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UPOV

RC/ad hoc/ 9

ORIGINAL: English

DATE: September 11, 1978

INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

GENEVA

AD HOC COMMITTEE ON
THE REVISION OF THE CONVENTION

Geneva, September 11 to 15, 1978

PROPOSAL FOR ARTICLE 13 OF THE UPOV CONVENTION

submitted by the US State Department

1. The Director of the Office of Business Practices of the State Department of the United States of America has submitted by telegram, received on September 11, 1978, an annotated proposal for Article 13 of the UPOV Convention. The annotated proposal is attached in the Annex.
2. The attention is drawn to the fact that observations of the United States of America to other Articles of the UPOV Convention are restated in document RC/ad hoc/5.

[Annex follows]

ANNEX

ANNOTATED PROPOSALS OF THE STATE DEPARTMENT OF THE
GOVERNMENT OF UNITED STATES OF AMERICA TO
ARTICLE 13 OF THE REVISED ACT OF THE
UPOV CONVENTION OF DECEMBER 2, 1961

TELEGRAM OF THE DIRECTOR OF THE OFFICE OF BUSINESS PRACTICES,
MR. HARVEY WINTER, TO THE SECRETARY-GENERAL OF UPOV,
DR. ARPAD BOGSCH, DATED SEPTEMBER, 1978.

PROPOSAL OF THE UNITED STATES

ARTICLE 13

VARIETY DENOMINATION

- (1) A variety shall be designated by a denomination.
- (2) Such denomination must enable the variety to be identified. It must not be misleading or confusing as to the characteristics, value, or identity of the variety. In particular, it must differ, in a way that avoids confusion on the part of the public, from every denomination which designates an existing variety in any member State of the Union.
- (3) The denomination of the variety shall be submitted by the breeder to the authority referred to in Article 30. If it is found that such denomination does not satisfy the requirements of the preceding paragraph, 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 at the same time as the title of protection is issued in accordance with the provisions of Article 7.
- (4)(a) If a breeder submits in a member State of the Union a denomination for a variety in which he enjoys a right

that could hamper the free use of the denomination, he may not, as from the time the variety denomination is registered, continue to assert his right against the free use of the denomination in that State.

- (b) Each member State shall provide measures to assure that prior rights of others are not affected by the registration of a variety denomination under this Article. If it is established that such registration would affect such a prior right, the competent authority shall permit the breeder to submit another denomination for that variety.
- (5) The breeder shall submit the same denomination for registration in all member States of the Union in which he seeks protection; provided that, if the competent authority of any such State finds that the denomination does not meet the requirements specified 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 that State a different denomination suitable for registration.

- (6) The member States of the Union are encouraged to take measures for assuring that the competent authorities of the member States are informed of matters concerning the registration of variety denominations.
- (7) Each member State shall endeavor to assure to the extent needed, by means of consumer protection, unfair competition, marketing, or other laws or regulations, that persons offering for sale or marketing protected or previously protected reproductive or vegetative propagating material in a member State of the Union shall be obliged to use the registered denomination of that variety, insofar as the prior rights of others do not prevent such use.
- (8) It shall be permitted to associate a trademark, trade-name or other proprietary indication with a registered variety denomination in the marketing of the variety.

DISCUSSION OF THE UNITED STATES PROPOSAL
FOR REVISING ARTICLE 13

Paragraph (1)

This paragraph states the well-established trade practice in our country of using variety denominations in the sale of plant materials. Moreover, the naming of seed placed in commerce is required under various federal and state laws.

Paragraph (2)

This paragraph, like the Secretary-General's proposal, does not specifically prohibit "figures (numbers) only" variety denominations. These denominations are said to be misleading or confusing to consumers. Our seed trade, which occasionally uses them, believes just the opposite. They point to a long history of consumer satisfaction in buying varieties identified in this way. A "figures only" denomination, the seed trade has found through experience, can be far more meaningful to consumers than a name in a foreign language or its translation, or a string of letters, or a strange-sounding coined or arbitrary name, all of which are permitted under paragraph (2).

Even without this prohibition, the paragraph does not impair any member State's right to reject these denominations individually or categorically as misleading or confusing. But this is a decision each member State should be entrusted

to make for itself. Also, elimination of this prohibition would avoid need for the narrowly-tailored exception of Article 36A.

It must be realized that determinations under this paragraph cannot be totally objective and complete. Our plant patent examining officials have no particular expertise in the judgments required by this paragraph, and may take some time in acquiring it. Even experts, however, will render somewhat subjective decisions. At times, our decision on the registrability of a particular denomination might differ from a decision on the same denomination made by another examining office.

Our paragraph, like the other proposals, permits registration only if the denomination is sufficiently different from denominations already registered in any member State. Naturally, the Patent and Trademark Office will be as systematic and thorough as possible in making these determinations. This Office expects to compile a reasonably complete collection of plant registers, taxonomy texts, and similar source materials, to be relied upon in applying the paragraph. But no examining office can guarantee the availability to its staff of all relevant information. The Department of Agriculture can be called upon for assistance, but their expertise and source materials may not be totally complete, either.

Our proposal follows the Secretary-General's in stating affirmatively that a variety denomination cannot be registered if it is misleading or confusing. This is more objective in application than a requirement that the denomination not be liable to mislead or confuse.

There is no reference in our proposal to the identity of the breeder, as in the other proposals. Its inclusion requires examining offices to make judgments about trademark rights, which our two examining Offices feel unable to do. Many trademarks in our country are not federally or even locally registered. It would be impossible for us to decide if a particular variety denomination is similar to such a trademark. Nor do we think it necessary or prudent for either of our Offices to make these trademark-like decisions. This is a matter that can be left to trademark or unfair competition laws.

The phrases "closely related botanical species" and "closely related species" in the two proposals are not clear to us. Each member State, we feel, must decide their meanings for itself and different understandings seem inevitable. Therefore, we have chosen another phrase. It emphasizes the Article's objective of identifying varieties to the consumer, rather than to botanists or government officials.

Paragraph (3)

The Patent and Trademark Office plans to register variety denominations by identifying them in newly-granted plant patents and weekly issues of the Official Gazette. The Plant Variety Protection Office will identify new variety denominations in certificates of protection and compile periodic lists of new denominations.

We see nothing in any of the proposals prohibiting the changing of a variety denomination prior to the marketing of the variety. Nor did we include such a prohibition in our proposal. Obviously, the change must be effective prior to marketing the variety. Otherwise, paragraph (7) of each of the proposals could not be complied with. Paragraph (5) in each proposal, requiring the new denomination to be registered in each of the member States where protection is sought, must also be complied with.

None of the proposals, including our own, deals with the possibility that a variety denomination in commercial use before the award of breeders' rights or even before applying for breeders' rights may be judged unregistrable by the examining office. The examining office would then require another denomination, and the variety would be known by two names. We do not see how to resolve this situation.

Paragraph (4)

This paragraph embodies a principle of our and other laws that a variety denomination cannot be used by the breeder as a trademark for identifying the source of the variety. But it is unfair to breeders to give this principle extraterritorial effect. To do so prejudices the breeder's freedom to seek the most suitable form of protection in each member State, whether it be reliance on trademark rights (identifying to consumers the source of the variety) or breeders' rights. Thus, our proposal utilizes the Administrative and Legal Committee's Alternative 2 for this paragraph.

Our paragraph (4) (b) requires each member State to protect third party property rights in a variety denomination registered by the breeder. It does not specify how this protection must be accorded. Its generality comes from the fact that the details or conditions of protecting third party property rights may not be inherently suited for a breeders' rights law.

In our country, the trademark owner would protect his mark by enjoining the breeder from using it as a variety denomination. This could be a totally judicial procedure not involving the Patent and Trademark Office, as it is today. The breeder would be able to submit another denomination if he

chooses to continue the exercise of his breeders' rights. Our proposal, however, does not require a judicial resolution of each conflict between a trademark and a variety denomination. An examining office could establish an administrative procedure for this purpose.

Paragraph (4) of the Council's version includes the phrase "and which applies . . . of trademark law." This phrase is open to widely-differing interpretations, and we urge that it be avoided.

It may turn out at the Diplomatic Conference that provisions regulating the relationship between trademarks and variety denominations hinder the Convention's widespread adoption by new member States. If so, we would enthusiastically support an Article that does not mention trademarks.

Paragraph (5)

This paragraph requires a breeder to use the same denomination for his protected variety in all member States. Breeders' organizations have pointed out to us the desirability of uniform naming in different countries. Thus, we feel we have their support in adopting regulations (or legislation, if need be) to put this paragraph into effect.

Our paragraph adopts much of the Secretary-General's language. It recognizes, therefore, that a denomination may be unregistrable in a member State for reasons other than unsuitability. We have changed his last few words, however, to avoid an implication that the "said requirements" means only the requirements of paragraph (2).

Our proposal, like the Secretary-General's, does not authorize a member State refusing registration of a particular denomination to demand the registration of its translation. If the denomination is unsuitable, the breeder should be allowed to select a new denomination best fitted to his needs. This may or may not be true of a translation.

Paragraph (6)

Implementation of this paragraph should help member States make the determinations required by the last sentence of paragraph (2). We would encourage and cooperate in the development of an information exchange system for variety denominations. Our proposal recognizes, however, that such a system is not yet in operation.

We have no particular objection to providing the Paris Union member States with information about registered variety denominations, as required in the Council's version. This could still be done under our proposal.

Paragraph (7)

The marking or identification of patented products (including plants) is properly the subject of unfair competition, marketing, or other consumer protection legislation. The Patent and Trademark Office, at least in our country, is not a regulatory agency. It would be unable to impose criminal or civil penalties, or hold a patent unenforceable, to compel the use of variety denominations. The power of the patent laws to compel such use either by third parties or patentees after expiration of the patent term is even more tenuous.

The inappropriateness of the patent laws in compelling the use of variety denominations is really not a cause for concern or alarm, however. Varieties are always sold in our country under variety denominations. Consumers are not interested in purchasing unidentified plants, and breeders respond by using denominations. Further legislative steps would, therefore, not be called for in our country. This seems to us an improvement over the other proposals mandating a practice already in use.

Paragraph (8)

Our proposal does not include an equivalent to paragraph (9) in document DC/3 or paragraph (8) in document DC/4. As the Secretary-General points out in connection with his proposal, the subject matter of paragraph (a) in these two proposals is either taken care of by paragraph (2) or is not within the scope of the Convention.

Paragraph (b) in these proposals assures that use of a variety denomination will preclude the acquisition of trademark rights in that name. In our case, it would not be necessary to change the trademark laws to accept Alternative 2 in document DC/4. However, there is no need for the Convention to deal with this aspect of trademarks (it is probably self-evident), and a danger of discouraging widespread adherence by doing so.

Paragraph (9)

This paragraph in document DC/4 (paragraph (10) in document DC/3) states a very important right of breeders to use a trademark with a variety name. We do not believe, however, that the bracketed material at the beginning of paragraph (9) (in document DC/4) is needed. It is intended to prevent the

cluttering of government records with proprietary indications. This might be handled just as well by regulations to the effect that trademarks or other proprietary indications may not be included in applications for breeders' rights.

The proposed addition to the end of paragraph (9) is more significant. It suggests or calls for administrative or judicial regulation of the use of variety denominations and trademarks. Again, this goes beyond the scope of the patent laws, and must be left to consumer protection legislation.

[End of Annex and of Document]