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CAJ/I/3

ORIGINAL: English

DATE: March 6, 1978

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

Proposal by the President of the Council

1. As described in detail in paragraphs 1 and 2 of document CAJ/I/2, the Council has asked the Administrative and Legal Committee to rediscuss, during its session to be held from April 17 to 19, 1978, "the question of Article 13 on the basis of the proposal from the Federal Republic of Germany, 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 ...". The proposal from the Federal Republic of Germany is annexed to document CAJ/I/2, whereas the proposal of the Secretary-General is contained in the document itself.

2. The President of the Council, Mr. Halvor Skov, has sent to the Secretary-General and, at the same time, to the members of the Council, a letter, dated February 8, 1978, together with the draft of a new wording of Article 13. Copies of the said letter and of the said draft are attached to this document.

[Annex follows]

ANNEX

LETTER FROM THE PRESIDENT OF THE COUNCIL OF UPOV, MR. HALVOR SKOV,
TO THE SECRETARY-GENERAL OF UPOV, DR. ARPAD BOGSCH,
DATED FEBRUARY 8, 1978

Denominations

Please find attached a draft-copy of a new-wording of Article 13, where I have omitted all references to trademarks.

I have made this draft in view of the German proposal to allow under certain conditions a denomination to be registered as a trademark, and in view of the fact that some States will have difficulty in accepting the German proposal.

In my opinion, a plant-convention should not legislate on trademarks but only see to it that there is no hindrance for the use of a denomination not only in cases where the use of a denomination is obligatory under the Convention (propagating material) but also where it is obligatory or even only optional only under national legislation.

It is clear that trademark-rights are the most relevant rights to hamper the free use of the denomination, but there may be other rights, too, such as rights to a family name, the name of a landed property (or building), trade names and certain specified names such as Red-Cross, Interpol and UPOV. I therefore think that there is good reason for avoiding references to trademarks in our Convention. Such line would also allow member States to legislate on the relationship between trademarks and denominations independently of the Convention, provided that they make sure that the denomination can be used freely.

I would like to make the following comments on my draft:

ad para 1. The French text says "designé par," which is rendered into "given" in the English text. I propose the English text to be amended to "designated by," which is not only the correct translation but also stronger (because you are given something you may not use it, but that is exactly what we want here). The other texts available to me (German, Spanish, Dutch, Danish and Swedish) have all a wording corresponding to the French text. However - this amendment has nothing to do with the main purpose of my draft.

ad para 2. No change.

ad para 3. Follow the order of the old text. But do not make requirements addressed to the breeder (that is: delete "the breeder... may not submit"). The requirement should refer only to the status of the denomination.

I have been - and still am - in doubts whether to use the expression private rights, property rights or prior rights. If we use "prior rights," difficulties may arise in respect of paragraph 10 of the present text. Possibly "other rights" could do.

I admit that there is no completely "free use of the denomination." I have considered if it would do to add "in accordance with paragraph 7 (of the old text)," but that would be too narrow, since that would refer only to propagating material, and in quite many cases it is convenient or even obligatory to use the denomination for the end-product.

ad para 4. Considering the order of paragraphs 3 and 4 proposed in the draft, the word "paragraphs" should remain in plural.

ad para 5. It is proposed to join in a paragraph all provisions aiming at the same denomination in all member States. - Subparagraph (a) has been taken from the EEC-directives and is intended more as a program, which leads to initiate subparagraph (b) with "consequently." - Subparagraph (c) is thought as an alternative to the present first subparagraph of paragraph 6, and reflects - I think - better the present situation without hindering the procedure foreseen in the present text. I have, however, no strong feelings about subparagraph (c).

The rest of my proposals are mere consequences of the above said.

I am well aware of the fact that my draft may need some polishing, but I have found it expedient to try to find new ways in respect of this difficult Article.

Best regards,

Yours sincerely,

H. Skov
(signed)

cc: M. J. Rigot
M. B. Laclavière
Dr. Böringer
Mr. G. Curotti
Mr. W. van Soest
Mr. J.F. van Wyk
Mr. S. Mejegard
Mr. W. Gfeller
Mr. H.A.S. Doughty

[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) A variety shall be designated by a denomination.

(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.

- (3) The denomination must not be subject to private (property) rights which would hamper the free use of the denomination. Consequently, if such rights accrue to the breeder he may no longer assert them against the denomination, after it has been registered (approved).

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

- (5) (a) The member States shall, as far as possible, ensure that the variety is known by the same denomination in all member States.

(b) Consequently, a variety must be submitted in member States of the Union under the same denomination, and 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 to submit a translation of the original denomination or another suitable denomination.

- (c) The Council shall establish rules of procedure to enable the competent authorities of the member States to comply with the provision of the preceding subparagraphs.

[Article 13, continued][Present Text][New 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.

[Delete paragraph (6) of the present text.]

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.

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

(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:

(7) [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." Furthermore, reword last sentence in subparagraph (b) as follows:]

(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.

Consequently, no person may, in any member State of the Union, apply for or obtain protection for private rights which would hamper the free use of the denomination.

[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]

[Delete paragraph (9) of the present text.]

(8) [Same as paragraph (10) of the present text, except omit (twice) the word "new," change "(7)" to "(6)," omit the words "if need be" and the words "or his successor in title."]

Furthermore, replace "in respect of signs used to distinguish their products or enterprises" by: "which hamper the free use of the denomination."]

[End of document]