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GENEVA

TECHNICAL WORKING PARTY ON AUTOMATION AND COMPUTER PROGRAMS

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VARIETY DENOMINATIONS

Document prepared by the Office of the Union

1. The purpose of this document is to:

(a) report on the adoption by the Council of the adoption of the revision of UPOV/INF/12 "Explanatory Notes on Variety Denominations under the UPOV Convention (document UPOV/INF/12/3), Annex I, Part I "Classes within a genus", with regard to Class 4.1 *Solanum tuberosum* L. / Class 4.2 *Solanum* other than Class 4.1;

(b) report on a proposal for a future revision of document UPOV/INF/12/3 Annex I, Part II "Classes encompassing more than one genus" (reproduced in the Annex to this document), with regard to the creation of a new class for *Eupatorium* and *Eutrochium*; and

(c) report on information concerning the registration of variety denominations as trademarks.

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

Background

2. At its sixty-first session, held in Geneva on March 25, 2010, the Administrative and Legal Committee (CAJ) proposed the revision of document UPOV/INF/12/2 Annex I, Part I "Classes within a genus", Class 4, in accordance with the proposals of the Technical Committee (TC) contained in paragraphs 23 and 24 of document CAJ/61/10, as follows (see document CAJ/61/11 "Report on the Conclusions", paragraph 39):

(a) The CAJ noted that there might be advantages in retaining Tomato rootstock species in the same variety denomination class as Tomato, but agreed with the TC conclusion that the Technical Working Party for Vegetables (TWV) should be invited to consider that matter, on the basis of the following two alternatives for an amendment to document UPOV/INF/12/2 Annex I, Part I "Classes within a genus", Class 4:

Alternative 1

	Botanical names	UPOV codes
Class 4.1	*Solanum tuberosum* L.	SOLAN_TUB
Class 4.2	*Solanum lycopersicum* var. *lycopersicum*	SOLAN_LYC_LYC
Class 4.3	*Solanum melongena* L.	SOLAN_MEL
Class 4.4	*Solanum* other than classes 4.1, 4.2 and 4.3	other than classes 4.1, 4.2 and 4.3

Alternative 2

	Botanical names	UPOV codes
Class 4.1	*Solanum tuberosum* L.	SOLAN_TUB
Class 4.2	*Solanum melongena* L.	SOLAN_MEL
Class 4.3	*Solanum* other than classes 4.1 and 4.2	other than classes 4.1 and 4.2

(b) The CAJ agreed that the alternative endorsed by the TWV be put forward as a revision of document UPOV/INF/12/2 for adoption by the Council at its forty-fourth ordinary session, to be held in Geneva on October 21, 2010.

Proposal of the Technical Working Party For Vegetables (TWV)

3. At its forty-fourth session, held in Veliko Tarnovo, Bulgaria, from July 5 to 9, 2010, the TWV agreed to the following structure for document UPOV/INF/12, Class 4:

	Botanical names	UPOV codes	Current UPOV codes
Class 4.1	Solanum tuberosum L.	SOLAN_TUB	SOLAN_TUB
Class 4.2	Tomato & Tomato rootstocks		
	Solanum lycopersicum L. (synonym: Lycopersicon esculentum Mill.)	SOLAN_LYC	LYCOP_ESC
	Solanum cheesmaniae (L. Ridley) Fosberg (Lycopersicon cheesmaniae L. Riley)	SOLAN_CHE	-
	Solanum chilense (Dunal) Reiche (Lycopersicon chilense Dunal)	SOLAN_CHI	-
	Solanum chmielewskii (C.M. Rick et al.) D.M. Spooner et al. (Lycopersicon chmielewskii C. M. Rick et al.)	SOLAN_CHM	-
	Solanum galapagense S.C. Darwin & Peralta (Lycopersicon cheesmaniae f. minor (Hook. f.) C. H. Müll.) (Lycopersicon cheesmaniae var. minor (Hook. f.) D. M. Porter)	SOLAN_GAL	-
	Solanum habrochaites S. Knapp & D.M. Spooner (Lycopersicon agrimoniifolium Dunal) (Lycopersicon hirsutum Dunal) (Lycopersicon hirsutum f. glabratum C. H. Müll.)	SOLAN_HAB	LYCOP_HIR
	Solanum pennellii Correll (Lycopersicon pennellii (Correll) D'Arcy)	SOLAN_PEN	-
	Solanum peruvianum L. (Lycopersicon dentatum Dunal) (Lycopersicon peruvianum (L.) Mill.)	SOLAN_PER	-
	Solanum pimpinellifolium L. (Lycopersicon pimpinellifolium (L.) Mill.) (Lycopersicon racemigerum Lange)	SOLAN_PIM	-
	and hybrids between those species		
Class 4.3	Solanum melongena L.	SOLAN_MEL	SOLAN_MEL
Class 4.4	Solanum other than classes 4.1, 4.2 and 4.3	other than classes 4.1, 4.2 and 4.3	

4. The TWV noted that it might be necessary to revise Class 4 over time if additional species of *Solanum* started to be used as Tomato rootstocks on a regular basis.

Adoption of document UPOV/INF/12/3

5. At its forty-fourth ordinary session, held in Geneva on October 21, 2010, the Council adopted document UPOV/INF/12/3 “Explanatory Notes on Variety Denominations under the UPOV Convention”. A copy of Annex I, Part I “Classes within a genus”, to document UPOV/INF/12/3 is reproduced in Annex I to this document.

6. At its sixty-first session, held in Geneva on March 25, 2010, the CAJ took note that the TC had agreed to the amendment of the UPOV codes for the relevant taxa, simultaneously with any revision of the “Explanatory Notes on Variety Denominations under the UPOV

Convention", document UPOV/INF/12/2, in accordance with the TC proposals, contained in paragraph 25 of document CAJ/61/10 (see document CAJ/61/11 "Report on the Conclusions", paragraph 40). On that basis, document UPOV/INF/12/3 has been published in conjunction with the amendment of the UPOV codes for the relevant taxa in the GENIE database (see Circular E-1504 of March 21, 2011).

EUPATORIUM AND EUTROCHIUM

7. A number of species included within the GENIE database and the UPOV-ROM Plant Variety Database (UPOV-ROM) as species of *Eupatorium* L. have been found to be indicated as belonging to other genera within GRIN[1]:

GENIE database	UPOV code	UPOV-ROM entries	GRIN database
Eupatorium L.	EUPAT	12*	*Eupatorium* L.
Eupatorium adenophorum Spreng. (*Ageratina adenophora* (Spreng.) R. M. King & H. Rob.)	EUPAT_ADE	0	*Ageratina adenophora* (Spreng.) R. M. King & H. Rob.
Eupatorium buniifolium Hook. & Arn. (*Acanthostyles buniifolius* (Hook. & Arn.) R. M. King & H. Rob.)	EUPAT_BUN	0	*Acanthostyles buniifolius* (Hook. & Arn.) R. M. King & H. Rob.
Eupatorium cannabinum L.	EUPAT_CAN	0	*Eupatorium cannabinum* L.
Eupatorium odoratum L. (*Chromolaena odorata* (L.) R. M. King & H. Rob.)	EUPAT_ODO	0	*Chromolaena odorata* (L.) R. M. King & H. Rob.
Eupatorium purpureum L.	EUPAT_PUR	2 (same denomination)	*Eutrochium purpureum* (L.) E. E. Lamont var. *purpureum* name verified on 28-Apr-2009

* 1 variety has same denomination as the variety *Eupatorium ligustrinum Ageratina ligustrina* (DC.) R. M. King & H. Rob. (see below);

2 varieties have the same denomination as the variety of *Eupatorium purpureum* L. (*Eutrochium purpureum* (L.) E. E. Lamont var. *purpureum*)

[1] USDA, ARS, National Genetic Resources Program. *Germplasm Resources Information Network - (GRIN)* [Online Database]. National Germplasm Resources Laboratory, Beltsville, Maryland. URL: *http://www.ars-grin.gov/cgi-bin/npgs/html/tax_search.pl*

Not in GENIE:

GENIE database	UPOV code	UPOV-ROM entries	GRIN database
Eupatorium dubium	-	1	*Eutrochium dubium* (Willd. ex Poir.) E. E. Lamont
Eupatorium ligustrinum	-	1	*Ageratina ligustrina* (DC.) R. M. King & H. Rob.

8. In such cases, problems can occur with the allocation of a variety to the appropriate UPOV denomination class. Document UPOV/INF/12/3 "Explanatory notes on variety denominations under the UPOV Convention", Section 2.5.2 states:

> "2.5.2 The variety denomination classes are as follows:
>
> "(a) General Rule (one genus / one class): for genera and species not covered by the List of Classes in Annex I, a genus is considered to be a class; […]"

9. With regard to UPOV codes, the "Guide to the UPOV Code System" states:

> "3.3 Introduction of New UPOV Codes / Amendments to UPOV Codes
>
> "[…]
>
> "(d) In general, amendments to UPOV codes will not be made as a result of taxonomic developments unless these result in a change to the genus classification of a species. The "Explanatory notes on variety denominations under the UPOV Convention" (document UPOV/INF/12/1) contain UPOV variety denomination classes; for genera and species not covered by the List of Classes in Annex I to document UPOV/INF/12/1, the general rule ("one genus / one class") is that a genus is considered to be a class (see document UPOV/INF/12/1, Section 2.5.2 and its Annex I). Therefore, it is important that the first element of the UPOV code can be used to sort species into the correct genus. The UPOV codes will also be amended if there are consequences for the content of a variety denomination class where the list of classes applies. Amendments to UPOV codes will be handled by the same procedure as the introduction of new UPOV codes as in paragraphs (a) and (b), above. However, in addition, all members of the Union and contributors of data to the Plant Variety Database will be informed of any amendments."

10. In the case of entries in the UPOV-ROM indicated by species, the problem is avoided by the allocation of the UPOV code. However, for entries indicated only by the genus, e.g. *Eupatorium* L., *Eutrochium* Raf., the same species and variety could be included in different denomination classes by different members of the Union.

11. The TC, at its forty-seventh session held in Geneva from April 4 to 7, 2011, noted the botanical synonymies that existed for species of *Eupatorium* L. and invited the TWO to consider the following possible solutions to that situation at its forty-fourth session to be held from November 7 to 11, 2011, in Fukuyama City, Hiroshima Prefecture, Japan:

(a) continue to consider all species currently included within the genus "Eupatorium" in the UPOV-ROM as "Eupatorium" (i.e. *Eupatorium purpureum* L., *Eupatorium dubium*, *Eupatorium ligustrinum*). The TC noted that this approach would not follow the "Guide to the UPOV Code System" and would not guarantee to avoid problems with other species of

"Eupatorium" that might occur in the UPOV-ROM in future: GRIN lists 91 species / subspecies that are sometimes included within "Eupatorium", of which only 17 are considered by GRIN to fall within *Eupatorium* L.. The TC noted that this approach would have the effect of creating a denomination class for "Eupatorium", without explicitly establishing the coverage of the class;

(b) create a new denomination class in document UPOV/INF/12/3 "Explanatory notes on variety denominations under the UPOV Convention", Annex I: Part II. "Classes encompassing more than one genus" to cover relevant genera, e.g. *Eupatorium* L., *Eutrochium* Raf., *Ageratina* Spach, etc.; or

(c) apply the GRIN botanical classification of species and continue to follow the General Rule (one genus / one class). For example, the varieties in the UPOV-ROM indicated as *Eupatorium purpureum* L. would be considered as *Eutrochium purpureum* (L.) E. E. Lamont var. *purpureum* and would be allocated a UPOV code for the genus *Eutrochium* Raf.. The TC noted that such an approach would require that the appropriate species could be correctly identified for the 12 varieties, and any other such entries in future, indicated as *Eupatorium* L. in the UPOV-ROM. The TC noted that this it would also be necessary to amend the UPOV codes for the species concerned (see document TC/47/26 "Report on the Conclusions", paragraphs 22 and 23).

12. The CAJ, at its sixty-third session held in Geneva on April 7, 2011, noted the botanical synonymies that existed for species of Eupatorium L. and noted that the TC, at its forty-seventh session, had invited the TWO to consider possible solutions, as set out in paragraph 11 above.

INFORMATION CONCERNING THE REGISTRATION OF VARIETY DENOMINATIONS AS TRADEMARKS

13. At the Symposium of the Royal General Bulbgrowers' Association (KAVB): "Plant names, global challenges", held in Amsterdam, the Netherlands, on October 12, 2010, a question was raised by a breeder on whether the existence of a variety denomination should be considered by trademark offices as a basis for rejecting a trademark for use for the same genus or species. An official from the Benelux Office for Intellectual Property explained that a trademark would only be rejected if the name was a "common name" and reported that the Benelux Office for Intellectual Property did not consider that a variety denomination constituted a "common name".

14. In order to provide further information on this matter, which may be of interest to members of the Union, the Office of the Union consulted with the Secretariat of the World Intellectual Property Organization (WIPO).

15. The Office of the Union explained that Article 20(1) of the 1991 Act of the UPOV Convention (Article 13(1) of the 1978 Act) provides as follows:

> "(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. " (emphasis added)

and the "Explanatory Notes on Variety Denominations under the UPOV Convention" (document UPOV/INF/12/3), provide as follows:

"*Explanatory Notes – Paragraph (1)*

"1.1 Article 5(2) of the 1991 Act and Article 6(1)(e) of the 1978 Act and the 1961 Convention require that the variety is designated by a denomination. Paragraph (1) provides for the denomination to be the generic designation of the variety, and subject to prior rights, no rights in the designation shall hamper the free use of the denomination of the variety, even after the expiration of the breeder's right. The obligation under paragraph (1) should be considered together with the obligation to use the variety denomination in respect of the offering for sale or marketing of propagating material of the variety (see paragraph (7)).

"1.2 The obligation under paragraph (1) 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 where a name is registered as a trademark by a trademark authority, the use of the name as a variety denomination may transform the trademark into a generic name. In such cases, the trademark may become liable for cancellation[2]. 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."

16. The WIPO Secretariat provided a reference to the recently published document WIPO/STrad/INF/5 (Grounds for Refusal for all Types of Marks) (see *http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_5.pdf*), which, *inter* alia, makes reference to Article 6 *quinquies* of the Paris Convention for the Protection of Industrial Property. In particular,

(a) Article 6 *quinquies* Section B of the Paris Convention provides as follows:

"Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases:

"(i) when they are of such a nature as to infringe rights acquired by third parties in the country where protection is claimed;

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[2] 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."

> "(ii) *when they* are devoid of any distinctive character, or consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or *have become customary* in the current language or in the bona fide and established practices of the trade of the country where protection is claimed;" (emphasis added)

(b) In that respect, the Guide to the Application of the Paris Convention[3] by Professor Bodenhausen adds the following information:

> "(g) Registration may also be refused or invalidated if the trademark concerned consists of a *generic name*, that is, a customary designation of the goods concerned, in the country where the protection is claimed. This has to be determined according to the bona fide and established practices of the trade in such country." (emphasis added)

17. In response to an informal approach by the WIPO Secretariat, the United Kingdom Intellectual Property Office (UKIPO) offered the following information in relation to the examination practice of UKIPO with respect to the application of trademarks that consist of varietal names:

> "VARIETAL NAMES
> Varietal names will no longer face an objection on absolute grounds at the prima facie stage, but *trade mark consisting of varietal names are liable to be declared invalid if the name was generic at the date of application*. If it is apparent to the Examiner that the name is generic he will object in the usual way under Section 3(1)(b),(c) and (d)." (emphasis added)

18. The TC, at its forty-seventh session held in Geneva from April 4 to 7, 2011, and the CAJ, at its sixty-third session held in Geneva on April 7, 2011, noted the information concerning the registration of variety denominations as trademarks, as set out in paragraphs 13 to 17 of this document,

[Annexes follow]

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[3] G. H. C. Bodenhausen: *Guide to the Application of the Paris Convention for the Protection of Industrial Property as revised in Stockholm in 1967,* WIPO Publication No. 661 (E) BIRPI 1969, reprinted 1991, Geneva , Switzerland, p. 116.

ANNEX I

UPOV Variety Denomination Classes:
A Variety Denomination Should not be Used More than Once in the Same Class

For the purposes of providing guidance on the third and fourth sentences of paragraph 2 of Article 20 of the 1991 Act and of Article 13 of the 1978 Act and the 1961 Convention, variety denomination classes have been developed. A variety denomination should not be used more than once in the same class. The classes have been developed such that the botanical taxa within the same class are considered to be closely related and/or liable to mislead or to cause confusion concerning the identity of the variety.

The variety denomination classes are as follows:

(a) General Rule (one genus / one class): for genera and species not covered by the List of Classes in this Annex, a genus is considered to be a class;

(b) Exceptions to the General Rule (list of classes):

(i) classes within a genus: List of classes in this Annex: Part I;

(ii) classes encompassing more than one genus: List of classes in this Annex: Part II.

LIST OF CLASSES

Part I

Classes within a genus

	Botanical names	UPOV codes
Class 1.1	Brassica oleracea	BRASS_OLE
Class 1.2	Brassica other than Brassica oleracea	other than BRASS_OLE
Class 2.1	Beta vulgaris L. var. alba DC., Beta vulgaris L. var. altissima	BETAA_VUL_GVA; BETAA_VUL_GVS
Class 2.2	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	Beta other than classes 2.1 and 2.2.	other than classes 2.1 and 2.2
Class 3.1	Cucumis sativus	CUCUM_SAT
Class 3.2	Cucumis melo	CUCUM_MEL
Class 3.3	Cucumis other than classes 3.1 and 3.2	other than classes 3.1 and 3.2

	Botanical names	UPOV codes
Class 4.1	Solanum tuberosum L.	SOLAN_TUB
Class 4.2	Tomato & Tomato rootstocks	
	Solanum lycopersicum L. (synonym: Lycopersicon esculentum Mill.)	SOLAN_LYC
	Solanum cheesmaniae (L. Ridley) Fosberg (Lycopersicon cheesmaniae L. Riley)	SOLAN_CHE
	Solanum chilense (Dunal) Reiche (Lycopersicon chilense Dunal)	SOLAN_CHI
	Solanum chmielewskii (C.M. Rick et al.) D.M. Spooner et al. (Lycopersicon chmielewskii C. M. Rick et al.)	SOLAN_CHM
	Solanum galapagense S.C. Darwin & Peralta (Lycopersicon cheesmaniae f. minor (Hook. f.) C. H. Müll.) (Lycopersicon cheesmaniae var. minor (Hook. f.) D. M. Porter)	SOLAN_GAL
	Solanum habrochaites S. Knapp & D.M. Spooner (Lycopersicon agrimoniifolium Dunal) (Lycopersicon hirsutum Dunal) (Lycopersicon hirsutum f. glabratum C. H. Müll.)	SOLAN_HAB
	Solanum pennellii Correll (Lycopersicon pennellii (Correll) D'Arcy)	SOLAN_PEN
	Solanum peruvianum L. (Lycopersicon dentatum Dunal) (Lycopersicon peruvianum (L.) Mill.)	SOLAN_PER
	Solanum pimpinellifolium L. (Lycopersicon pimpinellifolium (L.) Mill.) (Lycopersicon racemigerum Lange)	SOLAN_PIM
	and hybrids between those species	
Class 4.3	Solanum melongena L.	SOLAN_MEL
Class 4.4	Solanum other than classes 4.1, 4.2 and 4.3	other than classes 4.1, 4.2 and 4.3

[Annex II follows]

ANNEX II

LIST OF CLASSES (Continuation)

Part II

Classes encompassing more than one genus

	Botanical names	UPOV codes
Class 201	Secale, Triticale, Triticum	SECAL; TRITL; TRITI
Class 202	Megathyrsus, Panicum, Setaria, Steinchisma	MEGAT; PANIC; SETAR; STEIN
Class 203*	Agrostis, Dactylis, Festuca, Festulolium, Lolium, Phalaris, Phleum and Poa	AGROS; DCTLS; FESTU; FESTL; LOLIU; PHALR; PHLEU; POAAA
Class 204*	Lotus, Medicago, Ornithopus, Onobrychis, Trifolium	LOTUS; MEDIC; ORNTP; ONOBR; TRFOL
Class 205	Cichorium, Lactuca	CICHO; LACTU
Class 206	Petunia and Calibrachoa	PETUN; CALIB
Class 207	Chrysanthemum and Ajania	CHRYS; AJANI
Class 208	(Statice) Goniolimon, Limonium, Psylliostachys	GONIO; LIMON; PSYLL
Class 209	(Waxflower) Chamelaucium, Verticordia	CHMLC; VERTI; VECHM
Class 210	Jamesbrittania and Sutera	JAMES; SUTER
Class 211	(Mushrooms) Agaricus Agrocybe Auricularia Dictyophora Flammulina Ganoderma Grifola Hericium Hypsizigus Lentinula Lepista Lyophyllum Meripilus Mycoleptodonoides Naematoloma Panellus Pholiota Pleurotus Polyporus Sparassis Tricholoma	 AGARI AGROC AURIC DICTP FLAMM GANOD GRIFO HERIC HYPSI LENTI LEPIS LYOPH MERIP MYCOL NAEMA PANEL PHLIO PLEUR POLYO SPARA MACRO
Class 212	Verbena L. and Glandularia J. F. Gmel.	VERBE; GLAND

[End of Annex II and of document]

* Classes 203 and 204 are not solely established on the basis of closely related species.