

QUESTION 51

Application of the international convention for the protection of new varieties of plants of 1961

Yearbook 1971/I, pages 129 - 130
Executive Committee of Madrid, October 18 - 23, 1970

Q51

Question Q51

Application of the International Convention on the protection of plant varieties of 1961

Resolution

The Executive Committee

adopts the following resolution:

The International Association for the Protection of Industrial Property

welcomes the increased and improved possibilities for protecting new plant varieties brought about by the Convention for the Protection of New Varieties of Plants of 1961 which entered into force in 1968.

However, the interpretation of Article 13, 9, causes some concern.

It seems that it has been interpreted to mean that the producer or seller of a new variety is entitled to add a trademark to the denomination of that variety, only if that trademark is used for a range of varieties originating from him.

After careful consideration, IAPIP has reached the conclusion that this is not the proper interpretation.

The word "product" in Article 13, 3 and 9, means any merchandise sold under a trademark and in case of Article 13, 9, is wide enough to include a single plant variety.

When a category of products is involved, the words "species" and "genus" are used in the Plant Variety Convention.

The aim of Article 13, 9, is to preserve the basic right of any trademark owner to use a trademark for a particular product, just as much as he would be entitled to use it for a range of products which includes the particular product.

Moreover, any prohibition against the use of a trademark for a single variety only would contravene Article 7 of the Industrial Property Convention, wherever use or intention to use is prerequisite for a valid trademark registration.

IAPIP accordingly draws this matter to the attention of the council of UPOV and asks it to take such measures as may be appropriate.

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QUESTION 51

Application of the international convention for the protection of new varieties of plants of 1961

Yearbook 1973/I, pages 163 - 164
28th Congress of Mexico, November 12 - 18, 1972

Q51

Question Q51

Application of the International Convention for the Protection of New Varieties of Plants of 1961

Resolution

The International Association for the Protection of Industrial Property

considering that it has been invited to attend the meeting of the UPOV Working Party on Variety Denominations which will discuss the observations of a certain number of non-governmental organizations regarding the provisional guidelines for variety denominations;

considering that the intention behind the provisions of Article 13 (5) of the UPOV Convention clearly is that the denomination of a new variety should as far as possible be the same in all the Member States;

considering that it becomes increasingly difficult to find trademarks which can freely be adopted and that plant breeders should not be subjected to the same difficulties in selecting variety denominations,

considering further that Article 13 (9) of the Convention provides that it shall be permitted in respect of a product to add a trademark or a trade name to the denomination of a new variety;

considering also that no undue restrictions can be imposed regarding the use of a trademark by its lawful owner;

expresses as its opinion:

1. that the adoption of common rules for determining variety denominations is desirable with a view to harmonizing the application of Article 13 of the Convention in all Member States, but that the present guidelines are too exacting in the conditions they impose upon variety denominations and should therefore be eased more particularly in that it should not be necessary that the variety denomination consists solely of a word or words or of a combination of a word with letters and/or figures, but it should be sufficient that the denomination consists of one or more syllables optionally combined with one or more figures and/or letters;

2. that no obligation as regards the use of a trademark in addition to the variety denomination should be imposed other than the provision that the variety denomination must always be used in such a manner that it is clearly visible and legible, so that the buyer will not be confused with regard to the identity of a variety.

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QUESTION 51

Application of the international convention for the protection of new varieties of plants of 1961

Yearbook 1978/II, pages 145 - 146
40th Congress of Munich, May 15 - 19, 1978

Q51

Question Q51

Application of the International Convention for the Protection of New Varieties of Plants of 1961

Resolution

The IAPIP

welcomes the convening of the Diplomatic Conference on the Revision of the International Convention for the Protection of New Varieties of Plants and expresses the hope that this Conference will provide for further improving and strengthening of the protection of new varieties of plants.

Since the aim of a new breed and in particular of ornamental plants is a new shape, colour or fragrance of the plant or flower, the IAPIP feels that the alternative left open to member States under Article 5(4) of the International Convention to extend the protection to embrace the commercially marketed product, should be made an obligation, so as not to deprive the breeder of his reward by allowing imports of the products from countries where no protection exists.

The situation is comparable to process protection in the field of chemical patents. In this field, it has been recognized that the final product of the process should equally be protected. Rules to this effect are included in most national laws and have recently been included also into supranational agreements.

Should the efforts fail to protect the commercially marketed final product by the Convention, it is felt that the National Groups of the IAPIP in the countries which do not yet grant such protection should by all available means seek to obtain such protection by the respective national laws, at least for ornamental plants.

2. With respect to the three alternatives contained in the draft of the revised International Convention (Document UPOV DC/4) concerning Art. 13(4) and 8(b), preference is given to alternative 2. Alternative 3 is rejected since thereby other rights would unnecessarily be restricted in countries where a variety protection does not exist.¹

3. The IAPIP approves the version suggested for Article 13(7). In Section 9, the words in square brackets in the first sentence should be maintained. The second sentence should be deleted.²

1 Proposed Article 13(4) (a):

If the breeder submits in a member State of the Union as the denomination of a variety a designation in respect of which he enjoys a right which could hamper the free use of the variety denomination, he may not, as from the time when the variety denomination is registered, continue to assert his right in order to hamper the free use of the variety denomination [Alternative 1: in any member State of the Union applying the provisions of the Convention to the genus or species to which the variety belongs] [Alternative 2: in that State] [Alternative 3: in any member State of the Union].

Proposed Article 13 (8) (b):

The denomination of the variety shall [Alternative 1: in any member State of the Union applying the provisions of the Convention to the genus or species to which the variety belongs] [Alternative 2: in that State] [Alternative 3: in any member State of the Union] be regarded as the generic name for that variety. Subject to the provisions of paragraph (4) (b), no person may [Alternative 1: in any member State of the Union applying the provisions of the Convention to the genus or species to which the variety belongs] [Alternative 2: in that State] [Alternative 3: in any member State of the Union] apply for, or obtain, a right which could hamper the free use of the denomination.

2 The wording recommended by the IAPIP would thus read as follows:

(9) When a variety is offered for sale or marketed, it shall be permitted, in respect of the same product, to add a trademark or a trade name to the denomination of the variety.

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QUESTION 51

Application of the international convention for the protection of new varieties of plants of 1961

Yearbook 1991/I, page 278

Q51

Executive Committee of Barcelona, September 30 - October 5, 1990

Question Q51

Utilization of the International Convention for the Protection of New Varieties of Plants of 1961 (UPOV)

Resolution

1. AIPPI

- reaffirms its resolutions taken in Rio de Janeiro in May 1985 on Q 82 (Annuaire 1985/III D 348, F 276, E 312) and in April 1988 in Sydney (Annuaire 1988/II D 237, F 199, E 221) on Q 93 (Biotechnology).
 - welcomes the calling of a diplomatic conference for the revision of the Convention for the Protection of Plant Varieties of 1961 (UPOV) to be held in Geneva in March 1991, having regard to the developments in the field of the creation and breeding of new plant varieties and the resulting overlap with patent laws which rendered urgent a revision of the convention.
2. Having studied the draft text of the convention prepared by the Office of the Union (UPOV document 10 M/5/2 of August 22, 1990), the AIPPI notes with approval-
- a) that the prohibition of double protection according to Article 2, para. 2 of the present text, has been abolished;
 - b) that it is intended to incorporate definitions of certain concepts of the Convention and notably the concept of varieties;
 - c) that the general principle of national treatment has been incorporated;
 - d) that the effect of the breeder's right should no longer be confined to the propagating material only and shall in all contracting states parties extend also to the harvested material of the protected variety derived from the reproductive or vegetative

propagating material, as demanded by the AIPPI in its resolution of Munich in May 1978 on Q 51;

- e) that the general minimum duration of the breeder's right is to be not less than 20 years and not less than 25 years for trees and vines; and
 - f) that a measure of provisional protection of limited scope is contemplated during the period between the publication of the application for the grant of a breeder's right and the decision thereon, by way of remuneration from any person who also uses the variety in question.
3. It is, moreover, noted with satisfaction that the "Collision Norm" contained in the previous draft of June 22, 1989 (UPOV document IOM/IV/2) and by which a granted plant variety right would intervene in other laws by way of expropriation or compulsory licences, have been completely removed.

In this regard, the AIPPI reaffirms its position concerning breeder's rights that compulsory licence should be granted only in the public interest.

- 4. AIPPI is satisfied that the new text has retained the existing provision which permits the use of a specific mark as well as a varietal denomination as generic name for the purpose of offering for sale and distribution of a protected plant variety.
- 5. The proposals in the draft for the farmer's privileges as well as the specific provisions for the breeders' privileges appear obscure on several points and require further study.

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