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## INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

## ADMINISTRATIVE AND LEGAL COMMITTEE

## First Session

Geneva, April 17 to 19, 1978

## ARTICLE 13 OF THE UPOV CONVENTION

Memorandum by the Secretary-GeneralBackground

1. In its eleventh ordinary session (December 1977), the Council of UPOV discussed the question of the amendments that should be proposed for Article 13--dealing with the denominations of new varieties of plants--of the UPOV Convention in preparation for the Diplomatic Conference on the revision of that Convention, scheduled for October 1978. The discussions have been recorded in the report adopted by the Council, and the relevant passages of that report are annexed to this document (Annex I).

2. In concluding its discussions, the Council decided that "the proposed new text [that is, the text whose distribution--in preparation for the Diplomatic Conference--was decided by the Council in its December 1977 session] should be included in the preparatory document to be distributed but a footnote should indicate that other proposals for amendments of that Article might follow [this was done: see document DC/3, page 31; the text is reproduced in Annex II to this document]" and that "the Administrative and Legal Committee should re-examine the question of Article 13 on the basis of the proposal from the Federal Republic of Germany... [the text of this proposal is reproduced in Annex III to this document], a draft to be prepared by the Secretary-General (which would attempt a far-reaching simplification of the Article) and any other proposal which others might make in the meantime..." (document C/XI/21, paragraph 36; emphasis added).

Proposed New Draft for Article 13

3. The Secretary-General proposes that Article 13 should read as follows:

"Article 13"Denomination of the Variety

"(1) The breeder shall, before the issuance of the title of protection for the variety, submit, to the authority referred to in Article 30(1)(b) of each State in which he seeks protection, the denomination of the variety. That authority shall, subject to paragraph (3), register the denomination and indicate it in the title of protection issued by it.

"(2)(a) The denomination submitted must have the power to distinguish. [It shall not consist solely of figures.]

"(b) The denomination shall be neither misleading nor confusing. [In particular, it shall not be liable to mislead or cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder and it shall not be the same as or similar to denominations already registered or in current use for other varieties of the same or a closely related botanical species.]

"(3) The breeder shall submit the same denomination for the purposes of all the member States of the Union in which he seeks protection, provided that, if the authority referred to in Article 30(1)(b) of any such State finds that the denomination does not meet the requirements mentioned in paragraph (2), or that it is unsuitable or that its use would be unlawful in that State, such authority shall require the applicant to submit, for the purposes of the said State, a different denomination meeting the said requirements.

"(4) The breeder and any person acting on his behalf shall be obliged to use the denomination when he offers for sale or markets reproductive or vegetative propagating material of the variety. If such use would infringe prior rights in any member State of the Union, the authority referred to in Article 30(1)(b) of that State shall require the breeder to submit, for the purposes of the said State, a different denomination.

"(5) Each member State of the Union shall provide in its national law for the consequences of non-compliance with the requirements provided for in paragraphs (1) to (4)."

4. The above proposal is, to some extent, inspired by the views expressed by the Delegation of France in the December 1977 session of the Council when that Delegation said that "what was important was that the Convention should express that any given variety must have the same denomination in all member States and that the denomination must be neither confusing nor misleading" (document C/XI/21, paragraph 32). The proposal follows both these suggestions. It follows also the views of the Delegation of France when it said that "it might well be that all references to trademarks could be omitted in Article 13" (document C/XI/21, paragraph 32). (Indeed, it is believed that one of the major difficulties that the present Article 13 causes arises from the fact that a treaty dealing with the law of plant breeders' rights imposes obligations on countries in the field of the law of trademarks.)

Explanations of the Various Provisions Proposed

5. Ad paragraph (1). The "authority referred to in Article 30(1)(b)" is either the "special authority for the protection of new varieties of plants" or the "existing authority" to which the protection of new varieties of plants is "entrusted." Since it is not unusual for the indication of the denomination not to be made in the application itself but only later, even just shortly before the issuance of the title of protection, the proposal requires that the applicant indicate the denomination only "before the issuance of the title of the protection."

6. Ad paragraph (2). The first sentence of subparagraph (a) uses the expression "power to distinguish" since what is believed to be the intention is that the denomination should be something that is pungent, expressive, pregnant, rich in meaning, easily remembered (has an "Unterscheidungskraft"). The second sentence-- "It shall not consist solely of figures"--is placed between square brackets because of the well-known difficulties which certain States encounter in complying with this prohibition because of existing practices. However, these difficulties would be solved, albeit only for future member States (and only for some of them), thanks to Article 36A of the proposed new text of the Convention (see document DC/3), which allows them to admit denominations consisting solely of figures. Naturally, if the sentence between square brackets in the proposal were not adopted, Article 36A could be omitted. In subparagraph (b), the sentence within square brackets does not seem indispensable since its nature is merely explanatory. What it provides for could appear in the records of the Diplomatic Conference rather than in the text itself of the Convention.

7. Ad paragraph (3). The fact that the denomination, in a given State, would be misleading, confusing, "unsuitable" or unlawful may be noted by the authority sua sponte or may be brought to the attention of that authority by the applicant himself (or, particularly in States in which the application is published, by third persons). A denomination would, in particular, be "unlawful" where its use would be in violation of "prior rights" of third parties in their trademarks, trade names and the like. A denomination which offends public order or morality would also be unlawful or at least "unsuitable."

8. Ad paragraph (4). Persons acting on behalf of the breeder would be persons (including legal entities) who advertise, sell, etc., the propagating material with the authorization of the breeder. (The second sentence of this provision is inspired by the provision contained in paragraph (7), in fine, and the second sentence of paragraph (10), of the present text.)

9. Ad paragraph (5). The proposal obliges the member States to provide for sanctions but leaves it to the national law of each State to decide what such sanctions should consist of. The consequences may include the refusal of the grant of the title of protection and fines. Because of Article 10(4), they could not include the cancellation of the title of protection (unless Article 10(4) were amended accordingly).

Some Comparisons Between the Present Text of Article 13 and the Present Proposal

10. Ad paragraph (1) of the present text. This paragraph provides that "a new variety shall be given a denomination." It does not say when and by whom. Paragraph (1) of the proposal specifies when and by whom a denomination must be given.

11. Ad paragraph (2) of the present text. This paragraph provides that the denomination "must enable the new variety to be identified." The proposal avoids the use of the expression "to identify" since that expression might give the-- false--impression that there must be something in the denomination which describes the variety. Otherwise, how could the denomination "identify" the variety? But, in actual fact, most denominations are non-descriptive.

12. As to the question of denominations consisting solely of figures, see the observations made in paragraph 6 above.

13. Paragraph (2) of the present text also provides that the denomination must not be liable to mislead, etc. Paragraph (2)(b) of the proposal is, in this respect, very similar to the existing text.

14. Ad paragraph (3) of the present text. This provision is not taken over in the proposal because it deals with questions concerning the law of trademarks. Naturally, it is not legally impossible to oblige member States to adjust their trademark laws to the requirements of a treaty on plant breeders' rights; however, in practice, it is quite difficult to put into motion the necessary procedures for modifying national trademark laws, and international obligations under treaties dealing with trademarks, only in order to conform with the UPOV Convention.

15. Ad paragraph (4) of the present text. It is believed that everything that is essential in this paragraph is covered, explicitly or implicitly, by paragraphs (1) and (3) of the proposal.

16. Ad paragraph (5) of the present text. It is believed that everything that is essential in this paragraph is covered by paragraph (3) of the proposal.

17. Ad paragraph (6) of the present text. This provision has been omitted in the proposal since it remained, for all practical purposes, a dead letter in actual practice. However, the system provided for in this paragraph seems to serve a useful purpose, and, if the member States intend to put it into practice, it should be maintained, perhaps with some slight modifications.

18. Ad paragraph (7) of the present text. The basic idea of this provision--namely, that the denomination must be used in connection with the marketing of the propagating material of the variety--has been retained in the proposal (see paragraph (4) of the proposal). However, in respect of certain details the proposal is less ambitious. First, the proposal prescribes the obligation to use only for the protected breeder and persons acting on his behalf and not also in respect of persons--"any person in a member State of the Union"--unrelated to the breeder. It is believed that a Convention for the protection of the rights of plant breeders should give rights to and impose limitations only on breeders and persons over whom the breeders have control. It is recognized that it is in the public interest--particularly for "consumer protection"--that the denomination be used even where the breeder has no longer legal control over the propagating material. But it is also believed that this is a matter for laws (or treaties) dealing with the marketing of seeds, etc., and/or consumer protection, and not for a treaty dealing with the rights of breeders. As in the case of trademarks, it may cause practical difficulties if countries have to adjust their laws on seed marketing or consumer protection only in order to enable them to accede to the UPOV Convention. But, of course, there is nothing in the proposal which would prevent any member State from providing, even in its legislation on plant breeders' rights, stricter rules, such as those called for by the present text of Article 13, including in particular paragraph (7) thereof. Second, the present text prescribes the use of the denomination "even after the expiration of the protection" of the new variety, that is, ad perpetuum, or, in practice, as long as the variety is marketed. Here, too, the concept seems to have nothing to do with the rights of the breeder (which are limited in time) but comes from considerations of seed marketing and consumer protection. For the reasons already stated, it is therefore believed that the provision in question does not belong in the UPOV Convention. Third, the present text provides that the obligation to use the denomination does not apply where "prior rights...prevent such use." The essence of this provision, as far as it relates to the breeder or persons acting under his authority, is covered by the second sentence of paragraph (4) of the proposal.

19. Ad paragraph (8) of the present text. Subparagraph (a) of this paragraph provides, in essence, that a denomination protected in one member State may not be used, in any member State, as the denomination of another variety of the same or a closely related botanical species. If the latter variety is the subject of an application for protection, the provision seems to be superfluous since the denomination would be confusing and misleading and its registration prohibited. In all other cases, the prohibition would be justified on considerations of consumer protection, seed marketing or unfair competition, but not on the basis of considerations of protection for a breeder (who, in order to receive plant breeders' rights, has to obtain a special title of protection). Consequently, it is believed that the UPOV Convention is not the ideal place for dealing with the matter, and the provision is omitted in the proposal.

20. Subparagraph (b) of paragraph (8) of the present text prescribes a rule whose implementation requires that the trademark law of the country be in conformity with the UPOV Convention or be brought into conformity with it. The difficulties inherent in such a requirement have been stated above (see paragraphs 14 and 18), and, because of them, the proposal does not contain a comparable provision. One of the additional difficulties, although of a similar nature, is that the present text declares that the denomination is a "generic name." In trademark law, signs or words are generic because of their inherent meaning or because of the meaning they have acquired. To declare signs or words generic by legislative fiat--here, on the sole basis that they are used in connection with plant varieties--is, to say the least, unusual.

21. Ad paragraph (9) of the present text. This paragraph provides that "it shall be permitted, in respect of the same product, to add a trade mark to the denomination of the new variety." Putting to one side the question whether a variety may be properly called a product, the provision seems to be superfluous since, in the absence of a provision prohibiting the concurrent use of a denomination and a trade mark, such concurrent use seems to be permitted. That is the reason why the proposal does not take over this provision of the present text.

22. Ad paragraph (10) of the present text. Paragraph (3) and paragraph (4), second sentence, of the proposal--when they imply that a denomination which is unlawful must be refused or changed--cover the essence of this provision. For those reasons, the proposal does not take over the said paragraph.

23. General Observation. Naturally, the proposal, if adopted, would not prevent any Contracting State (present or future) from maintaining (or introducing) legislation in conformity with the present text; in particular, a State could consider denominations as unfit for trademark registration since the proposal leaves any State free to legislate as it likes in the field of trademarks.

[Three Annexes follow]

## ANNEX I

PASSAGES RELATING TO VARIETY DENOMINATIONS IN THE REPORT ON THE  
ELEVENTH ORDINARY SESSION OF THE UPOV COUNCIL HELD IN DECEMBER 1977

[Document C/XI/21, pages 8 and 9]

.....

29. Article 13. The Council examined the proposals presented in writing by the German Federal Plant Varieties Office (reproduced in Annex II of this document).

30. Those proposals were introduced by the Delegation of the Federal Republic of Germany, which indicated that, after having consulted trademark experts, it aimed at achieving greater flexibility as far as the provisions on the relation between variety denominations and trademarks were concerned.

31. The Delegation of Denmark stated that it could conclude from previous discussions with Danish trademark experts that the latter were definitely opposed to the idea of having a variety denomination registered as a trademark, whether or not the variety denomination was used in Denmark.

32. The Delegation of France generally favored the spirit of the proposal of the Delegation of the Federal Republic of Germany. It said that Article 13 could be simplified. What was important was that the Convention should express that any given variety must have the same denomination in all member States and that the denomination must be neither confusing nor misleading. It might well be that all references to trademarks could be omitted in Article 13.

33. The Council discussed a proposal from the Delegation of the United Kingdom that in Article 13(9) (after "trademark") the words "or a trade name" be added.

34. The Delegation of the United Kingdom explained that the view had been expressed in its country that Article 13(9) permitted a trademark to be added to the variety denomination but forbade the addition of any other sign, in particular a trade name.

35. After several delegations had stated that they did not share that view, the Council agreed that the problem was to be solved by including in the Explanatory Notes and in the Records of the Diplomatic Conference an understanding that Article 13(9) did not prevent the addition to the variety denomination not only of a trademark but also of a trade name, a brand name or any other indication, name or sign.

36. In conclusion, the Council decided that

(i) the proposed new text of Article 13 should be included in the preparatory document to be distributed but a footnote should indicate that other proposals for amendments of that Article might follow;

(ii) the Administrative and Legal Committee should re-examine the question of Article 13 on the basis of the proposal from the Federal Republic of Germany (referred to above), a draft to be prepared by the Secretary-General (which would attempt a far-reaching simplification of the Article) and any other proposal which others might make in the meantime; non-member States particularly interested in the question might be invited to participate in the discussions; the Delegation of Japan added that its country was interested in that question.

[Annex II follows]

## ANNEX II

PROVISIONS RELATING TO VARIETY DENOMINATIONS IN THE PROPOSED NEW TEXT  
OF THE UPOV CONVENTION

[Annex I to document DC/3,  
pages 30 to 35 and 90 to 93]

[starting on next page]



[Annex I to document DC/3, page 30]

Explanatory Notes on Article 13

Ad paragraph (1): The only amendment proposed is to omit the word "new." For explanations, see the Explanatory Notes on Article 1(1).

Ad paragraph (2): It is proposed to omit the word "new"; for explanations, see the Explanatory Notes on Article 1(1). Furthermore, it is proposed that the expression "existing varieties" be put into the singular in view of the fact that any given denomination normally designates only one variety, and not several. Finally, it is proposed to combine both subparagraphs in one paragraph.

It is to be noted that the rule contained in this paragraph and according to which a denomination "may not consist solely of figures" may be subject to an exception, namely, where the proposed new Article 36A applies (see that Article).

Ad paragraph (3) in the present text (paragraph (4) in the new text): It is proposed to omit the words "or his successor in title" wherever they appear. For explanations, see the Explanatory Notes on Article 1(1). Furthermore, it is proposed that this paragraph be amended in two respects.

According to the present text, any applicant who wishes to use as a denomination a sign which is one of his trade marks is obliged to undertake to renounce his right to the trade mark and--if he does not comply with this obligation--he may not, as from the time of the registration of the denomination, continue to assert his right to the trade mark in respect of products identical or similar to the plant variety. It is proposed merely to provide in the Convention that the applicant be prevented, in the above-mentioned situation, from asserting his right to the trade mark in respect of the above-mentioned products. The proposed solution would simplify the procedure before the plant variety rights offices of member States since such offices would no longer be required to compel the applicant to renounce his right in a trade mark and the applicant would no longer be required to attach a declaration of renunciation to his application. The proposed solution would not, on the other hand, prevent a member State from requiring under its domestic law the renouncement of the right to the trade mark.

The other proposed amendment would be the following. The present text provides, in effect, that the applicant who continues to use the denomination as a trade mark cannot assert his right to the trade mark (as far as certain products are concerned) in any member State; the proposed new text would limit the application of this sanction to those member States in which the genus or species to which the variety in question belongs is eligible for protection. The reason for such an amendment lies in the belief that it does not seem to be justified to deprive the applicant of the rights and advantages conferred upon him by a trade mark in member States in which he is not in a position to enjoy plant variety protection because such protection is simply not available, as the national laws do not offer the possibility of protection to the genus or species in question. In such States, because of the lack of plant variety protection, breeders can neither control the sale of propagating material of their varieties nor enforce the payment of royalties for their use; in such States, they should at least not be deprived of the exercise of any rights they may derive from their trade marks when their varieties are sold under such marks.

It is proposed to interchange paragraphs (3) and (4) in the new text in view of the fact that the case treated in paragraph (3) of the present text would no longer be a reason for a national authority to refuse registering a proposed denomination.

Ad paragraph (4) in the present text (paragraph (3) in the new text): It is proposed to omit the word "new." For explanations, see the Explanatory Notes on Article 1(1). It is further proposed to put the expression "of the preceding paragraphs" into the singular, as a consequence of the proposed amendment of paragraph (3) in the present text and of the interchanging of paragraphs (3) and (4): in the new text, the proposed denomination would have to satisfy the requirements of only one paragraph (namely, paragraph (2)).

Ad paragraph (5): It is proposed to omit the word "new" and the words "or his successor in title." For explanations, see the Explanatory Notes on Article 1(1).

[Annex I to document DC/3, page 31]

[Present Text]

## Article 13

[Denomination of New Varieties of Plants]

(1) A new variety shall be given a denomination.

(2) Such denomination must enable the new variety to be identified; in particular, it may not consist solely of figures.

The denomination must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the new variety or the identity of the breeder. In particular, it must be different from every denomination which designates, in any member State of the Union, existing varieties of the same or a closely related botanical species.

(3) The breeder or his successor in title may not submit as the denomination of a new variety either a designation in respect of which he enjoys the protection, in a member State of the Union, accorded to trade marks, and which applies to products which are identical or similar within the meaning of trade mark law, or a designation liable to cause confusion with such a mark, unless he undertakes to renounce his right to the mark as from the registration of the denomination of the new variety.

If the breeder or his successor in title nevertheless submits such a denomination, he may not, as from the time when it is registered, continue to assert his right to the trade mark in respect of the above-mentioned products.

(4) The denomination of the new variety shall be submitted by the breeder or his successor in title to the authority referred to in Article 30. If it is found that such denomination does not satisfy the requirements of the preceding paragraphs, the authority shall refuse to register it and shall require the breeder or his successor in title to propose another denomination within a prescribed period. The denomination shall be registered at the same time as the title of protection is issued in accordance with the provisions of Article 7.

(5) A new variety must be submitted in member States of the Union under the same denomination. The competent authority for the issue of the title of protection in each member State of the Union shall register the denomination so submitted, unless it considers that denomination unsuitable in that State. In this case, it may require the breeder or his successor in title to submit a translation of the original denomination or another suitable denomination.

[New Text]

## Article 13 \*

Denomination of Varieties of Plants

(1) [No change, except omit the word "new."]

(2) Such denomination must enable the variety to be identified; in particular, it may not consist solely of figures. 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 any member State of the Union, an existing variety of the same or a closely related botanical species.

(4) If the breeder submits as the denomination of the variety either a designation in respect of which he enjoys the protection accorded to trade marks, and which applies to products which are identical or similar within the meaning of trade mark law, or a designation liable to cause confusion with such a mark, he may not, as from the time when it is registered, continue to assert his right to the trade mark, in respect of the above-mentioned products, in any member State of the Union applying the provisions of the Convention to the genus or species to which the variety belongs.

(3) [Same as paragraph (4) of the present text, except omit the word "new," replace "paragraphs" by "paragraph" and omit the words "or his successor in title" wherever they appear.]

(5) [No change, except omit the word "new" and the words "or his successor in title."]

\* Other proposals for amendments formulated by the competent bodies of UPOV might be distributed in preparation for the Diplomatic Conference.

[Annex I to document DC/3, page 32]

[Explanatory Notes on Article 13, continued]

Ad paragraph (6), first subparagraph, in the present text (paragraph (6) in the new text): The only amendment proposed is to omit the word "new". For explanations, see the Explanatory Notes on Article 1(1).

Ad paragraph (6), second subparagraph, in the present text (paragraph (7) in the new text): It is proposed to omit the word "new." For explanations, see the Explanatory Notes on Article 1(1). It is furthermore proposed to delete the last sentence.

Ad paragraph (7) in the present text (paragraph (8) in the new text): It is proposed to omit the word "new" in all cases in which it appears. For explanations, see the Explanatory Notes on Article 1(1). It is furthermore proposed to change the reference to paragraph (10) to a reference to paragraph (11) since the numbering of the subparagraphs has been changed in the new text.

Ad paragraph (8) in the present text (paragraph (9) in the new text): It is proposed to omit the word "new" in all cases in which it appears and the words "or his successor in title." For explanations, see the Explanatory Notes on Article 1(1).

[Annex I to document DC/3, page 33]

[Article 13, continued][Present Text]

(6) When the denomination of a new variety is submitted to the competent authority of a member State of the Union, the latter shall communicate it to the Office of the Union referred to in Article 15, which shall notify it to the competent authorities of the other member States of the Union. Any member State of the Union may address its objections, if any, through the said Office, to the State which communicated the denomination.

The competent authority of each member State of the Union shall notify each registration of the denomination of a new variety and each refusal of registration to the Office of the Union, which shall inform the competent authorities of the other member States of the Union. Registrations shall also be communicated by the Office to the member States of the Paris Union for the Protection of Industrial Property.

(7) Any person in a member State of the Union who offers for sale or markets reproductive or vegetative propagating material of a new variety shall be obliged to use the denomination of that new variety, even after the expiration of the protection of that variety, in so far as, in accordance with the provisions of paragraph (10), prior rights do not prevent such use.

(8) From the date of issue of a title of protection to a breeder or his successor in title in a member State of the Union:

(a) the denomination of the new variety may not be used, in any member State of the Union, as the denomination of another variety of the same or a closely related botanical species;

(b) the denomination of the new variety shall be regarded as the generic name for that variety. Consequently, subject to the provisions of paragraph (10), no person may, in any member State of the Union, apply for the registration of, or obtain protection as a trade mark for, a denomination identical to or liable to cause confusion with such denomination, in respect of identical or similar products within the meaning of trade mark law.

[New Text]

(6) [Same as the first subparagraph of paragraph (6) of the present text, except omit the word "new."]

(7) The competent authority of each member State of the Union shall notify each registration of the denomination of a variety and each refusal of registration to the Office of the Union, which shall inform the competent authorities of the other member States of the Union.

(8) [Same as paragraph (7) of the present text, except omit the word "new" in all cases in which it appears and change "(10)" to "(11)".]

(9) [Same as paragraph (8) of the present text, except omit the word "new" in all cases in which it appears and the words "or his successor in title."]

[Annex I to document DC/3, page 34]

[Explanatory Notes on Article 13, continued]

Ad paragraph (9) in the present text (paragraph (10) in the new text): The only amendment proposed is to omit the word "new." For explanations, see the Explanatory Notes on Article 1(1). It is understood that this paragraph permits the addition to a variety denomination not only of a trade mark, but also of other indications, names and signs such as a trade name, a brand name, etc.

Ad paragraph (10) in the present text (paragraph (11) in the new text): It is proposed to omit the word "new" in all cases in which it appears and the words "or his successor in title." For explanations, see the Explanatory Notes on Article 1(1). Furthermore, it is proposed to replace "paragraph (7)" by "paragraph (8)" and to omit the words "if need be."

[Annex I to document DC/3, page 35]

[Article 13, continued]

[Present Text]

(9) It shall be permitted, in respect of the same product, to add a trade mark to the denomination of the new variety.

(10) Prior rights of third parties in respect of signs used to distinguish their products or enterprises shall not be affected. If, by reason of a prior right, the use of the denomination of a new variety is forbidden to a person who, in accordance with the provisions of paragraph (7), is obliged to use it, the competent authority shall, if need be, require the breeder or his successor in title to submit another denomination for the new variety.

[New Text]

(10) [Same as paragraph (9) of the present text, except omit the word "new."]

(11) [Same as paragraph (10) of the present text, except omit (twice) the word "new," change "(7)" to "(8)", omit the words "if need be" and the words "or his successor in title."]

[Annex I to document DC/3, page 90]

Explanatory Notes on Article 36

Ad paragraph (1): It is proposed to omit the word "new" in the term "a new variety" and the words "or his successor in title" wherever they appear. For explanations, see the Explanatory Notes on Article 1(1).

Ad paragraph (2): It is proposed to omit the words "or his successor in title." For explanations, see the Explanatory Notes on Article 1(1).

[Annex I to document DC/3, page 91]

[Present Text]

Article 36

Transitional Rules Concerning the  
Relationship Between Variety  
Denominations and Trade Marks]

(1) If, at the date of entry into force of this Convention in respect of a member State of the Union, the breeder of a new variety protected in that State, or his successor in title, enjoys in that State the protection of the denomination of that variety as a trade mark for identical or similar products within the meaning of trade mark law, he may either renounce the protection in respect of the trade mark or submit a new denomination. If a new denomination has not been submitted within a period of six months, the breeder or his successor in title may not continue to assert his right to the trade mark for the above-mentioned products.

(2) If a new denomination is registered for the variety, the breeder or his successor in title may not prohibit the use of the previous denomination by persons obliged to use it before the entry into force of this Convention, until a period of one year has expired from the publication of the registration of the new denomination.

[New Text]

Article 36

Transitional Rules Concerning the  
Relationship Between Variety  
Denominations and Trade Marks

(1) [No change, except omit the word "new" in the term "a new variety" and the words "or his successor in title" wherever they appear.]

(2) [No change, except omit the words "or his successor in title."]



[Annex I to document DC/3, page 92]

Explanatory Notes on Article 36A

This new Article would constitute a limited exception to the rule contained in Article 13(2), which provides that no denomination may "consist solely of figures."

Ad paragraph (1): In a number of States which are interested in joining the Union, breeders are allowed to designate their varieties by a series of figures. Such denominations have become customary in those States, at least with respect to certain genera or species, and any prohibition of such practice would probably constitute, for those States, an unsurmountable obstacle to joining the Union. It is therefore proposed that such States be permitted to derogate from the above-mentioned provision of Article 13(2).

The proposed permission would be as restricted as possible. The admission of numerical denominations must be established practice and not merely sporadic or exceptional. Such practice must be established at the date of opening the revised Act for signature. This date has been preferred to the date of ratification or accession by a State in order to avoid making numerical denominations established practice between the date of opening for signature of the revised Act and the date of ratification or accession.

Ad paragraph (2): This paragraph would allow the withdrawal of the notification provided for in paragraph (1).

[Annex I to document DC/3, page 93]

[Present Text]

[There is no Article 36A in the present text]

[New Text]

Article 36A

Exceptional Rules for the Use of  
Denominations Consisting Solely of Figures

(1) Notwithstanding the provisions of paragraph (2) of Article 13, any State which, at the date of opening for signature of this Act, has the established practice of admitting variety denominations consisting solely of figures may continue such practice in respect of all or certain genera and species if, at the time of signing this Act or of depositing its instrument of ratification or accession to this Act, it notifies the Secretary-General of the Union of its intention to do so and, unless it intends to do so in respect of all genera or species, of the genera and species in respect of which it intends to continue the said practice.

(2) The said State may, at any time, notify the Secretary-General of the withdrawal of the notification it has made under paragraph (1). Such withdrawal shall take effect on the date which the State shall indicate in its notification of withdrawal.

[Annex III follows]

## ANNEX III

LETTER DATED NOVEMBER 29, 1977, FROM THE GERMAN FEDERAL PLANT VARIETIES OFFICE  
CONCERNING VARIETY DENOMINATIONS

[Annex II to document C/XI/21]

Subject: Revision of the Convention, Article 13

Reference: Document VD/XI/2, Numbers 7 and 16, and  
Document IRC/VI/21

Dear Colleagues,

After examining the proposals for revising Article 13 and in agreement with the Federal Ministry of Justice, we would draw your attention to the following:

According to Article 13(8)(b) of the present text, which has not been changed so far by the Committee of Experts, a variety denomination having been registered in one member State may not be the subject of an application for registration or be registered as a trademark in any other member State. This provision creates the following problems:

No trademark Office of any member State examines before registering a trademark whether that trademark is identical or liable to cause confusion with a registered variety denomination (see document VD/XI/2, paragraph 16). Also, it is obviously not intended in any member State that this practice, which does not comply with the text of the Convention, should be changed. A breeder, who has asked for protection of a variety in only one or a few member States is thus practically not prevented from having the variety denomination registered as a trademark, even for the same variety, in other member States in which he has not asked for protection for the variety. In these other States the following situation could arise:

If a dealer exports propagating material of the variety, legally acquired by him in the State in which protection has been granted to it, to one of the above-mentioned other States under the established variety denomination, the breeder could take the following measures in those States, on the basis of his identical trademark.

1. He could prohibit the use of the variety denomination by the dealer, on the basis of his identical trademark, and thereby make it impossible for the dealer to comply with Article 13(7) (present text). Thus he could use his trademark to secure for himself the exclusive right to market the variety in another State, a right which would go beyond the protection to which he was entitled under plant variety protection.
2. He could also market propagating material of similar varieties of the same species under the same trademark in order, for instance, to profit from the economic success of the variety in question. It would be very difficult, if not impossible, for the consumer to know whether the name under which he bought propagating material was a variety denomination, or a trademark, and it would therefore not be possible to recognize by the name whether the propagating material offered belonged to the variety or not.

The cases described under numbers 1 and 2 both stand in contradiction to the function of the variety denomination as laid down in Article 13. The following possibility should therefore be taken into consideration: Applications for registration and registration of a trademark which are identical with a variety denomination established in another member State, by the breeder or by his successor in title, are no longer to be excluded in view of the existing practice in the member States. The right to use the trademark is to be limited to the variety itself, however, as is the right to use the variety denomination. Furthermore, the right deriving from a trademark is to be limited in that its use cannot be prohibited if, in the member States in question, it is permissible for it to coexist with plant variety protection.

The following practical reasons speak in favor of permitting applications for registration and registration of trademarks which are identical with a variety denomination established in another member State, by the breeder or his successor in title, quite apart from the above-mentioned practice in the member States:

If the abuses described above are excluded (see below), it must be acknowledged that the breeder has a legitimate interest in a variety denomination which is protected in one member State being registered as a trademark in other member States, should he not be able to obtain variety protection in those other member States, due to the species in question not being eligible for protection there, or if he does not wish to apply for plant variety protection in those other States, for instance, because it is not economically worthwhile. In such a case, a trademark could provide a degree of protection for the variety. Furthermore, the breeder can also be interested in obtaining trademark protection in a member State (normally the State of origin) if he wishes to use such a trademark as a basis for obtaining trademark protection in States not party to the Convention, which require a trademark, either generally or for international trademark applications (Madrid Agreement), to be registered in the country of origin.

If the wishes of the breeders are to be taken into consideration and abuses are to be prevented, the solution will have to adopt the following principles:

(a) Only the breeder or his successor in title, not a third person, may have a variety denomination registered as a trademark.

(b) He may not use this trademark to prevent the variety denomination being used by a third person.

(c) He may have the trademark registered only for the variety in question, not for any other variety of the same or a related species.

If these principles are adopted, paragraph (8) [in the new text, paragraph (9)] of Article 13 could be worded as follows, whereby the question whether the variety denomination can still be considered a generic term and whether this should be stated expressly is left open:

"From the date of issue of a title of protection to a breeder or his successor in title in a member State of the Union:

(a) subject to subparagraph (b) and to paragraph (10) [in the new text, paragraph (11)], no person may apply in any member State of the Union for the registration of, or obtain protection as a trademark for, a denomination identical or liable to cause confusion with such denomination, in respect of identical or similar products within the meaning of trademark law.

(b) The breeder or his successor in title may apply in any member State for registration as a trademark of any denomination identical to a variety denomination. He may not assert his rights deriving from the trademark, however, in the event of the denomination being used for the variety, if the use of the denomination is admissible under plant variety protection in those States in which the trademark is registered.

(c) The variety denomination of the variety may not be used as a variety denomination or, subject to paragraph (10) [in the new text, paragraph (11)], as a trademark for another variety of the same botanical species or a related species in any member State."

Should there be problems in allowing the registration of a variety denomination as a trademark in all the member States, the proposal for the third sentence of subparagraph (b) above could be worded, similar to the proposal in document IRC/VI/2, as follows:

"The breeder or his successor in title may apply for the registration of a denomination which is identical with a variety denomination as a trademark for the variety in any member State not applying the Convention to the genus or species to which the variety belongs. In such case ... (continue as in subparagraph (b) above)."

CAJ/I/2  
Annex III, page 3

It must, however, be mentioned that such a rule could cause difficulties when the member State in question subsequently extends application of the Convention to the species concerned.

As far as Article 13(4) [paragraph (3) in the new text] is concerned, we agree basically with the proposal made by the Dutch experts in document VD/XI/2, and propose the following wording:

"(4) If the breeder or his successor in title proposes a variety denomination for which he enjoys, in a member State of the Union, the protection accorded to trademarks in respect of the variety or of another variety of the same botanical or of a related species, or a designation liable to cause confusion with such trademark, he may not, as from the time the variety denomination is registered for such varieties continue to assert his rights deriving from the trademark in any member State in which the variety is protected."

Furthermore, it might be considered whether reference should not be made in paragraph (9) [in the new text, paragraph (10)] to the fact that a trademark used in addition to the denomination of the variety must not overshadow the variety denomination to such an extent that that denomination ceases to exercise the functions allotted to it under the Convention. The following second sentence might therefore be added to the paragraph:

"The variety denomination must remain easily recognizable in cases where a trademark is added to it."

[End of Annex III and of document]