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WORKING GROUP ON VARIETY DENOMINATION

First Meeting
Geneva, March 18, 2016

REVISION OF DOCUMENT UPOV/INF/12/5 "EXPLANATORY NOTES ON VARIETY DENOMINATIONS
 UNDER THE UPOV CONVENTION"

Document prepared by the Office of the Union

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EXECUTIVE SUMMARY

1. The purpose of this document is to provide background information to assist the Working Group on Variety Denominations (WG-DEN) in its consideration of the proposals for a revision of document UPOV/INF/12/5 "Explanatory Notes on Variety Denominations under the UPOV Convention" (see document UPOV/INF/12/6 Draft 1).

2. The WG-DEN is invited to:

(a) note the developments reported in this document; and

(b) consider the proposals for the revision of document UPOV/INF/12/5 "Explanatory Notes on Variety Denominations under the UPOV Convention" as set out in document UPOV/INF/12/6 Draft1.

3. The structure of this document is as follows:

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4. The following abbreviations are used in this document:

CAJ: Administrative and Legal Committee

CAJ-AG: Administrative and Legal Committee Advisory Group

WG-DST: Working Group for Variety Denomination Search Tool

WG-DEN: Working Group on Denomination

BACKGROUND

5. The Administrative and Legal Committee (CAJ), at its seventy-second session, held in Geneva, on October 26 and 27, 2015, agreed the following next steps for the revision of the “Explanatory Notes on Variety Denominations under the UPOV Convention” (see document CAJ/72/9 “Report on the Conclusions”, paragraph 23):

“(a) to expand the mandate and the composition of the Working Group for the Development of a UPOV Denomination Similarity Search Tool (WG-DST) to prepare recommendations for the CAJ concerning the revision of document UPOV/INF/12 “Explanatory Notes on Variety Denominations under the UPOV Convention” (Working Group on Variety Denominations (WG-DEN));

(b) the Office of the Union to issue a circular with a request to CAJ members and observers to participate in the WG-DEN and, if appropriate, to present proposals for revisions of document UPOV/INF/12, by January 20, 2016;

(c) the WG-DEN to meet during the week of the UPOV sessions in March 2016;

(d) the WG-DEN to consider the proposals received in response to the circular in paragraph (b) above and the proposals in paragraphs 28 to 37 and 41 of document CAJ/72/3 in conjunction with the work on the development of an effective UPOV similarity search tool;

(e) the WG-DEN to consider proposals for the expansion of the content of PLUTO database to include all recognized varieties, including those that had not been, or were no longer, registered/protected (see document CAJ/72/6 “UPOV Information Databases”, paragraph 38).”

6. On December 3, 2015, the Office of the Union issued Circular E-15/276 “Working Group on Variety Denominations (WG-DEN)” to CAJ members and observers with an invitation to express interest to participate in the WG-DEN and, if appropriate, to present proposals for revisions of document UPOV/INF/12, by January 20, 2016.

7. On the basis of the replies to Circular E-15/276, combined with the existing members of the WG-DST, the composition of the WG-DEN is as follows: Australia, Chile, China, Croatia, European Union, France, Japan, Netherlands, New Zealand, South Africa, Spain, United States of America, European Seed Association (ESA) and the International Seed Federation (ISF).

8. On February 23, 2016, the Office of the Union issued an *ad hoc* invitation to the International Commission for the Nomenclature of Cultivated Plants of the International Union for Biological Sciences (IUBS Commission) to participate in the WG-DEN. The IUBS Commission is responsible for the revision of the International Code of Nomenclature for Cultivated Plants (ICNCP).

PROPOSALS FOR THE REVISION OF DOCUMENT UPOV/INF/12/5 “EXPLANATORY NOTES ON VARIETY DENOMINATIONS UNDER THE UPOV CONVENTION” (DOCUMENT UPOV/INF/12/6 DRAFT 1)

9. The CAJ, at its seventy-second session, agreed that the WG-DEN, at its first meeting, should consider the proposals received in response to the Circular E-15/276 and the proposals in paragraphs 28 to 37 and 41 of document CAJ/72/3 in conjunction with the work on the development of an effective UPOV similarity search tool (see paragraph 5). Proposals in paragraphs 28 to 37 and 41 of document CAJ/72/3 have been introduced in highlighted boxes in the relevant sections of document UPOV/INF/12/6 Draft 1 for consideration by the WG-DEN, at its first meeting.

10. In reply to Circular E-15/276, the Office of the Union received comments from the Community Plant Variety Office of the European Union (CPVO), New Zealand, and joint comments from the European Seed Association (ESA) and the International Seed Federation (ISF). The comments of the CPVO, New Zealand, ESA and ISF are presented in Annexes I to III to this document, respectively. In addition, the comments received have been introduced in highlighted boxes in the relevant sections of document UPOV/INF/12/6 Draft 1 for consideration by the WG-DEN, at its first meeting.

11. The *ad hoc* invitation to the IUBS Commission contained an invitation to submit proposals for a revision of document UPOV/INF/12/5 by March 4, 2016. No proposals had been received from the IUBS Commission by March 11, 2016.

12. *The WG-DEN is invited to:*

(a) note the developments reported in this document; and

(b) consider the proposals for the revision of document UPOV/INF/12/5 “Explanatory Notes on Variety Denominations under the UPOV Convention” as set out in document UPOV/INF/12/6 Draft 1.

[Annexes follow]

ANNEX I

COMMENTS FROM THE COMMUNITY PLANT VARIETY OFFICE OF THE EUROPEAN UNION

Please find underneath the first CPVO reaction concerning the revision of document UPOV INF/12/5.

We would like to welcome the initiative taken by UPOV to revise the “Explanatory notes on variety denominations under the UPOV convention” (doc. INF/12/5) and the invitation addressed to the CPVO to make comments and suggestions in the frame of such procedure. It happens that the CPVO has also initiated a revision of its own guidelines and explanatory notes on variety denominations, as the UPOV Secretariat has been informed. For this reason our contribution for the revision of the UPOV document INF/12/5, will be limited to comments of more general nature, since we don't know yet the modifications that will be made to our actual guidelines on variety denominations. We are finalizing a draft proposal to be discussed in the first meeting of the CPVO working group that will meet on the 30th March and for which UPOV will be invited. We are planning to send this draft to the participants of the CPVO working group in the first half of February, including the UPOV Office.

CPVO comments to UPOV doc. INF/12/5

We consider that some parts of the document could be more detailed and clear in order to provide a better guidance to the authorities taking decisions on variety denominations (VD). The advantage would be to achieve a higher degree of harmonisation in the rules used for the assessment of proposed VD, aiming to reduce the number of situations leading to the creation of synonyms due to a refusal by non-compliance of the original VD with the rules on VDs adopted by authorities in UPOV member states. We also think that more examples could be provided in order to better illustrate the different criteria used in the assessment of VDs. The CPVO is also aware that there must be a balance between the level of details and various practices in the UPOV world.

We'll refer now to some paragraphs that we think could benefit from such amendments:

Paragraph 2

1. The CPVO is of the opinion that it would be important to mention the difference between fancy names and codes;
2. This paragraph should provide more detailed guidance in section 2.3.1 dealing with “characteristics of the variety” and provide clear examples of suitable and non-suitable proposals for VDs;
3. 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;
4. To include a section providing guidance on the assessment of similarity of VDs consisting of “first names”;
5. More detailed guidance and examples in the section 2.3.2 dealing with the value of the variety;
6. 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;
7. 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.

(Articles 3, 4 & 7 of the CPVO Guidelines on variety denominations provide some more detailed guidance on this subjects)

Paragraph 4

In 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).

This are the comments that we think are opportune to submit for the time being. In case of interest the CPVO could prepare a presentation for the meeting of UPOV working group on the 18th March, providing some concrete examples showing the interest of a more clear guidance in some paragraphs of the document INF/12/5.

[Annex II follows]

ANNEX II

COMMENTS FROM NEW ZEALAND

NZ proposals for consideration by the WG-DEN

1. Confirm the proposal already stated in CAJ/72/3 Paragraph 26

In addition CAJ/72/3 paragraphs 31 and 32 require further consideration.

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 stated in para 31. We should not have *Malus* variety 'Apple', *Carex* variety 'Sedge'. This is also consistent with ICNCP 19.23

Para 32 should read "The WG-DST agreed that 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".²³

This is also consistent with ICNCP 19.24

Current 32 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'

Revision of UPOV/INF/12/5

2. Paragraph Two

Examples under 2.1 Identification now includes the use of Genus or species prefixes *Agapanthus* 'Agapetite', Lavender 'Lavang12'

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) 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.

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 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 (a)(ii) Consider whether this exemption should continue from the general recommendation 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

Agree with proposed new wording in CAJ/72/3 para 33

2.3.3 d) + CAJ/72/3 para 37 The reuse of denominations should be possible for genera that require on going 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.

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'

2.5.1 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."

3. 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?

4. 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.

5. 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.

[Annex III follows]

ANNEX III

COMMENTS FROM THE EUROPEAN SEED ASSOCIATION (ESA)
AND THE INTERNATIONAL SEED FEDERATION (ISF)

In response to the UPOV circular mentioned in the subject of the present letter the European Seed Association and the International Seed Federation nominated one joint representative in the person of Mrs. Astrid Schenkeveld to represent the positions of both organizations in the UPOV Working Group on Variety Denominations (WG-DEN). By the present letter we wish to submit our joint comments on documents UPOV/INF/12/5 Draft 2 and CAJ/72/3 for consideration by the WG-DEN at its meeting scheduled for Friday, March 18, 2016.

Comments on document UPOV/INF/12/5 Draft 2:

- Point 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.”
- Point 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).
- In point 2.3.3. (b) we 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”.
- Point 2.3.3 (b) (iii) 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.
- In point 2.3.3 (d) we propose to mention 10 years as an example of suitable period. This is what is indicated in the CPVO guidelines on variety denominations.
- We understand that point 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.
- In 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.
- In point 4(a) the first sentence of this point seems to suggest that prior rights can only be intellectual property rights (“*under plant breeder’s rights law, trademark law or any other intellectual property legislation*”). This is however not necessarily the case. For example trade names can be prior rights but they are not considered to be IP rights under all national legislations. In point (e) of this same point 4 there are examples of prior rights given where also trade names are mentioned (sub (iii)). This, in our view, is correct but may be inconsistent with what is stated under point (a). Therefore we propose to delete the mentioned sentence under point (a) and instead refer only to the list of examples in point (e).

- In point 4(e) sub point (i) the last sentence reads: “*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.*” In trademark law the commonly used terminology is “likelihood of **confusion**” therefore we propose to also use “likelihood of confusion” here instead of “likelihood of association”.
- Under point 7.2 (c) a proposal from Aprebes 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.
- ESA has already commented on UPOV/INF/12/5 Draft 1 in June 2014 and those comments have been incorporated in document UPOV/ONF/12/5 Draft 2. However, we would like to retain only the comments as outlined here above.

Comments on document CAJ/72/3 Variety Denominations:

- In paragraphs 19 to 21 the idea to develop a list of non-acceptable terms is discussed. In principle we are of the view that it will be very difficult to define such a list and in the event that this exercise is in the end pursued, we believe that it should be made very clear that such list is only providing some examples but cannot be interpreted as an exhaustive list.
- In paragraph 20 and in paragraph 22(b) of the Report on the conclusions of the UPOV CAJ session in October 2015 (CAJ/72/9) it is noted that it is proposed to consider botanical and common names as non-acceptable terms. In this respect we would like to reiterate our comment regarding point 2.3.1 (d) of UPOV/INF/12/5 Draft 2 as outlined above.
- In paragraph 37 it is proposed that re-use of denominations should be avoided in all cases. So far, point 2.3.3. (d) of UPOV/INF/12/5 Draft 2 states that in certain cases after a certain period of time such re-use should be possible. Further on, in the same paragraph it is also 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.

[End of Annex III and of document]