety is derived from, or related to, another variety when that is not, in fact, the case;

Example: a denomination which is similar to that of another variety of the same species or closely related species, e.g. "Southern cross 1"; "Southern cross 2"; etc., giving the impression that these varieties are a series of related varieties with similar characteristics, when, in fact, this is not the case.

Proposal by WG-DST^c

Section 2.3.1 (c) to include new examples of denominations as follows:

(i) might erroneously imply relation to, or derivation from, other varieties;

Example: "alpha" and "alpha-HT" (in a case where "alpha-HT" differs from "alpha" in characteristics other than herbicide tolerance (HT) and is not closely related to Alpha), and

(ii) would not imply relation to, or derivation from, other varieties;

Example: "Prince Albert" and "Prince Alexander", and "Ivory Bells" and "Lilac Bells" where the words "Prince" and "Bells" have been used for unrelated varieties and for varieties bred by different breeders .

Proposal by ESA/ISF^e

Section 2.3.1 (c) relates to the situation where a denomination is used which is similar or very close to the denomination of another variety of the same species or closely related species. In practice, breeders sometimes "re-use" variety names for runner-up varieties with an addition to the original name. In these cases there is indeed a relation between the varieties and we believe that this practice should be allowed (as it is allowed in the EU). Therefore, we propose to add in this paragraph the following sentence: "When varieties belong to the same breeder, one can assume a relation between the varieties and in that case similar denominations as given in the examples are allowed."

Proposal by WG-DST^c

To add 2.3.1.(d) as follows:

"(d) contain the botanical or common name of the genus to which that variety belongs. The identity of the denomination and that of the genus to which it belongs could become unclear and confusing."

Proposal by WG-DST^c

Example in section 2.3.1 (d): *Carex* variety "Sedge". *Carex* is the botanical name of the genus, for which the common name is sedge.

Proposal by New Zealand^b

New Section 2.3.1 (d): it should not be acceptable for a denomination to contain the same botanical or common name of the genus to which the variety belongs as started in para 31. We should not have *Malus* variety 'Apple', *Carex* variety 'Sedge'. This is also consistent with ICNCP 19.23

Proposal by WG-DST^c

The use of the botanical or common name of a genus to which a variety does not belong should be avoided, unless the botanical name or common name had a wider meaning, e.g. “Rose”, “Cosmos”, “Lilac”, “Veronica” and “Bianca”.

Proposal by the European Union (CPVO)^a

Section 2.3.1 to provide more detailed guidance and provide clear examples of suitable and non-suitable proposals for VDs.

Proposal by New Zealand in relation to the above proposal by WG-DST^b

The use of the botanical or common name of a genus to which a variety does belong should be avoided, unless the botanical name or common name had a wider meaning, e.g. “Rose”, “Cosmos”, “Lilac”, “Veronica” and “Bianca”.

This is also consistent with ICNCP 19.24

The comment proposal of WG-DST is not compatible with existing practice which permits a genus or common name in a denomination providing that it is not the genus or common name assigned for that variety. The following examples of approved denominations are in PLUTO.

Blueberry (*Vaccinium*) ‘Camellia’

Lavender (*Lavandula*) ‘Blueberry Ruffles’

Penstemon ‘Blueberry Taffy’

Dianthus ‘Erica’

Proposal by ESA/ISF^e

Section 2.3.1 (d) states that the denomination should not “*contain the Latin or common name of the genus to which that variety belongs*”. In practice this would mean that *Capsicum* ‘pepper’ is not allowed, however, *Solanum lycopersicon* ‘pepper’ would be allowed. We doubt whether that is desirable. We would propose to rather follow the following approach: a denomination should not contain the Latin or common name of a genus within the same crop group (i.e. ornamental, agriculture, vegetables).

2.3.2 Value of the variety

The denomination should not consist of, or contain, comparative or superlative designations.

Example: a denomination which includes terms such as “Best”, “Superior”, “Sweeter”.

Proposal by the European Union (CPVO)^a

More detailed guidance and examples in the Section 2.3.2 dealing with the value of the variety.

Proposal by New Zealand^b

Section 2.3.2: the current guidance is too simplified. It should not be enough just to include superlatives or comparatives, a more complete evaluation should be used considering the whole context and presence and position of other words in the denomination. ‘Pink Supreme’, ‘Best Wishes’ and ‘Lake Superior’ contain superlatives but viewed as a whole, may be acceptable denominations.

2.3.3 Identity of the variety

(a) As a general recommendation, a difference of only one letter or one number may be considered to be liable to mislead or cause confusion concerning the identity of the variety, except where the:

Proposal by WG-DST^c

Section 2.3.3 (a): to differentiate between letters in the form of words and other cases as follows:

- (i) in the case of denominations consisting of letters not in the form of words, a difference of a single letter should be regarded as a clear difference, with examples to be provided;
- (ii) in the case of denominations consisting of figures, a difference of a single figure should be regarded as a clear difference, with examples to be provided; and
- (iii) in the case of denominations consisting of figures and letters, not in the form of words, one letter or figure difference should be regarded as clear difference, with examples to be provided.

Proposal by New Zealand^b

Section 2.3.3 (a): the same guidance should apply to alpha numeric combination denominations as it does to all other denominations containing letters and numbers.

Proposal by ESA/ISF^e

Section 2.3.3 ~~(b)~~ (a): propose to simplify and thereby improve the readability of the first line of the sentence in the following way: "For denominations consisting solely of letters, as a general recommendation..."

(i) difference of one letter provides for a clear visual or phonetic difference, e.g. if it concerns a letter at the beginning of a word:

Example 1: in the English language, 'Harry' and 'Larry' would not cause confusion; However, 'Bough' and 'Bow' might cause confusion (in phonetic terms);

Example 2: in the Japanese and Korean languages there is no difference between "L" and "R" sounds, thus "Lion" and "Raion" are exactly the same although these are distinguishable for English mother tongue speakers;

Proposal by ESA/ISF^e

Section 2.3.3 ~~(b)~~ ~~(iii)~~ (a) (i): refers to a case where a difference of one letter at the beginning may not provide a clear visual and phonetic difference. The example given in the first bullet however does not have a difference of one letter in the beginning but of two letters and is therefore somewhat confusing.

(ii) denominations consist of a combination of letters and figures;

Proposal by New Zealand^b

Section 2.3.3 (a) (ii): consider whether this exemption should continue from the general recommendation.

(iii) denominations consist "solely of figures".

(b) The use of a denomination which is similar to that used for a variety of another species or genera in the same denomination class (see section 2.5) may cause confusion.

Proposal by WG-DST^c

To add the following example: “Helena” and “Elena”. A clear visual difference may not provide a clear phonetic difference in a language other than English (in Spanish).

Proposal by WG-DST^c

Acceptability of denominations to be considered in their original alphabet for the territory concerned and transcriptions and/or transliterations not to be considered for similarity purposes. To delete the example “Raion” and “Lion”, because they would not be confused in the Roman alphabet.

(c) In order to provide clarity and certainty in relation to variety denominations, the re-use of denominations is, in general, discouraged, since the re-use of a denomination, even where that relates to a variety which no longer exists (see section 2.4.2) may, nevertheless, cause confusion. In some limited cases an exception may be acceptable, for example a variety which was never commercialized, or was only commercialized in a limited way for a very short time. In those cases, a suitable period of time after discontinued commercialization of the variety would be required before the re-use of the denomination in order to avoid causing confusion in relation to the identity and/or the characteristics of the variety.

Proposal by WG-DST^c

New section 2.3.3 (d): to recommend that consideration be given to avoiding re-use of denominations in all cases. However, it clarified that it would be important to consider only denominations of varieties (i.e. plant groupings that meet the definition of variety in Article 1 (vi) of the 1991 Act) and, in addition, to expand the content of PLUTO database to include all varieties, including those that had not been, or were no longer, registered/protected.^f

Proposal by the European Union (CPVO)^a

To make clear in section 2.3.3 dealing with the identity of the variety, that the re-use of the same or a similar VDs is possible under certain conditions, especially when an earlier variety has disappeared.

Proposal by New Zealand^b

New section 2.3.3 (d): to re-use of denominations should be possible for genera that require ongoing maintenance, such as annual seed crops. It may be possible to sufficiently establish that a variety no longer exists. For vegetatively propagated species it may be much more difficult to adequately establish that a variety no longer exists. The re-use of denominations should not be entirely ruled out.

Proposal by ESA/ISF^e

Section: 2.3.3 (d): propose to mention 10 years as an example of suitable period. This is what is indicated in the CPVO guidelines on variety denominations.

Proposal by ESA/ISF^e

WG-DST has proposed to include all varieties in PLUTO, also those which had not been or were no longer registered/protected. We understand that this may cover varieties that may have been marketed under a “test-marketing regime” prior to registration. Breeders would like to be able to re-use names which have not yet been registered and not yet been marketed. These are rare cases but still too restrictive rules are not favored. As outlined also above, we propose to allow re-use of denominations after a period of 10 years.

2.3.4 Identity of the breeder

The variety denomination should not mislead or cause confusion concerning the identity of the breeder.

Proposal by New Zealand^b

Section 2.3.4 examples: the identity of the breeder is often shown using prefixes of various kinds Apple ‘Scired’, Apple ‘Scifresh’, Rose ‘Macrexy’, Rose ‘Macgenev’.

2.4. Different from an existing variety of the same plant species or of a closely related species

2.4.1 Paragraph (2) states that the denomination must be “different” from an existing variety of the same plant species or a closely related species⁴.

Proposal by ESA/ISF^e

Section 2.4 is intended to provide guidance on what it means that the denomination has to be different from any other denomination designating an existing variety of the same plant species or of a closely related species. We propose to also specify here that this does not only refer to denominations used for protected varieties but also denominations registered under national variety registration laws.

2.4.2 The following explanation is for the purposes of variety denominations and without prejudice to the meaning of a “variety whose existence is a matter of common knowledge” in Article 7 of the 1991 Act and in Article 6(1)(a) of the 1978 Act and the 1961 Convention. In general, the re-use of denominations is discouraged but, under exceptional circumstances (see section 2.3.3(c)), the denomination of an old variety could, in principle, be registered for a new variety.

2.5. *Variety denomination classes: a variety denomination should not be used more than once in the same class*

2.5.1 For the purposes of providing guidance on the third (see section 2.3.3(b)) and fourth sentences of paragraph 2 of Article 20 of the 1991 Act and of Article 13 of the 1978 Act and the 1961 Convention, variety denomination classes have been developed. A variety denomination should not be used more than once in the same class. The classes have been developed such that the botanical taxa within the same class are considered to be closely related and/or liable to mislead or to cause confusion concerning the identity of the variety.

Proposal by New Zealand^b

Section 2.5.1 additional sentence proposed:

For certain genera (e.g. Prunus) there may be sufficient botanical difference between species within the genus to permit the same denomination to exist in the same genus (class). A cherry variety is generally considered not likely to be confused with an apricot variety.

⁴ Article 20(2) of the 1991 Act refers to “plant species” and Article 13(2) of the 1978 Act and 1961 Convention refers to “botanical species”; the divergence in terminology does not contain any difference in substance.

2.5.2 The variety denomination classes are as follows:

- (a) General Rule (one genus / one class): for genera and species not covered by the List of Classes in Annex I, a genus is considered to be a class;
- (b) Exceptions to the General Rule (list of classes):
 - (i) classes within a genus: List of classes in Annex I: Part I;
 - (ii) classes encompassing more than one genus: List of classes in Annex I: Part II.

2.5.3 It is recommended that the UPOV Plant Variety Database (“UPOV-ROM”) used in the process to check if, in the territory of any member of the Union, the proposed denomination is different from denominations of existing varieties of the same genus or, if appropriate, variety denomination class (see Annex I). Attention is drawn to the “General Notice and Disclaimer” of the UPOV-ROM to ensure that the information contained in the UPOV-ROM is considered in an appropriate way.

Proposal by the European Union (CPVO)^a

To make clear in Section 2.5 dealing with variety denomination classes, in cases of UPOV classes containing more than one genus, that the situation where the genera are different is taken into account with a more lenient approach in respect of the similarity between VDs used for varieties belonging to different genera. This could also apply, in certain cases, to different species within a genus.

Paragraph 3

(Paragraph 4 of Article 13 of the 1961 Convention)

[Registration of the denomination] The denomination of the variety shall be submitted by the breeder to the authority. If it is found that the denomination does not satisfy the requirements of paragraph (2), the authority shall refuse to register it and shall require the breeder to propose another denomination within a prescribed period. The denomination shall be registered by the authority at the same time as the breeder’s right is granted.

Explanatory Notes – Paragraph (3)

3.1 If the authority has found no grounds for refusal under paragraph (2), and knows of no grounds for refusal under paragraph (4), the proposed denomination shall be registered, published and communicated to the authorities of the other members of the Union.

3.2 In the event of prior rights (paragraph (4)) or other grounds for refusal, any interested person may file an objection to the registration. The authorities of the other members of the Union may submit observations (see Explanatory Notes of paragraph (6)).

3.3 Relevant objections and observations should be communicated to the applicant. The applicant should be given the opportunity to reply to the observations. If the authority considers the denomination unsuitable within its territory, it will require the breeder to submit another denomination. Failure to submit a proposal within the prescribed period should entail the rejection of the application.

3.4 The examination of the proposed denomination and of the other conditions for the protection of the variety are procedures which should be undertaken in parallel in order to ensure that the denomination can be registered at the time the breeder’s right is granted.

Proposal by ESA/ISF^e

Paragraph 3

In the introductory text it is stated that “the authority shall refuse to register it and shall require the breeder to propose another denomination with a prescribed period”. The words “prescribed period” indeed appear in Article 20(3) of the UPOV Convention but in practice the breeder may propose a new denomination at any time before the grant. In order to avoid confusion it would be useful to clarify that the “prescribed period” basically refers to before grant.

Paragraph 4

(Paragraph 10 of Article 13 of the 1961 Convention)

[Prior rights of third persons] Prior rights of third persons shall not be affected. If, by reason of a prior right, the use of the denomination of a variety is forbidden to a person who, in accordance with the provisions of paragraph (7), is obliged to use it, the authority shall require the breeder to submit another denomination for the variety.

Explanatory Notes – Paragraph (4)

4. In deciding on the suitability of the proposed denomination and examining objections and observations in relation to prior rights of third persons, the following are intended to assist authorities.

(a) An authority should not accept a variety denomination if a prior right, the exercise of which may prevent the use of the proposed denomination, has already been granted to a third party under plant breeder's right law, trademark law or any other intellectual property legislation. It is the responsibility of the title holder of a prior right to assert his rights through the available objection or court procedures. However, authorities are encouraged to make prior searches in relevant publications (e.g. official gazettes) and databases (e.g. UPOV-ROM) to identify prior rights for variety denominations. They may also make searches in other registers, such as trademark registers, before accepting a variety denomination.

Proposal by CAJ-AG⁹

To modify 4(a) as follows:

“(a) An authority should not accept a variety denomination if ~~a~~ there is an existing prior right, the exercise of which may prevent the use of the proposed denomination, ~~has already been granted to a third party under plant breeder's right law, trademark law or any other intellectual property legislation.~~ It is the responsibility of the title holder of a prior right to assert his rights through the available objection or court procedures. However, authorities are encouraged to make prior searches in relevant publications (e.g. official gazettes) and databases (e.g. UPOV Plant Variety Database (PLUTO) <http://www.upov.int/pluto/en/>) to identify prior rights for variety denominations. They may also make searches in other registers, such as trademark registers, before accepting a variety denomination.”

Proposal by the European Union (CPVO)^a

It is stated that an authority should not accept a variety denomination if it exists already a prior right. In the opinion of the CPVO this paragraph should allow also other approaches, in the case of the CPVO, the office doesn't refuse ex officio a proposal for VD in case of existence of an identical prior right (trade mark). In such cases the CPVO informs the applicant about a situation of identity with a prior right (trade mark) and refuses the proposal only in case of formal objection by the owner of the prior right (trade mark).

(b) The notion of prior rights should include those rights which are in force, in the territory concerned, at the time of publication of the proposed denomination. For rights whose duration starts at the filing date of the application, the filing dates are those relevant for prior right considerations, provided those applications lead to the granting of rights.

(c) In the case of two conflicting proposed variety denominations (see paragraph (2)) in the same or different territories, the one with an earlier publication date should be retained and the relevant authority should request the breeder, whose proposed denomination was or might have been published at a later date, to submit another denomination.

(d) If, after the granting of a breeder's right, it is discovered that there was a prior right concerning the denomination which would have resulted in the rejection of the denomination, the denomination should be cancelled and the breeder should propose another suitable denomination for the variety. Article 22(1)(b)(iii) of the 1991 Act states that, if the breeder does not propose another suitable denomination, the authority may cancel the breeder's right.

(e) The following items provide some guidance on what might constitute a “prior right”, the exercise of which may prevent the use of the proposed denomination:

(i) A trademark may be considered as a prior right when the proposed denomination is identical to a trademark registered for an identical good. For all practical purposes, such identity of goods is most likely to occur in respect of trademarks registered for goods under Class 31 of the Nice Classification⁵, although it is recalled that, in certain countries, trademarks may also be protected on the basis of use and without registration. If the trademark and proposed denomination are not identical, but similar, the trademark, in some cases, may constitute a prior right, the exercise of which may prevent the use of the proposed denomination, and the breeder may be required to propose another denomination. If, in spite of the similarity between the proposed denomination and the trademark, the exercise of the latter will not prevent the use of the proposed denomination, the denomination may be accepted; rejections of denominations by the authority on the basis of similarity to a trademark will, in general, result from oppositions of trademark holders, observations of authorities responsible for trademark registration, or judgments from a competent court. In cases of mere similarity or small likelihood of association by users, waivers granted to breeders by prior trademark right holders could be a suitable solution.

Proposal by CAJ-AG⁹

To modify last sentence of 4(e)(i) as follows:

“In cases of mere similarity or small likelihood of ~~association~~ confusion by users, waivers granted to breeders by prior trademark right holders could be a suitable solution.”

(ii) If the proposed denomination is identical with or similar to a well-known mark, it may be unsuitable, even if the well-known mark applies to goods other than those appearing in Class 31 of the Nice Classification⁶;

(iii) Prior rights might also concern trade names⁷ and names of famous persons;

(iv) Names and abbreviations of intergovernmental organizations, which are excluded by international conventions from use as trademarks or parts of trademarks, are not suitable as variety denominations⁸;

(v) Prior rights concerning appellations of origin and geographical indications (e.g. “Scotch”) may exist under national legislation on grounds of common law or registration⁹;

(vi) In certain cases, prior rights in geographical names (e.g. names of cities or States) may exist; however, there is no general rule on these cases and assessment should be based on the probatory material presented on a case-by-case basis.

Paragraph 5

[Same denomination in all members of the Union] A variety must be submitted to all members of the Union under the same denomination. The authority of each member of the Union shall register the denomination so submitted, unless it considers the denomination unsuitable within its territory. In the latter case, it shall require the breeder to submit another denomination.

Explanatory Notes – Paragraph (5)

5.1 This provision reflects the importance of a single variety denomination for the effective operation of the UPOV system.

⁵ Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1957, as revised in Stockholm on July 14, 1967, and Geneva on May 13, 1977, and amended on September 28, 1979.

⁶ Well-known marks are protected by the Paris Convention for the Protection of Industrial Property (Article 6*bis*) and the Agreement on Trade-Related Aspects on Intellectual Property Rights (Article 16.2 and 3 of the TRIPS Agreement). See also the 1999 WIPO Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

⁷ Article 8 of the Paris Convention.

⁸ This recommendation includes names and abbreviations notified pursuant to Article 6*ter* of the Paris Convention.

⁹ Articles 22 to 24 of the TRIPS Agreement provide for an obligation for WTO Members to protect geographical indications; the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration sets up international registration procedures for appellations of origin in the States party to that Agreement.

5.2 *Paragraph (5) provides clear directions both for breeders and authorities:*

(a) In relation to subsequent applications of the same variety, the breeder must submit in all members of the Union the denomination that was submitted with the first application. An exception to the above obligation might be appropriate when the proposed denomination is refused by one authority before the denomination is registered by any of the other members of the Union, in which case the breeder is encouraged to submit a new denomination to all authorities in order to obtain a single denomination in all territories.

(b) The essential obligation under paragraph (5) is that authorities should accept the denomination that was submitted and registered with the first application, unless such denomination is unsuitable in their territory (see section 5.3). On that basis, although certain provisions on variety denominations allow for authorities to develop individual guidance concerning best practices, the obligation under paragraph (5) should be given priority, unless there is direct conflict with the provisions of the UPOV Convention. In that respect, it is also recommended to avoid any narrow interpretation of the provisions of the UPOV Convention and related guidance or best practices, which could lead to the unnecessary refusal of variety denominations and, consequently, the unnecessary creation of synonyms for a variety;

(c) Due to different alphabetic scripts or systems of writing, it may be necessary to transliterate or transcribe the submitted denomination to enable its registration in another territory. In such cases, both the variety denomination submitted in the application and its transliteration or transcription are regarded as the same denomination. However, a translation would not be considered as the same denomination.

5.3 Whilst a degree of flexibility is appropriate, the following non-exhaustive list may assist the authorities in deciding what is unsuitable. A proposed denomination may be refused by an authority of a member if it transpires that, despite best endeavors (see section 5.5), in its territory

(a) it does not conform to the provisions in paragraphs (2) and (4); or

(b) it is contrary to public policy.

5.4 In order to permit the correct identification of a variety registered with different denominations due to exceptional cases (see section 5.3 above), in different territories, a regional or international synonym register may be developed by UPOV and/or by some members of the Union.

5.5 To reduce the risk of a variety denomination being considered to be unsuitable within a territory in which protection is to be sought, members of the Union are encouraged to make available to other authorities and breeders, the criteria, guidance and best practices which they apply for variety denominations. In particular, authorities are encouraged to make available any electronic search functions which they use in the examination of denominations in a form which would allow the on-line checking of a proposed variety denomination, against databases of relevant varieties and, in particular, the UPOV Plant Variety Database. Members of the Union may also choose to provide customized variety denomination checking services. Members of the Union are encouraged to use the UPOV website to provide information on, and links to, such resources.

Proposal by New Zealand^b

Paragraph 5

The principle of one denomination per variety worldwide should not be diminished however it could be helpful to provide guidance for an approved approach where two denominations exist. Such guidance goes against Article 20(5), the principle of a single denomination, but unfortunately this does occur all too frequently. Should an authority following a number of other denomination proposals or approvals for earlier foreign applications, accept the first approved denomination or accept the most common denomination?

Paragraph 6

[Information among the authorities of members of the Union] The authority of a member of the Union shall ensure that the authorities of all the other members of the Union are informed of matters concerning variety denominations, in particular the submission, registration and cancellation of denominations. Any authority may address its observations, if any, on the registration of a denomination to the authority which communicated that denomination.

Explanatory Notes – Paragraph (6)

6.1 Provisions of paragraph (6) indicate the importance of cooperation and exchange of information among authorities.

6.2 The obligation to inform other members of the Union of matters concerning variety denominations relies on the exchange of official gazettes and other means of publication. It is recommended that the layout of the official gazette be based on the UPOV Model Plant Breeder's Right Gazette (document UPOV/INF/5), in particular, the chapters containing information on variety denominations, should be appropriately identified in the table of contents. However, the UPOV Plant Variety Database is an important mechanism by which to maximize the availability of information for members of the Union concerning variety denominations in a practical form.

6.3 Paragraph (6) provides for the possibility for a member of the Union to make observations if it considers that a proposed denomination in another member of the Union is unsuitable. In particular with respect to the provisions of paragraph (5), the authority should take into account all observations made by the authorities of other members when deciding on the suitability of a proposed denomination. If the observations refer to an obstacle for approval which, according to the provisions on variety denominations under the UPOV Convention, applies to all members, then the proposed denomination should be refused. If the observation refers to an obstacle to approval only in the member of the Union which has transmitted the observation (e.g. prior trademark right within that territory), the applicant should be informed accordingly. If it is envisaged that protection will be applied for, or if it can be expected that reproductive or propagating material of the variety will be marketed in the territory of the member of the Union which has transmitted the observation, the authority examining the proposed denomination should request the applicant to propose another denomination.

6.4 The authorities making observations and the authority conducting the examination should, as far as possible, endeavor to reach an agreement on the acceptability of a variety denomination.

6.5 It is recommended that a communication of the final decision be addressed to any authority which has transmitted an observation.

6.6 Authorities are encouraged to send information on variety denominations to authorities dealing with the protection of other rights (e.g. authorities responsible for registering trademarks).

6.7 A model form for observations on proposed denominations submitted in another member of the Union can be seen in Annex II. A model form for a reply to observations can be seen in Annex III. Copies of these communications should be sent at the same time to the authorities of the other members of the Union.

Proposal by New Zealand^b

Paragraph 6

The current explanatory notes are correct in a broad sense with cooperation and exchange of information still of importance, but do not reflect current operational practice for many authorities. PLUTO and in the future similarity search tools are now the key resources and not structured observation or notification between authorities. Journals and Gazette remain important for legal publication requirements however their role in informing about denominations between authorities has decreased.

Paragraph 7

[Obligation to use the denomination] Any person who, within the territory of one of the members of the Union, offers for sale or markets propagating material of a variety protected within the said territory shall be obliged to use the denomination of that variety, even after the expiration of the breeder's right in that variety, except where, in accordance with the provisions of paragraph (4), prior rights prevent such use.

Explanatory Note – Paragraph (7)

7.1 If it is found that prior rights of a third party prevent the use of the registered variety denomination, the authority shall require the breeder to submit another denomination. Article 22(1)(b)(iii) of the 1991 Act provides that the breeder's right may be cancelled if "the breeder does not propose, where the denomination of the variety is cancelled after the grant of the right, another suitable denomination."

7.2 The following items provide guidance in relation to changes of registered variety denominations:

(a) The UPOV Convention requires a change of the registered denomination where the denomination of the variety is cancelled after the grant of the right. The competent authority should cancel a variety denomination if:

(i) by reason of a prior right, the use of the denomination of a variety is forbidden to a person who, in accordance with the provisions of paragraph (7), is obliged to use it (see paragraph (4) "Prior rights of third persons");

(ii) the denomination is unsuitable because it is contrary to the provisions in paragraph (2) "Characteristics of the denomination";

(b) In cases where the registered denomination is subsequently refused in another member of the Union because it is unsuitable in that territory (e.g. prior right), at the request of the breeder, the authority may consider it appropriate to change the denomination to the denomination registered in the said other member of the Union (see provisions in paragraph (5) "Same denomination in all Contracting Parties"); and

(c) In general, subject to (a) and (b) above, it would not be appropriate for the authority to change a registered denomination following a request by the breeder.^h

Paragraph 8

[Indications used in association with denominations] When a variety is offered for sale or marketed, it shall be permitted to associate a trademark, trade name or other similar indication with a registered variety denomination. If such an indication is so associated, the denomination must nevertheless be easily recognizable.

This provision is self-explanatory.

Proposal by New Zealand^b

Paragraph 8

Explanatory notes could be helpful because commercial synonyms often become the effective variety identifier. Commercial synonyms, other than registered trademarks, have no legal standing and are not covered by UPOV guidance, but there are many examples where protected varieties effectively have two names, but only one being the approved denomination. UPOV guidance should resemble practical reality and further elaboration should be considered.

[Annexes follow]

ANNEX I

UPOV Variety Denomination Classes:A Variety Denomination Should not be Used More than Once in the Same Class

For the purposes of providing guidance on the third and fourth sentences of paragraph 2 of Article 20 of the 1991 Act and of Article 13 of the 1978 Act and the 1961 Convention, variety denomination classes have been developed. A variety denomination should not be used more than once in the same class. The classes have been developed such that the botanical taxa within the same class are considered to be closely related and/or liable to mislead or to cause confusion concerning the identity of the variety.

The variety denomination classes are as follows:

(a) General Rule (one genus / one class): for genera and species not covered by the List of Classes in this Annex, a genus is considered to be a class;

(b) Exceptions to the General Rule (list of classes):

- (i) classes within a genus: List of classes in this Annex: Part I;
- (ii) classes encompassing more than one genus: List of classes in this Annex: Part II.

LIST OF CLASSES

Part I*Classes within a genus*

	<u>Botanical names</u>	<u>UPOV codes</u>
Class 1.1	Brassica oleracea	BRASS_OLE
Class 1.2	Brassica other than Brassica oleracea	other than BRASS_OLE
Class 2.1	Beta vulgaris L. var. alba DC., Beta vulgaris L. var. altissima	BETAA_VUL_GVA; BETAA_VUL_GVS
Class 2.2	Beta vulgaris ssp. vulgaris var. conditiva Alef. (syn.: B. vulgaris L. var. rubra L.), B. vulgaris L. var. cicla L., B. vulgaris L. ssp. vulgaris var. vulgaris	BETAA_VUL_GVC; BETAA_VUL_GVF
Class 2.3	Beta other than classes 2.1 and 2.2.	other than classes 2.1 and 2.2
Class 3.1	Cucumis sativus	CUCUM_SAT
Class 3.2	Cucumis melo	CUCUM_MEL
Class 3.3	Cucumis other than classes 3.1 and 3.2	other than classes 3.1 and 3.2
Class 4.1	Solanum tuberosum L.	SOLAN_TUB
Class 4.2	Tomato & Tomato rootstocks	
	Solanum lycopersicum L. (synonym: Lycopersicon esculentum Mill.)	SOLAN_LYC
	Solanum cheesmaniae (L. Ridley) Fosberg (Lycopersicon cheesmaniae L. Riley)	SOLAN_CHE
	Solanum chilense (Dunal) Reiche (Lycopersicon chilense Dunal)	SOLAN_CHI
	Solanum chmielewskii (C.M. Rick et al.) D.M. Spooner et al. (Lycopersicon chmielewskii C. M. Rick et al.)	SOLAN_CHM

	<u>Botanical names</u>	<u>UPOV codes</u>
	Solanum galapagense S.C. Darwin & Peralta (Lycopersicon cheesmaniae f. minor (Hook. f.) C. H. Müll.) (Lycopersicon cheesmaniae var. minor (Hook. f.) D. M. Porter)	SOLAN_GAL
	Solanum habrochaites S. Knapp & D.M. Spooner (Lycopersicon agrimoniifolium Dunal) (Lycopersicon hirsutum Dunal) (Lycopersicon hirsutum f. glabratum C. H. Müll.)	SOLAN_HAB
	Solanum pennellii Correll (Lycopersicon pennellii (Correll) D'Arcy)	SOLAN_PEN
	Solanum peruvianum L. (Lycopersicon dentatum Dunal) (Lycopersicon peruvianum (L.) Mill.)	SOLAN_PER
	Solanum pimpinellifolium L. (Lycopersicon pimpinellifolium (L.) Mill.) (Lycopersicon racemigerum Lange)	SOLAN_PIM
	and hybrids between those species	
Class 4.3	Solanum melongena L.	SOLAN_MEL
Class 4.4	Solanum other than classes 4.1, 4.2 and 4.3	other than classes 4.1, 4.2 and 4.3

LIST OF CLASSES (Continuation)

Part II*Classes encompassing more than one genus*

	<u>Botanical names</u>	<u>UPOV codes</u>
Class 201	Secale, Triticale, Triticum	SECAL; TRITL; TRITI
Class 202	Megathyrsus, Panicum, Setaria, Steinchisma	MEGAT; PANIC; SETAR; STEIN
Class 203*	Agrostis, Dactylis, Festuca, Festulolium, Lolium, Phalaris, Phleum and Poa	AGROS; DCTLS; FESTU; FESTL; LOLIU; PHALR; PHLEU; POAAA
Class 204*	Lotus, Medicago, Ornithopus, Onobrychis, Trifolium	LOTUS; MEDIC; ORNTP; ONOBR; TRFOL
Class 205	Cichorium, Lactuca	CICHO; LACTU
Class 206	Petunia and Calibrachoa	PETUN; CALIB
Class 207	Chrysanthemum and Ajanía	CHRY5; AJANI
Class 208	(Statice) Goniolimon, Limonium, Psylliostachys	GONIO; LIMON; PSYLL
Class 209	(Waxflower) Chamelaucium, Verticordia	CHMLC; VERTI; VECHM
Class 210	Jamesbrittenia and Sutera	JAMES; SUTER
Class 211	(Mushrooms) Agaricus Agrocybe Auricularia Dictyophora Flammulina Ganoderma Grifola Hericium Hypsizigus Lentinula Lepista Lyophyllum Meripilus Mycoleptodonoides Naematoloma Panellus Pholiota Pleurotus Polyporus Sparassis Tricholoma	AGARI AGROC AURIC DICTP FLAMM GANOD GRIFO HERIC HYP5I LENTI LEPIS LYOPH MERIP MYCOL NAEMA PANEL PHLIO PLEUR POLYO SPARA MACRO
Class 212	Verbena L. and Glandularia J. F. Gmel.	VERBE; GLAND
Class 213	Eupatorium L. Acanthostyles R. M. King & H. Rob. Ageratina Spach Asplundianthus R. M. King & H. Rob. Bartlettina R. M. King & H. Rob. Campuloclinium DC. Chromolaena DC. Conoclinium DC. Cronquistianthus R. M. King & H. Rob. Eutrochium Raf. Fleischmannia Sch. Bip. Praxelis Cass. Vioreckia R. M. King & H. Rob.	EUPAT - AGERT - - - - - - - EUTRO - - -

[Annex II follows]

* Classes 203 and 204 are not solely established on the basis of closely related species.

ANNEX II

Model Form for Observations on Proposed Variety Denominations Submitted
to Another Member of the Union

From:

Your ref.

Our ref.

Observations on a Submitted Variety Denomination

To:

Submitted Variety Denomination: _____

Genus/Species (Botanical name): _____ UPOV Code: _____

Gazette: _____
(number/year)

Applicant: _____

Observations: _____

If the observations refer to a trademark or another right, name and address of the holder thereof (if possible):

Copies sent to the authorities of the other members of the Union

Date: _____ Signature: _____

[Annex III follows]

ANNEX II

Model Reply to Observations on Proposed Variety Denominations
Submitted to Another Member of the Union

From:

Your ref.

Our ref.

Reply to Observations on a Submitted Variety Denomination

To:

In reply to your objection to the denomination [.....] for the variety of [Botanical name/UPOV code], we wish to inform you that:

1. ☐ In our opinion there is sufficient difference between the names and both in writing and pronunciation. Therefore the [authority] sees no reason to reject the denomination.
2. ☐ The [authority] accepted this denomination and no objections were received during the prescribed period after publishing.
3. ☐ This variety has been registered under this name on
4. ☐ First publication as proposed denomination in
5. ☐ The applicant has been requested for another denomination.
6. ☐ This is the same variety.
7. ☐ Application on the variety has been withdrawn/rejected.
8. ☐ The applicant has withdrawn the proposed denomination for the variety.
9. ☐ Other

Copies sent to the authorities of the other members of the Union

Date: _____

Signature: _____

[End of Annex III and of document]

Endnotes

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- ^a Proposal by the European Union (CPVO) in reply to UPOV circular E-15/276 of December 3, 2015 (see document CAJ/72/9 "Report", paragraph 23 (d))
- ^b Proposal by New Zealand in reply to UPOV circular E-15/276 of December 3, 2015 (see document CAJ/72/9 "Report", paragraph 23 (d))
- ^c Proposal by WG-DST at its second meeting held in Geneva, on June 9, 2015 (see document CAJ/72/9 "Report", paragraph 23 (d))
- ^d Proposal by CAJ-AG at its ninth session held in Geneva, on October 14 and 17, 2014 (see document CAJ/72/9 "Report", paragraph 23 (d))
- ^e Proposal by ESA/ISF in reply to UPOV Circular E-15/276 of December 3, 2015 (see document CAJ/72/9 "Report", paragraph 23 (d))
- ^f See document UPOV/WG-DEN/1/4 "Expansion of the content of PLUTO Database".
- ^g Proposal by CAJ-AG based on an initial proposal by ESA of June 25, 2014 and submitted by ESA in the reply to UPOV Circular E-15/276 of December 3, 2015 (see document CAJ/72/9 "Report", paragraph 23 (d))
- ^h In reply to UPOV Circular E-15/276 of December 3, 2015, ESA made the following comment on a proposed text for Section 7.2 (c) made by APBEBES to the CAJ-AG on October 24, 2014:
- "Under point 7.2 (c) a proposal from Apbrebes has been inserted. In general, we believe that the scenario described by point 7.2 (c) would be very seldom since points (a) and (b) already cover the scenarios in which normally a breeder would request a change of the denomination. Further on, we do not fully understand whether the last sentence of the proposal (starting with "If the denomination is changed...") refers only to a change under point (c) or would also apply to points (a) and (b). If this would be the case, we would like to point out that it would not be possible to continue to mention the old name next to the new name since under (a) this would still constitute an infringement of the trademark and under (b) the breeder would certainly not want to continue mentioning a name next to the new name which may be offensive for example."
- The proposed text by APBEBES was not retained in the version adopted by the Council in October 29, 2015. Therefore, the above comment made by ESA is not relevant for the present text of Section 7.2 (c).