



UPOV/WG-DEN/2/2

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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS

Geneva

WORKING GROUP ON VARIETY DENOMINATIONS

Second Meeting Geneva, October 25, 2016

REVISION OF DOCUMENT UPOV/INF/12/5 "EXPLANATORY NOTES ON VARIETY DENOMINATIONS UNDER THE UPOV CONVENTION"

Document prepared by the Office of the Union

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EXECUTIVE SUMMARY

1. The purpose of this document is to provide background information to assist the Working Group on Variety Denominations (WG-DEN) in its consideration of the proposals for a revision of document UPOV/INF/12/5 "Explanatory Notes on Variety Denominations under the UPOV Convention" (see document UPOV/INF/12/6 Draft 2).

2. The WG-DEN is invited to:

(a) note the matters agreed by the WG-DEN, as reported in paragraph 6 of this document;

(b) note the matters agreed by the WG-DEN to be considered at the second meeting of the WG-DEN, as reported in paragraph 7 of this document;

(c) note the information provided by members of the WG-DEN, as reported in Annexes I to III of this document;

(d) note that the information provided in this document has been incorporated in document UPOV/INF/12/5 "Explanatory Notes on Variety Denominations under the UPOV Convention" as set out in document UPOV/INF/12/6 Draft 2; and

(e) consider the proposals for a revision of document UPOV/INF/12/5 "Explanatory Notes on Variety Denominations under the UPOV Convention" on the basis of document UPOV/INF/12/6 Draft 2.

3. The structure of this document is as follows:

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4. The following abbreviations are used in this document:

CAJ: Administrative and Legal Committee
CAJ-AG: Administrative and Legal Committee Advisory Group
WG-DST: Working Group for the Development of a UPOV Denomination Similarity Search Tool
WG-DEN: Working Group on Variety Denominations

BACKGROUND

5. The background to this matter is provided in document UPOV/WG-DEN/1/2 "Revision of document UPOV/INF/12/5 'Explanatory Notes on Variety Denominations under the UPOV Convention'".

DEVELOPMENTS AT THE WG-DEN, AT ITS FIRST MEETING

Items agreed at the WG-DEN

6. The WG-DEN, at its first meeting, held in Geneva, on March 18, 2016, agreed the following with regard to a possible revision of document UPOV/INF/12/5:

(a) there are four categories of denominations: pronounceable words; letters only (not in the form of pronounceable words); letters and figures; and figures only (see document UPOV/WG-DEN/1/6 "Report", paragraph 7);

(b) to add "genera" in the text of Section 2.2.2 (b) as follows (see document UPOV/WG-DEN/1/6 "Report", paragraph 9):

"(b) accepted market practices for particular variety types (e.g. hybrids) and particular genera/species (e.g. Medicago, Helianthus)."

(c) to add a new paragraph (c) in Section 2.2.2, as proposed by the CAJ-AG at its ninth session, held in Geneva, on October 14 and 17, 2014, as follows (see document UPOV/WG-DEN/1/6 "Report", paragraph 10):

"(c) 'established practice' is determined to be when registration has been accepted for one species or group, so that it can be used in other species which have not yet registered any variety whose denomination consists solely of figures."

(d) to delete Section 2.3.1 (c) from document UPOV/INF/12 because it was not feasible to assess the situation and noted that certain related issues were covered by Section 2.3.4 "Identity of the breeder" (see document UPOV/WG-DEN/1/6 "Report", paragraph 15);

(e) superlatives and comparatives should only be unacceptable if they mislead or cause confusion concerning the characteristics of the variety (see document UPOV/WG-DEN/1/6 "Report", paragraph 18);

(f) on Section 2.3.3 (a) (see document UPOV/WG-DEN/1/6 "Report", paragraph 22):

(i) delete the example of "Lion" and "Raion", and

(ii) add "Helena" and "Elena" as an example of a clear visual difference that may not provide a clear phonetic difference in a language other than English (in Spanish);

(g) with regard to the term "variety" contained in section 2.4 "Different from an existing variety of the same plant species or of a closely related species", the WG-DEN clarified that the term related to the definition of variety as defined in Article 1 (vi) of the 1991 Act of the UPOV Convention (see document UPOV/WG-DEN/1/6 "Report", paragraph 32);

(h) guidance concerning denominations belonging to the same denomination class should be the same, irrespective of whether the denomination class followed the general rule or was one of the exceptional classes (see document UPOV/WG-DEN/1/6 "Report", paragraph 33);

- (i) the term “UPOV-ROM” should be replaced by “PLUTO database” in Section 2.5.3 (see document UPOV/WG-DEN/1/6 “Report”, paragraph 36);
- (j) not to change the current text of the explanatory note on Section 3 “Registration of the denomination” (see document UPOV/WG-DEN/1/6 “Report”, paragraph 37);
- (k) a modification of the last sentence of Section 4(e)(i) as proposed by CAJ-AG, as follows (see document UPOV/WG-DEN/1/6 “Report”, paragraph 40):

“In cases of mere similarity or small likelihood of ~~association~~ confusion by users, waivers granted to breeders by prior trademark right holders could be a suitable solution.”

Items agreed to consider further

7. The WG-DEN agreed to consider the following items at its second meeting:

(a) “fancy name” and “code” as used by the Community Plant Variety Office of the European Union (CPVO): the CPVO to provide further comments for consideration (see document UPOV/WG-DEN/1/6 “Report”, paragraph 6);

(b) the use of “first names”: to refer developments in the CPVO on that matter (see document UPOV/WG-DEN/1/6 “Report”, paragraph 12);

(c) a variety name that consists solely of descriptive terms that mislead or cause confusion concerning the characteristics, value or identity of the variety or the identity of a breeder: examples for acceptable cases to be provided (see document UPOV/WG-DEN/1/6 “Report”, paragraph 13);

(d) the following issues with regard to confusion concerning the use of botanical and common names in relation to denominations (see document UPOV/WG-DEN/1/6 “Report”, paragraph 17):

(i) to consider the guidance of the International Code for the Nomenclature of Cultivated Plants (ICNCP) of the International Commission for the Nomenclature of Cultivated Plants of the International Union for Biological Sciences (IUBS Commission) on the use of botanical and common names with a view to exploring greater harmonization,

(ii) whether to refuse the use of all botanical names and only accept certain common names that have a wider meaning,

(iii) whether to broaden the guidance proposed by the WG-DST in new paragraph (d) to cover the use of any genus/species name that was covered by the same variety denomination class or was in the same crop category,

(iv) whether to provide guidance on the use of part of the genus/species name or a slightly changed version of the genus/species name in a variety denomination, and

(v) whether to consider all languages of UPOV members in relation to common names of the genus to which a variety belongs;

(e) examples of acceptable and unacceptable use of superlatives and comparatives: examples to be provided in document UPOV/INF/12 (see document UPOV/WG-DEN/1/6 “Report”, paragraph 19);

(f) CPVO to provide information on its guidance and experience on the use of color terms when examining variety denominations (see document UPOV/WG-DEN/1/6 “Report”, paragraph 21);

(g) Section 2.3.3 (a), to consider the example of “Bow” and “Bough” (see document UPOV/WG-DEN/1/6 “Report”, paragraph 22);

(h) the proposal made by New Zealand that, for all categories of denominations including pronounceable words, a difference of one letter or one figure should not be considered to be liable to mislead and cause confusion concerning the identity of the variety (see document UPOV/WG-DEN/1/6 “Report”, paragraph 24);

(i) the WG-DST proposal (see below) while noting that Argentina would not accept a difference of one letter with the same number in the case of variety denomination category (iii) "Letters and figures" (see document UPOV/WG-DEN/1/6 "Report", paragraph 26):

"The WG-DST agreed the need to differentiate between letters in the form of words and other cases, and agreed on the following:

(i) in the case of denominations consisting of letters not in the form of words, a difference of a single letter should be regarded as a clear difference, with examples to be provided;

(ii) in the case of denominations consisting of figures, a difference of a single figure should be regarded as a clear difference, with examples to be provided; and

(iii) in the case of denominations consisting of figures and letters, not in the form of words, one letter or figure difference should be regarded as clear difference, with examples to be provided."

(j) re-use of a denomination (see document UPOV/WG-DEN/1/6 "Report", paragraph 27):

(a) to clarify that the guidance only concerns the re-use of denominations in the same denomination class,

(b) to consider whether a time period of 10 years after the variety was no longer commercialized is appropriate for international guidance, given:

(i) the difficulty of obtaining information on commercialization in different territories,

(ii) the presence of varieties in genebanks, and

(iii) that farmers would probably remember varieties over a considerably longer time than 10 years;

(k) the use of prefixes to identify the breeder and issues that could arise, on the basis of information to be provided by the members of the WG-DEN (see document UPOV/WG-DEN/1/6 "Report", paragraph 30);

(l) the list of denomination classes in document UPOV/INF/12 Annex I "List of Classes" to better reflect current practices of members of the Union (see document UPOV/WG-DEN/1/6 "Report", paragraph 34);

(m) cases in which the denomination accepted in the first application was not the denomination used by other authorities when a different denomination was accepted by a second authority (see document UPOV/WG-DEN/1/6 "Report", paragraphs 41 and 44);

(n) document UPOV/INF/12 to be amended to encourage members of the Union to contribute data to the PLUTO database in accordance with the guidance provided in document UPOV/INF/15 "Guidance for members of UPOV" (see document UPOV/WG-DEN/1/6 "Report", paragraph 45);

(o) to investigate the reasons that breeders used names other than variety denominations with a view to considering whether a change to document UPOV/INF/12 could reduce such practices (see document UPOV/WG-DEN/1/6 "Report", paragraphs 47 and 48).

Further information to be provided

8. The WG-DEN, at its first meeting, held in Geneva, on March 18, 2016, agreed to invite members of the WG-DEN to provide the following information by May 20, 2016, as provided in document UPOV/WG-DEN/1/6 "Report":

(a) to provide examples for acceptable cases of variety denominations that consisted solely of descriptive terms (see document UPOV/WG-DEN/1/6 "Report", paragraph 14);

(b) to submit examples of acceptable and unacceptable use of superlatives and comparatives (see document UPOV/WG-DEN/1/6 "Report", paragraph 20);

(c) to provide examples and information on the use of prefixes to identify the breeder and issues that could arise (see document UPOV/WG-DEN/1/6 "Report", paragraph 31);

(d) to make proposals concerning a possible revision of the variety denomination classes (see document UPOV/WG-DEN/1/6 "Report", paragraph 35);

(e) to submit comments/proposals on Section 4(a), regarding prior rights of third persons, in relation to their practices concerning searches and measures concerning prior rights (see document UPOV/WG-DEN/1/6 "Report", paragraph 39); and

(f) to provide information of cases in which the denomination accepted in the first application was not the denomination used by other authorities when a different denomination was accepted by a second authority (see document UPOV/WG-DEN/1/6 "Report", paragraph 43).

9. The Office of the Union issued Circular E-16/088 on April 13, 2016, inviting WG-DEN members to provide the requested information. The information provided by France, the Netherlands and New Zealand is reproduced in Annexes I to III of this document.

10. Document UPOV/IN/12/6 Draft 2 "Explanatory Notes on Variety Denominations under the UPOV Convention", which will be considered by the WG-DEN at its second meeting, incorporates information from WG-DEN, at its first meeting, and submitted by France, the Netherlands and New Zealand.

11. *The WG-DEN is invited to:*

(a) *note the matters agreed by the WG-DEN as reported in paragraph 6 of this document;*

(b) *note the matters agreed by the WG-DEN to be considered at the second meeting of the WG-DEN as reported in paragraph 7 of this document;*

(c) *note the information provided by members of the WG-DEN, as reported in Annexes I to III of this document;*

(d) *note that the information provided in this document has been incorporated in document UPOV/INF/12/5 "Explanatory Notes on Variety Denominations under the UPOV Convention" as set out in document UPOV/INF/12/6 Draft 2; and*

(e) *consider the proposals for a revision of document UPOV/INF/12/5 "Explanatory Notes on Variety Denominations under the UPOV Convention" on the basis of document UPOV/INF/12/6 Draft 2.*

[Annexes follow]

ANNEX I

INFORMATION SUBMITTED BY FRANCE

- Regarding denominations that consist solely of descriptive terms, we are in the opinion that it should be avoided, never mind it is misleading or not. Actually, if misleading, it should be prescribed because of the 3rd sentence of paragraph 2 of UPOV/INF/12/6 (“must not be liable to mislead...”). On the other hand, descriptive denominations should also be avoided even if not misleading, because it may prevent users to identify the variety among other that may possess the same characteristics (1st sentence of paragraph 2 of UPOV/INF/12/6 “denomination must enable the variety to be identified”). For instance, a yellow tomato with big fruits should not be designated by the denomination ‘Yellowsteak’, because it will prevent users to identify this variety amongst other varieties with such characteristics (same for ‘Earlygreen’ for a early variety of green apple).
- Regarding the use of botanical names, we think it should be avoided if it may mislead concerning the identity of the variety, or if it prevents users from identifying the variety amongst others. Latin or common names of the species/genera which the variety belongs (as such, or with an evocating word) should not be the only word of the denomination. Example of non acceptable denominations because preventing from identifying the variety: ‘Lolius’ for a *Lolium perenne* variety, ‘Sunflow’ for a sunflower variety. On the contrary, a denomination proposal ‘Pineapple’ or ‘Cherry’ for a tomato variety may be suitable, provided that it does not cause any confusion concerning the characteristics of the variety. In our opinion, the notion of “crop sector” used in the EU to authorize botanical name used as denomination as soon as it belongs to another crop sector that the one concerned by the variety works quite well (eg a botanical name of an ornamental species for a denomination of a agricultural variety).
- Concerning comparative/superlative, in general we do not accept denominations including this type of terms, provided that (specially for superlative terms) it has not been proved by the competent authority and may thus be misleading. Examples: ‘EXCELSIOR’, ‘EXCELLIUM’.
- Regarding the proposal made by NZ to consider as not misleading a difference of only 1 letter/figure, we do not support this amendment of paragraph 2.3.3 (a) of UPOV/INF/12/6. We recently had a discussion with national breeders, supporting the current European approach not considering, as a general principle, a difference of only 1 letter/figure as consistent not to create confusion.
- Regarding breeder’s identifier in a denomination, France considers breeder as defined by the Art 1 of the UPOV Convention. Furthermore, as licensees may be different depending on the geographical areas concerned and may change depending on commercial strategy of companies and timeframe, we strongly support the necessity to stick to the following principle: a breeder’s identifier in a denomination should only refer to the original breeder or breeding company. The use of breeder’s identifier in a denomination is not compulsory, but when used, it should not be misleading regarding identity of the breeder *sensus stricto*. Example: ‘ABC’ is the prefixe commonly used by breeding company A, while ‘DEF’ is the one used by the breeding company D. For a said crop, A company gives some licenses to D company; for the consistency of D portfolio, A company propose ‘DEF Mano’ for one of the varieties bred by ABC and licensed to D company. From our point of view, this proposal is not acceptable because cause confusion regarding breeder’s identity.
- Concerning UPOV classes, we may comment later on (need for internal consultation).
- Regarding prior rights of third persons, French PBR Office INOV applies the following approach: assuming that a prior right of a third party may prevent users or PBR holder to use the denomination, we may not accept denomination identical to a trade mark on common products. A limited waiver may lead us to accept this denomination. For national listing purposes, a slightly different approach is followed, in line with CPVO’s one: in case of denomination proposal identical to a third person trade mark, applicant is informed of risk of confusion and likelihood of infringement, and therefore invited to take a conclusion whether to go on with this proposal or to propose another denomination.
- Concerning same denominations in all members of the Union, we are in the opinion that necessity of synonyms should be limited to very specific cases (ie already existing variety of the same UPOV class with the same denomination registered/listed in UPOV Member territory or very clear non-acceptable denomination). Following this statement, it is necessary to act for a more harmonized guidance for denomination evaluation, and for an Pluto updating with national/regional consolidated data as soon as possible.

ANNEX II

INFORMATION SUBMITTED BY THE NETHERLANDS

Suggestions and comments on the draft report of the WG-DEN

Naktuinbouw, Roelofarendsveen, The Netherlands
Kees van Ettekoven & Marco Hoffman
19-5-2016

14.. Acceptable denominations consisted of descriptive terms are:

- 'Little Blond', 'White Gold', 'Terracotta'

17 i.. Guidance ICNCP

- Naktuinbouw offers to make a comparison between ICNCP and the UPOV Notes

20.. Acceptable and unacceptable superlatives and comparatives

Acceptable are:

- 'Excellent', 'Brilliant Taste'

Unacceptable are:

- 'Longest of All', 'Best Ever', 'Germany's Best'

31.. Examples and use of prefixes to identify the breeder

- The German Rose breeder Kordes has KOR as the prefix for their varieties; e.g. 'Korbin', 'Korgazell' & 'Korkuma'. It would be misleading if other Rose breeders would use the same prefix.

35.. Variety denomination classes

- For harmonization we suggest to follow the denomination classes of the ICNCP; see appendix V ICNCP. If wished Naktuinbouw can make a comparison and a list of relevant additions.

39.. Practices concerning prior rights

- It often happens that a new variety denomination already registered by a trademark office in in class 31, but the trademark is not in use for the crop concerned. E.g. Grand Bleu is a registered trademark since 1999 (WIPO 719128). In practice it is in use for *Caryopteris xclandonensis* 'Inoveris'. When a Hydrangea breeder wants to use it as a variety denomination for *Hydrangea macrophylla*, he should be able to use it when the trademark owner has no objection.

43.. Examples of different denominations for the same variety provided

47.. Reasons for breeders to use trademarks instead of variety denominations provided

[Annex III follows]

ANNEX III

INFORMATION SUBMITTED BY NEW ZEALAND

Paragraph 14

Sophora 'Early Gold' *Prunus persica* 'Early Gold' the varieties have early flowering/fruiting and yellow orange flowers/fruit. Such a denomination is considered acceptable.

Apple 'Dennys Royal Gala' Acceptable Mr Denny developed the variety from a mutation he identified from 'Royal Gala'

Paragraph 20

Trachelium 'Lake Superior' the use of superior has no connection with value or worth. Acceptable.
Clematis 'Best Wishes' Best has no connection with value, worth. Acceptable

The superlative Supreme has been accepted in denominations, 'Regal Supreme', 'Pink Supreme', 'Thai Supreme' but note that the word order appears to significant because there are very few, if any, denominations where use of Supreme is acceptable when used first "Supreme XXX"

Dahlia Best Bet a colloquial term in New Zealand for "the best", "guaranteed" Not acceptable
Magnolia Best Purple implies the best purple Magnolia. Not acceptable.

Paragraph 30

Eucomis 'Eudun1' The breeder of this variety is the first to use the prefix Eu, indicating the genus of the variety. Does this also indicate the breeder?

Other examples *Agapanthus* 'Agapetite', *Carex* 'Carfit01', *Westringia* 'WES08'

\If a breeder is the first to use a genus prefix to identify their varieties, could this prevent other breeders of that genus from using the genus prefix?

Paragraph 35

There currently exist more than one *Prunus* variety with the same denomination because there exists clear species divisions within the genus; plum, peach, apricot, cherry. Should there be classes within *Prunus*?
In a similar way, should there be classes within *Rubus*; blackberry, raspberry, hybridberry?

Paragraph 39

It is routine to search the NZ trade mark register Class 31 as part of the denomination examination. The search is made using a proprietary similarity search tool called ACSEPTO. If there is a conflict between a mark and the proposed denomination, the applicant is notified and given time to decide their position. When the Class 31 mark is in a goods or service category that differs from denomination usage, the denomination may be accepted. For example, the denomination of a milling wheat variety may conflict with a Class 31 mark used to sell live animals or animal food. The denomination may be accepted because the two are unlikely to cross over in the market place. It is also advisable for the denomination proposer to communicate with the mark holder and if the applicant advises that the mark holder has no objection to the usage of the denomination, the proposed denomination may also be accepted.

Paragraph 43

Case in which the denomination accepted in the first application was not the denomination accepted in all subsequent applications. The acceptance of a subsequent denomination results in a single variety having more than one denomination.

Examples provided.