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**ADMINISTRATIVE AND LEGAL COMMITTEE**

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**DRAFT EXPLANATORY NOTES ON ARTICLE 20 OF THE 1991 ACT OF THE  
UPOV CONVENTION CONCERNING VARIETY DENOMINATIONS**

*Document prepared by the Office of the Union*

1. At its forty-fourth session, on October 3, 2001, the Administrative and Legal Committee (CAJ) agreed to establish an *Ad hoc* Working Group on Variety Denominations (WG-VD) to promote the harmonization of decisions on variety denominations (see document CAJ/44/3 and paragraph 24 of document CAJ/44/9).
2. The terms of reference for the WG-VD (see document CAJ/44/3), agreed by the CAJ on that occasion, included the drafting of a set of guidelines to encourage harmonized decisions on variety denominations and, if appropriate, to modify existing guidance on this matter. The existing guidance on variety denominations “UPOV Recommendations on Variety Denominations” (document UPOV/INF/12 Rev.) is reproduced in Annex I to this document. The updated version of UPOV/INF/12 Rev., in the form of “Explanatory Notes” clearly linked to Article 20 of the 1991 Act of the UPOV Convention, as proposed by the WG-VD, is reproduced in Annex II to this document (Draft Explanatory Notes on Article 20). The composition of the WG-VD, and the activities which resulted in the Draft Explanatory Notes on Article 20, are summarized in the following paragraphs.
3. Several members and observers, covering different regions, alphabets and expertise, participated in the WG-VD: Argentina, Belgium, Canada, Chile, China, Colombia, Croatia, European Community, France, Japan, New Zealand, Poland, Republic of Korea, Romania, Singapore, South Africa, Spain, the World Intellectual Property Organization (WIPO), the International Community of Breeders of Asexually Reproduced Ornamental and Fruit-Tree

Varieties (CIOPORA), the International Seed Federation (ISF), and the International Union of Biological Sciences Commission for the Nomenclature of Cultivated Plants (IUBS Commission).

4. The WG-VD held eight meetings in conjunction with the CAJ sessions (between October 2001 and April 2005). To assist deliberations in the above meetings, the WG-VD prepared three questionnaires addressed to all members of the Union and other interested organizations. The questionnaires were aimed at seeking information and/or advice on:

(a) key issues that needed to be explored by the WG-VD in the drafting of an updated version of UPOV/INF/12 Rev. (Draft Explanatory Notes on Article 20);

(b) how the effectiveness of the UPOV-ROM (or similar web-based databases) might be improved with regard to matters concerning variety denominations (the replies to this questionnaire led to a program to improve the effectiveness of the UPOV-ROM that is currently underway);

(c) whether there was a need for a review of Recommendation 9 and the corresponding List of Classes for variety denomination purposes contained in document UPOV/INF/12 Rev. (see Annex I to this document). Taking into account the replies to this questionnaire, the WG-VD reached a consensus in relation to certain proposals for revision of Recommendation 9 and the List of Classes and also identified other proposals which required further consultation or coordination with relevant parties (for instance, Technical Working Parties). The results of these consultations have been incorporated in the Draft Explanatory Notes on Article 20 (see Appendix III of Annex II to this document), subject to a pending consultation with the Technical Working Party for Agricultural Crops (TWA), which will take place from October 31 to November 4, 2005. In the event of a proposal for change to Appendix III of Annex II to this document by the TWA, the CAJ will be informed accordingly.

5. Relevant documents of the WG-VD can be found on the UPOV website at [http://www.upov.int/restrict/en/wg-vd/index\\_wg-vd.htm](http://www.upov.int/restrict/en/wg-vd/index_wg-vd.htm) .

6. Once the Draft Explanatory Notes on Article 20 in Annex II to this document are approved by the CAJ and adopted by the Council of UPOV, it is proposed that the “UPOV Recommendations on Variety Denominations” (document UPOV/INF/12 Rev.) be superseded by those explanatory notes.

7. It is proposed that no further meetings of the WG-VD will take place unless proposed by the CAJ.

8. *The CAJ is invited to note and comment the content of this document and its Annexes and, in particular:*

*(a) to consider the “Draft Explanatory Notes on Article 20 of the 1991 Act of the UPOV Convention concerning Variety Denominations”, reproduced in Annex II to this document; and*

*(b) to consider the proposals in paragraphs 6 and 7 of this document.*

[Annexes follow]

UPOV RECOMMENDATIONS ON VARIETY DENOMINATIONS

adopted by the Council of UPOV  
on October 16, 1987  
and amended on October 25, 1991

(document UPOV/INF/12 Rev.)

The Council of the international Union for the Protection of New Varieties of Plants (UPOV) refers to Articles 6(1)(e) and 13 of the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as revised at Geneva on November 10, 1972, and on October 23, 1978, and in particular to the fact that, according to that Convention, a variety must be given a denomination destined to be its generic designation before a title of protection can be issued in respect of it.

The Council points out that, according to Article 13, a variety denomination must be suitable as a generic designation and must enable the variety to be identified; it must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder.

The Council emphasizes that the main purpose of the rules laid down in Article 13 is to ensure that, as far as possible, protected varieties are designated in all member States by the same variety denomination, that the approved variety denominations establish themselves as the generic designations and that they are used in the marketing of reproductive or propagating material, even after the expiration of protection.

The Council considers that such an aim can only be achieved if the broadly worded provisions on variety denominations in Article 13 are uniformly interpreted and applied by the member States, and that the adoption of appropriate recommendations is therefore advisable.

The Council also considers that the adoption of such recommendations for the uniform interpretation and application of the provisions of Article 13 would be of assistance not only to the authorities of member States but also to breeders having to select variety denominations.

The Council, having regard to Article 21(h) of the Convention, under which it has the task of taking all necessary decisions to ensure the efficient functioning of the Union, and in the light of the experience acquired by member States in connection with variety denominations, recommends that the authorities of member States,

- (i) base their decisions on the suitability of proposed variety denominations on the recommendations set out in Part I below,
- (ii) take into account, when assessing such suitability, the recommendations, on the exchange of information and on procedure set out in Part II below,

(iii) give comprehensive information on the recommendations to the breeders so that they can take them into account when selecting variety denominations.

## PART I

### SUITABILITY OF PROPOSED VARIETY DENOMINATIONS

#### Recommendation 1

Designations that do not show clearly enough their status of variety denomination are not suitable as generic designations and thus also as variety denominations. This may be the case in particular with designations that are identical or may be confused with other indications, in particular those that are commonly used in trade.

#### Recommendation 2

(1) Designations that the average user cannot recognize or reproduce in speech and/or writing are not suitable as generic designations and thus also as variety denominations.

(2) In the case of varieties whose propagating material is exclusively marketed within a limited circle of specialists, as in the case of parent varieties for the production of hybrids, the average user should be taken to mean the average specialist in that circle.

#### Recommendation 3

Designations whose use is to remain free are not suitable as generic designations and thus also as variety denominations. This may be the case in particular with designations which consist exclusively or predominantly of terms in everyday language whose recognition as variety denominations would prevent others from using them when marketing reproductive or propagating material of other varieties.

#### Recommendation 4

Designations whose use may be forbidden in the marketing of propagating material of the variety are not suitable as generic designations and thus also as variety denominations. This may be the case in particular with:

(i) designations in which the applicant himself has some other right (for instance a right in the name or a trademark) which he could assert under the legislation of the member State concerned to oppose use of the registered variety denomination, either at any time or at least after the expiration of protection;

(ii) designations in which third parties have asserted a prior right;

(iii) designations that are contrary to public policy in the member State concerned.

Recommendation 5

Names and abbreviations of international organizations which are excluded by international conventions from use as trademarks or parts of trademarks are not suitable as generic designations and thus also as variety denominations.

Recommendation 6

A designation is not suitable as variety denomination on the ground of liability to mislead if there is a risk of it giving rise to misconceptions concerning the characteristics or value of the variety. This may be the case in particular with:

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

(ii) designations that refer to specific characteristics of the variety in such a way that the impression is created that only the variety possesses them, whereas in fact other varieties of the species in question also have or may have the same characteristics;

(iii) comparative and superlative designations;

(iv) designations that convey the impression that the variety is derived from or related to another variety when that is not in fact the case.

Recommendation 7

A designation is not suitable as variety denomination on the ground of liability to mislead if there is a risk of it giving rise to misconceptions concerning the identity of the breeder.

Recommendation 8

(1) A designation is liable to cause confusion and/or to mislead, and therefore is not suitable, if it is identical or similar to a designation under which a variety of the same or a closely related botanical species has been made known or officially registered or under which reproductive or propagating material of that variety has been marketed.

(2) Paragraph (1) is not to be applied where the variety made known or registered earlier or already marketed is no longer cultivated and its denomination has not acquired any particular importance, except where special circumstances nevertheless might make it liable to mislead.

Recommendation 9

For the purposes of the fourth sentence of Article 13(2) of the Convention, all taxonomic units are considered closely related that belong to the same botanical genus or are contained in the same class in the list in [Appendix I](#) to these Recommendations.

PART II  
PROCEDURE

Recommendation 10

(1) When rendering its decision on the suitability of a variety denomination, the authority referred to in Article 30(1)(b) of the Convention (hereinafter referred to as "the authority") should take into account all observations made by the authorities of other member States.

(2) The authorities should accept as far as possible a variety denomination established in another member State even if they have objections to it.

Recommendation 11

(1) The information exchanged between the authorities of member States on variety denominations and the communication of observations on proposed variety denominations, required in Article 13(6) of the UPOV Convention, should be effected by the exchange of the official gazettes published by the member States in accordance with Article 30(1)(c) of the UPOV Convention. The layout of those official gazettes should be based on the UPOV Model Plant Breeders' Rights Gazette (document UPOV/INF/5) and on any other recommendations made by UPOV; in particular, the chapters containing information on variety denominations should be appropriately identified in the table of contents.

(2) Each authority should send a mutually agreed number of copies of each issue of its official gazette immediately on publication to the authorities of the other member States.

Recommendation 12

(1) Each authority should examine the filed variety denominations published in the official gazettes of the other member States. If it finds a variety denomination to be unsuitable, it should proceed as follows:

(i) As soon as possible, but not later than three months after publication of the issue concerned, it should communicate its observations, together with its reasons, to the authority that has published the variety denomination, on the form reproduced in Annex II to these Recommendations. (In some countries, the statutory period for filing comments on a proposed denomination may be less than three months, after which time comments may no longer be acceptable for consideration.)

(ii) A copy of the above-mentioned communication should be sent at the same time to the authorities of the other member States.

(2) The authority that has published the filed denomination should immediately examine the observations communicated by the authorities of the other member States and should proceed as follows:

(i) If the observations refer to an obstacle to approval that according to the Convention applies to all member States, the authority should accept the observations in case of doubt and should reject the filed denomination. If it does not share the misgivings of the other authority, it should inform that other authority accordingly and should give its reasons. As far as possible the offices concerned should endeavor to reach agreement.

(ii) If the observation refers to a circumstance that is an obstacle to approval only in the member State whose authority has transmitted the observation, but not in the member State whose authority has published the filed denomination (e.g. the denomination is identical with someone else's trademark in the former State only), the latter authority, depending on the circumstances of the case, either should reject the filed denomination or should inform the applicant accordingly, requesting him to file another variety denomination if it is envisaged that protection will be applied for in the member State whose authority has transmitted the observation or if it can be expected that reproductive or propagating material of the variety will be marketed in that same State. If this procedure does not result in the filing of another variety denomination, no communication need be addressed to the authority that has transmitted the observation.

[Appendix follows]



APPENDIX TO ANNEX I

LIST OF CLASSES FOR VARIETY DENOMINATION PURPOSES

As amended by the Council at its twenty-fifth ordinary session,  
on October 25, 1991

[Recommendation 9

For the purposes of the fourth sentence of Article 13(2) of the Convention, all taxonomic units are considered closely related that belong to the same botanical genus or are contained in the same class in the list in Annex I to these Recommendations.]

Note: Classes which contain subdivisions of a genus may lead to the existence of a complementary class containing the other subdivisions of the genus concerned (example: Class 9 (*Vicia faba*) leads to the existence of another class containing the other species of the genus *Vicia*).\*

Class 1: *Avena*, *Hordeum*, *Secale*, *Triticale*, *Triticum*

Class 2: *Panicum*, *Setaria*

Class 3: *Sorghum*, *Zea*

Class 4: *Agrostis*, *Alopecurus*, *Arrhenatherum*, *Bromus*, *Cynosurus*, *Dactylis*, *Festuca*, *Lolium*, *Phalaris*, *Phleum*, *Poa*, *Trisetum*

Class 5: *Brassica oleracea*, *Brassica chinensis*, *Brassica pekinensis*

Class 6: *Brassica napus*, *B. campestris*, *B. rapa*, *B. juncea*, *B. nigra*, *Sinapis*

Class 7: *Lotus*, *Medicago*, *Ornithopus*, *Onobrychis*, *Trifolium*

Class 8: *Lupinus albus* L., *L. angustifolius* L., *L. luteus* L.

Class 9: *Vicia faba* L.

Class 10: *Beta vulgaris* L. var. *alba* DC., *Beta vulgaris* L. var. *altissima*

Class 11: *Beta vulgaris* ssp. *vulgaris* var. *conditiva* Alef. (syn.: *Beta vulgaris* L. var. *rubra* L.), *Beta vulgaris* L. var. *ciela* L., *Beta vulgaris* L. ssp. *vulgaris* var. *vulgaris*

Class 12: *Lactuca*, *Valerianella*, *Cichorium*

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\* The complementary classes have been added by the Office of the Union for the convenience of the reader and are given the numbers 28 to 35.

Class 13: Cucumis sativus

Class 14: Citrullus, Cucumis melo, Cucurbita

Class 15: Anthriscus, Petroselinum

Class 16: Daucus, Pastinaca

Class 17: Anethum, Carum, Foeniculum

Class 18: Bromeliaceae

Class 19: Picea, Abies, Pseudotsuga, Pinus, Larix

Class 20: Calluna, Erica

Class 21: Solanum tuberosum L.

Class 22: Nicotiana rustica L., N. tabacum L.

Class 23: Helianthus tuberosus

Class 24: Helianthus annuus

Class 25: Orchidaceae

Class 26: Epiphyllum, Rhipsalidopsis, Schlumbergera, Zygocactus

Class 27: Proteaceae

## COMPLEMENTARY CLASSES

Class 28: Species of Brassica other than  
(in Class 5 + 6) Brassica oleracea, Brassica chinensis, Brassica pekinensis + Brassica napus,  
B. campestris, B. rapa, B. juncea, B. nigra, Sinapis

Class 29: Species of Lupinus other than  
(in Class 8) Lupinus albus L., L. angustifolius L., L. luteus L.

Class 30: Species of Vicia other than  
(in Class 9) Vicia faba L.

Class 31: Species of Beta + subdivisions of the species Beta vulgaris other than  
(in Class 10 +11) Beta vulgaris L. var. alba DC., Beta vulgaris L. var. altissima + Beta  
vulgaris ssp. vulgaris var. conditiva Alef. (syn.: Beta vulgaris L. var. rubra L.), Beta vulgaris  
L. var. cicla L., Beta vulgaris L. ssp. vulgaris var. vulgaris

Class 32: Species of Cucumis other than  
(in Class 13 + 14) Cucumis sativus + Citrullus, Cucumis melo, Cucurbita

Class 33: Species of Solanum other than  
(in Class 21) *Solanum tuberosum* L.

Class 34: Species of Nicotiana other than  
(in Class 22) *Nicotiana rustica* L., *N. tabacum* L.

Class 35: Species of Helianthus other than  
(in Class 23 + 24) *Helianthus tuberosus* + *Helianthus annuus*

[Annex II follows]

**DRAFT**

EXPLANATORY NOTES ON ARTICLE 20 OF THE 1991 ACT OF THE  
UPOV CONVENTION CONCERNING VARIETY DENOMINATIONS

Introduction

The only binding obligations for members of the Union are those contained in the text of the International Convention for the Protection of New Varieties of Plants (the UPOV Convention) itself, and this document should not be interpreted in a way that is inconsistent with the relevant Act for the member of the Union concerned. However, these explanatory notes are intended to assist in the understanding and harmonized application of the provisions of Article 20 of the 1991 Act.

Clarifications provided in these explanatory notes on variety denominations relate to the UPOV Convention, independent of the Act to which a State or Intergovernmental Organization is bound. Prior guidance on this matter “UPOV Recommendations on Variety Denominations” (document UPOV/INF/12 Rev.) is superseded by these explanatory notes<sup>1</sup>.

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<sup>1</sup> Once these draft explanatory notes have been approved by the Administrative and Legal Committee and adopted by the Council of UPOV, the “UPOV Model Form for the Application for a Variety Denomination” will be amended accordingly (UPOV Publication 644(E), Important Texts and Documents, Section 11).

## Article 20 of the 1991 Act of the UPOV Convention

### Variety Denomination

**(1) [Designation of varieties by denominations; use of the denomination] (a) The variety shall be designated by a denomination which will be its generic designation. (b) Each Contracting Party shall ensure that, subject to paragraph (4), no rights in the designation registered as the denomination of the variety shall hamper the free use of the denomination in connection with the variety, even after the expiration of the breeder's right.**

#### *Draft Explanatory Notes – Article 20(1)*

1.1. Article 5(2) of the Convention requires that the variety is designated by a denomination. Article 20(1)(a) provides for the denomination to be the generic designation of the variety. Article 20(1)(b) provides that no rights shall hamper the free use of the denomination of the variety, even after the expiration of the breeder's right and should be considered together with the obligation to use the variety denomination in respect of the sale or marketing of propagating material of the variety (see Article 20(7)).

1.2. The obligation under Article 20(1)(b) to allow for the use of the denomination in connection with the variety, even after the expiration of the breeder's right, is of relevance if the breeder of the variety is also the holder of a trademark which is identical to the variety denomination. It should be noted that the registration, by a public authority, of a trademark as the generic name of a variety may render the trademark liable for cancellation<sup>2</sup>. In order to provide clarity and certainty in relation to variety denominations, authorities should refuse a variety denomination which is the same as a trademark in which the breeder has a right. The breeder may choose to renounce the trademark right prior to the submission of a proposed denomination in order to avoid its refusal.

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<sup>2</sup> WIPO Publication N°489 "WIPO Intellectual Property Handbook"

#### Proper Use of Trademarks

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

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

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

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

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

*Draft Explanatory Notes – Article 20(2)*

## 2.1 *Identification*

Provisions under Article 20(2) emphasize the “identification” role of the denomination. Bearing in mind that the main objective of the denomination is to identify the variety, sufficient flexibility should be given to incorporate evolving practices in designating varieties.

## 2.2 *Solely of figures*

2.2.1 Article 20(2) states that the denomination may not consist “solely of figures” except where this is an “established practice” for designating varieties. The expression “solely of figures” refers to variety denominations consisting of numbers only (e.g. 91150). Thus, denominations containing both letters and figures are not subject to the “established practice” requirement (e.g. AX350).

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

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

(b) accepted market practices for particular variety types (e.g. hybrids).

## 2.3 *Liable to mislead or to cause confusion*

Article 20(2) states that the denomination must not be liable to “mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder.” These aspects are considered below:

### 2.3.1 *Characteristics of the variety*

The denomination should not:

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

*Example:* a denomination “red ruby” for a variety of an ornamental species whose flowers are white, or for a fruit variety whose fruits are green, might not be acceptable.

(b) refer to specific characteristics of the variety in such a way that the impression is created that only the variety possesses them, whereas in fact other varieties of the species in question also have or may have the same characteristics;

*Example:* “Sweet” for a fruit variety.

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

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

### 2.3.2 Value of the variety

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

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

### 2.3.3 Identity of the variety

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

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

*Example (i):* in the English language, “Harry” and “Larry” would not cause confusion; However, “Anne” and “Aнна” could cause confusion; “Bough” and “Bow” might also cause confusion (in phonetic terms);

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

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

(iii) denominations consist “solely of figures”.

(b) The use of a denomination which is similar to that used for a variety of another species or genera in the same denomination class (see section 2.4.3) may cause confusion.

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

#### 2.3.4 Identity of the breeder

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

Example: a variety incorporating the name of a breeder, if he is not the breeder of the variety.

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

2.4.1 Article 20(2) states that the denomination must be “different” from an existing variety of the same plant species or a closely related species<sup>3</sup>.

2.4.2 The following explanation is for the purposes of variety denominations and without prejudice to the meaning of a “variety whose existence is a matter of common knowledge” in Article 7. Under exceptional circumstances (see 2.3.3(c)), if a variety (the “old” variety) has ceased to exist and the re-use of the denomination for a new variety is not liable to mislead or to cause confusion concerning the identity and/or the characteristics of the new variety, the denomination of an old variety could, in principle, be registered for a new variety.

2.4.3 For the purposes of the third (see section 2.3.3(b)) and fourth sentences of Article 20(2), Appendix III provides guidance on what are considered to be “closely related species,” and where the use of the same denomination for varieties belonging to different species or genera may be liable to mislead or to cause confusion concerning the identity of the variety.

2.4.4 It is recommended that the UPOV Plant Variety Database (“UPOV-ROM”) is used in the process to check if, in the territory of any member of the Union, the proposed denomination is different from denominations of existing varieties of the same genus or, if appropriate, variety denomination class (see Appendix III).

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<sup>3</sup> Article 13 of the 1978 Act refers to “botanical species or of a closely related species” the divergence in terminology does not contain any difference in substance.



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

*Draft Explanatory Notes – Article 20(3)*

3.1 If the authority referred to in Article 30(1)(ii) (hereinafter referred to as “the authority”) has found no grounds for refusal under Article 20(2), and knows of no grounds for refusal under Article 20(4), the proposed denomination shall be registered, published and communicated to the authorities of the other members of the Union.

3.2 In the event of prior rights (Article 20(4)) or other grounds for refusal, any interested person may file an objection to the registration. The authorities of the other members of the Union may submit observations (See Draft Explanatory Notes of Article 20(6)).

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

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

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

*Draft Explanatory Notes – Article 20(4)*

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

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

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

(c) In the case of two conflicting proposed variety denominations (see Article 20(2)) in the same or different territories, the one with an earlier publication date should be retained and the relevant authority should request the breeder, whose proposed denomination was or might have been published at a later date, to submit another denomination.

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

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

(i) A trademark may be considered as a prior right when the proposed denomination is identical to a trademark registered for an identical good. For all practical purposes, such identity of goods is most likely to occur in respect of trademarks registered for goods under Class 31 of the Nice Classification<sup>4</sup>, although it is recalled that, in certain countries, trademarks may also be protected on the basis of use and without registration. If the trademark and proposed denomination are not identical, but similar, the trademark, in some cases, may constitute a prior right, the exercise of which may prevent the use of the

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<sup>4</sup> Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1957, as revised in Stockholm on July 14, 1967, and Geneva on May 13, 1977, and amended on September 28, 1979.

proposed denomination, and the breeder may be required to propose another denomination. If, in spite of the similarity between the proposed denomination and the trademark, the exercise of the latter will not prevent the use of the proposed denomination, the denomination may be accepted; rejections of denominations by the authority on the basis of similarity to a trademark will, in general, result from oppositions of trademark holders, observations of authorities responsible for trademark registration, or judgments from a competent court. In cases of mere similarity or small likelihood of association by users, waivers granted to breeders by prior trademark right holders could be a suitable solution.

(ii) If the proposed denomination is identical with or similar to a well-known mark, it may be unsuitable, even if the well-known mark applies to goods other than those appearing in Class 31 of the Nice Classification<sup>5</sup>;

(iii) Prior rights might also concern trade names<sup>6</sup> and names of famous persons;

(iv) Names and abbreviations of intergovernmental organizations, which are excluded by international conventions from use as trademarks or parts of trademarks, are not suitable as variety denominations<sup>7</sup>;

(v) Prior rights concerning appellations of origin and geographical indications (e.g. “Scotch”) may exist under national legislation on grounds of common law or registration<sup>8</sup>;

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

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<sup>5</sup> Well-known marks are protected by the Paris Convention for the Protection of Industrial Property (Article 6*bis*) and the Agreement on Trade-Related Aspects on Intellectual Property Rights (Article 16.2 and 3 of the TRIPS Agreement). See also the 1999 WIPO Joint Recommendation Concerning Provisions on the Protection of Well-known Marks.

<sup>6</sup> Article 8 of the Paris Convention.

<sup>7</sup> This recommendation includes names and abbreviations notified pursuant to Article 6*ter* of the Paris Convention.

<sup>8</sup> Articles 22 to 24 of the TRIPS Agreement provide for an obligation for WTO Members to protect geographical indications; the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration sets up international registration procedures for appellations of origin in the States party to that Agreement.

**(5) [Same denomination in all Contracting Parties] A variety must be submitted to all Contracting Parties under the same denomination. The authority of each Contracting Party shall register the denomination so submitted, unless it considers the denomination unsuitable within its territory. In the latter case, it shall require the breeder to submit another denomination.**

*Draft Explanatory Notes – Article 20(5)*

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

5.2 Article 20(5) provides clear directions both for breeders and authorities:

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

(b) The essential obligation under Article 20(5) is that authorities should accept the denomination that was submitted and registered with the first application, unless such denomination is unsuitable in their territory (see 5.3). On that basis, although certain provisions of Article 20 allow for authorities to develop individual guidance or best practices, the obligation under Article 20(5) should be given priority, unless there is direct conflict with other relevant provisions of Article 20. In this respect, it is also recommended to avoid any narrow interpretation of the provisions of Article 20 and related guidance or best practices, which could lead to the unnecessary refusal of variety denominations and, consequently, the unnecessary creation of synonyms for a variety;

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

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

(a) it does not conform to the provisions in Article 20(2) and (4); or

(b) it is contrary to public policy.

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

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

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

*Draft Explanatory Notes – Article 20(6)*

6.1 Provisions of Article 20(6) indicate the importance of cooperation and exchange of information among authorities.

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

6.3 Article 20(6) provides for the possibility for a member of the Union to make observations if it considers that a proposed denomination in another member of the Union is unsuitable. In particular with respect to the provisions of Article 20(5), the authority should take into account all observations made by the authorities of other members when deciding on the suitability of a proposed denomination. If the observations refer to an obstacle for approval which, according to Article 20, applies to all members, then the proposed denomination should be refused. If the observation refers to an obstacle to approval only in the member of the Union which has transmitted the observation (e.g. prior trademark right within that territory), the applicant should be informed accordingly. If it is envisaged that protection will be applied for, or if it can be expected that reproductive or propagating material of the variety will be marketed in the territory of the member of the Union which has transmitted the observation, the authority examining the proposed denomination should request the applicant to propose another denomination.

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

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

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

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

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

*Draft Explanatory Note– Article 20(7)*

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

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

This provision is self-explanatory.

[Appendix I follows]



APPENDIX I TO ANNEX II

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

From

\_\_\_\_\_  
Your ref.

\_\_\_\_\_  
Our ref.

**Observations on a Submitted Variety Denomination**

To

Submitted Variety Denomination: \_\_\_\_\_

Genus/Species (Botanical name): \_\_\_\_\_ UPOV Code: \_\_\_\_\_

Gazette: \_\_\_\_\_  
(number/year)

Applicant: \_\_\_\_\_

Observations: \_\_\_\_\_

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

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

\_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

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

Date:

Signature:

[Appendix II follows]

APPENDIX II TO ANNEX II

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

From

\_\_\_\_\_  
Your ref.

\_\_\_\_\_  
Our ref.

**Reply to Observations on a Submitted Variety Denomination**

To

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

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

Copies to the authorities of the other members of the Union

Date:

Signature:

[Appendix III follows]

## APPENDIX III TO ANNEX II

*For the purposes of the third and fourth sentences of Article 20(2) of the 1991 Act of the UPOV Convention, this Appendix provides guidance on what are considered to be “closely related species,” and where the use of the same denomination for varieties belonging to different species or genera may be liable to mislead or to cause confusion concerning the identity of the variety.*

## LIST OF CLASSES

Part I

Plant species, which are in different classes in Part I of the List of Classes, notwithstanding the fact that they may belong to the same genus, are considered not to be closely related and are not liable to mislead or to cause confusion concerning the identity of the variety.

\* indicates old class has been modified (see Appendix to Annex I). References to old classes will be deleted in the final version of this Appendix.

	<u>Old class</u>	<u>Botanical names</u>	<u>UPOV codes</u>
Class 1.1	5*	Brassica oleracea	BRASS_OLE
Class 1.2 <sup>1</sup>	5*, 6*, 28*	Brassica other than Brassica oleracea	other than BRASS_OLE
Class 2.1	10	Beta vulgaris L. var. alba DC., Beta vulgaris L. var. altissima	BETAA_VUL_GVA; BETAA_VUL_GVS
Class 2.2	11	Beta vulgaris ssp. vulgaris var. conditiva Alef. (syn.: B. vulgaris L. var. rubra L.), B. vulgaris L. var. cicla L., B. vulgaris L. ssp. vulgaris var. vulgaris	BETAA_VUL_GVC; BETAA_VUL_GVF
Class 2.3	31	Beta other than classes 2.1 and 2.2.	other than classes 2.1 and 2.2
Class 3.1	13	Cucumis sativus	CUCUM_SAT
Class 3.2	14*	Cucumis melo	CUCUM_MEL
Class 3.3	32*	Cucumis other than classes 3.1 and 3.2	other than classes 3.1 and 3.2
Class 4.1	21	Solanum tuberosum L.	SOLAN_TUB
Class 4.2	33	Solanum other than class 4.1	other than class 4.1

<sup>1</sup> The WG-VD proposed a separate class for Brassica rapa (B. campestris): Chinensis group and Pekinensis group. The Technical Working Group for Vegetables (TWV) concluded that such a class would not be appropriate.

Part II

Plant species that belong to any of the genera in the same class in Part II of the List of Classes, are considered to be closely related and/or are liable to mislead or cause confusion concerning the identity of the variety.

	<u>Old class</u>	<u>Botanical names</u>	<u>UPOV codes</u>
Class 201	1*	Secale, Triticale, Triticum	SECAL; TRITL; TRITI
Class 202	2	Panicum, Setaria	PANIC; SETAR
Class 203	4*	Agrostis, Dactylis, Festuca, Festulolium, Lolium, Phalaris, Phleum and Poa <i>to be considered further by TWA</i>	AGROS; DCTLS; FESTU; FESTL; LOLIU; PHALR; PHLEU; POAAA
Class 204	7	Lotus, Medicago, Ornithopus, Onobrychis, Trifolium <i>to be considered further by TWA</i>	LOTUS; MEDIC; ORNTP; ONOBR; TRFOL
Class 205	12*	Cichorium, Lactuca	CICHO; LACTU
Class 206	new	Petunia and Calibrachoa	PETUN; CALIB
Class 207	new	Chrysanthemum and Ajanía	CHRYC; AJANI
Class 208	new	(Statice) Goniolimon, Limonium, Psylliostachys	GONIO; LIMON; PSYLL_
Class 209	new	(Waxflower) Chamelaucium, Verticordia	CHMLC; VERTI; VECHM
Class 210	new	Jamesbrittania and Sutera	JAMES; SUTER
Class 211	new	Edible Mushrooms Agaricus bisporus Agaricus blazei Agrocybe cylindracea Auricularia auricula Auricularia polytricha (Mont.) Sacc. Dictyophora indusiata (Ventenat:Persoon) Fischer Flammulina velutipes Ganoderma lucidum (Leyss:Fries) Karsten Grifola frondosa Hericiun erinaceum Hypsizigun marmoreus Hypsizigun ulmarius Lentinula edodes Lepista nuda (Bulliard:Fries) Cooke Lepista sordida (Schumacher:Fries) Singer Lyophyllum decastes Lyophyllum shimeji (Kawamura) Hongo Meripilus giganteus (Persoon:Fries) Kartern Mycoleptodonoides aitchisonii (Berkeley) Maas Geesteranus Naematoloma sublateritium Panellus serotinus Pholiota adiposa Pholiota nameko Pleurotus cornucopiae var.citrinooleatus Pleurotus cystidiosus Pleurotus cystidiosus subsp. Abalonus	AGARI_BIS AGARI_BLA AGROC_CYL AURIC_AUR AURIC_POL DICTP_IND FLAMM_VEL GANOD_LUC GRIFO_FRO HERIC_ERI HYPSE_MAR HYPSE_ULM LENTI_ELO LEPIS_NUD LEPIS_SOR LYOPH_DEC LYOPH_SHI MERIP_GIG MYCOL_AIT  NAEMA_SUB PANEL_SER PHLIO_ADI PHLIO_NAM PLEUR_COR PLEUR_CYS PLEUR_CYS_ABA

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	<u>Old class</u>	<u>Botanical names</u>	<u>UPOV codes</u>
Class 211 Cont/d		Pleurotus eryngii Pleurotus ostreatus Pleurotus pulmonarius Polyporus tuberaster (Jacquin ex Persoon) Fries Sparassis crispa (Wulfen) Fries Tricholoma giganteum Massee	PLEUR_ERY PLEUR_OST PLEUR_PUL POLYO_TUB SPARA_CRI MACRO_GIG

Deleted classes

The following classes are proposed to be deleted and to follow the general recommendation i.e. “all plant species that belong to a different genus are considered not to be closely related and are not liable to mislead or to cause confusion concerning the identity of the variety”.

<u>Old class</u>	<u>Botanical names</u>
3	Sorghum, Zea
15	Anthriscus, Petroselinum
16	Daucus, Pastinaca
17	Anethum, Carum, Foeniculum
18	Bromeliaceae
19	Picea, Abies, Pseudotsuga, Pinus, Larix
20	Calluna, Erica
25	Orchidaceae
26	Epiphyllum, Rhipsalidopsis, Schlumbergera, Zygocactus
27	Proteaceae
8 & 29	Lupinus albus L., L. angustifolius L., L. luteus L. / other Lupinus
9 & 30	Vicia faba L. / other Vicia
22 & 34	Nicotiana rustica L., N. tabacum L. / other Nicotiana
23, 24 & 35	Helianthus tuberosus / Helianthus annuus / other Helianthus

[End of Appendix III to Annex II and of document]