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INTERNATIONAL UNION FOR THE PROTECTION OF NEW VARIETIES OF PLANTS
GENEVA

AD HOC WORKING GROUP ON VARIETY DENOMINATIONS

First Session
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ISSUES ARISING FROM RESPONSES TO THE
QUESTIONNAIRE ON VARIETY DENOMINATIONS

Document prepared by the Office of the Union

1. The Office of the Union (hereinafter referred to as “the Office”) received an excellent response to the questionnaire sent to members of the *Ad hoc* Working Group on Variety Denominations (hereinafter referred to as “the Working Group”). It received both a large number of responses and very detailed comments on the issues arising when considering variety denominations. A copy of the questionnaire is attached as an Annex to this document.
2. The general aspects which arose as a result of the responses to the questionnaire were the need to: update UPOV recommendations to acknowledge the 1991 Act of the UPOV Convention (hereinafter referred to as “the Convention”); provide a clear link between the recommendations and the relevant Articles of the Convention; eliminate inconsistencies between the recommendations and the Convention; provide, as far as possible, explanatory notes for certain key elements in the Convention, which are not addressed in the current recommendations; review if the classes of closely related species specified in document UPOV/INF/12 Rev. are still universally acceptable; consider how the effectiveness of the UPOV-ROM might be improved; and provide a mechanism for revising recommendations in response to ongoing developments. These aspects are developed below.

Updating UPOV Recommendations to Reflect the 1991 Revision of the Convention

3. The current UPOV Recommendations on Variety Denominations (UPOV/INF/12 Rev.) do not relate to the 1991 Act of the Convention. There are no substantial changes between the variety denomination requirements in Article 13 of the 1978 Act and Article 20 of the 1991 Act. However, it is clear that any future document should make reference to the most recent Act of the Convention.

Linking Recommendations to Relevant Articles of the Convention

4. The recommendations in UPOV/INF/12 Rev. make no systematic reference to the relevant Articles of the Convention. Such links would have two benefits. Firstly, they would enable users seeking guidance on the interpretation of particular aspects of the Convention to find this more easily. Secondly, they would help to ensure that there are no inconsistencies between the recommendations and the Convention.

5. A further benefit would be that this approach would be consistent with the proposal agreed by the Consultative Committee (see document CC/62/8, paragraphs 17-21), for the development of “Explanatory Notes on the 1991 Act of the UPOV Convention.”

Eliminating Inconsistencies Between Recommendations and the Convention

6. As mentioned in paragraph 4 above, the lack of clear links between the recommendations contained in UPOV/INF/12 Rev. and the Convention makes it more likely for inconsistencies to arise. The responses to the questionnaire have highlighted some areas where it might be appropriate to reconsider if the current recommendations are completely consistent with the Convention.

7. For example, Recommendation 10 of UPOV/INF/12 Rev. states that the authority “should accept as far as possible” a variety denomination established in another member State “even if they have objections to it,” whereas Article 20(5) of the 1991 Act of the Convention states that the authority “shall” register the denomination unless it considers the denomination “unsuitable within its territory.” The acceptance of variety denominations registered by other members of the Union is an aspect where further clarification might be beneficial. The interpretation of, for example, “unsuitable within its territory” is particularly critical in this respect, with some members of the Union considering that a variety denomination may be unsuitable if it is difficult to pronounce. Furthermore, a denomination using a different alphabet to that used in the territory might be considered to be unsuitable for a particular territory. Thus, it is important that the issue is not confused by the introduction of recommendations which stray from the terms used in the Convention.

8. In some cases, the recommendations are perhaps not inconsistent, but equally are not completely coherent. For example, Article 20(2) of the 1991 Act states that, in particular, the denomination must be “different” from an existing variety of the same plant species or a closely related species. Recommendation 8(1) of UPOV/INF/12 Rev. states that a variety is not suitable if it is “identical or similar.” There is a possibility that a denomination might be “similar” but still be considered “different.” Furthermore, it has been remarked, in the response to the questionnaire, that the interpretation of an “existing variety” in Recommendation 8(1) and (2) requires some clarification.

Explanatory Notes for Key Elements in the Convention Not Already Addressed in the UPOV Recommendations

9. There are certain important elements in the Convention for which further explanation might be useful. For example, Article 20(2) of the 1991 Act states that the denomination may not consist “solely of figures” except where this is an “established practice” for designating varieties. The responses to the questionnaire indicate that it might be useful, for example, to clarify if the exclusion of denominations consisting solely of figures means that codes containing both letters and figures are not affected by this provision and to provide a non-exhaustive list of what might be considered to be “established practice.”

10. Equally, a non-exhaustive list of types of denomination which might be liable to “mislead or to cause confusion concerning the characteristics, value or identity of the variety or identity of the breeder” (Article 20(2) of the 1991 Act) would appear to be of some help in harmonizing the acceptance of variety denominations. Thus, some members of the Union refuse denominations if these variously are names of famous people, botanical names, well known trading names, common names or breeding terms.

11. Still concerning Article 20(2) of the 1991 Act, it appears that some explanation or clarification of what makes a denomination “different” would be helpful, e.g. is a single digit difference sufficient in some or all cases, or none. Furthermore, the requirement for a denomination to be different from that of any “existing variety” may need to be clarified beyond Recommendation 8 of UPOV/INF/12 Rev. and consideration given to this term in relation to the discussions in the Administrative and Legal Committee (hereinafter referred to as “the CAJ”), on the existence of a variety in Article 7 of the 1991 Act of the Convention.

12. In Article 20(6) of the 1991 Act, it states that 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.” The wording of this Article reflects the importance of harmonized variety denominations for the effective operation of the UPOV system. Recommendation 11 of UPOV/INF/12 Rev. relies on the exchange of official gazettes as the mechanism for this. However, it is clear that the UPOV-ROM is, potentially, a much more effective and efficient way of communicating information regarding variety denominations, and this might be reflected in any future document. Furthermore, although it is not an explicit requirement of the Convention, it might be beneficial to encourage information on variety denominations to be disseminated to those other authorities which are responsible for variety denominations, but are authorities of States or organizations which are not members of the Union.

13. The examples given above are not intended to represent a complete analysis of all elements of the Convention where explanatory notes, including non-exhaustive lists of examples, might be useful. The purpose of these examples is to illustrate that the responses to the questionnaire have highlighted that there are such elements, which are not addressed by the current UPOV Recommendations.

Review of Annex I “List of Classes for Variety Denomination Purposes”

14. The members of the Working Group advised that, in general, they follow Recommendation 9 and Annex I “List of Classes for Variety Denomination Purposes,” but one member did advise of a case where it chose not to follow the Recommendation. This

indicates that it might be appropriate to conduct a wider survey to see if there is a need for a review of the existing classes, or a need to introduce new ones.

Potential for Improved Effectiveness of the UPOV-ROM

15. The responses to the questionnaire indicated that the UPOV-ROM is used differently by the members and observers in the Working Group. Furthermore, there were different views on possible improvements. Suggestions included improved instructions for users and the need to include data from wider sources, such as the Organisation for Economic Co-operation and Development (OECD), international registration authorities and, for ornamental species, commercial registers. This response indicates another area where a survey of all members might be appropriate. In particular, consideration might be given to the role of the UPOV-ROM, or other such database, as an effective and efficient system of complying with members' obligations under Article 20(6) of the 1991 Act of the Convention (see paragraph 12 above).

16. The Working Group is reminded that the Working Group on the Publication of Variety Descriptions (hereinafter referred to as "the WG-PVD") is also concerned with the use of the UPOV ROM, or a web-based database, as a possible means of publishing variety descriptions. Therefore, it would be beneficial if the timing of the advice of the Working Group could, with the help of the Office, be coordinated with the WG-PVD.

Response to Ongoing Developments

17. Developments in variety denominations are subject to different influences and, although general guidance can be provided, the application of such guidance will be influenced by various factors, ranging from breeding developments through to social developments. For example, what might be considered to be "established practice for designating varieties" and the classes of "closely related species" for denomination purposes (see Article 20(2) of the 1991 Act), might change in relation to breeding developments. On the other hand, what is considered by a member to be "unsuitable within its territory" might be influenced by wider factors.

18. Therefore, the future "recommendations," or "explanatory notes" (see paragraph 5 above), might be enhanced by the provision of non-exhaustive lists of examples, which could be subject to periodic updating in relation to ongoing developments.

Conclusion and Future Work Plan

19. The responses to the questionnaire have highlighted aspects in which the current recommendations might be improved and other measures taken. It is suggested that this might be taken forward as follows:

- (a) The Office to draft an updated version of UPOV/INF/12 Rev., in the form of "explanatory notes" clearly linked to the Convention, consistent with the proposal agreed by the Consultative Committee (see paragraph 5 above). This would utilize the existing recommendations as far as possible, but would eliminate any inconsistencies with the Convention and, as appropriate, would be elaborated and clarified to take into

account responses received from the questionnaire. In particular, it would address the matters raised in paragraphs 3 to 13 of this document, as well as any other matters raised by the Working Group at its forthcoming meeting on April 18, 2002. This draft would be presented to the next session of the Working Group which, it is anticipated, would be held during the week commencing October 21, 2002.

(b) The Office to draft a questionnaire for all members of the Union and other interested organizations, seeking information on how the effectiveness of the UPOV-ROM (or similar web-based database) might be improved. It would also seek advice from members on how important and relevant they consider this mechanism to be for complying with Article 20(6) of the 1991 Act of the Convention. This draft questionnaire would be sent to the members of the Working Group for comment, with the aim of issuing a questionnaire by August 2002 in order that the responses can be analyzed by the Working Group and its recommendations reported to the Administrative and Legal Committee (hereinafter referred to as “the CAJ”) during its session in October 2002.

(c) The Office to draft a questionnaire for all members of the Union and other interested organizations, to seek advice on whether there is a need for a review of the classes of closely related species contained in Annex I of UPOV/INF/12 Rev. and, if so, aspects which need to be considered. This draft questionnaire would be sent to the members of the Working Group for comment, with the aim of issuing a questionnaire by December 2002.

(d) The Working Group to consider whether a “standing” group should be established by UPOV, for ongoing review of matters concerning variety denominations.

20. The Working Group is invited to consider the work plan presented in paragraph 19.

[Annex follows]

**QUESTIONNAIRE FOR THE
UPOV WORKING GROUP ON VARIETY DENOMINATIONS**PREPARED BY THE OFFICE OF THE UNION
DECEMBER 21, 2001

This questionnaire is intended to identify common practices and areas of divergence concerning decisions on variety denominations. Members of the Working Group are invited to share their experience in the implementation of the provisions on variety denominations and also to express views on how to further interpret in a harmonized way the current legal framework. This questionnaire can be directly completed and returned in electronic form. Please send it to upov.mail@wipo.int by January 15, 2002.

I. Legal Framework on Variety Denominations

1. Explain briefly how the provisions of Article 20 of the 1991 Act of the UPOV Convention (Article 13 of the 1978 Act) have been implemented in your legislation (please provide, if available, an electronic copy of the relevant provisions).

2. Explain briefly the role, if any, of the UPOV Recommendations on Variety Denominations of October 16, 1987, as amended on October 25, 1991 (document UPOV/INF/12 Rev.), in the application and interpretation of the provisions of your legislation on variety denominations. Please identify any conflict or different approach between these Recommendations and your legislation.

3. Explain briefly your procedure for submission, registration and cancellation of variety denominations.

4. How do you make available the information concerning submission, registration and cancellation of variety denominations?

(a) Official Gazette

<input type="checkbox"/> Yes	<input type="checkbox"/> No
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(b) Communications to authorities of other members of the Union

<input type="checkbox"/> Yes	<input type="checkbox"/> No
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(c) Communications to authorities, also responsible for the registration of variety denominations, of States or organizations that are not members of the Union. If yes, please specify.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(d) Communications to other entities (e.g. Intellectual Property Office). If yes, please specify.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(e) Other ways and recipients

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5. Please indicate, if possible, the approximate average time needed between the submission and the registration of a variety denomination.

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6. The UPOV Convention provides for “observations” (see Article 20(6) of the 1991 Act and Article 13(6) of the 1978 Act). Please indicate if you have a system that permits oppositions, the timing, information required, authority making the decision and whether appeals are possible.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

II. Same Variety Denomination in all Members of the Union

7. Article 20(5) of the 1991 Act (Article 13(5) of the 1978 Act) requires that a variety be submitted to all UPOV members under the same denomination. Please indicate if you have faced the following situations and how you have dealt with them.

(a) The breeder has submitted a different denomination in your territory

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(b) The use of the proposed variety denomination was forbidden due to a prior right in your territory. If yes, please indicate if such prior right has been a trademark (well-known mark or

marks used for identical or similar goods), trade name, geographical indication, names or acronyms of intergovernmental organizations, others...

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(c) The proposed denomination was unsuitable within your territory. If yes, please specify and provide an example if available: (e.g. the acceptance of the proposed denomination was incompatible with a provision in your legislation; the proposed denomination was not pronounceable in the official language/s in your territory; the proposed denomination did not permit the variety to be identified, etc...)

<input type="checkbox"/> Yes	<input type="checkbox"/> No

III. Composition of Variety Denominations

8. Article 20(2) of the 1991 Act (Article 13(2) of the 1978 Act) provides that the denomination may not consist “solely of figures” except where this is an “established practice.” Explain briefly how this provision is implemented in your legislation or relevant guidelines.

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9. Does your legislation accept denominations consisting “solely of figures”? If yes, please specify the rules or conditions.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

10. Could you briefly explain your views on the use of variety denominations consisting “solely in figures”?

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11. Does your legislation define the term “established practice”? If yes, please include the definition.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

IV. Confusing or Misleading Variety Denominations

12. The third sentence of Article 20(2) of the 1991 Act (Article 13(2) of the 1978 Act) indicates that the denomination should not be liable to “mislead” or to “cause confusion” concerning the characteristics, value or identity of the variety or the identity of the breeder. Does your legislation provide for particular provisions or guidelines to implement this provision? If yes, please explain briefly.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

13. In the following cases, please indicate whether a proposed denomination could be considered misleading or confusing:

(a) it consists of, or contains, comparatives or superlatives;

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(b) it consists of, or contains, a term which provides a false impression of a characteristic or value of the variety;

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(c) it consists of, or contains, a reference to a famous person;

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(d) others.

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V. Different from Existing Variety Denominations of the Same Plant Species or of a Closely Related Species

14. The fourth sentence of Article 20(2) of the 1991 Act (Article 13(2) of the 1978 Act) indicates that the denomination must be different from every denomination which designates, in the territory of any member of the Union, an “existing” variety of the “same plant species”

or of a “closely related species.” What are the criteria in your legislation for deciding if the proposed denomination is “different”?

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15. Do you follow UPOV Recommendation 9 and the corresponding Annex 1 for the purposes of identifying what is considered to be a “closely related species”?

<input type="checkbox"/> Yes	<input type="checkbox"/> No

16. Does the addition or removal of a single figure (number or letter) make the proposed denomination “different”. If yes, specify any particular conditions.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

17. What are the sources of information available to identify the denominations of “existing varieties” in the territory of any member of the Union?

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VI. Role of the UPOV-ROM and Possible Improvements

18. Do you use the UPOV-ROM in any of the following ways for the registration procedure of variety denominations?

(a) To check if the breeder has submitted the same denomination as that registered by other members of the Union.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(b) To check if a denomination consisting “solely of figures” has already been registered by other members of the Union.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(c) To check if the proposed denomination is different from others in the territory of a UPOV member for an existing variety of the same plant species or of a closely related species.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(d) Other.

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19. Please advise on possible improvements to the UPOV-ROM which would help the authorities in the procedure for registering variety denominations.

(a) Introduction of a code of species

<input type="checkbox"/> Yes	<input type="checkbox"/> No
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(b) Access to raw data for searching purposes

<input type="checkbox"/> Yes	<input type="checkbox"/> No
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(c) Increase frequency of updating

<input type="checkbox"/> Yes	<input type="checkbox"/> No
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(d) Internet access to the data

<input type="checkbox"/> Yes	<input type="checkbox"/> No
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(e) Inclusion of other sources (e.g. “International Code of Nomenclature for Cultivated Plants”)

<input type="checkbox"/> Yes	<input type="checkbox"/> No
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(f) Are you aware that the UPOV-ROM includes voluntary submission of data from authorities, responsible for the registration of variety denominations, of States or organizations being not members of the Union?

<input type="checkbox"/> Yes	<input type="checkbox"/> No
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(g) Is it necessary for the Office of the Union to actively encourage other voluntary contributions? If yes, please specify.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

(h) Others.

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VII. Other Rights in the Designation Registered as the Denomination

20. Does your legislation address the situation where a breeder, submitting a denomination, is also the owner of a trademark, trade name, or other right identical to the denomination? If yes, please explain.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

21. Article 20(1)(b) of the 1991 Act (Article 13(1) of the 1978 Act) permits the situation in Question 20, on the condition that no other right/s, in the designation, shall hamper the free use of the denomination in connection with the variety, even after the expiration of the breeder's right. Have you experienced or are you aware of any difficulties in applying this provision?

<input type="checkbox"/> Yes	<input type="checkbox"/> No

VIII. Others

22. Does your legislation or practice allow the registration of a variety denomination previously used in connection with a variety that is no longer cultivated? If yes, please specify under what circumstances (e.g. after a certain period; only if the denomination has not acquired any particular importance).

<input type="checkbox"/> Yes	<input type="checkbox"/> No

23. The UPOV Convention requires to register, if possible, the "same" variety denomination, in all members of the Union. This may create some difficulties in States with different official languages or using different alphabets. Does your legislation or practice deal with the situation of the transliteration or translation of variety denominations? If yes, please explain.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

24. Does your legislation introduce other impediments for registration of a variety denomination? (e.g. the exclusion of breeding terms, the exclusion of offensive terms, etc..). If yes, please explain.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

25. Does your legislation contain provisions and remedies concerning non-compliance with the obligations regarding the use of variety denominations? If yes, please specify.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

26. Does the competent Office dealing with the registration of trademarks, receive information concerning submitted, registered and cancelled variety denominations?

<input type="checkbox"/> Yes	<input type="checkbox"/> No

27. Are you aware of oppositions to trademark applications or of cancellations of trademark rights due to prior registered variety denominations? If applicable, please explain.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

28. Do you consider it would be useful to send a similar type of questionnaire to all members of the Union in order to obtain a more complete assessment of the current experience in the application of the provisions on variety denominations? If yes, please indicate any additional question, or change in the present ones.

<input type="checkbox"/> Yes	<input type="checkbox"/> No

Thank you for your contribution.

[End of Annex and of document]