

**Plant variety names and synonyms and
the *Plant Breeder's Rights Act 1994* (Cth)**

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Table of contents

Executive summary	iiv
Listing of recommendations	x
Part 1: Introduction	1
Part 2: Relevant negotiations, laws, practices, and so on	8
2.1 WTO TRIPS Agreement	8
2.2 UPOV scheme	8
2.3 Plant Breeder’s Rights Act 1994 (Cth)	9
2.4 Trade Marks Act 1995 (Cth)	12
2.5 Decisions about PBRs and trade marks.....	20
2.5.1 Heritage Seeds Pty Ltd (2007).....	20
2.5.2 Re SFR Holdings Inc (2013).....	21
2.5.3 Mastronardi Produce Ltd v Registrar of Trade Marks (2014).....	23
2.5.4 Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks (2015)	26
2.5.5 Other related litigation in Australia	27
2.6 ACIP review	28
Part 3: Review of relevant prior academic and trade literature.....	29
Part 4: Review of any empirical materials	32
Part 5: Analysis of the policy issue	33
5.1 The operation of naming for PBRs and trade marks.....	33
5.2 Names or synonyms that are deceptive, confusing or contrary to law	37
5.3 Plant variety names or synonyms that ‘be or include’ a trade mark	44
5.4 The problem of composite trade marks	47
5.5 Misleading names and synonyms	49
5.6 The apparent requirement for a synonym	51
5.7 Codes as Names	53
5.8 Non-Roman characters and transliterations of names and synonyms	54
5.9 Formal signage of PBR protected names and synonyms	56
5.10 Using the PBR protected name in marketing.....	58
5.11 UPOV harmonisation of plant naming	60
5.12 Trade names, designations or references and trade marks and plant names.....	61
Part 6: Final words.....	65
References.....	66
Attachment 1.....	72
Attachment 2.....	73
Attachment 3.....	76
Attachment 4.....	79

Executive summary

Plant variety names and synonyms under the *Plant Breeder's Rights Act 1994* (Cth) are essential to identifying plant varieties and distinguishing between different plant varieties. There are, however, conflicting purposes for plant variety names and synonyms, the key one being as a trade mark under the *Trade Mark Act 1995* (Cth). These legislative schemes conflict where the *Plant Breeder's Rights Act 1994* (Cth) requires a name or synonym to describe a plant variety while the *Trade Mark Act 1995* (Cth) requires a sign that can be a name or synonym to identify the goods and services of one person from another person. This report is about the policy setting to achieve an appropriate balance, and importantly, ensuring that a *Plant Breeder's Rights Act 1994* (Cth) name or synonym is available for everyone to describe a plant variety without the property rights of a *Trade Mark Act 1995* (Cth) trade mark.

This report was prepared as part of a contract with IP Australia for 'Research in respect of Plant Breeder's Rights policy issues and presentation of an analytical report: C2022/10042'. This report delivers on that part of the contract about 'The inclusion of trade marks in plant variety names and synonyms'.

The report includes a comprehensive review of the relevant negotiations, laws, practices, statutory schemes, judgements, policy reviews, academic and scholarly literature and IP Australia's empirical materials about breeder's rights. After that the report addresses the identified policy issues that might need further consideration and includes an analysis and recommendations.

The operation of naming for PBRs and trade marks (§5.1)

While the scheme for variety naming in the *Plant Breeder's Rights Act 1994* (Cth) appears simple, its practical application is complex with different and overlapping arrangements for naming under the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth). The tensions between the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth) manifest in ways that are dependent on the time order of applications. This is because the assessment of compatibility of the PBR name and synonym and trade mark is made at the time of the later application. To address this problem, the relevant considerations for the *Plant Breeder's Rights Act 1994* (Cth) should be set out clearly so that examiners and those applying know and understand the process and relevant thresholds for a successful application. Similarly, it is also important for applications under the *Trade Marks Act 1995* (Cth) involving plant names and synonyms that examiners and those applying know and understand the process and relevant thresholds for a successful application.

Recommendation 1

IP Australia should address the problems imposed by trade marks under the *Trade Marks Act 1995* (Cth) as they apply to the *Plant Breeder's Rights Act 1994* (Cth) during PBR examination through explanatory materials to assist the PBR stakeholders, including small and medium enterprises, understanding the requirements for suitable names and synonyms. Specifically, IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) about choosing suitable names and synonyms with clearer guidance about:

1. A name or synonym that is not likely to deceive or cause confusion.
2. A name or synonym that does not be or include a trade mark.

Recommendation 2

IP Australia should continue to harmonize the guidance and practice of trade mark examiners to ensure they are aware of the specific needs of names and synonyms under the *Plant Breeder's Rights Act 1994* (Cth).

Names or synonyms that are deceptive, confusing or contrary to law (§5.2)

Neither the *Plant Breeder's Rights Act 1994* (Cth) nor the *Trade Marks Act 1995* (Cth) directly address how different a plant variety name or synonym must be from the trade marks, how different a trade marks must be from the plant variety name or synonym, and how similar plant variety names or synonyms can be to each other. The *Plant Breeder's Rights Act 1994* (Cth) provides that a name and synonym should not 'be likely to deceive or cause confusion' or 'contrary to law', and the *Trade Marks Act 1995* (Cth) provides that a trade mark should not be registered if a 'connotation' would 'be likely to deceive or cause confusion', it is 'substantially identical or deceptively similar' to another trade mark or is 'contrary to law'. These standards have overlapping operation and the the *Trade Marks Act 1995* (Cth) experience is useful in informing the application of the related *Plant Breeder's Rights Act 1994* (Cth) provisions.

Recommendation 3

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that a plant variety name and synonym must not 'be likely to deceive or cause confusion' informed by the *Trade Marks Act 1995* (Cth) standard 'substantially identical with, or deceptively similar to'.

Recommendation 4

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that a plant variety name and synonym must not be 'misleading or deceptive or is likely to mislead or deceive' under the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws.

Recommendation 5

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that a plant varieties with the same owner can be a naming thicket so as not to deceive or cause confusion.

Plant variety names or synonyms that 'be or include' a trade mark (§5.3)

The *Plant Breeder's Rights Act 1994* (Cth) provides that a plant variety name or synonym must not 'be or include' a registered trade mark or current application for a trade mark under the *Trade Marks Act 1995* (Cth) 'in respect of live plants, plant cells and plant tissues'. The further limitations under the *Plant Breeder's Rights Act 1994* (Cth) are that a plant variety name or synonym must be 'a word or words (whether invented or not) with or without the addition of either or both' of 'a letter or letters that do not constitute a word' and/or 'a figure or figures' and 'comply with the International Code of Botanical Nomenclature and subsidiary codes'.

Once a word or words have been identified, the issue for the examiner under the *Plant Breeder's Rights Act 1994* (Cth) is to assess how different does a name have to be to be a valid plant variety name or synonym?

Recommendation 6

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines about the forms of trade marks that are likely to either co-exist or conflict with plant variety names or synonyms under the *Plant Breeder's Rights Act 1994* (Cth).

The problem of composite trade marks (§5.4)

A possible problem arises where a trade mark includes in combination with words any devices, shapes, sounds, scents and/or colour elements as a composite trade mark. For such a composite to be registered the trade mark must be 'capable of distinguishing the applicant's goods or services'. The problem arises for the *Plant Breeder's Rights Act 1994* (Cth) when the plant variety name and synonym are a part of the composite trade mark and then how to apply the *Plant Breeder's Rights Act 1994* (Cth) provision that a name or synonym not 'be or include a trade mark ... in respect of live plants, plant cells and plant tissues'.

Recommendation 7

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) and other materials to clarify the treatment of words in composite trade marks as they apply plant variety names or synonyms under the *Plant Breeder's Rights Act 1994* (Cth).

Misleading names and synonyms (§5.5)

The *International Convention for the Protection of New Varieties of Plants* done at Geneva on 19 March 1991 (UPOV 1991), that is implemented in the *Plant Breeder's Rights Act 1994* (Cth) provides, in part, that a variety denomination 'must not be liable to mislead ... concerning the characteristics, value or identity of the variety or the identity of the breeder'. The concern is that the current *Plant Breeder's Rights Act 1994* (Cth) does not include this UPOV requirement. This is not correct. The current *Plant Breeder's Rights Act 1994* (Cth) provides a broad requirement that a valid name or synonym must not 'be contrary to law' that will include the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws that provide '[a] person must not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive'.

Recommendation 8

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) and other materials to clarify the role of the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws as they apply plant variety names or synonyms under the *Plant Breeder's Rights Act 1994* (Cth).

The apparent requirement for a synonym (§5.6)

The concern is that the application form provided by IP Australia seeks a synonym when this is not necessarily a requirement under the *Plant Breeder's Rights Act 1994* (Cth). The *only*

requirement for a synonym is when a PBR has been granted in another UPOV jurisdiction using a name that does not satisfy the *Plant Breeder's Rights Act 1994* (Cth) requirements for a word or words with letters and figures, comply with international naming codes and satisfy various other standards such as not be contrary to law and not include the name of a deceased person. The consequence is that novice applicants might be compromising their future uses of possible trade mark words as valuable marketing tools by using the words as a PBR synonym rather than as a trade mark under the *Trade Marks Act 1995* (Cth).

Recommendation 9

IP Australia should amend the application form and other guidance and practice materials and information to make it clear that a synonym is not necessarily required for a successful PBR grant unless a synonym has been granted in another UPOV jurisdiction.

Codes as Names (§5.7)

A long running debate in UPOV has been about variety denominations in the form of figures such as '91150' rather than names comprising words, letters and figures and combinations such as 'AX350'. The problem remains that there is a practice among some breeders to use variety denominations comprised only of figures and this can create problems for registering variety denominations under the current *Plant Breeder's Rights Act 1994* (Cth) that only accepts PBR names and synonyms be a word or words, with or without letters or figures but not just figures. UPOV 1991 does provide for plant variety name or synonym consisting solely of figures where breeders have an established practice for designating varieties. There does not appear, however, to be any need for such an amendment among stakeholders.

Recommendation 10

The Australian Government should retain the current *Plant Breeder's Rights Act 1994* (Cth) requirement that PBR names and synonyms be a word or words, with or without letters or figures but not just figures.

Non-Roman characters and transliterations of names and synonyms (§5.8)

The *Plant Breeder's Rights Act 1994* (Cth) provides that a plant variety name and synonym must be 'a word or words (whether invented or not) with or without the addition of either or both' of 'a letter or letters that do not constitute a word' and/or 'a figure or figures'. The concern is that the current *Plant Breeder's Rights Act 1994* (Cth) scheme assumes names and figures will conform with Roman characters and many of the checks on examination use databases that only include Roman characters and transliterations of names and synonyms in Roman characters. The question is whether plant variety name and synonym should accommodate non-Roman characters in plant variety names and synonyms.

Recommendation 11

The Australian Government should seek to harmonise plant variety names and synonyms under the *Plant Breeder's Rights Act 1994* (Cth) to exclude non-Roman characters and retain the practice of requiring original Roman character scripts and any non-Roman characters be accompanied with transliterations, transcriptions or translations into Roman scripts.

Formal signage of PBR protected names and synonyms (§5.9)

The *Plant Breeder's Rights Act 1994* (Cth) provides that a PBR is infringed if the name or synonym entered on the Register of Plant Varieties is used for 'any other plant variety of the same plant class' or 'a plant of any other variety of the same plant class' being plants in the same genus or belonging to 'a group of closely related genera'. The effect of this provision is to make the name and synonym protected names. The current lacuna is where the name or synonym is used and there is no associated label with the PBR logo. Unlike copyrights (©) or trade marks (™ and ®), PBRs do not have similar universal notices of their protected status. Should a plant variety name or synonym be accompanied by some form of symbol that protects that name under the *Plant Breeder's Rights Act 1994* (Cth) and addresses the innocent infringement defence?

Recommendation 12

The Australian Government should monitor developments among stakeholders and at UPOV and other fora whether the names and synonyms entered on the Register of Plant Varieties should have some indication of the protected status of the name like copyrights (©) or trade marks (™ and ®).

Using the PBR protected name in marketing (§5.10)

The *Plant Breeder's Rights Act 1994* (Cth) does not presently require the use of the protected name whenever a PBR protected variety is sold, offered for sale or marketed. This is a requirement in UPOV 1991 and has been implemented in other jurisdictions. The current *Plant Breeder's Rights Act 1994* (Cth) seeks a delicate compromise between the use of the plant denomination and synonym with the uses of other commercial marking arrangements including the *Trade Marks Act 1995* (Cth). To ensure a clear demarcation between the PBR'ed name (being one name for a defined variety that can be used without limitation) and other names and marks, such as trade marks under the *Trade Marks Act 1995* (Cth), the *Plant Breeder's Rights Act 1994* (Cth) should require the selling, offering for sale or marketing to include the easily recognisable PBR name together with any associated names and marks. The United Kingdom *Plant Varieties Act 1997* (UK) provides a suitable model.

Recommendation 13

The Australian Government should amend the *Plant Breeder's Rights Act 1994* (Cth) to require the use of the PBR protected name whenever a PBR protected variety is sold, offered for sale or marketed with a variety name for the purposes of propagation as opposed to final consumption, and this should not preclude associated names and marks so long as the PBR protected name is easily recognisable.

UPOV harmonisation of plant naming (§5.11)

There is variation in naming varieties for PBRs in different jurisdictions with the possibility that a name in one jurisdiction might be rejected in another. A broader harmonisation process like the *Patent Cooperation Treaty* system to enable the filing of PBR applications in several countries with a single application that will include variety denominations could resolve some of these problems. UPOV has started this process developing the PRISMA on-line tool to assist making plant variety protection applications across participating UPOV members. Australia is already a part of this program.

Recommendation 14

The Australian Government should continue supporting a harmonization process to enable the filing of PBR applications in several countries with a single application. This will introduce consistent variety naming rules across UPOV members and harmonise naming practices.

Trade names, designations or references and trade marks and plant names (§5.12)

The basic distinction between a trade mark and a trade name (or trade designation or trade reference) is that the former is protected by the *Trade Marks Act 1995* (Cth) while the latter is protected through an action for passing off or unfair competition. A trade name can appear like a plant name and will often be used in a trade mark application. Such a name may be capable of distinguishing trade sources of a named plant variety and so might also be a valid to distinguish varieties for the purposes of the PBR name. The point here is that a trade name can, depending on the evidence, distinguish the goods or services of a trade mark applicant and be a valid trade mark under the *Trade Marks Act 1995* (Cth). Clearly, however, a trade name must be distinguished from a plant variety name that cannot itself be a trade mark *per se*.

Recommendation 15

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines about the uses of trade names (or trade designations or trade references) together with plant variety names for the purposes of the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth).

Listing of recommendations

1. IP Australia should address the problems imposed by trade marks under the *Trade Marks Act 1995* (Cth) as they apply to the *Plant Breeder's Rights Act 1994* (Cth) during PBR examination through explanatory materials to assist the PBR stakeholders, including small and medium enterprises, understanding the requirements for suitable names and synonyms. Specifically, IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) about choosing suitable names and synonyms with clearer guidance about:
 3. A name or synonym that is not likely to deceive or cause confusion.
 4. A name or synonym that does not be or include a trade mark.
2. IP Australia should continue to harmonize the guidance and practice of trade mark examiners to ensure they are aware of the specific needs of names and synonyms under the *Plant Breeder's Rights Act 1994* (Cth).
3. IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that a plant variety name and synonym must not 'be likely to deceive or cause confusion' informed by the *Trade Marks Act 1995* (Cth) standard 'substantially identical with, or deceptively similar to'.
4. IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that a plant variety name and synonym must not be 'misleading or deceptive or is likely to mislead or deceive' under the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws.
5. IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that a plant varieties with the same owner can be a naming thicket so as not to deceive or cause confusion.
6. IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines about the forms of trade marks that are likely to either co-exist or conflict with plant variety names or synonyms under the *Plant Breeder's Rights Act 1994* (Cth).
7. IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) and other materials to clarify the treatment of words in composite trade marks as they apply plant variety names or synonyms under the *Plant Breeder's Rights Act 1994* (Cth).
8. IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) and other materials to clarify the role of the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws as they apply plant variety names or synonyms under the *Plant Breeder's Rights Act 1994* (Cth).
9. IP Australia should amend the application form and other guidance and practice materials and information to make it clear that a synonym is not necessarily required for a successful PBR grant unless a synonym has been granted in another UPOV jurisdiction.
10. The Australian Government should retain the current *Plant Breeder's Rights Act 1994* (Cth) requirement that PBR names and synonyms be a word or words, with or without letters or figures but not just figures.
11. The Australian Government should seek to harmonise plant variety names and synonyms under the *Plant Breeder's Rights Act 1994* (Cth) to exclude non-Roman characters and retain the practice of requiring original Roman character scripts and any non-Roman characters be accompanied with transliterations, transcriptions or translations into Roman scripts.

12. The Australian Government should monitor developments among stakeholders and at UPOV and other fora whether the names and synonyms entered on the Register of Plant Varieties should have some indication of the protected status of the name like copyrights (©) or trade marks (™ and ®).
13. The Australian Government should amend the *Plant Breeder's Rights Act 1994* (Cth) to require the use of the PBR protected name whenever a PBR protected variety is sold, offered for sale or marketed with a variety name for the purposes of propagation as opposed to final consumption, and this should not preclude associated names and marks so long as the PBR protected name is easily recognisable.
14. The Australian Government should continue supporting a harmonization process to enable the filing of PBR applications in several countries with a single application. This will introduce consistent variety naming rules across UPOV members and harmonise naming practices.
15. IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines about the uses of trade names (or trade designations or trade references) together with plant variety names for the purposes of the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth).

Part 1: Introduction

Names for plants have many purposes – identifying an unfamiliar organism, a convenient and practical way to know what is being discussed, an orderly system for storing and retrieving information, showing kinship relationships between organisms, constructing classes about which inductive generalisations might be made, and so on.¹ The core ideal here is that a name is fundamental to communication about plants,² and as an anchor for mobilizing, serving, integrating and exchanging information about plants.³ The other advantage of a name is that it is much easier to use than a lengthy description.⁴ The *Plant Breeder's Rights Act 1994* (Cth) has harnessed these ideals requiring an application for a Plant Breeder's Rights (PBRs) to disclose a variety name as a unique identifier and description of the plant.⁵ More specifically, the *Plant Breeder's Rights Act 1994* (Cth) requires that the names used for new varieties 'must comply with the International Code of Botanical Nomenclature and subsidiary codes'.⁶ This is important because the naming codes capture a consensus about defining and describing a plant that is accepted around the world.⁷ The *Plant Breeder's Rights Act 1994* (Cth) does not, however, just apply these naming codes *per se* as plant names for PBRs are for the purposes of the *Plant Breeder's Rights Act 1994* (Cth) that do not necessarily coincide with the other purposes of plant names.

There is, of course, a long history to plant naming. The origins are with ideas of natural kinds and essences distinguishing between things we can see and their universal forms, and the conception that things could be grouped into their natural kinds that might reveal their ideal form or essence.⁸ Over time names expanded to include many words describing the object until that was reigned in to reflect our modern naming conventions:

Up until Carl Linnaeus applied linguistic rules (albeit just recommendations rather than strict rules),⁹ nomenclatures proceeded on the basis that the non-vernacular name defined the plant or animal and this usually involved a single word for a known kind of plant (a generic word, such as Chestnut), and then an additional word or words if two or more kinds were known (a specific word with a generic word, such as Red Oak, Pin Oak, and so on).¹⁰ As the number of known species increased 'the specific names developed into long descriptive phrases'¹¹ that were 'just sufficient to distinguish a given species

¹ Frederick Warburton, 'The Purpose of Classifications' (1967) 26 *Systematic Zoology* 241, 241-242.

² See Roger Spencer, Rob Cross and Peter Lumley, *Plant Names: A Guide to Botanical Nomenclature* (3rd edition, CSIRO Publishing, 2007) p. 1.

³ Charles Hussey, Yde de Jong and David Remsen, 'Actual Usage of Biological Nomenclature and its Implications for Data Integrators; A National, Regional and Global Perspective' (2008) 1950 *ZooTaxa* 5, 5.

⁴ D. Gledhill, *The Names of Plants* (Cambridge University Press, 1985) p. 3.

⁵ *Plant Breeder's Rights Act 1994* (Cth) s. 26(2)(f).

⁶ *Plant Breeder's Rights Act 1994* (Cth) s. 27(6).

⁷ See Brad Sherman, 'Taxonomic Property' (2008) 67 *Cambridge Law Journal* 560, 566-583.

⁸ See Karl Popper, *The Open Society and Its Enemies* (Princeton, 1950) p. 31.

⁹ See Benoît Dayrat, 'Celebrating 250 Dynamic Years of Nomenclatural Debates' in Andrew Polaszek, *Systema Naturae 250: The Linnaean Ark* (CRC Press, 2010) pp. 189-190. See also T Sprague, 'The Plan of Species Plantarum' (1955) 165 *Proceedings of the Linnaean Society of London* 151.

¹⁰ Helen Choate, 'The Origin and Development of the Binomial System of Nomenclature' (1912) 15 *Plant World* 257, 257. See also Sandra Knapp, Gerardo Lamas, Eimear Nic Lughadha and Gianfranco Novarino, 'Stability or Stasis in the Names of Organisms: The Evolving Codes of Nomenclature' (2004) 359 *Philosophical Transactions of the Royal Society of London B: Biological Sciences* 611, 611-612; William Stearn, 'The Background of Linnaeus's Contributions to the Nomenclature and Methods of Systematic Biology' (1959) 8 *Systematic Zoology* 4, 5-7.

¹¹ Helen Choate, 'The Origin and Development of the Binomial System of Nomenclature' (1912) 15 *Plant World* 257, 257. See also Stearn, *ibid.*, 6.

unambiguously from all others included within the same genus'.¹² These polynomial phrase-names reflected the Aristotelian ideal that an organism could be identified and distinguished according to a statement in words of a 'genus' together with the 'differentia' to render a definition (species).¹³ In Aristotelian terminology the genus being 'the category of essence all such things as it would be appropriate to mention in reply to the question, "What is the object before you?"', and the definition (species) being 'a phrase signifying a thing's essence'.¹⁴ Examples set out by Linnaeus's *Flora svecica* (1745) for the species grouped in the genus *Veronica* illustrate the polynomial name description: *Veronica floribus spicatis, foliis ternis*; *Veronica floribus spicatis, foliis oppositis, caule erecto*; *Veronica floribus racemosis lateralibus, foliis linearibus integerrimis*; and so on.¹⁵

A key development in biological taxonomy was recognising that the essence of a thing may not be knowable¹⁶ because the essences and properties could not necessarily be distinguished,¹⁷ and therefore the taxonomy was arbitrary and convenient: 'these boundaries of species are as men, and not as Nature, makes them'.¹⁸ While maintaining the language of Aristotle, this was a significant advance because this recognised that the name was not a definition of the essence (the 'real essence') but rather a signifier of the notional idea of the grouping of organisms (the 'nominal essence').^{19 20}

The form of modern naming codes trace back to the 'gentleman-naturalist establishment' in England²¹ seeking control over their preferred naming practices.²² Their imposition normalise the Linnaean binomial (genus and species, such as *Phaseolus vulgaris*) and initiate the break between the botanical and zoological nomenclatures.²³ The history of these evolving botanical and zoological nomenclatures is now long, complex and well documented by

¹² John Heller, 'The Early History of Binomial Nomenclature' (1964) 1 *Huntia* 33, 34 and the references therein.

¹³ Aristotle, *Topica*, Book I, 4-5 in William Ross (ed), *The Works of Aristotle Translated into English*, Volume 1 (translated W Pickard-Cambridge; Oxford University Press, 1971) 101 b 17-25.

¹⁴ Aristotle, *ibid.*, 101 b 39-40.

¹⁵ Heller, above n. 12, 48.

¹⁶ See Phillip Sloan, 'John Locke, John Ray, and the Problem of the Natural System' (1972) 5 *Journal of the History of Biology* 1, 14-26. This is the entry into the debates about the distinctions between artificial and natural systems and essentialism that are not addressed here: see S. Müller-Wille, 'Systems and How Linnaeus Looked at them in Retrospect' (2013) 70 *Annals of Science* 305, 307-316 and the references therein.

¹⁷ See A. Cain, 'Logic and Memory in Linnaeus's System of Taxonomy' (1958) 169 *Proceedings of the Linnaean Society of London* 144, 146-147 and the references therein.

¹⁸ John Locke, *An Essay Concerning Human Understanding* (A Fraser (ed.); Dover Publications, 1959), p. 81 (Book III, iv, 30).

¹⁹ By extension this leads to thinking about meaning and definition of species as individuals where they are diagnosed rather than defined exhibiting part-whole relations and their names are proper names of individual rather than collective names of groupings: see Roberto Keller, Richard Boyd and Quentin Wheeler, 'The Illogical Basis of Phylogenetic Nomenclature' (2003) 69 *Botanical Review* 93, 95-97 and the references therein.

²⁰ Charles Lawson, 'Nomenclature as a Standardized Metadata System for Ordering and Accessing Information About Plants'. In Charles Lawson and Kamalesh Adhikari (eds), *Biodiversity, Genetic Resources and Intellectual Property: Developments in Access and Benefit Sharing* (Routledge, 2018) pp. 84-85.

²¹ Gordon McOuat, 'Species, Rules and Meanings: The Politics of Language and the Ends of Definitions in 19th Century Natural History' (1996) 27 *Studies in the History and Philosophy of Science* 473, 507. See also Gordon McOuat, 'Cataloguing Power: Delineating "Competent Naturalists" and the Meaning of Species in the British Museum' (2001) 34 *British Journal for the History of Science* 1; Harriet Ritvo, 'The Power of the Word: Scientific Nomenclature and the Spread of Empire' (1990) 77 *Victorian Newsletter* 5.

²² See McOuat – Species, *ibid.*, 494-504 and the references therein. For an early articulation and discussion of possible rules see Hugh Strickland, 'Rules for Zoological Nomenclature' (1837) 1 *Magazine of Natural History and Journal of Zoology, Botany, Mineralogy, Geology, and Meteorology* 173.

²³ Alessandro Minelli, 'Zoological vs Botanical Nomenclature: A Forgotten "BioCode" Experiment from the times of the Strickland Code' (2008) 1950 *ZooTaxa* 21, 22; Dan Nicolson, 'A History of Botanical Nomenclature' (1991) 78 *Annals of the Missouri Botanic Garden* 33, 34.

others.²⁴ At their heart, however, remains the taxon names and Linnaeus's taxa rank hierarchy (Kingdoms, Classes, Orders, Genera and Species), despite recent attempts to introduce a truly phylogenetic code,²⁵ with the detailed descriptions of the plant removed to another place through publications.

The modern naming codes establish a set of principles, binding rules, non-binding recommendations and illustrative examples that are scientifically neutral and independent of the scientific opinion used to decide the taxonomy.²⁶ The effect of this binomial genus and species naming is to serve the two critical functions: to generically name a genus to signify a believed relationship; and, to uniquely identify a species with a specific name.²⁷ The *International Code of Nomenclature for algae, fungi and plants (Shenzhen Plant Code)*²⁸ addresses the scientific needs of botanists and taxonomists and the *International Code of Nomenclature for Cultivated Plants (Cultivated Plant Code)*²⁹ addresses the special requirements for plants in cultivation including horticulture, forestry, agriculture and silviculture.³⁰ These different codes are necessary because plants in cultivation are selected for desirable character traits and against undesirable character traits which can mean there are significant differences between the wild varieties and their cultivated varieties and dramatic differences across closely related cultivated plants.³¹ To address this problem the ordinary *Shenzhen Plant Code* naming is not sufficient and the *Cultivated Plant Code* introduces names below the level of genus and species to distinguish cultivated varieties consistent with maintaining the traditional binomial naming system.³² The *Cultivated Plant Code* also functions to provide a different kind of name to suit the requirements of economically important cultivated plants.³³ Under the *Cultivated Plant Code* an additional and simple non-Latin name for commercial or ornamental plants (so-called 'fancy' names)³⁴

²⁴ See Dayrat, above n. 9, pp. 186-240 and the references therein; Otto Kraus, 'The Linnaean Foundations of Zoological and Botanical Nomenclature' (2008) 1950 *ZooTaxa* 9 and the references therein; Knapp et al., above n. 10 references therein; R. Melville, *Towards Stability in the Names of Animals: A History of the International Commission on Zoological Nomenclature 1895-1995* (ICZN, 1995); Nicolson, *ibid.* and the references therein; M Green, 'History of Plant Nomenclature' [1927] *Bulletin of Miscellaneous Information* 403; and so on.

²⁵ Kevin de Queiroz and Jacques Gauthier, 'Toward a Phylogenetic System of Biological Nomenclature' (1994) 9 *Trends in Ecology and Evolution* 27.

²⁶ Although there remain competing nomenclature practices and conventions: see, for examples, Werner Greuter, 'Recent Developments in International Biological Nomenclature' (2004) *Turkish Journal of Botany* 17, 23-24.

²⁷ Ernst Mayr, 'Notes on Nomenclature and Classification' (1954) 3 *Systematic Zoology* 86, 86.

²⁸ N. Turland et al. (eds.), *International Code of Nomenclature for algae, fungi and plants (Shenzhen Code) adopted by the International Botanical Congress held in Shenzhen, China in July 2017*, Regnum Vegetabile 159 (Koeltz Botanical Books 2018) (Shenzhen Plant Code).

²⁹ C. Brickell et al., *International Code of Nomenclature for Cultivated Plants*, 9th edition (ISHS, 2016) (Cultivated Plant Code).

³⁰ Cultivated Plant Code, Article 1. See also Roger Spencer and Robert Cross, 'The *International Code of Botanical Nomenclature* (ICBN), the *International Code of Nomenclature for Cultivated Plants* (ICNCP), and the *Cultigen*' (2007) 56 *Taxon* 938, 938. See also William Stearn, 'Historical Survey of the Naming of Cultivated Plants' (1986) 182 *Acta Horticulturae* 19.

³¹ See Cultivated Plant Code, Preamble 1 (footnote).

³² Shenzhen Plant Code, Article 28.1, Cultivated Plant Code, Principle 2.

³³ See Spencer and Cross, above n. 30, 938. See Gledhill, above n. 4, p. 41.

³⁴ See an account of the historical origins of these names: William Stearn, 'Proposed International Code of Nomenclature for Cultivated Plants' (1952) 77 *Journal of the Royal Horticultural Society* 77. Interestingly this was also the approach recommended by the International Botanic Congress in 1905: see also Alphonse de Candolle, *Laws of Botanical Nomenclature adopted by the International Botanical Congress held at Paris in August 1867*,

compliments the Latin taxonomic genus and species name with a ‘cultivar’,³⁵ ‘Group’,³⁶ and ‘grex’³⁷ epithet.³⁸ As an example, a *Shenzhen Plant Code* name might be ‘*Asparagus officinalis*’ while the *Cultivated Plant Code* name might be ‘*Asparagus officinalis* ‘Calet’’.³⁹ The outcome of these naming codes is that a plant variety will have a unique name linked to a description that distinguishes the plant variety from all others.⁴⁰ The *International Convention for the Protection of New Varieties of Plants* done at Geneva on 19 March 1991 (UPOV 1991)⁴¹ takes advantage of these *Cultivated Plant Code* ‘cultivar’,⁴² ‘Group’,⁴³ and ‘grex’⁴⁴ epithets⁴⁵ using the language of ‘variety denomination’⁴⁶ and requires that every ‘variety shall be designated by a denomination which will be its generic designation’.⁴⁷ While UPOV does not specify the form of the denomination, it is a requirement of registration⁴⁸ and must be publicly disclosed.⁴⁹ Each UPOV Member is then left to establish the form of denomination, with the *Cultivated Plant Code* being the preferred form in all UPOV Member countries including Australia⁵⁰ and delivering a fixed, accurate and uniform system for assigning and using variety denominations.

A foundational principle in the *Cultivated Plant Code* is that ‘[n]ames of plants governed by the [*Cultivated Plant Code*] must be universally and freely available for use by any person [individual and corporation] to denote a taxon’.⁵¹ And to avoid any doubt, the *Cultivated Plant Code* expressly provides:

Plants are sometimes marketed using Trade Marks. Such Trade Marks are the intellectual property of an individual or corporate body and are not therefore freely available for any person to use; consequently, they cannot be considered as names as defined in this [*Cultivated Plant Code*].⁵²

And that is the problem – and has been for a long time⁵³ – how to name a plant so that the name is unique and at the same time use that name in all circumstances including in commerce *and* as a form of intellectual property.⁵⁴ The overlap here is that UPOV 1991

together with an Historical Introduction and Commentary by Alphonse de Candolle (translated by Hugh Weddell; Reeve & Company, 1868) pp. 49-50.

³⁵ *Cultivated Plant Code*, Article 2.

³⁶ *Cultivated Plant Code*, Article 3.

³⁷ *Cultivated Plant Code*, Article 4.

³⁸ See *Cultivated Plant Code*, Article 8.1.

³⁹ See *Cultivated Plant Code*, Article 6.2 (Ex. 1).

⁴⁰ *Shenzhen Plant Code*, Article 29, *Cultivated Plant Code*, Articles 7 and 25.

⁴¹ [2000] ATS 6 (UPOV 1991).

⁴² *Cultivated Plant Code*, Article 2.

⁴³ *Cultivated Plant Code*, Article 3.

⁴⁴ *Cultivated Plant Code*, Article 4.

⁴⁵ See *Cultivated Plant Code*, Article 8.1.

⁴⁶ UPOV 1991, Article 20.

⁴⁷ UPOV 1991, Article 20.1.

⁴⁸ UPOV 1991, Article 5.2.

⁴⁹ UPOV 1991, Article 30.1(iii).

⁵⁰ See *Plant Breeder's Rights Act 1994* (Cth) s. 27(6).

⁵¹ *Cultivated Plant Code*, Principle 4.

⁵² *Cultivated Plant Code*, Principle 6. See also R. Darke, ‘Preserving the Distinction between Cultivars and Trademarks’ (1995) 413 *Acta Horticulturae* 27.

⁵³ See Jay Sanderson, *Plants, People and Practices: The Nature and History of the UPOV Convention* (Cambridge University press, 2017) pp. 144-147.

⁵⁴ See Vincent Gioia, ‘Using and Registering Plant Names as Trademarks’ (1995) 413 *Acta Horticulturae* 19.

requires a unique name to distinguish the plant variety⁵⁵ (and likewise the *Cultivated Plant Code*)⁵⁶ while the World Trade Organisation's (WTO) *Agreement on Trade-Related Aspects of Intellectual Property Rights* (TRIPS Agreement)⁵⁷ requires proprietary trade marks to distinguish that good (and services) from others in order to promote commerce.⁵⁸ The name (variety) and sign (trade mark) are, however, for the *same* plant objects. The UPOV 1991, implementing Australia's commitments to the TRIPS Agreement,⁵⁹ expressly addresses this tension providing that any denomination designating a variety must be freely usable in connection with the variety.⁶⁰ An example illustrates the concerns.

The new rose variety that was extraordinarily popular from the mid-1940s onwards was marketed using the name 'PEACE' although its formal cultivar name was '*Rosa* 'Madame A. Meilland''.⁶¹ This use of different names for the same object undermines the ideal that a name fixes an object. The *Cultivated Plant Code* does not regulate these marketing names,⁶² calling them 'trade designations',⁶³ and provides that 'trade designations must always be distinguished typographically from cultivar, Group and grex epithets'.⁶⁴ For example, '*Rosa* PEACE ('Madame A. Meilland')'.⁶⁵ These marketing names or 'trade designations' are, however, subject to intellectual property claims as trade marks because they can be a sign that distinguishes in the course of trade the goods and services of one person from another person.⁶⁶ A useful articulation of this specific naming issues for plants was addressed by Lloyd-Jacob J in *Wheatcroft Brothers Ltd's Trade Marks* where a trade mark was sought for a new variety of rose.⁶⁷ After explaining the method by which a new rose variety was created, he said:

In light of the evidence before me, it is clear that at the respective dates of application for each of these marks, the Respondents intended only to use each mark in relation to one variety of rose, which variety as they well knew and intended either was or would be characterised by the same name recorded in the register of the [Rose] Society ... An intention to use the mark as the name of a variety appears to be wholly inconsistent with a bona fide intention to use it as signifying a connection in the course of trade with the supplier, for which purpose it must necessarily be capable of differentiating between examples of the same variety coming from differing trade sources.

⁵⁵ UPOV 1991, Article 20.

⁵⁶ *Cultivated Plant Code*, Principle 4.

⁵⁷ *Marrakesh Agreement Establishing the World Trade Organization* [1995] ATS 8, Annex 1C (*Agreement on Trade-Related Aspects of Intellectual Property Rights*) (TRIPS Agreement).

⁵⁸ See *Cultivated Plant Code*, Principle 1; TRIPS Agreement, Article 15.1. Recognizing the inherent conflict of purpose between the *Cultivated Plant Code* and trade marks in designating a commercialization name: 'The institution of the variety denomination has been known for a very long time indeed: it became customary long ago to classify "cultivated plants" according to various "varieties" and to bring them onto the market under their "varietal name": F. Wuesthoff, 'Cultivated Plant Nomenclature and Plant Variety Rights' (1973) 22 *Taxon* 455, 455.

⁵⁹ See TRIPS Agreement, Article 27(3)(b).

⁶⁰ UPOV 1991, Article 20.1.

⁶¹ See Lee Ann Nolan, 'A Rose by Any Other Name' (2019) 59 *Southeastern Geographer* 329; Tony Avent, 'Name that Plant – The Misuse of Trademarks in Horticulture' (2008) 12 *Friends of the JC Raulston Arboretum Newsletter* 3.

⁶² *Cultivated Plant Code*, Principle 6, Articles 13.1 and Appendix X.

⁶³ See *Cultivated Plant Code*, Articles 13 and 17.

⁶⁴ *Cultivated Plant Code*, Article 17.3.

⁶⁵ *Cultivated Plant Code*, Article 17.3 (Ex. 2).

⁶⁶ See *Trade Marks Act 1995* (Cth) s. 17.

⁶⁷ *Wheatcroft Brothers Ltd's Trade Marks* [1954] Ch 210.

If the question be posed: Was the name intended for use to distinguish rose trees of the Respondents' growing from rose trees of the same variety grown by others, or was it intended for use to distinguish one variety introduced by the Respondents from the generality of roses? – there can be only one answer, for the inevitable consequence of registration with the Society was to give the name a variety status.⁶⁸

To address this, at least in part, the *Plant Breeder's Rights Act 1994* (Cth) provides that a new variety name cannot include a registered trade mark under the *Trade Marks Act 1995* (Cth) in respect of live plants, plant cells and plant tissues.⁶⁹ This leads to some confusion, however, about the difference between variety names, trade marks, scientific names, synonyms and common names. This is important because the marketing arrangements for plant varieties often involve variety names and trade marks (like the 'Rosa PEACE ('Madame A. Meilland')' and the more recent example of the apple '*Malus domestica* PINK LADY ('Cripps Pink')')⁷⁰ that can conflict or impede commercialisation strategies and consumer understandings about the plant varieties in the market.⁷¹ But words (names) are vital to the efficient and effective commercialisation of plant varieties, so understanding the interplay between the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth), and *visa versa*, is critical. Perhaps the best example here is the PBR'ed variety *Malus domestica* 'Cripps Pink'⁷² and the related trade mark 'PINK LADY'.⁷³ In this example, the volume of production was controlled through the PBR and the quality was controlled through the trade mark.⁷⁴ The commercial strategy, therefore, appeared to be to obtain a common or generic name for a plant (variety name) that was separate and distinct from any mark identifying the commercial sources of that plant (trade mark).⁷⁵ This also reflects the ideal that generic names, being names that the public used as the common names for a good or service, are outside the scope of trade marks.⁷⁶ This shows that finding a balance between the uses of names in the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth) is important for both commercialisation strategies and consumer understandings in the market. Finding that balance is complicated.

A balance problem exists because the subject matter of names under the *Plant Breeder's Rights Act 1994* (Cth), for example '*Asparagus officinalis* 'Calet'',⁷⁷ can also be the subject

⁶⁸ *Wheatcroft Brothers Ltd's Trade Marks* [1954] Ch 210, 220-221 (Lloyd-Jacob J).

⁶⁹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(e).

⁷⁰ Western Australia Agriculture Authority, '*Malus Domestica Borkh* 'Cripps Pink'', Community Plant Variety Right No 1640, 15 January 1997; Apple and Pear Australia Limited, 'Pink Lady', Registered Trade Mark 1280838, 14 January 2009 (Class 31: Fruits, plant material and trees; all being of the genera: Citrus, Prunus, Pyrus or Vitis).

⁷¹ See, for example, J. Clark and R. Jondle, 'Intellectual Property Rights for Fruit Crops' in J. Hancock (ed.), *Temperate Fruit Crop Breeding: Germplasm to Genomics* (Springer, 2008) pp. 439-455.

⁷² See, for example, Western Australia Agriculture Authority, '*Malus Domestica Borkh* 'Cripps Pink'', Community Plant Variety Right No 1640, 15 January 1997. See also J. Cripps, L. Richards and A. Mairata, 'Pink Lady' Apple' (1993) 28 *HortScience* 1057. Notably, the trade mark 'Cripps Pink' was not successfully registered in Australia because it was not novel at the time Australia introduced variety registrations under the *Plant Variety Rights Act 1987* (Cth).

⁷³ See, for example, Apple and Pear Australia Limited, above n. 70.

⁷⁴ See Mitsukazu Sakuradani, 'Intellectual Property Management through Fruit Tree Club System: The Case Study of the Apple Cultivar 'Cripps Pink'' (2021) 10 *Journal of Management Science* 21, 26.

⁷⁵ See Stanley Schlosser, 'The Registration of Plant Variety Denominations' (1988) 29 *IDEA* 177, 181.

⁷⁶ See, for example, *Trade Marks Act 1995* (Cth) s. 24.

⁷⁷ See Cultivated Plant Code, Article 6.2 (Ex. 1).

matter of 'signs' under the *Trade Marks Act 1995* (Cth).⁷⁸ Further, the *Trade Marks Act 1995* (Cth) does not expressly prevent the name of plant variety for which a PBR exists being registered as a trade mark,⁷⁹ and the *Plant Breeder's Rights Act 1994* (Cth) sets out prevent a trade marked name being used for a new plant variety,⁸⁰ although there remains ambiguities in the current scheme. There is compounded because there is a presumption that a trade mark is registerable⁸¹ and the Registrar must accept an application unless satisfied that there are grounds for rejecting it.⁸² As a consequence, there is a potential conflict between PBRs and trade marks that are addressed in this report.

The report sets out to assess the role and place of naming requirements in the *Plant Breeder's Rights Act 1994* (Cth), the interaction between the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth) and then to consider a range of issues that appear problematic in the current statutory schemes with recommendations for their resolution. The report is structured as follows:

Part 2 – Outlines the international and national negotiations, laws and practices including the naming schemes under both the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth). This includes details about the legislative amendments, court decisions and practice information as a background to the assessment of names and synonyms for PBRs and trade marks.

Part 3 – Reviews the relevant prior academic and trade literature about naming plant varieties. While the literature is not extensive, it is focussed on the practicalities of naming in the plant industries, and specifically the interactions between PBRs and trade marks.

Part 4 – Reviews the empirical materials in the IP Australia Policy Register with responses addressing the fruit sector and the nursery sector favouring a strategy of separating dealing with the variety name under the *Plant Breeder's Rights Act 1994* (Cth) from the trade mark name ('sign') under the *Trade Marks Act 1995* (Cth) and then using the trade mark as a marketing tool where the trade mark used to market the variety outlasted the PBR. Other responses addressed the limited numbers of available and possible names and the apparent requirement for a synonym when it was not always necessary and might disadvantage the applicant.

Part 5 – Addresses the policy issues that arise about plant naming under the *Plant Breeder's Rights Act 1994* (Cth) and its interaction with the *Trade Marks Act 1995* (Cth). These include the operation of naming for PBRs and trade marks, how similar can names and synonyms be, the apparent requirement for a synonym, formal signage of a PBR protected names and synonyms and UPOV harmonisation of plant naming.

Part 6 – This sets out the final words concluding that the balance for plant variety names and synonym set by the current *Plant Breeder's Rights Act 1994* (Cth) is probably appropriate with the main recommendations being about the application of the existing standards, mostly through better information and education for stakeholders.

⁷⁸ *Trade Marks Act 1995* (Cth) s. 6(1).

⁷⁹ See *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [19].

⁸⁰ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(e).

⁸¹ See Explanatory Memorandum to the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011 (Cth), pp. 145-147 (Item 113).

⁸² *Trade Marks Act 1995* (Cth) s. 33(1).

Part 2: Relevant negotiations, laws, practices, and so on

This part traces the relevant laws under the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth) that are relevant in understanding the interactions between these statutory schemes as they deal with plant names.

2.1 WTO TRIPS Agreement

Australia's commitments to the WTO's TRIPS Agreement includes requirements to protect plant varieties⁸³ and trade marks.⁸⁴ For plant varieties this is effected through Australia's commitment to UPOV 1991 that is then implemented in the *Plant Breeder's Rights Act 1994* (Cth). For trade marks, the TRIPS Agreement requirements are implemented through the *Trade Marks Act 1995* (Cth).⁸⁵

2.2 UPOV scheme

UPOV 1991 includes a commitment to protect new plant varieties that have a name called a 'denomination' (Articles 5(2) and 20). UPOV 1991 provides in Article 20 the naming requirements:

- (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.
- (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.
- (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.
- (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.
- (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.
- (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.
- (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

⁸³ TRIPS Agreement, Article 27.3(b).

⁸⁴ TRIPS Agreement, Article 15.

⁸⁵ Explanatory Memorandum to the Trade Marks Bill 1995 (Cth) p. 2.

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.

- (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.

The UPOV explanatory materials provides that a variety name needs to satisfy the following: be a suitable generic designation; enable the variety to be identified; and, not mislead or cause confusion about 'the characteristics, value or identity of the variety or the identity of the breeder'.⁸⁶ A further objective is that the name used for the particular variety is 'designated in all members of the Union by the same variety denomination'.⁸⁷ The specific explanatory materials provide:

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. 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.⁸⁸

UPOV specifically points to the problems of combining a denomination with a trade mark and the intention of genericness of plant names, even after the expiration of the PBR.⁸⁹ While UPOV 1991 may set out a preference for PBR names and trade marks to be different, there is acceptance that this might not be possible, and in those circumstances:

If an authority is aware and allows a denomination to be registered when the breeder of the variety is also the holder of a trademark that is identical to the variety denomination, the authority, should inform the breeder of the obligation to allow the use of the denomination in connection with the variety, even after the expiration of the breeder's right.⁹⁰

2.3 Plant Breeder's Rights Act 1994 (Cth)

The *Plant Breeder's Rights Act 1994* (Cth) sets out a scheme for the grant of a PBR for a new variety that is distinct, uniform and stable.⁹¹ The intention was to give effect to Australia's commitments to UPOV 1991.⁹² A key requirement in the application is the designation of a

⁸⁶ International Union for the Protection of New Varieties of Plants, *Explanatory Notes on Variety Denominations under the UPOV Convention* (2021) UPOV/EXN/DEN/1, [2] (p. 3). Noting the earlier superseded notes: International Union for the Protection of New Varieties of Plants, *Explanatory Notes on Variety Denominations under the UPOV Convention* (2015) UPOV/INF/12/5.

⁸⁷ UPOV/EXN/DEN/1, *ibid.*, [3] (p. 3).

⁸⁸ *Ibid.*, [1.2] (p. 4).

⁸⁹ *Ibid.*, [1.2(footnote)] and [1.3] (p. 4). See also World Intellectual Property Organization, *WIPO Intellectual Property Handbook*, WIPO Publication No 489(E) (WIPO, 2004) [2.397]-[2.398].

⁹⁰ UPOV/EXN/DEN/1, *ibid.*, [1.3] (p. 4).

⁹¹ *Plant Breeder's Rights Act 1994* (Cth) s. 43(1).

⁹² *Plant Breeder's Rights Act 1994* (Cth) ss. 3(1) and 10(a). See also Senate, *Hansard*, 24 March 1994, p 2306 (Senator John Faulkner); House of Representatives, *Hansard*, 24 August 1994, p 157 (Minister for Administrative Services).

name and any proposed synonyms for the plant variety so as to distinguish that variety from all others⁹³ and the names of the parental varieties used to breed the new variety.⁹⁴ The name selected for the new variety must conform to the requirements (set out in s. 27):

- (1) If PBR has not been granted in another contracting party in a plant variety before an application for that right in that variety is made in Australia, the name set out in the application must comply with subsections (4), (5), (6) and (7).
- (2) If, before making an application in Australia for PBR in a plant variety, PBR has been granted in that variety in another contracting party:
 - (a) the name of the variety set out in the Australian application must be the name under which PBR was first granted in another contracting party; but
 - (b) there may, and, if the name referred to in paragraph (a) does not comply with subsections (4), (5), (6) and (7) there must, also be included in the application a synonym, additional to the name of the variety.
- (3) The synonym must be a name determined in accordance with subsections (4), (5), (6) and (7) as if the variety had not been the subject of a grant of PBR in another contracting party.
- (3A) If, before making an application in Australia for PBR in a plant variety, PBR has not been granted in that variety in another contracting party, a synonym may also be included in the application.
- (4) A name (including a synonym), in respect of a plant variety, must be a word or words (whether invented or not) with or without the addition of either or both of the following:
 - (a) a letter or letters that do not constitute a word;
 - (b) a figure or figures.
- (5) A name (including a synonym), in respect of a plant variety must not:
 - (a) be likely to deceive or cause confusion, including confusion with the name of another plant variety of the same plant class; or
 - (b) be contrary to law; or
 - (c) contain scandalous or offensive matter; or
 - (d) be prohibited by regulations in force at the time of the application; or
 - (e) be or include a trade mark that is registered, or whose registration is being sought, under the *Trade Marks Act 1995* [(Cth)], in respect of live plants, plant cells and plant tissues.
- (6) A name (including a synonym), in respect of a plant variety must comply with the *International Code of Botanical Nomenclature* and subsidiary codes.
- (7) A name (including a synonym), in respect of a plant variety must not consist of, or include:
 - (a) the name of a natural person living at the time of the application unless the person has given written consent to the name of the variety; or
 - (b) the name of a natural person who died within the period of 10 years before the application unless the legal personal representative of the person has given written consent to the name of the variety; or
 - (c) the name of a corporation or other organisation, unless the corporation or other organisation has given its written consent to the name of the variety.⁹⁵

There is a key definition of ‘synonym’:

synonym, in relation to the name of a plant variety, means a name that:

- (a) is included in an application in addition to the name of the variety; and
- (b) is a name by which the variety will be known or sold in Australia.⁹⁶

⁹³ *Plant Breeder’s Rights Act 1994* (Cth) s. 26(2)(f).

⁹⁴ *Plant Breeder’s Rights Act 1994* (Cth) s. 26(2)(ga).

⁹⁵ *Plant Breeder’s Rights Act 1994* (Cth) 27.

⁹⁶ *Plant Breeder’s Rights Act 1994* (Cth) s. 3(1) (‘synonym’).

With the grant of a PBR,⁹⁷ the Registrar of Plant Breeder's Rights⁹⁸ is required to enter the PBR name and synonym⁹⁹ on the Register of Plant Varieties.¹⁰⁰ It is then an infringement of the PBR to use that registered name¹⁰¹ or the registered synonym:

... PBR in a plant variety is infringed by ... (c) a person using a name of the variety that is entered in the Register in relation to:

- (i) any other plant variety of the same plant class; or
- (ii) a plant of any other variety of the same plant class.¹⁰²

In this provision, 'plant class' is defined:

plant class, for the purpose of variety denomination, means a class consisting of all plants:

- (a) that belong to a single botanical genus; or
 - (b) that belong to a group of closely related genera;
- that is specified from time to time as a plant class in the Registrar's List of Plant Classes maintained under subsection 61(1A) [Registrar's List of Plant Classes].¹⁰³

The Registrar's List of Plant Classes,¹⁰⁴ which is part of the Register of Plant Varieties,¹⁰⁵ sets out 'classes have been developed [by UPOV] 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'.¹⁰⁶ The Registrar's list must have regard to that UPOV list.¹⁰⁷ UPOV also makes available a tool to check proposed names against existing names¹⁰⁸ (PLUTO Plant Variety Database).¹⁰⁹ Other relevant databases of names are maintained by the Registrar of Plant Breeder's Rights¹¹⁰ and the Registrar of Trade Marks.¹¹¹

The original intention was that the new variety name comply with 'the International Code of Botanical nomenclature and its related codes'.¹¹² These are the *International Code of Nomenclature for algae, fungi and plants (Shenzhen Plant Code)*¹¹³ that addresses the scientific needs of botanists and taxonomists and the *International Code of Nomenclature for*

⁹⁷ *Plant Breeder's Rights Act 1994* (Cth) s. 44(1).

⁹⁸ *Plant Breeder's Rights Act 1994* (Cth) s. 58.

⁹⁹ *Plant Breeder's Rights Act 1994* (Cth) s. 46(1)(b).

¹⁰⁰ *Plant Breeder's Rights Act 1994* (Cth) s. 61.

¹⁰¹ *Plant Breeder's Rights Act 1994* (Cth) s. 53(1)(c).

¹⁰² *Plant Breeder's Rights Act 1994* (Cth) s. 53(1A).

¹⁰³ *Plant Breeder's Rights Act 1994* (Cth) s. 3(1) ('plant class').

¹⁰⁴ *Plant Breeder's Rights Act 1994* (Cth) s. 61(1A).

¹⁰⁵ *Plant Breeder's Rights Act 1994* (Cth) s. 61(1C).

¹⁰⁶ See UPOV/EXN/DEN/1, above n. 86, Annex I.

¹⁰⁷ *Plant Breeder's Rights Act 1994* (Cth) s. 61(1B).

¹⁰⁸ UPOV/EXN/DEN/1, above n. 86, [2.5]-[2.6].

¹⁰⁹ See International Union for the Protection of New Varieties of Plants, *PLUTO Plant Variety Database* (2022) at <<https://www.upov.int/pluto/en>>.

¹¹⁰ See IP Australia, *Searchable Database for All PBR Varieties* (2022) at <http://pericles.ipaustralia.gov.au/pbr_db>.

¹¹¹ See IP Australia, *Australian Trade Mark Search* (2022) at <<https://search.ipaustralia.gov.au/trademarks/search/quick>>.

¹¹² Explanatory Memorandum to the Plant Breeder's Rights Bill 1994 (Cth), p. 8 (clause 27).

¹¹³ Turland *et al.*, above n. 28.

*Cultivated Plants (Cultivated Plant Code)*¹¹⁴ that addresses the special requirements for plants in cultivation including horticulture, forestry, agriculture and silviculture.¹¹⁵

The naming provisions of the *Plant Breeder's Rights Act 1994* (Cth) have been amended twice. First by the *Agriculture, Fisheries and Forestry Legislation Amendment Act (No 1) 1999* (Cth) that introduced the ideal of a 'plant class' to make the naming of new varieties easier.¹¹⁶ The concern had been that a unique name was administratively complicated for both the applicants and assessors and would be made more efficient by limiting the unique name to a specific plant class, with the same name being possible in a different plant class without confusing the marketplace.¹¹⁷ And so, '[t]he duplication of names in closely related cereal crops, such as wheat, barley and oats, would not be accepted'.¹¹⁸ The amendment also called for the administrators (then the PBR Office) to maintain a list of classes available to applicants so as to distinguish unique names to only the specific plant class.¹¹⁹ This adopted work that had been done by UPOV to assist in developing uniformly interpreted and applied variety denominations across UPOV members.¹²⁰

The second amendment by the *Plant Breeder's Rights Amendment Act 2002* (Cth) replaced the definition of 'synonym' as a part of enhancing access to the PBR scheme for breeders and recast the provision requiring the PBR application include the names of the parental varieties as part of improving the administration of PBR scheme.¹²¹ The registering of the 'synonym' addressed the problem that varieties first registered in Australia but not outside Australia did not also get protection for the synonym when registering the same variety in another UPOV member jurisdiction. Meanwhile, those varieties first registered in other jurisdictions got the protected synonym in Australia too and this was considered disadvantageous to Australian breeders.¹²² The listing of parental variety names was part of recasting the provision to protect commercially sensitive information on the application form from public scrutiny by avoiding a detailed description.¹²³

2.4 Trade Marks Act 1995 (Cth)

In addition to the *Plant Breeder's Rights Act 1994* (Cth), the *Trade Marks Act 1995* (Cth) also sets out a statutory scheme for protecting signs that will include names. Common law trade marks are not addressed by the *Plant Breeder's Rights Act 1994* (Cth). In contrast to the limited scope of names and synonyms consistent with the naming codes under the *Plant Breeder's Rights Act 1994* (Cth),¹²⁴ the *Trade Marks Act 1995* (Cth) provides that a trade mark is:

¹¹⁴ Brickell, above n. 29.

¹¹⁵ See Spencer and Cross, above n. 30, 938.

¹¹⁶ House of Representatives, *Hansard*, 3 December 1998, p. 1283 (Minister for Trade); Senate, *Hansard*, 8 March 1999, p. 2325 (Minister for Regional Services, Territories and Local Government).

¹¹⁷ House of Representatives – *Hansard*, *ibid.*, p. 1283; Senate – *Hansard*, *ibid.*, p. 2325.

¹¹⁸ House of Representatives – *Hansard*, *ibid.*, p. 1283; Senate – *Hansard*, *ibid.*, p. 2325.

¹¹⁹ House of Representatives – *Hansard*, *ibid.*, p. 1283; Senate – *Hansard*, *ibid.*, p. 2325.

¹²⁰ UPOV/EXN/DEN/1, above n. 86, [5].

¹²¹ See House of Representatives, *Hansard (Main Committee)*, 12 December 2002, p. 10589 (Minister for Agriculture, Fisheries and Forestry); Senate, *Hansard*, 13 March 2002, p. 603 (Minister for Health and Ageing).

¹²² Explanatory Memorandum to the Plant Breeder's Rights Amendment Bill 2002 (Cth) p. 4.

¹²³ *Ibid.*, p. 5.

¹²⁴ *Plant Breeder's Rights Act 1994* (Cth) s. 27(6).

a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.¹²⁵

Where 'sign' is defined:

sign includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.¹²⁶

The 'exclusive rights' of a trade mark are 'to use the trade mark' and 'to authorise other persons to use the trade mark', both 'in relation to the goods and/or services in respect of which the trade mark is registered'.¹²⁷ In effect, a registered trade mark in, on or in relation to an object such as a label on a plant, gives the trade mark owner the 'exclusive rights' to controlling the use of that object, such as sale of the plant labelled with a registered trade mark.¹²⁸ The *Trade Marks Act 1995* (Cth) then provides that a trade mark application must be rejected where the name makes it difficult to distinguish the applicant's product¹²⁹ or that the name might deceive or cause confusion¹³⁰ or be substantially identical or deceptively similar,¹³¹ and this is assessed at the time of application.¹³² The Registrar of Trade Marks starts from the proposition that '[t]rade marks that include the name of a particular plant may not be inherently capable of distinguishing ... certain goods' and 'the examiner's decision should take into account ordinary significance (where a plant name has other meaning in the common domain) in connection with the nature of the claimed goods'.¹³³ Such a trade mark application should be rejected because '[i]f a trade mark includes the name of a plant in a manner that simply describes what the good(s) are made from, other traders also have a legitimate need to use that reference, on the same or similar goods'.¹³⁴ For example:

The word KIPFLER, applied to potato chips ... Kipfler is a common and well known variety of potato. The ordinary signification would be that the potato chips are made from Kipfler potatoes. Other traders should also be able to indicate that their potato chips are made from Kipfler potatoes.¹³⁵

The result of these propositions is that for a plant name to be a trade mark it must be able to 'distinguish' goods.¹³⁶ And a plant name describes the plant variety as opposed to distinguishing the particular plant as a good, and will continue to do so even when the PBR has exhausted and others want to use that name to describe that plant. This measure is given substance through the requirement that an application be rejected if it does not, on the

¹²⁵ *Trade Marks Act 1995* (Cth) s. 17.

¹²⁶ *Trade Marks Act 1995* (Cth) s. 6(1).

¹²⁷ *Trade Marks Act 1995* (Cth) s. 20(1).

¹²⁸ The *Trade Marks Act 1995* (Cth) s. 7(4) provides '**use of a trade mark in relation to goods** means use of the trade mark upon, or in physical or other relation to, the goods (including second-hand goods)'.

¹²⁹ *Trade Marks Act 1995* (Cth) s. 41.

¹³⁰ *Trade Marks Act 1995* (Cth) s. 43.

¹³¹ *Trade Marks Act 1995* (Cth) s. 44.

¹³² *Trade Marks Act 1995* (Cth) ss. 33 and 43 (application – likely to deceive or cause confusion), 44 (application – deceptively similar (or substantially identical)) and 60 (opposition – likely to deceive or cause confusion).

¹³³ IP Australia, *Trade Marks Manual of Practice and Procedure* (IP Australia, 2022) [22.27].

¹³⁴ *Ibid.*

¹³⁵ *Ibid.*

¹³⁶ *Trade Marks Act 1995* (Cth) ss. 17 and 41. See also *ibid.*

balance of probabilities with a presumption of registrability placing the onus of the Registrar,¹³⁷ distinguish the goods (and services) of the applicant (s 41):

41 Trade mark not distinguishing applicant's goods or services

(1) An application for the registration of a trade mark must be rejected if the trade mark is not capable of distinguishing the applicant's goods or services in respect of which the trade mark is sought to be registered (the **designated goods or services**) from the goods or services of other persons.

Note: For **goods of a person** and **services of a person** see section 6.

(2) A trade mark is taken not to be capable of distinguishing the designated goods or services from the goods or services of other persons only if either subsection (3) or (4) applies to the trade mark.

(3) This subsection applies to a trade mark if:

(a) the trade mark is not to any extent inherently adapted to distinguish the designated goods or services from the goods or services of other persons; and

(b) the applicant has not used the trade mark before the filing date in respect of the application to such an extent that the trade mark does in fact distinguish the designated goods or services as being those of the applicant.

(4) This subsection applies to a trade mark if:

(a) the trade mark is, to some extent, but not sufficiently, inherently adapted to distinguish the designated goods or services from the goods or services of other persons; and

(b) the trade mark does not and will not distinguish the designated goods or services as being those of the applicant having regard to the combined effect of the following:

(i) the extent to which the trade mark is inherently adapted to distinguish the goods or services from the goods or services of other persons;

(ii) the use, or intended use, of the trade mark by the applicant;

(iii) any other circumstances.

Note 1: Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

(a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or

(b) the time of production of goods or of the rendering of services.

Note 2: For **goods of a person** and **services of a person** see section 6.

Note 3: Use of a trade mark by a predecessor in title of an applicant and an authorised use of a trade mark by another person are each taken to be use of the trade mark by the applicant (see subsections (5) and 7(3) and section 8).

(5) For the purposes of this section, the use of a trade mark by a predecessor in title of an applicant for the registration of the trade mark is taken to be a use of the trade mark by the applicant.

Note 1: For **applicant** and **predecessor in title** see section 6.

Note 2: If a predecessor in title had authorised another person to use the trade mark, any authorised use of the trade mark by the other person is taken to be a use of the trade mark by the predecessor in title (see subsection 7(3) and section 8).

Before the current *Trade Marks Act 1995* (Cth), the *Trade Marks Act 1955* (Cth) provided for two registers essentially distinguishing between 'distinctive' and 'becoming distinctive':¹³⁸ Part A was for trade marks that were essentially distinctive, such as 'a word not having direct reference to the character or quality of the goods';¹³⁹ and, Part B for other trade marks and specifically those capable of becoming distinctive.¹⁴⁰ The TRIPS Agreement required a trade mark be 'capable of distinguishing' as opposed to being 'distinctive',¹⁴¹ and this required a

¹³⁷ Explanatory Memorandum to the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011 (Cth), p. 146 (Item 113).

¹³⁸ *Trade Marks Act 1955* (Cth) ss. 24 and 25.

¹³⁹ *Trade Marks Act 1955* (Cth) s. 24.

¹⁴⁰ *Trade Marks Act 1955* (Cth) s. 25.

¹⁴¹ TRIPS Agreement, Article 15.1.

change to the threshold for a trade mark in Australia. The new, and now current *Trade Marks Act 1995* (Cth) reflected this new threshold.¹⁴² The provision was then amended (from 15 April 2013)¹⁴³ to address the decision in *Blount Inc v The Registrar of Trade Marks*¹⁴⁴ that had interpreted the requirement for the sign to be inherently adapted to distinguish the applicant's goods without the presumption of registrability.¹⁴⁵ The amendment clarified that registrability was to be presumed with the Explanatory Memorandum for the amendment providing:

The changes are intended to clarify that the presumption of registrability ... The amendments are not meant to alter the key concepts of 'inherently adapted to distinguish', 'capable of distinguishing', and 'does or will distinguish'. The judicial tests for these terms are settled and the amendments are not intended to change the legal concept of a trade mark distinguishing the applicant's good or services from others.¹⁴⁶

The *Trade Marks Act 1995* (Cth) now specifically addresses whether the trade mark for a good or service distinguishes the applicant's and another's goods or services.¹⁴⁷ This is framed negatively because the standard is applied on the balance of probabilities with a presumption of registrability placing the onus of the Registrar to justify why the trade mark is *not* registerable.¹⁴⁸ A good or service is thus taken 'not to be capable of distinguishing' goods or services from another's goods or services (s 41(2)) if:

- (1) The goods (or services) are 'not to any extent inherently adapted to distinguish' and have not acquired distinctiveness before the application filing date (s 41(3)).
- (2) The goods (or services) are 'to some extent, but not sufficiently, inherently adapted to distinguish' and do not distinguish taking into account that extent, their use or intended use, and 'any other circumstance' (s 41(4)).

This provision, therefore, addresses four kinds of trade marks:

- (1) Registrable trade marks that *do* inherently distinguish goods and services (so, inherently distinctive);
- (2) Registrable trade marks that *do not* inherently distinguish goods and services, although their use at the time of the application means they have acquired the ability and can distinguish goods and services (so, acquired distinctiveness);
- (3) Registrable trade marks that *does to some extent* inherently distinguish goods and services, falling between inherently distinguish goods and services (inherently

¹⁴² *Trade Marks Act 1955* (Cth) s. 41.

¹⁴³ *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth) s. 3 and sch. 6 (item 113).

¹⁴⁴ (1998) 40 IPR 498 (Branson J). See also *Sports Warehouse Inc v Fry Consulting Pty Ltd* (2010) 87 IPR 300, [28] (Kenny J).

¹⁴⁵ Explanatory Memorandum to the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011 (Cth), p. 146 (Item 113).

¹⁴⁶ *Ibid.*

¹⁴⁷ *Trade Marks Act 1995* (Cth) s. 41(1).

¹⁴⁸ Explanatory Memorandum to the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011 (Cth), p. 146 (Item 113).

distinctive) and have acquire through their use at the time of the application the ability to inherently distinguish goods and services (acquired distinctiveness);

- (4) Unregistrable trade marks that *can never* distinguish goods and services.

The judicial standards for these key concepts is settled:

- (1) *Inherently adapted to distinguish* – That there is something inherent about the trade mark that makes it unique for the applicant’s goods or services. A note to the relevant provision in the *Trade Marks Act 1995* (Cth) that ‘fairly reflects the trend of relevant judicial authority’¹⁴⁹ provides:

Trade marks that are not inherently adapted to distinguish goods or services are mostly trade marks that consist wholly of a sign that is ordinarily used to indicate:

- (a) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
- (b) the time of production of goods or of the rendering of services.¹⁵⁰

The relevant judicially articulated test is, where if the answer is ‘yes’ then the trade mark is not inherently adapted to distinguish:

whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods.¹⁵¹

In a slightly more detailed context:

that the question whether a mark is adapted to distinguish be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives – in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess – will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it.¹⁵²

In applying this standard, the High Court has suggested a two-step approach in *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd*:

the consideration of the ‘ordinary signification’ of any word or words (English or foreign) which constitute a trade mark is crucial, whether (as here [the Italian words ‘ORO’ and ‘CINQUE STELLE’]) a trade mark consisting of such a word or words is alleged not to be registrable because it is not an invented word and it has ‘direct’ reference to the character and quality of goods, or because it is a laudatory epithet or a geographical name, or because it is a surname, or because it has lost its distinctiveness, or because it never had the requisite distinctiveness to start with. Once the ‘ordinary signification’ of a word, English or foreign, is established an enquiry can then be made into whether other traders might legitimately need to use the word in respect of their goods. If a

¹⁴⁹ *Ocean Spray Cranberries Inc v Registrar of Trade Marks* (2000) 47 IPR 579, [30] (Wilcox J).

¹⁵⁰ *Trade Marks Act 1995* (Cth) s. 41(4) (Note 1).

¹⁵¹ *Eclipse Sleep Products Inc v Registrar of Trade Marks* (1957) 99 CLR 300, 310 (Dixon CJ, Williams and Kitto JJ) citing *Registrar of Trade Marks v W. & G. Du Cros Ltd* (1913) AC 624, 635 (Lord Parker of Waddington). See also *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511, 513 (Kitto J).

¹⁵² *Clark Equipment Co v Registrar of Trade Marks* (1964) 111 CLR 511, 514 (Kitto J).

foreign word contains an allusive reference to the relevant goods it is prima facie qualified for the grant of a monopoly. However, if the foreign word is understood by the target audience as having a directly descriptive meaning in relation to the relevant goods, then prima facie the proprietor is not entitled to a monopoly of it. Speaking generally, words which are prima facie entitled to a monopoly secured by registration are inherently adapted to distinguish (footnotes omitted).¹⁵³

- (2) *Acquired distinctiveness* – That there is something that comes through the use of a trade mark in the market place that consumers come to associate the goods or services with the trade mark owner. The trite example is the cultural and geographical place in the United States’ state of Colorado that in the marketplace for backpacks and the trade mark ‘COLORADO’ had a unique association with Colorado Group Ltd.¹⁵⁴

As a generalisation, invented words without an association or significance (such as a merger of two words like ‘hair’ and ‘fusion’ to ‘HAIRFUSION’ for a hair good)¹⁵⁵ are inherently adapted to distinguish.¹⁵⁶ Meanwhile, a purely descriptive word is un-registerable (such as ‘CRANBERRY CLASSIC’ for fruit juices)¹⁵⁷ unless it has acquired distinctiveness through use (such as ‘OREGON’ for power tool accessories).¹⁵⁸ The effect of these standards is to require an assessment of the distinctiveness of a word that ‘commonly calls for an inquiry into the word’s ordinary signification and whether or not it has acquired a secondary meaning’¹⁵⁹ and ‘the test of inherent adaptability to distinguish looks to the future’.¹⁶⁰ Applied to plant names this has been addressed in the Federal Court by asking:

- (1) *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) – ‘Would traders of buffalo grass of the Sir Walter variety, in the exercise of the common right of the public to make honest use of words for the sake of the signification which they ordinarily possess, think of the sign SIR WALTER and want to use it in connection with the designated goods?’¹⁶¹.
- (2) *Mastronardi Produce Ltd v Registrar of Trade* (2014) – ‘two questions: (1) how would ZIMA be understood as at 25 July 2011 by ordinary Australians seeing it for the first time used in respect of tomatoes; and (2) how likely is it that other persons, trading in tomatoes and being actuated only by proper motives, will think of the word ZIMA and want to use it in connexion with tomatoes in any manner which would infringe a registered trade mark granted in respect of it?’¹⁶²

¹⁵³ *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2014) 254 CLR 337, [71] (French CJ, Hayne, Crennan and Kiefel JJ).

¹⁵⁴ See *Colorado Group Ltd v Strandbags Group Pty Ltd* (2007) 74 IPR 246, [51]-[52] (Alsop J).

¹⁵⁵ *Advanced Hair Studio of America Pty Ltd v Registrar of Trade Marks* (1988) 12 IPR 1 (Bowen CJ, Woodward and Lockhart JJ).

¹⁵⁶ See, for example, *Michael Sharwood & Partners Pty Ltd v Fuddrucker Inc* (1989) 15 IPR 188 (S Farquhar). See also *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks* (2002) 56 IPR 30, [148] (French, Lindgren and Stone JJ).

¹⁵⁷ *Ocean Spray Cranberries Inc v Registrar of Trade Marks* (2000) 47 IPR 579 (Wilcox J).

¹⁵⁸ *Blount v Registrar of Trade Marks* (1998) 40 IPR 498 (Branson J).

¹⁵⁹ *Cantarella Bros Pty Ltd v Modena Trading Pty Ltd* (2014) 254 CLR 337, [44] (French CJ, Hayne, Crennan and Kiefel JJ).

¹⁶⁰ *Mantra IP Pty Ltd v Spagnuolo* (2012) 96 IPR 464, [46] (Reeves J).

¹⁶¹ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [45] (Yates J).

¹⁶² *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [24] (Gordon J).

The bright lines from the cases appear to be:

- (1) *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) – Words like ‘SIR WALTER’ for a soft leafed buffalo grass are not registerable trade marks because it is the given and proper name for the new variety, ‘the grass’s given name and accepted official designation’, and other traders might want to use the name.¹⁶³ Significantly, this trade mark was the name of a PBR’ed variety under the *Plant Breeder’s Rights Act 1994* (Cth).¹⁶⁴
- (2) *Mastronardi Produce Ltd v Registrar of Trade* (2014) – Invented words like ‘ZIMA’ as a sign for a style of tomatoes (rather than a particular variety) can be a registerable trade mark because they have no obvious meaning and do not describe the character or quality of the goods,¹⁶⁵ so that the ‘ZIMA’ trade mark was inherently adapted to distinguish the applicant’s tomatoes from the tomatoes of others.¹⁶⁶ Significantly, this trade mark was not the name of a PBR’ed variety under the *Plant Breeder’s Rights Act 1994* (Cth).

In addition to the distinctiveness grounds for rejecting a trade mark application,¹⁶⁷ an application may also be rejected because the trade mark is scandalous,¹⁶⁸ contrary to law¹⁶⁹ or deceptive or confusing¹⁷⁰ or be substantially identical or deceptively similar.¹⁷¹ A trade mark is scandalous if it would cause ‘a significant degree of disgrace, shock or outrage ... beyond merely giving offence’.¹⁷² A trade mark is contrary to law it would contravene a law, such as use a statutorily protected words such as ‘OPEN TAFE’ to advertise TAFE courses.¹⁷³ Certainly, a PBR name will be refused a trade mark as contrary to law.¹⁷⁴ The deceptive or confusing is more complex and may be a ground against the application on examination¹⁷⁵ and in opposition proceedings.¹⁷⁶

- (1) *Application – likely to deceive or cause confusion* (s 43) – On an application the trade mark is determined to have ‘some connotation’ that makes it likely to deceive or cause confusion in connection with particular goods and services. The connotation means that the deception and confusion arise from some inherent quality of the mark¹⁷⁷ and may include reputation. The scope of this standard is not entirely clear and has been given a

¹⁶³ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [55] (Yates J).

¹⁶⁴ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [11] and [55] (Yates J).

¹⁶⁵ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [25] and [41] (Gordon J).

¹⁶⁶ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [47] (Gordon J).

¹⁶⁷ *Trade Marks Act 1995* (Cth) s. 41.

¹⁶⁸ *Trade Marks Act 1995* (Cth) s. 42(a).

¹⁶⁹ *Trade Marks Act 1995* (Cth) s. 42(b).

¹⁷⁰ *Trade Marks Act 1995* (Cth) s. 43.

¹⁷¹ *Trade Marks Act 1995* (Cth) s. 44.

¹⁷² *Cosmetic, Toiletry and Fragrance Association Foundation v Fanni Barns Pty Ltd* (2003) 57 IPR 594, 599 (T Williams).

¹⁷³ *Open Universities Australia Pty Ltd v 1IQ Pty Ltd* (2012) 99 IPR 334 (I Thompson).

¹⁷⁴ *Trade Marks Act 1995* (Cth) s. 42(b); *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(e).

¹⁷⁵ See *Trade Marks Act 1995* (Cth) s. 31(b).

¹⁷⁶ See *Trade Marks Act 1995* (Cth) ss. 52 and 60.

¹⁷⁷ See *Registrar of Trade Marks v Woolworths Ltd* (1999) 45 IPR 411, [79] (Branson J).

broad application by the Registrar of Trade Marks and may overlap with the apparently different standard applied in opposition proceedings (s 60, addressed below).

- (2) *Application – deceptively similar or substantially identical* (s 44(1)) – On an application the trade mark is substantially identical or deceptively similar to a trade mark already registered by another person for similar goods or services in the sense of a resemblance between the marks. The substantially identical means that the compared trade marks have the same essential features with maybe different inessential features.¹⁷⁸ Deceptively similar means ‘if it so nearly resembles that other mark that it is likely to deceive or cause confusion’.¹⁷⁹ This is determined according to the ideal ‘to estimate the effect or impression produced on the mind of potential customers by the mark or device’ of deception or confusion.¹⁸⁰ This resemblance can happen in many circumstances and will include reputation.
- (3) *Opposition – likely to deceive or cause confusion* (s 60) – On opposition that a trade mark, ‘because of the reputation of [another] trade mark’ would ‘be likely to deceive or cause confusion’.¹⁸¹ In other words, the reputation attaching to another mark would lead to deception or confusion of the public.¹⁸²

¹⁷⁸ *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407, 415 (Windeyer J).

¹⁷⁹ *Trade Marks Act 1995* (Cth) s. 10.

¹⁸⁰ *Australian Woollen Mills Ltd v F. S. Walton & Co Ltd* (1937) 58 CLR 641, 658 (Dixon and McTiernan JJ).

¹⁸¹ See *Registrar of Trade Marks v Woolworths Ltd* (1999) 45 IPR 411, [79] (Branson J).

¹⁸² See, for example, *Pfizer Products Inc v Karam* (2006) 70 IPR 599 (Gyles J) (assessing the confusion between ‘HERBAGRA’ and ‘VIAGRA’).

Table 1: Comparison of the equivalent naming provisions in the *Plant Breeder's Rights Act 1994* (Cth) name and the *Trade Marks Act 1995* (Cth).

<i>Plant Breeder's Rights Act 1994</i> (Cth)		<i>Trade Marks Act 1995</i> (Cth)	
s 27(4) ('name' and 'synonym')	Only word or words with/without letter(s) and/or figure(s)	s 6(1) ('sign')	Any letter, word, name, signature, numeral, and so on
s 27(5)(a)	Not be likely to deceive or cause confusion, including confusion with the name of another plant variety of the same plant class	s 43	Not be likely to deceive or cause confusion because of a connotation inherent in the mark (not through comparison with another mark)
		s 44	Not be deceptively similar to another mark
		s 60	Trade marks that are likely to deceive or cause confusion in relation to another mark that has acquired a reputation in Australia (on opposition)
		s 120	Trade marks that are likely to deceive or cause confusion because it is substantially identical or deceptively similar (infringement)
s 27(5)(b)	Not be contrary to law	s 42(b)	Not be contrary to law
s 27(5)(c)	Not contain scandalous or offensive matter	s 42(a)	Not contain scandalous or offensive matter
ss 27(1) and (2)	Must use the same name and synonym for varieties with prior granted PBRs in other UPOV member countries	-	-
s 27(5)(d)	Not be prohibited by regulations	-	-
s 27(5)(e)	Not be or include a trade mark that is registered, or whose registration is being sought for live plants, plant cells and plant tissues	-	-
s 27(6)	Name that complies with naming codes	-	-
s 27(7)(a)	Not consist of or include the name of a natural person living at the time of the application without consent	-	-
s 27(7)(b)	Not consist of or include the name of a natural person who died within the period of 10 years before the application without consent	-	-
s 27(7)(c)	Not consist of or include the name of a corporation or other organisation without consent	-	-
-	-	s 41(2)	Trade mark does inherently distinguish goods and services (so, inherently distinctive)
-	-	s 41(3)	Trade mark is not to any extent inherently adapted to distinguish and can be accepted if evidence of use prior to application is sufficient to show acquired distinctiveness
-	-	s 41(4)	Trade mark is to some extent, but not sufficiently, inherently adapted to distinguish and evidence can be used to show acquired distinctiveness

2.5 Decisions about PBRs and trade marks

The following decisions highlight the interaction between PBRs and trade marks.

2.5.1 *Heritage Seeds Pty Ltd (2007)*

In *Heritage Seeds Pty Ltd* a PBR had been granted for a fungal endophyte variety 'AR1'.¹⁸³ The applicant, unrelated to the PBR holder, sought a trade mark under the *Trade Marks Act 1995* (Cth) for the sign 'PLUS AR1'.¹⁸⁴ The question decided by the delegate of the Registrar was whether the 'PLUS' with the PBR'ed variety name 'AR1' was sufficient to distinguish the applicant's goods from the goods of others for the purposes of the *Trade Marks Act 1995* (Cth) trade mark.¹⁸⁵ The delegate reasoned:

¹⁸³ *Heritage Seeds Pty Ltd* [2007] ATMO 4, [2] and [9] (A. Windsor).

¹⁸⁴ *Heritage Seeds Pty Ltd* [2007] ATMO 4, [2] (A. Windsor).

¹⁸⁵ *Heritage Seeds Pty Ltd* [2007] ATMO 4, [15] (A. Windsor).

The letter/numeral combination AR1 is the name of a specific living organism. The name is registered under Australian law, by a party other than the applicant. The accepted name of such an organism, whether registered under some form of plant breeder's or variety rights law, whether generally accepted in the relevant trade or by the buying public, describes the organism. It thus has no inherent adaptation to distinguish one trader's goods from those of another, in respect of the organism itself or its host plants. Whether a trade mark incorporating such a term will have sufficient adaptation to distinguish will depend on the other material incorporated within it.¹⁸⁶

The delegate then rejected the application because the word 'PLUS' referred to the good as a rye grass plus the fungal endophyte sold together and this was something other traders would want to do when they were selling similar goods such as 'ryegrass variety X plus AR1'.¹⁸⁷ This was a describing use and not a distinguishing use and so a trade mark was not available as this was not inherently adapted to distinguish the designated goods¹⁸⁸ as required by the *Trade Marks Act 1995* (Cth).¹⁸⁹ The decision illustrates that a protected PBR'ed variety name with an additional sign might be a trade mark under the *Trade Marks Act 1995* (Cth) if the sign is more than just descriptive and can distinguish the variety from others.

2.5.2 Re SFR Holdings Inc (2013)

In *Re SFR Holdings Inc* the application for a trade mark was for the name 'SEADWARF PASPALUM SDX-1'¹⁹⁰ being a particular plant of the genus *Paspalum*.¹⁹¹ The examiner raised grounds for rejecting the trade mark on the basis that:

SDX-1 is the name of a variety of *Paspalum*, namely *Paspalum vaginatum* Swartz. As such it has been granted PBR rights. You are the owner of those rights and they were granted in December 2008. The term SEADWARF is the commonly used name for this variety of *Paspalum*. In other words SEADWARF is, at least, a synonym for the variety in question.¹⁹²

The examiner's concern was that it was difficult to distinguish the applicant's product¹⁹³ or that the name might deceive or cause confusion.¹⁹⁴ First, the name 'combines the commonly used varietal indicator with the "formal" variety name' which was 'of course, common practice to show' such information on plant labels and this was problematic as '[o]ther traders should be able to use this information to describe their similar goods'.¹⁹⁵ Secondly, that the mark might be used on other varieties so that '[i]f this mark was used on plants or plant material

¹⁸⁶ *Heritage Seeds Pty Ltd* [2007] ATMO 4, [19] (A. Windsor).

¹⁸⁷ *Heritage Seeds Pty Ltd* [2007] ATMO 4, [20] (A. Windsor).

¹⁸⁸ *Heritage Seeds Pty Ltd* [2007] ATMO 4, [20] (A. Windsor).

¹⁸⁹ The relevant provisions were the then *Trade Marks Act 1995* (Cth) ss. 41(5) that was replaced by ss. 41(2) and (4): see *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth) s. 3 and sch. 6 (item 113); Explanatory Memorandum to the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011 (Cth), pp. 145-147 (Item 113).

¹⁹⁰ Noting that earlier applications for the word 'SEADWARF' for 'natural turf, reinforced turf, turf grasses, turf seedlings, grass seeds' had been rejected under the *Trade Marks Act 1995* (Cth) ss. 41 and 43 and withdrawn, although a trade mark was registered for 'SEADWARF' for 'non-artificial turf grasses' in the United States: *Re SFR Holdings Inc* (2013) 103 IPR 190, [9]-[10].

ss 41 and 43 of the Act

¹⁹¹ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

¹⁹² *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

¹⁹³ *Trade Marks Act 1995* (Cth) s. 41. *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

¹⁹⁴ *Trade Marks Act 1995* (Cth) s. 43. *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

¹⁹⁵ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

not being of the variety of *Paspalum* called SDX-1 it would be misleading to buyers of your goods and would cause confusion in the marketplace'.¹⁹⁶

These second ground that the name might deceive or cause confusion¹⁹⁷ was addressed by amending the specification of the trade mark so that the mark 'SEADWARF PASPALUM SDX-1' was limited to *only* 'Natural turf, reinforced turf, turf grasses, turf seedlings, grass seeds; all being plants or plant material of the variety SDX-1 of the genus *Paspalum*'.¹⁹⁸ In effect, this was limiting the mark to a very specific plant, and importantly, leaving the word 'Paspalum' open to broader use. On the first ground, that it was difficult to distinguish the applicant's product,¹⁹⁹ the applicant argued that 'as owner of the PBR right, [the applicant] was the only person with the right, by virtue of the [*Plant Breeder's Rights Act 1994* (Cth)], to use the trade mark in order to sell, or licence the sale of, the relevant goods'.²⁰⁰ The evidence showed that 'SEADWARF' was the only existing dwarf cultivar of a grass known as Seashore Paspalum,²⁰¹ and that as a specialist grass for use on golf courses, architect designs, and so on, the target market in Australia was 'such that the buyers and users of the product are most likely to be able to differentiate the trade mark element of the Mark Seadwarf from the varietal and generic elements of the Mark'.²⁰² The objection was that the 'trade mark is SEADWARF PASPALUM SDX-1' and that '[t]his is the name of a particular plant of the genus Paspalum'.²⁰³ In rejecting this application,²⁰⁴ the delegate stated:

the registered name of the variety or the synonym by which it is to be known in the trade serve a single purpose and that is to describe the plant in respect of which the names are to be applied. They are effectively generic descriptions of the specific plant. It is well understood in trade marks law that the name of a product, and especially a new product, is not well adapted to distinguish the relevant goods of one producer from those of another ... The primary descriptive meaning of the trade mark is that of a particular kind of Paspalum grass. It has no secondary meaning, and is not capable of developing any secondary meaning. The whole purpose behind the genesis of the trade mark is to identify the grass which the applicant has developed and intends to market in Australia. Given that the trade mark is clearly composed of a registered variety name, the trade name for the same plant (recorded on the PBR register) and the name of the genus of grass in respect of which the two previously mentioned names are to be applied, the combination of words serves a single purpose and that is to define exactly which grass the name refers to. It can have no other purpose. As such, it is a mere description of the relevant goods, it has no inherent adaptation to distinguish those goods.²⁰⁵

Commenting on the tension between the *Plant Breeder's Rights Act 1994* (Cth) name and the *Trade Marks Act 1995* (Cth),²⁰⁶ the delegate said that a PBR holder using a name for PBR'ed variety is:

¹⁹⁶ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

¹⁹⁷ *Trade Marks Act 1995* (Cth) s. 43. *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

¹⁹⁸ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2]-[4] (A. Windsor).

¹⁹⁹ *Trade Marks Act 1995* (Cth) s. 41.

²⁰⁰ *Re SFR Holdings Inc* (2013) 103 IPR 190, [11] (A. Windsor).

²⁰¹ *Re SFR Holdings Inc* (2013) 103 IPR 190, [13] (A. Windsor).

²⁰² *Re SFR Holdings Inc* (2013) 103 IPR 190, [15] (A. Windsor).

²⁰³ *Re SFR Holdings Inc* (2013) 103 IPR 190, [25] (A. Windsor).

²⁰⁴ *Re SFR Holdings Inc* (2013) 103 IPR 190, [36] (A. Windsor).

²⁰⁵ *Re SFR Holdings Inc* (2013) 103 IPR 190, [29] and [32] (A. Windsor).

²⁰⁶ *Re SFR Holdings Inc* (2013) 103 IPR 190, [28] and [33] (A. Windsor).

... effectively the guardian of the names applied to its particular Paspalum plant for the term of the PBR grant. After that date it loses the right to restrict use of either of the names it has chosen to enter upon the PBR register in respect of the specific Paspalum plant. Registration of a trade mark is not subject to a fixed term and the presence on the Trade Marks Register of the trade mark after expiry of the PBR grant would effectively preclude any use of the officially accepted varietal name and its synonym (which after 20 years is likely to be well accepted by the trade) by other interested parties. Such an action goes against the intent of the [*Plant Breeder's Rights Act 1994* (Cth)]. I am thus satisfied that it is clear that registration as a trade mark of the registered name of a plant variety and/or of its designated trade reference or synonym is inappropriate.²⁰⁷

The examiner's concern had first been that the trade mark 'combines the commonly used varietal indicator with the "formal" variety name'²⁰⁸ and this was addressed by limiting the specification of good to particular forms of 'plants or plant material of the variety SDX-1 of the genus Paspalum'.²⁰⁹

An important nuance in this case was that the name 'SEADWARF' was nominated as a trade reference on the application²¹⁰ where the trade mark was being sought after the PBR had been granted.²¹¹ Recall, the PBR had specified the name as '*Paspalum vaginatum* Swartz SDX-1' while the trade mark application was for the name 'SEADWARF Paspalum SDX-1'²¹² where the name 'SEADWARF' was a common name of the that variety of Paspalum and nominated as the trade reference.²¹³ Trade references are merely names used in commerce, and confusingly, a trade reference can include a number of different cultivars under the same name, and *vice versa*, the same cultivar can have more than one name.²¹⁴ In this case the trade reference in combination with the genus and variety name was found not capable of distinguishing the goods (plants).²¹⁵ But, it is possible that the trade reference together with a genus and variety name might be capable of distinguishing the goods (plant). Where the genus and variety name describe the plant it is possible that the trad reference could distinguish the trade source, and in those circumstances a trade mark might be valid.

2.5.3 *Mastronardi Produce Ltd v Registrar of Trade Marks (2014)*

In *Re Mastronardi Produce Ltd* (2013) before IP Australia an application for a trade mark was filed for the word 'ZIMA' for 'tomatoes' under the *Trade Marks Act 1995* (Cth).²¹⁶ The word, however, was already the name of a particular plant of the genus *Solanum lycopersicon*.²¹⁷ The original application was rejected on the basis that the mark would not distinguish the applicant's product²¹⁸ and that it might deceive or cause confusion.²¹⁹ On further consideration by a delegate of the Registrar of Trade Marks, the *Trade Marks Act 1995* (Cth)

²⁰⁷ *Re SFR Holdings Inc* (2013) 103 IPR 190, [34] (A. Windsor).

²⁰⁸ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

²⁰⁹ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] and [3] (A. Windsor).

²¹⁰ *Re SFR Holdings Inc* (2013) 103 IPR 190, [7] and [23] (A. Windsor).

²¹¹ See *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

²¹² *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

²¹³ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

²¹⁴ See Naktuinbouw, *List of Names of Woody Plants and Perennials* available at <http://www.internationalplantnames.com/html/English/how_to_use_the_list.htm#Geslach>.

²¹⁵ *Re SFR Holdings Inc* (2013) 103 IPR 190, [32] (A. Windsor).

²¹⁶ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [1] (A. Windsor).

²¹⁷ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [2] (A. Windsor).

²¹⁸ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [2] (A. Windsor). See *Trade Marks Act 1995* (Cth) s. 41.

²¹⁹ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [2] (A. Windsor). See *Trade Marks Act 1995* (Cth) s. 43.

was understood to have the ‘essential or primary function of a trade mark is to act as an indication of the trade source of the goods in relation to which the sign is to be used’.²²⁰ An internet search of the word ‘ZIMA’ revealed that it was a word associated primarily with the ‘the name of a particular cultivated variety of *Solanum lycopersicum* which the applicant is growing and marketing’.²²¹ Based on this analysis, the delegate considered that the ‘trade mark therefore lacks any inherent adaptation to distinguish the applicant’s tomatoes as it appears to be an appropriate description of the goods in respect of which it is to be used’.²²² The onus was then for the application to provide evidence demonstrating ‘that at the filing date, the trade mark did distinguish the applicant’s goods from those of other traders’.²²³ The applicant’s evidence was that the word ‘ZIMA’ was developed as a brand for four different varieties of a particular type of golden grape tomato that resulted from a combination of different crosses from closely related varieties and all sold under the same brand mark.²²⁴ The intention was also to use the mark for future different varieties of golden grape tomatoes.²²⁵ The purpose of the brand was ‘that ZIMA is a reference to a particular brand name, and not a reference to a particular tomato variety’.²²⁶ The applicant’s evidence was also and specifically that the mark ‘ZIMA’ was not registered as a PBR in any country and that its use was about a commercial brand and not PBRs.²²⁷ The delegate commented:

It is clear from the applicant’s evidence that the trade mark is to be (and has been) used in respect of the fruit of at least one cultivated variety of tomato. I do not consider it to be significant that these tomatoes are to be presented for sale in a particular kind of plastic container – the word ZIMA is taken by purchasers to refer to the fruit itself. This is clear from the marketing materials and the comments from purchasers to which I have had access. I do not agree with Mr Heerey that the applicant’s use of the word ‘variety’ occurring in its evidence is clearly a reference to the fruit in its package, rather than to the fruit itself ... The buying public is unlikely to be aware that these seeds are claimed to be of different cultivars of orange grape tomatoes, and thus that the fruit within the packages may be fruits of different kinds of tomato plants. I can see nothing in the evidence that suggests that the applicant is actively promoting the trade mark as a brand for a range of different tomato fruits, and by default it appears to me (and to the public) as a single cultivated variety of tomato (footnote omitted).²²⁸

The delegate considered that the word ‘ZIMA’ was being used ‘as a reference to a particular cultivated variety of orange grape tomato’,²²⁹ and as such, the mark would not distinguish the applicant’s goods.²³⁰ The delegate relied on the same evidence to conclude the word might deceive or cause confusion:²³¹

It is clear that the buying public likewise views the trade mark as a reference to a variety of golden grape tomato. Therefore the secondary meaning within the trade mark is that of a particular variety of golden

²²⁰ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [10] (A. Windsor). See also *Blount Inc v Registrar of Trade Marks* (1998) 40 IPR 498, p. 504 (Branson J).

²²¹ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [17] (A. Windsor).

²²² *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [17] (A. Windsor).

²²³ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [18] (A. Windsor).

²²⁴ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [21] (A. Windsor).

²²⁵ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [23] (A. Windsor).

²²⁶ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [23] (A. Windsor).

²²⁷ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [24] (A. Windsor).

²²⁸ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [26]-[27] (A. Windsor).

²²⁹ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [28] (A. Windsor).

²³⁰ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [28] (A. Windsor). See *Trade Marks Act 1995* (Cth) s. 41.

²³¹ *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [31] (A. Windsor). See *Trade Marks Act 1995* (Cth) s. 43.

grape tomato. If the trade mark is applied to other tomatoes which are not of this variety, then the buying public is likely to be deceived or confused about the true nature of the tomatoes they are buying.²³²

On appeal to the Federal Court in *Mastronardi Produce Ltd v Registrar of Trade Marks* the issue in dispute was whether the sign 'ZIMA' was inherently adapted to distinguish the designated goods from the goods of others.²³³ The standard was that identified as Kitto J's question in *Clark Equipment Co v Registrar of Trade Marks*:²³⁴

the question whether a mark is adapted to distinguish [is to] be tested by reference to the likelihood that other persons, trading in goods of the relevant kind and being actuated only by proper motives – in the exercise, that is to say, of the common right of the public to make honest use of words forming part of the common heritage, for the sake of the signification which they ordinarily possess – will think of the word and want to use it in connexion with similar goods in any manner which would infringe a registered trade mark granted in respect of it.²³⁵

The applicable principles were identified as those applied in *Mantra IP Pty Ltd v Spagnuolo*:²³⁶

[R]egard must be had to the presumption of registrability in s. 33 of the [Trade Marks Act 1995 (Cth)]. The assessment under s. 41(3) looks to the mark itself and its inherent nature; it does not take into account the effect of use; it considers how the mark would be understood by ordinary Australians seeing it for the first time. *The question can be tested by asking whether other traders trading in services of the same or a similar kind and only actuated by proper motives are likely to want to use the mark in connection with the same or similar services. A proper motive is one founded on the 'common right of the public to make honest use of words forming part of the common heritage'.* Signs that are descriptive in nature, or use a geographical name, form part of the 'common heritage' and, therefore, cannot usually be inherently distinctive. This test is to be applied negatively, not positively and the assessment is to involve a 'practical evaluative judgment ... in the real world'.²³⁷

Justice Gordon considered the matter was resolved through two distinct questions:

(1) how would ZIMA be understood as at 25 July 2011 by ordinary Australians seeing it for the first time used in respect of tomatoes; and (2) how likely is it that other persons, trading in tomatoes and being actuated only by proper motives, will think of the word ZIMA and want to use it in connexion with tomatoes in any manner which would infringe a registered trade mark granted in respect of it?²³⁸

Justice Gordon was provided with further evidence that there was no use of the word 'ZIMA' by the applicant, suppliers, retailers or consumers for a variety of tomatoes²³⁹ because it was an invented word (and not in a dictionary)²⁴⁰ coined by the applicant for to supply of its golden grape tomatoes,²⁴¹ and also known as 'sweet orange grape tomatoes' and 'golden snacking tomatoes'.²⁴² So, 'the word ZIMA could not and did not convey any obvious meaning to

²³² *Re Mastronardi Produce Ltd* (2013) 103 IPR 339, [31] (A. Windsor).

²³³ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [13] (Gordon J).

²³⁴ (1964) 111 CLR 511, 514 (Kitto J).

²³⁵ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [15] (Gordon J).

²³⁶ *Mantra IP Pty Ltd v Spagnuolo* (2012) 96 IPR 464 (Reeves J).

²³⁷ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [19] (Gordon J) citing *Mantra IP Pty Ltd v Spagnuolo* (2012) 96 IPR 464, [52] (Reeves J).

²³⁸ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [24] (Gordon J).

²³⁹ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [34] (Gordon J).

²⁴⁰ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [25] (Gordon J).

²⁴¹ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [1], [5] and [25] (Gordon J).

²⁴² *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [42] (Gordon J).

ordinary Australians'.²⁴³ Significantly, the golden grape tomatoes sold under the name 'ZIMA' were from six different seeds that produced six varieties of golden grape tomato,²⁴⁴ tomatoes for sale were produced by one or more cultivars with common characteristics²⁴⁵ and about 50 cultivars were capable of producing tomatoes with the preferred characters.²⁴⁶ Based on this evidence Justice Gordon concluded that 'there are a number of descriptors that other traders could find within the common heritage of the language to describe these tomatoes without having to use the word ZIMA'.²⁴⁷ This meant that it was unlikely that others persons would think of the sign 'ZIMA' and want to use it in connection with tomatoes.²⁴⁸ And as such, the word 'ZIMA' was a valid trade mark under the *Trade Marks Act 1995* (Cth).²⁴⁹

The decision shows that a word as a sign, in this case the word 'ZIMA', can be a trade mark where the name does not provide a unique description of the plant variety. Instead, the trade mark distinguished the suppliers golden grape tomatoes from those of others and was capable of functioning as a valid trade mark.²⁵⁰ The counter to this decision was the use of the words 'SIR WALTER' for a variety of turf grass.

2.5.4 Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks (2015)

In *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* the applicant sought a trade mark for the words 'SIR WALTER' in respect of goods and services in a number of classes, including 'turf grass'.²⁵¹ The delegate of the Registrar of Trade Marks reject the application because 'SIR WALTER was not inherently adapted to distinguish these goods from the goods of other persons',²⁵² in part because the name was used as the name for the grass and not as a trade mark to distinguish the goods as the applicant's goods.²⁵³ The appeal was on the basis of the description of 'SIR WALTER' as 'Buffalo grass of the 'Sir Walter' variety (as lodged with the Registrar of Plant Breeder's Rights (ref: certificate no 1028)), being part of the genus *Stenotaphrum* and a member of the species *Secundatum*'.²⁵⁴ The applicant argued 'that SIR WALTER is, to some extent, inherently adapted to distinguish the designated goods, and thus registrable as a trade mark for this reason alone'.²⁵⁵

²⁴³ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [25] (Gordon J).

²⁴⁴ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [38] (Gordon J).

²⁴⁵ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [40] (Gordon J).

²⁴⁶ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [44] (Gordon J).

²⁴⁷ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [44] (Gordon J).

²⁴⁸ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [45] (Gordon J).

²⁴⁹ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [47] (Gordon J).

²⁵⁰ See also *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [66] (Yates J).

²⁵¹ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [2] (Yates J).

²⁵² *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [3] (Yates J).

²⁵³ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [43] (Yates J).

²⁵⁴ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [5] (Yates J).

²⁵⁵ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [25]. (Yates J) The relevant provisions were the then *Trade Marks Act 1995* (Cth) ss. 41(5) and (6) that were replaced by ss. 41(2), (3) and (4): see *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth) s. 3 and sch. 6 (item 113); Explanatory Memorandum to the Intellectual Property Laws Amendment (Raising the Bar) Bill 2011 (Cth), pp. 145-147 (Item 113).

In deciding that the mark ‘SIR WALTER’ was not ‘to any extent inherently adapted to distinguish the designated goods as the [applicant’s] goods’,²⁵⁶ Justice Yates framed the issue as:

The matter can be assessed by adapting Kitto J’s question in [*Clark Equipment Co v Registrar of Trade Marks*]²⁵⁷ to the facts of the present case: Would traders of buffalo grass of the Sir Walter variety, in the exercise of the common right of the public to make honest use of words for the sake of the signification which they ordinarily possess, think of the sign SIR WALTER and want to use it in connection with the designated goods?²⁵⁸

The answer was ‘yes’,²⁵⁹ and as such:

SIR WALTER denotes the Sir Walter plant variety of buffalo grass with its particular characteristics and attributes. It is not adapted to distinguish one trader’s goods (here, Sir Walter grass) from the goods (again, Sir Walter grass) of other traders.²⁶⁰

Putting this into a broader context:

Here, the [applicant] developed a new thing – a new variety of buffalo grass having particular characteristics – which it called Sir Walter. Sir Walter is the given and proper name for the new variety. It has no other name. In this way, the name Sir Walter must be taken to be part of the common stock of language that denotes this particular variety of grass ... When used in connection with the relevant goods, the name Sir Walter is no less the descriptor of the new variety because it might be possible to describe Sir Walter grass using other words. I am satisfied that, in the normal course of events, other traders would wish to use the name Sir Walter for the grass, for no reason other than the obvious one: Sir Walter is the grass’s given name and accepted official designation.²⁶¹

2.5.5 Other related litigation in Australia

Other litigation in Australia has involved the trade mark ‘PINK LADY’ in a licencing arrangement determined in *Apple and Pear Australia Ltd v Pink Lady America LLC*.²⁶² Recall the apple variety *Malus domestica* ‘Cripps Pink’ was bred by the Western Australian Department of Agriculture and Food (WA-DAF) with PBRs granted to WA-DAF in approximately 30 countries and the trade mark ‘PINK LADY’ granted to WA-DAF in approximately 70 countries.²⁶³ The ‘PINK LADY’ trade mark was transferred to Apple and Pear Australia Limited as a more suitable commercial operator than WA-DAF.²⁶⁴ In this dispute between Apple and Pear Australia Limited and Pink Lady America LLC, the Victorian Court of Appeal considered an option agreement that transferred ownership of the ‘PINK LADY’ trademarks in Chile for a royalty free, in perpetuity exclusive licence to use the trademarks for all apple products between Chile and North America.²⁶⁵ The court held that the agreement

²⁵⁶ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [44] (Yates J).

²⁵⁷ (1964) 111 CLR 511, 513-514 (Kitto J).

²⁵⁸ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [45] (Yates J).

²⁵⁹ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [46] (Yates J).

²⁶⁰ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [47] (Yates J).

²⁶¹ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [55] (Yates J).

²⁶² (2016) 124 IPR 497 (Croft J).

²⁶³ See Sanderson, above n. 53, pp. 150-152.

²⁶⁴ See Sakuradani, above n. 74, 24.

²⁶⁵ *Apple and Pear Australia Ltd v Pink Lady America LLC* (2016) 124 IPR 497, [1]-[2] (Croft J).

was limited to the trade marks listed in the agreement schedule.²⁶⁶ The case did not raise any issues about variety naming and trade marks.

2.6 ACIP review

The Advisory Council on Intellectual Property (ACIP) carried out a review of the enforcement of PBR in Australia ‘to consider possible strategies to assist PBR owners to effectively enforce valid rights’.²⁶⁷ There the main concern about trade marks was about seizure powers that incorporated features of the Australia *Case R 279/2014-1 ‘Silverado’* (First Board of Appeal EUIPO), [4].n notice system for trade marks.²⁶⁸ An ACIP review of the enforcement of the *Trade Marks Act 1995* (Cth), however, addressed the concern that the naming requirements in the *Plant Breeder’s Rights Act 1994* (Cth) forced owners of the plant varieties to develop both a varietal name and a trade mark to market their variety.²⁶⁹ Proponents of this concern wanted to use the same name for both a *Plant Breeder’s Rights Act 1994* (Cth) PBR and a register *Trade Marks Act 1995* (Cth) trade mark.²⁷⁰ ACIP considered that:

The variety name should be available for all to use as it is the only name by which the plant can be referred to – allowing a trade mark registration for the name would ‘undermine the very definition of a trade mark and the intent and purpose of the Trade Marks Act’.²⁷¹

ACIP considered that any ‘confusion or misunderstanding about [the *Plant Breeder’s Rights Act 1994* (Cth) name] and the [*Trade Marks Act 1995* (Cth)] trade mark rights ... could be addressed by increasing education and awareness in this area’.²⁷²

²⁶⁶ *Apple and Pear Australia Ltd v Pink Lady America LLC* (2016) 124 IPR 497, [188]-[189] (Croft J).

²⁶⁷ Advisory Council on Intellectual Property, *A Review of Enforcement of Plant Breeder’s Rights* (IP Australia, 2010) p. iii.

²⁶⁸ *Ibid.*, pp. 14 and 114 (Recommendation 18).

²⁶⁹ Advisory Council on Intellectual Property, *Review of Trade Mark Enforcement* (IP Australia, 2004) p. 28.

²⁷⁰ *Ibid.*

²⁷¹ *Ibid.*

²⁷² *Ibid.*

Part 3: Review of relevant prior academic and trade literature

The interaction between the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth) has not been extensively addressed in the academic and trade literature,²⁷³ other than with exemplars of combining the uses of PBRs and trade marks as a useful commercialisation strategy for new plant varieties.²⁷⁴ The strategies and uses of intellectual property are generally commercially sensitive, however, so they are not subject to much research and analysis. There appear to be two basic strategies.²⁷⁵

(1) *Commercialisation (for royalties)* – Traditionally, plant varieties have been commercialised on the basis of their variety name, with traditional apple varieties being a good example such as 'Granny Smith', 'Golden Delicious', and so on.²⁷⁶ In more recent times and with the introduction of intellectual property, branding has become more important with the development of so-called managed variety names such as 'KIKU', 'KANZI', 'JAZZ', 'PACIFIC ROSE', 'PINK LADY', and so on.²⁷⁷ As an example, the apple variety *Malus domestica* 'Cripps Pink' was bred by the Western Australian Department of Agriculture and Food (WA-DAF) with PBRs granted to WA-DAF in approximately 30 countries and the trade mark 'PINK LADY' granted to WA-DAF in approximately 70 countries.²⁷⁸ The 'PINK LADY' trade mark was transferred to Apple and Pear Australia Limited as a more suitable commercial operator than WA-DAF.²⁷⁹ The trade marks were words and words and figures, with a temporal strategy that started out with words and expanded to include figures to avoid the trade mark becoming a generic name for the variety.²⁸⁰ The essence of the commercialisation strategy was to clearly differentiate between the PBR name and the trade mark, with the commercial strategy built around the trade mark. The combination of the PBR and the trade mark enables the variety owner to use the PBR to licence the propagation and fruit production and the trade mark to regulate the volumes and qualities of product in the market(s).²⁸¹ In this context the PBR

²⁷³ See Genevieve Wilkinson, 'Cultivating Plant Marks for Registration' (2015) 28 *Australian Intellectual Property Law Bulletin* 255.

²⁷⁴ See, for examples, Bradley Rickard, Todd Schmit, Miguel Gómez and Hao Lu, 'Developing Brands for Patented Fruit Varieties: Does the Name Matter?' (2013) 29 *Agribusiness* 259; James Luby and David Bedford, 'Cultivars as Consumer Brands: Trends in Protecting and Commercializing Apple Cultivars via Intellectual Property Rights' (2015) 55 *Crop Science* 2504; William Tucker and Gavin Ross, 'Use of Trademarks in a Plant-licensing Program' in Anatole Krattiger, Richard Mahoney, Lita Nelson, Jennifer Thomson, Alan Bennett, Kanikaram Satyanarayana, Gregory Graff, Carlos Fernandez and Stanley Kowalski (eds.) *Intellectual Property Management in Health and Agricultural Innovation: A Handbook of Best Practices*, Volume Two (MIHR Oxford, PIPRA Davis and bioDevelopments-International Institute Ithaca, 2007) p. 1062-1064; and so on.

²⁷⁵ See generally Robert Jondle, Krista Hill and Tony Sanny, 'Current Legal Issues in Intellectual Property Rights and Protection for Crop Plants' (2015) 55 *Crop Science* 2496.

²⁷⁶ See Rickard *et al.*, above n. 274, 259-260.

²⁷⁷ See Luby and Bedford, above n. 274, 2509-2510. See also Susan Brown and Kevin Maloney, 'An Update on Apple Cultivars, Brands and Club-marketing' (2013) 21 *New York Fruit Quarterly* 3; Susan Brown and Kevin Maloney, 'Making Sense of New Apple Varieties, Trade Marks and Clubs: Current Status' (2009) 7 *New York Fruit Quarterly* 9.

²⁷⁸ See Sanderson, above n. 53, pp. 150-152.

²⁷⁹ See Sakuradani, above n. 74, 24.

²⁸⁰ For the generic descriptor issues see Wilkinson, above n. 273, 227.

²⁸¹ See Luby and Bedford, above n. 274, 2509-2510.

might be conceived as ‘protection’ while the trade mark is about ‘utilization’.²⁸² This proved successful and has been replicated by others.²⁸³

- (2) *Promoting behaviour and practice (stewardship schemes)* – Stewardship schemes are important for preventing or delaying weeds, pests and pathogens overcoming valuable resistance in new varieties through good resistance management.²⁸⁴ This has become increasingly important with the advent of climate change. In effect, however, this is just relying on the exclusive rights of the PBR and trade mark to impose obligations on growers and marketers to comply with obligations imposed by licence terms and conditions.²⁸⁵

There is a small literature, however, demonstrating that cultivar names and trade marks for plant varieties are being confused. For example, a study of the 61 papers presented to the 2017 International Turfgrass Research Conference on warm season turfgrasses found 18 referred to trade mark names, and of these, 15 depicted trade mark names as cultivar names.²⁸⁶ A similar review of 302 refereed journal articles about warm-season turfgrass found 101 that used marketing names as cultivar names.²⁸⁷ Perhaps importantly, these studies also showed that there were many other nomenclature errors in identifying relevant plant materials being studied.²⁸⁸ This confusion is probably emblematic of the inherent tensions between cultivar names and trade marks that have been apparent in some of the early literature and discussions at UPOV.²⁸⁹

The unresolved tension is between the groupings seeking to stabilise cultivar naming through the *Cultivated Plant Code* and plant taxonomy²⁹⁰ and breeders’ concerned about the uses of

²⁸² See Sakuradani, above n. 74, 22.

²⁸³ See, for example, Daniele Asioli, Maurizio Canavari, Luca Malaguti and Chiara Mignani, ‘Fruit Branding: Exploring Factors Affecting Adoption of the New Pear Cultivar “Angelys” in Italian Large Retail’ (2016) 16 *International Journal of Fruit Science* 284 (pears); Don Loch, ‘Commercial Branding of Warm-Season Turfgrass Varieties: Implications for Researchers’ (2019) *Newsletter of the International Turfgrass Society* available at <<https://turfgrassociety.com/newsletters/2019-01%20itsnd.pdf>> (turf grass); Brown and Maloney, above n. 277; Vincent Gioia, ‘Managing Trademarks and Plant Variety Protection of Ornamentals for Profit’ in J. Van Huylbroeck *et al.* (eds.), *XX International Eucarpia Symposium, Section Ornamentals, Strategies for New Ornamentals*, Part I 552 (ISHS, 2001) pp. 225-236; and so on. See also Tucker and Ross, above n. 274, pp. 1062-1064.

²⁸⁴ See Marinus Smulders, Clemens van de Wiel and Lambertus Lotz, ‘The Use of Intellectual Property Systems in Plant Breeding for Ensuring Deployment of Good Agricultural Practices’ (2021) 11 *Agronomy* 1163.

²⁸⁵ See Lambertus Lotz, Clemens van de Wiel and Marinus Smulders, ‘How to Assure that Farmers Apply New Technology According to Good Agricultural Practice: Lessons from Dutch Initiatives’ (2018) 6 *Frontiers in Environmental Science* 89.

²⁸⁶ Loch, above n. 283, pp. 4-6.

²⁸⁷ *Ibid.*, p. 4.

²⁸⁸ *Ibid.*

²⁸⁹ See, for example, Council of UPOV, *UPOV Recommendations on Variety Denominations* (1984) UPOB/INF/10. See also Administrative and Legal Committee, *Variety Denominations* (1986) CAJ/XVII/4; Administrative and Legal Committee, *Variety Denominations Observations from COMASSO* (1986) CAJ/XVII/7; Administrative and Legal Committee, *Variety Denominations* (1986) CAJ/XVIII/5.

²⁹⁰ See, for examples, J. Ochsmann, ‘Current Problems in Nomenclature and Taxonomy of Cultivated Plants’ in C. Davidson and P. Trehane (eds.), *XXVI International Horticultural Congress, IV International Symposium on Taxonomy of Cultivated Plants* 634 (IHC, 2002) pp. 56-57 available at <https://www.lib.teiep.gr/images/stories/acta/Acta%20634/634_5.pdf>; V. Gioia, ‘Trademark Rights – A Sometimes Overlooked Tool for Plant Variety (Marketing) Protection’ in S. Andrews, A. Leslie and C. Alexander

multiple names (cultivar names and trade marks) in commerce.²⁹¹ This is perhaps made more problematic because there are no universally accepted basic norms for either cultivar naming or taxonomy,²⁹² and UPOV has adopted provisions that do not clearly delineate between cultivar names and trade marks.²⁹³ The result has been reported to be consumer confusion between the variety names and trade marks,²⁹⁴ the loss of valuable trade marks through it becoming a generic name in common use for the plant,²⁹⁵ a loss of coordination between variety rights and seed laws,²⁹⁶ and superfluous to PBRs,²⁹⁷ and so on.²⁹⁸

(eds.), *Taxonomy of Cultivated Plants*, Third International Symposium (Royal Botanic Gardens, 1999) pp. 81-87; and so on.

²⁹¹ See, for examples, Schlosser, above n. 75; Marie-Christine Piatti and Marie Jouffray, 'Plant Variety Names in National and International Law, Part I' (1984) 10 *European Intellectual Property Review* 283; Marie-Christine Piatti and Marie Jouffray, 'Plant Variety Names in National and International Law, Part II' (1984) 11 *European Intellectual Property Review* 311; and so on.

²⁹² See, for examples, E. Scott, 'Plant Breeder's Rights Trials for Ornamentals: The International Testing System and its Interaction with the Naming Process for New Cultivars' in S. Andrews, A. Leslie and C. Alexander (eds.), *Taxonomy of Cultivated Plants*, Third International Symposium (Royal Botanic Gardens, 1999) pp. 89-94; Schlosser, above n. 75, 179-180.

²⁹³ See also U. Löscher, 'Variety Denomination According to Plant Breeders' Rights' (1986) 182 *Acta Horticulturae* 59.

²⁹⁴ Schlosser, above n. 75, 184.

²⁹⁵ Schlosser, above n. 75, 184.

²⁹⁶ Andre Heitz, 'History of the UPOV Convention and the Rationale for Plant Breeder's Rights' in International Union for the Protection of New Varieties of Plants, *Seminar of the Nature of and Rationale for the Protection of Plant varieties under the UPOV Convention* (UPOV, 1990) pp. 26-28.

²⁹⁷ International Union for the Protection of New Varieties of Plants, *Records of the Geneva Diplomatic Conference on the Revision of the International Convention for the Protection of New Varieties of Plants*, UPOV Publication No. 337(E) (UPOV, 1978) p. 90.

²⁹⁸ See Sanderson, above n. 53, pp. 139-161.

Part 4: Review of any empirical materials

The IP Australia Policy Register raised the issue of PBRs and trade marks:

A plant variety name/synonym must not include a trade mark registered in respect of live plants, plant cells and plant tissues.

Unlike when trade marks are compared under the Trade Marks Act, the PBR Act does not allow consideration of whether the included trade mark is deceptively similar to the overall variety name, or if the relevant plant is actually similar to the goods the trade mark is registered for.

This can cause apparently unfair results, preventing PBR stakeholders registering their preferred name, even where an equivalent trade mark would be registrable.²⁹⁹

As a summary, the responses to the IP Australia Policy Register have been:

1. *Treating PBR names and trade marks separately* – The fruit sector and the nursery sector appear to favour a strategy of separating dealing with the variety name under the *Plant Breeder's Rights Act 1994* (Cth) from the trade mark name ('sign') under the *Trade Marks Act 1995* (Cth). This follows the apple 'PINK LADY' approach where the name of the variety used for PBR was *Malus domestica* 'Cripps Pink'³⁰⁰ and the related trade mark was 'PINK LADY'.³⁰¹ The advantage of this approach was that the trade mark used to market the variety outlasted the PBR. Some of those consulted reported ongoing confusion about the uses of names in these two separate schemes and the effects of the overlap of these schemes. The following example illustrates the concern. Where a breeder wants to seek a PBR and rely on the 12-month grace period within which the variety has been exploited in Australia,³⁰² then in that time a variety name and trade mark will have been selected (named, branded and labelled). If that name is then determined at the time of applying for the PBR to be unacceptable then there are likely to be significant expenses renaming and relabelling the variety.
2. *Limited numbers of available and possible names* – The vegetables sector and the fruit and nut sectors reported the limited range of names available given how many names were already used and are therefore off limits.
3. *The apparent requirement for a synonym* – The concern was that the application form provided by IP Australia seeks a synonym when this may not actually be a requirement under the *Plant Breeder's Rights Act 1994* (Cth).³⁰³ The consequence is that novice applicants might be compromising their future uses of possible trade mark words as valuable marketing tools by using the words as a PBR synonym rather than as a trade mark under the *Trade Marks Act 1995* (Cth) (see Attachment 1).

²⁹⁹ IP Australia Policy Register, *Inclusion of Trade Marks in Plant Variety Names or Synonyms*, Policy ID: 122 (IP Australia, 2022) at <<https://www.ipaustralia.gov.au/policy-register/inclusion-trade-marks-plant-variety-names-or-synonyms>>.

³⁰⁰ See, for example, Western Australia Agriculture Authority, '*Malus Domestica* Borkh "Cripps Pink"', Community Plant Variety Right No 1640, 15 January 1997.

³⁰¹ See, for example, Apple and Pear Australia Limited, above n. 70.

³⁰² *Plant Breeder's Rights Act 1994* (Cth) s. 43(6)(a).

³⁰³ See *Plant Breeder's Rights Act 1994* (Cth) s. 27.

Part 5: Analysis of the policy issue

The interaction between the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth) raises specific policy issues that are addressed here. The issues for breeders, sellers and incentives are addressed in the next part (Part 6).

5.1 The operation of naming for PBRs and trade marks

While the scheme for variety naming in the *Plant Breeder's Rights Act 1994* (Cth) appears simple, its practical application is complex with different and overlapping arrangements for naming under the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth). The decisions about application for PBRs under the *Plant Breeder's Rights Act 1994* (Cth) require a name for the plant variety that is consistent with the name and synonym standards under the *Plant Breeder's Rights Act 1994* (Cth)³⁰⁴ and specifically consistent with the naming codes³⁰⁵ and not 'be or include a trade mark'.³⁰⁶ The tensions between PBR and trade marks have always been present because they are different schemes with different and competing objectives – PBRs are about promoting plant breeding through maximising benefits through controlling access and use of new varieties while trade marks are about distinguishing goods of one market participant from another. Under the legislative schemes the trade mark problems manifest in ways that are dependent on the time order of applications for a PBR and then a trade mark, or visa versa. This is because the assessment of compatibility of the PBR name and synonym and trade mark is made at the time of the later application, by the PBR examiner *after* a trade mark or by the trade mark examiner *after* a PBR application. As a matter of practice, however, the two scenarios relevant for consideration for the *Plant Breeder's Rights Act 1994* (Cth) are: (1) an application is made under the *Plant Breeder's Rights Act 1994* (Cth) whether there is either no trade mark or a trade mark has been applied for or granted, and the PBR examiner considers the application; or (2) an application is made under the *Trade Marks Act 1995* (Cth) after a PBR has been applied for or granted under the *Plant Breeder's Rights Act 1994* (Cth). These are considered in turn.

Where the application for a PBR is examined, accepting that these may not be the steps actually followed by a PBR examiner, the scope of relevant considerations and complexity in making that assessment are apparent:

1. Consider information set out on the application form and based on information and guidance for PBR applicants about choosing suitable names and synonyms on the IP Australia website (see Attachments 1 and 2). This essentially requires a name (and synonym) that is the same as the name (and synonym) used in other variety right applications, be compatible with the naming codes, be a unique word of letters that can include numbers, not be a banned word and have the relevant consents if the name (and synonym) is of a person or an organisation (see Attachments 2 and 4).
2. Consider information about the examination processes in the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) (see Attachment 3).

³⁰⁴ *Plant Breeder's Rights Act 1994* (Cth) s. 27.

³⁰⁵ *Plant Breeder's Rights Act 1994* (Cth) s. 27(6).

³⁰⁶ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(e).

3. Check details about the proposed name (and synonym) with searches of the UPOV GENIE Database and any additional searches required in the GRIN, APNI and IPNI databases (see Attachment 3).
4. Conducting relevant additional searches of the UPOV, IP Australia and trade mark databases, and stepping out an assessment of all the relevant thresholds for accepting a suitable name or synonym – a variety denomination assessment (see Attachment 4). This involves addressing subjective thresholds for likely to deceive or cause confusion³⁰⁷ and contain scandalous or offensive matter.³⁰⁸ The bounds of likely to deceive or cause confusion are unclear. This is addressed further below (see **§5.2**).
5. Where a relevant trade mark is identified in the variety denomination assessment (see Attachment 3), then the PBR examiner must make an assessment whether the name or synonym is the trade mark or name or synonym ‘be or include’ the trade mark.³⁰⁹ The bounds of a suitable name that might ‘be or include’ a trade mark are unclear. This is addressed further below (see **§5.3**).
6. Where the examiner is satisfied that the name and synonym are within the *Plant Breeder’s Rights Act 1994* (Cth) scheme, the application is accepted³¹⁰ and granted³¹¹ subject to any objection no later than six months after a public notice of the variety description³¹² that the PBR if granted would affect commercial interests.³¹³ After that the PBR can be revoked,³¹⁴ but not on the grounds that the name or synonym is or includes a trade mark, unless this fact existed before the PBR was granted (and absenting error this is unlikely).³¹⁵ The effect is that once granted the name and synonym are permanent and co-exist with any granted trade marks.

The *Plant Breeder’s Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth) set out different schemes. It is important that the relevant considerations for the *Plant Breeder’s Rights Act 1994* (Cth) are clearly set out so that examiners and those applying for PBRs under the *Plant Breeder’s Rights Act 1994* (Cth) know and understand the process and relevant thresholds for a successful application. The current guidance to PBR examiners and available to applicants and other stakeholders is a checklist of relevant considerations (Attachment 3) with some additional checklists for names and synonyms (Attachment 4). Unfortunately, there is no information available about the kinds of relevant considerations that a PBR examiner might address in applying the thresholds like a name or synonym that might deceive or cause confusion, be contrary to law, contain scandalous or offensive matter, and so on. And importantly, there is no information about the threshold that a name or synonym does not ‘be or include a trade mark’.

³⁰⁷ *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(a).

³⁰⁸ *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(c).

³⁰⁹ *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(e).

³¹⁰ *Plant Breeder’s Rights Act 1994* (Cth) s. 30(2).

³¹¹ *Plant Breeder’s Rights Act 1994* (Cth) s. 44(1).

³¹² *Plant Breeder’s Rights Act 1994* (Cth) ss. 34(1), 35(1) and 44(1).

³¹³ *Plant Breeder’s Rights Act 1994* (Cth) s. 35(1)(a).

³¹⁴ *Plant Breeder’s Rights Act 1994* (Cth) s. 50(1).

³¹⁵ *Plant Breeder’s Rights Act 1994* (Cth) s. 50(1)(a).

The next concern is where the application for a trade mark is examined *after* the application for a PBR, then any PBR name or synonym is being assessed against the *Trade Marks Act 1995* (Cth) standards. The cases decided by the Registrar of Trade Marks and delegates, such as *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) and *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) show that the plant names and synonyms used under the *Plant Breeder's Rights Act 1994* (Cth) are not excluded from trade marks *per se*. Rather general principles are applied by the examiner:

1. Where the PBR name or synonym are the same as the proposed trade mark then the proposed trade mark will be rejected because it is contrary to law,³¹⁶ is not capable of distinguishing the goods because it merely describes the plant,³¹⁷ or is likely to deceive or confuse because it merely describes the plant or could be used for a different variety.³¹⁸ Thus, *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) confirmed that a PBR name ('Sir Walter') cannot be a trade mark.³¹⁹
2. Where the proposed trade mark is not the same as the PBR name or synonym, the trade mark may also be rejected where the proposed trade mark might describe the character or quality of the goods.³²⁰ Thus, *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) confirmed that an invented word (in that case 'ZIMA') that was not the PBR name or synonym that didn't uniquely describe the plant variety could be a valid trade mark.³²¹

As the preferred practice in the plant industries of appears to be to attain a common or generic name for a plant (variety name and synonym) that is separate and distinct from any mark identifying the commercial sources of that plant (trade mark),³²² this poses ongoing problems for the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth) schemes. For the *Plant Breeder's Rights Act 1994* (Cth) scheme this means there are two identifiers for the same plant variety, and for the *Trade Marks Act 1995* (Cth) scheme the trade mark name becomes the descriptor of the goods rather than distinguishing the sources of the goods (genericism). This is particularly problematic for the *Trade Marks Act 1995* (Cth) scheme where at the time of assessment the variety name and synonym and the trade mark name are distinguishingly different, but through use of the trade mark without the variety name and synonym the trade mark becomes generic for that good. Apples are a good example – the trade marks 'PINK LADY',³²³ 'JAZZ',³²⁴ 'KANZI'³²⁵ and 'MODI'³²⁶ for apple varieties *Malus*

³¹⁶ *Trade Marks Act 1995* (Cth) s. 42(b); *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(e).

³¹⁷ *Trade Marks Act 1995* (Cth) s. 41(1).

³¹⁸ *Trade Marks Act 1995* (Cth) s. 43.

³¹⁹ *Buchanan Turf Supplies Pty Ltd v Registrar of Trade Marks* (2015) 114 IPR 81, [47] (Yates J). See also *Re Application by Strauss* (1999) 47 IPR 191 (T Williams).

³²⁰ *Trade Marks Act 1995* (Cth) ss. 41(1) and 43.

³²¹ *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [47] (Gordon J).

³²² See Schlosser, above n. 75, 181.

³²³ Apple and Pear Australia Limited, above n. 70.

³²⁴ Venturefruit Global Limited, 'Jazz', Registered Trade Mark 900210, 14 January 2002 (Class 31: Agricultural, horticultural and forestry products and grains not included in other classes; fresh fruits, vegetables and other plant products not included in other classes; trees, seeds and plants; none of the foregoing being plants or plant material of the genus *Hibiscus* or *Tibouchina*).

³²⁵ Better3Fruit N.V., 'Kanzi', Registered Trade Mark 961011, 16 May 2003 (Class 31: Fresh fruits).

³²⁶ Consorzio Italiano Vivaisti, 'Modi', Registered Trade Mark 1853774, 6 April 2017 (Class 31: Apple seeds, trees and fruits).

domestica ‘Cripps Pink’, *Malus domestica* ‘Scifresh’, *Malus domestica* ‘Nicoter’ and *Malus domestica* ‘Civg198’ respectively have become the name consumers think of and want to use in connection with that variety of apple.³²⁷ Like the *Plant Breeder’s Rights Act 1994* (Cth) with revocation,³²⁸ the opportunities to review the threshold criteria for the grant of a trade mark are limited.³²⁹ There is, however, a general power in the *Trade Marks Act 1995* (Cth) for a court to determine that a trade mark sign becomes accepted as a sign describing the goods (and services).³³⁰ Where a court³³¹ makes that determination the trade mark’s ‘exclusive rights’ cease to apply to the goods and services.³³²

Recommendation 1

IP Australia should address the problems imposed by trade marks under the *Trade Marks Act 1995* (Cth) as they apply to the *Plant Breeder’s Rights Act 1994* (Cth) during PBR examination through explanatory materials to assist the PBR stakeholders, including small and medium enterprises, understanding the requirements for suitable names and synonyms. Specifically, IP Australia should update the IP Australia, *Plant Breeder’s Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) about choosing suitable names and synonyms with clearer guidance about:

5. A name or synonym that is not likely to deceive or cause confusion.
6. A name or synonym that does not be or include a trade mark.

Recommendation 2

IP Australia should continue to harmonize the guidance and practice of trade mark examiners to ensure they are aware of the specific needs of names and synonyms under the *Plant Breeder’s Rights Act 1994* (Cth).

Problem: The policy problem is potentially different and conflicting outcomes depending on the order in which applications for PBRs and trade marks are made, and the thresholds applied under the *Plant Breeder’s Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth).

Preferred solution: To minimise the potentially different and conflicting outcomes there should be more information made available about the scheme clarifying the relevant considerations and thresholds in both the *Plant Breeder’s Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth). This is best done through updating the IP Australia, *Plant Breeder’s Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022). While the tensions between the plant naming and trade mark schemes might never be finally resolved, more information about their operation and application will assist applicants, PBR examiners, trade mark examiners and other stakeholder proposing and considering names. This might be expected to flow through to the IP Australia website, information sheets, and so on. The information should be the relevant considerations for the *Plant Breeder’s Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth) so that examiners and those making applications know and understand the process and relevant thresholds for a successful application.

³²⁷ See *Mastronardi Produce Ltd v Registrar of Trade Marks* (2014) 108 IPR 7, [24] (Gordon J).

³²⁸ *Plant Breeder’s Rights Act 1994* (Cth) s. 50(1).

³²⁹ *Trade Marks Act 1995* (Cth) ss. 52(1) (opposition) and 84A(1) (revocation).

³³⁰ *Trade Marks Act 1995* (Cth) s. 24(4).

³³¹ See *Trade Marks Act 1995* (Cth) s. 190.

³³² *Trade Marks Act 1995* (Cth) ss. 24(2) and (3).

Benefits: The benefits are likely to be better informed applicants addressing relevant considerations for examiners and examiners better able to make good decisions that appropriately balance the relevant considerations for the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth). As names are important for commercialisation, and particularly trade marks, better informed applicants can propose compliant names and avoid the disappoint and (high) costs of names being rejected at the application stage, that is often well after the commercialisation strategies have been developed and often well into implementation.

Costs: The costs are likely to be the hidden costs of determining and navigating complex and uncertain legal thresholds and standards. Clarifying the legal thresholds and standards should avoid some of that complexity and uncertainty with PBR owners clearer about those legal thresholds and standards.

5.2 Names or synonyms that are deceptive, confusing or contrary to law

Neither the *Plant Breeder's Rights Act 1994* (Cth) nor the *Trade Marks Act 1995* (Cth) directly address how different a plant variety name or synonym must be from the trade marks, how different a trade marks must be from the plant variety name or synonym, and how similar plant variety names or synonyms can be to each other. This has been highlighted, in part, through the European Union cases dealing with allowing the same name to be trade marked for different genera,³³³ and the United States cases disallowing portions of the same variety names as a trade mark.³³⁴ Thus, the Community trade mark 'SILVERADO' for live plants and natural flowers of roses was an accepted trade mark where that same name was already a variety denomination for a different genus type of lungwort and garden lettuce,³³⁵ and the United States trade mark 'DELTAPINE' for various soybean and cotton planting seed was rejected because it was a portion of existing soybean and cotton variety names including 'DELTAPINE 50', 'DELTAPINE 20', 'DELTAPINE 105' and 'DELTAPINE 506' for the same varieties.³³⁶ The further concern is where names and synonyms include parts of earlier variety names and synonyms and trade marks. The European Union case of *Kordes' Rose Monique* dealt with the trade mark 'Kordes' Rose Monique' for roses, rose plants and rose-propagating materials where the word 'Monique' had been registered for a plant variety right.³³⁷ While the court considered that the name 'Monique' was not an essential element of the trade mark,³³⁸ there remains some doubt about where to draw that bright line.

The *Plant Breeder's Rights Act 1994* (Cth) provides that a name and synonym should not 'be likely to deceive or cause confusion'³³⁹ and the *Trade Marks Act 1995* (Cth) provides that a trade mark should not be registered if a 'connotation' would 'be likely to deceive or cause

³³³ See *Case R 895/2014-1 'Ice Tea'* (First Board of Appeal EUIPO); *Case R 894/2014-1 'Skyfire'* (First Board of Appeal EUIPO); *Case R 691/2014-1 'Wasabi'* (First Board of Appeal EUIPO); *Case R 528/2014-1 'Geisha'* (First Board of Appeal EUIPO); *Case R 280/2014-1 'Goldrush'* (First Board of Appeal EUIPO); *Case R 279/2014-1 'Silverado'* (First Board of Appeal EUIPO).

³³⁴ See *In re Delta & Pine Land Co.*, 26 U.S.P.Q.2d 1157 (T.T.A.B. 1993).

³³⁵ *Case R 279/2014-1 'Silverado'* (First Board of Appeal EUIPO), [1]-[2] and [10].

³³⁶ *In re Delta & Pine Land Co.*, 26 U.S.P.Q.2d 1157 (T.T.A.B. 1993).

³³⁷ *Kordes' Rose Monique* (2019) T-569/18, [2]-[5].

³³⁸ *Kordes' Rose Monique* (2019) T-569/18, [32].

³³⁹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(a).

confusion³⁴⁰ or it is substantially identical or deceptively similar to another trade mark.³⁴¹ The trade mark law is relatively well developed in assessing these questions. The *Plant Breeder's Rights Act 1994* (Cth) is not.

The concern is that under the *Plant Breeder's Rights Act 1994* (Cth) the threshold of 'be likely to deceive or cause confusion'³⁴² may be set very low, such as allowing names and synonyms 'DELTAPINE 50', 'DELTAPINE 20', 'DELTAPINE 105' and 'DELTAPINE 506' for various soybean and cotton varieties.³⁴³ Where it is the same PBR owner with a naming thicket this may be commercially desirable and convenient for that owner, as it was for the 'DELTAPINE ##' thicket where the Delta & Pine Land Co. was selling various soybean and cotton seeds for planting using the company associated word.³⁴⁴ For competing PBR owners where this might affect their commercial interests with little opportunity for redress outside the objection processes under the *Plant Breeder's Rights Act 1994* (Cth),³⁴⁵ the same standards may not be desirable. How the *Plant Breeder's Rights Act 1994* (Cth) provision is applied is uncertain, and there are not the broader approaches apparent for the same issue under the *Trade Marks Act 1995* (Cth) including the additional standards of substantially identical or deceptively similar.³⁴⁶ So, how might the *Plant Breeder's Rights Act 1994* (Cth) threshold of 'be likely to deceive or cause confusion'³⁴⁷ be applied taking account of the similar standard in the *Trade Marks Act 1995* (Cth)?

In the *Trade Marks Act 1995* (Cth) the threshold of 'be likely to deceive or cause confusion' is a relevant consideration on trade mark examination,³⁴⁸ as a ground of opposition³⁴⁹ and as a (limited) ground of revocation.³⁵⁰ On examination it is that the 'connotation ... would be likely to deceive or cause confusion'³⁵¹ that requires a consideration of all surrounding circumstances 'including the circumstances in which the marks will be used, the circumstances in which the services will be provided, and the character of the probable users of the services'.³⁵² The appropriate methodology in making this determination was addressed in *Primary Health Care Limited v Commonwealth of Australia* where the Full Federal Court first considered whether the application satisfied the threshold that the mark distinguish the applicants goods or services from others ('denotation').³⁵³ After that the application can be

³⁴⁰ *Trade Marks Act 1995* (Cth) s. 43.

³⁴¹ *Trade Marks Act 1995* (Cth) s. 44.

³⁴² *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(a).

³⁴³ See *In re Delta & Pine Land Co.*, 26 U.S.P.Q.2d 1157, 1157 (T.T.A.B. 1993).

³⁴⁴ See *In re Delta & Pine Land Co.*, 26 U.S.P.Q.2d 1157, 1157 (T.T.A.B. 1993).

³⁴⁵ *Plant Breeder's Rights Act 1994* (Cth) s. 35(1).

³⁴⁶ *Trade Marks Act 1995* (Cth) s. 44(1).

³⁴⁷ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(a).

³⁴⁸ *Trade Marks Act 1995* (Cth) s. 43.

³⁴⁹ *Trade Marks Act 1995* (Cth) s. 57.

³⁵⁰ *Trade Marks Act 1995* (Cth) s. 84A(1). Although this is a limited ground because a mere difference of opinion is not sufficient: see, for example, *Aleem Pty Ltd atf The Mini-Tankers IP Trust* (2015) 112 IPR 97, [21]-[26] (Claudia Murray).

³⁵¹ *Trade Marks Act 1995* (Cth) s. 43.

³⁵² *Southern Cross Refrigerating Co v Toowoomba Foundry Pty Ltd* (1954) 91 CLR 592, 595 (Kitto J).

³⁵³ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [10] (Greenwood J), [94]-[95] and [106] (Katzmann J) and [394]-[395] (Rangiah J). See also *Trade Marks Act 1995* (Cth) ss. 17 and 41(1).

rejected if there is some (different) ‘connotation’³⁵⁴ that ‘in relation to the designated goods or services would be likely to deceive or cause confusion’.³⁵⁵ The questions then are, first, whether there is some ‘connotation’, and secondly, whether that ‘would be likely to deceive or cause confusion’?³⁵⁶ In this case, the appeal failed because the Full Federal Court accepted the trial judge’s determination that the word mark ‘Primary Health Care’ and the logo device ‘PRIMARY’ in conjunction with ‘Health Care Limited’ was ‘not capable of distinguishing ... the services’ and this resolved the matter.³⁵⁷ While not decisive, there were differing views about the next steps in properly determining the connotation.³⁵⁸ The Full Federal Court identified the ‘connotation’ as ‘a secondary meaning implied by the mark’,³⁵⁹ and then further detailed as a meaning ‘beyond its *only role* as a badge of origin of the applicant as the source or origin of the identified goods or services’ (emphasis in original),³⁶⁰ ‘whether the mark the subject of the application (or a sign contained in the mark) connotes something other than a connection in the course of trade between the relevant goods or services and the person who applied (or intended to apply) it to those goods or services’³⁶¹ and ‘an implied or secondary meaning that is *inherent* in the trade mark’ (emphasis in original),³⁶² but this ‘must be found within the mark itself’.³⁶³ Justice Greenwood then ‘add some observations’ about the application of the ‘connotation’ standard.³⁶⁴ He considered the word mark and the logo device did not denote a distinct service from a like service of others but did have a ‘clear connotation’ as the ‘first level or first contact health care’ in a health system where ‘*first level* health care, being the health care received as a result of the *first contact* between an individual and a health care system’ (emphasis in original).³⁶⁵ On the facts in this case for Justice Greenwood, the connotation would have been likely to deceive or cause confusion because its use conveyed a false impression that the applicant delivered clinical services when they were neither the provider nor responsible for the clinical care of patients.³⁶⁶ Justice Katzmann considered that ‘the denotation is the deployment of the mark to distinguish the designated services of the applicant from those of other traders and its connotation is the provision of first level or first

³⁵⁴ Noting that ‘An exception is that a made-up word may have no primary meaning, but still have a connotation’: *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [394] (Rangiah J).

³⁵⁵ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [12] (Greenwood J), [106] and [111] (Katzmann J) and [394] (Rangiah J). See also *Trade Marks Act 1995* (Cth) s. 43.

³⁵⁶ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [14], [18] and [30] (Greenwood J), [103] (Katzmann J) and [399] (Rangiah J).

³⁵⁷ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [2] (Greenwood J), [78] (Katzmann J) and [437] (Rangiah J). See also *Trade Marks Act 1995* (Cth) s. 41(1) noting that at the time of the trial and before *Intellectual Property Laws Amendment (Raising the Bar) Act 2012* (Cth) s. 3 and sch. 6 (item 113) amendment this was *Trade Marks Act 1995* (Cth) s. 41(2). See also *Primary Health Care Limited v Commonwealth of Australia* (2016) 117 IPR 73, [7] (Jagot J).

³⁵⁸ See *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [3] (Greenwood J), [78] (Katzmann J) and [404] (Rangiah J).

³⁵⁹ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [17] (Greenwood J), [103] (Katzmann J) and [398] (Rangiah J) citing *Pfizer Products v Karam* (2006) 70 IPR 599, [53] (Gyles J).

³⁶⁰ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [23] (Greenwood J).

³⁶¹ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [113] (Katzmann J).

³⁶² *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [396] (Rangiah J).

³⁶³ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [401] (Rangiah J).

³⁶⁴ See *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [3] and [6]-[56] (Greenwood J).

³⁶⁵ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [16] (Greenwood J) (and [105] (Katzmann J)).

³⁶⁶ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [54] (Greenwood J).

contact health care'.³⁶⁷ And, unlike the others, Justice Rangiah considered that the trial judge had made an error because the connotation identified was in fact its denotation.³⁶⁸ More importantly, however, is the purpose of this ground of rejection:

the underlying purpose ... is to prevent the public being deceived or confused as to the nature of the goods offered by reason of a secondary meaning connoted by the mark in question, rather than, for example, deception by reason of similarity with other marks.³⁶⁹

Applying this to the *Plant Breeder's Rights Act 1994* (Cth) that a plant variety name must not 'be likely to deceive or cause confusion',³⁷⁰ it is apparent that the *Trade Marks Act 1995* (Cth) 'be likely to deceive or cause confusion' is in the context of the 'connotation ... would be likely to deceive or cause confusion'.³⁷¹ The *Trade Marks Act 1995* (Cth) 'connotation' is limited to the secondary meaning connoted by the trade mark in question and not about the similarity with other trade marks, and so the plant variety name would be relevant in assessing a secondary meaning that deceived or caused confusion. Put simply, however, for the *Plant Breeder's Rights Act 1994* (Cth) the name must not 'be likely to deceive or cause confusion'³⁷² and the *Trade Marks Act 1995* (Cth) 'connotation' analysis is not likely relevant because that is about the secondary meaning connoted by a variety name. In this sense the relevant assessment is of 'the likely to deceive or cause confusion', and that is addressed in the meaning of 'deceptively similar' in the context of the *Trade Marks Act 1995* (Cth) standard of 'substantially identical with, or deceptively similar to'.³⁷³ This is addressed next.

The *Trade Marks Act 1995* (Cth) threshold of 'substantially identical with, or deceptively similar to' is to an already registered trade mark of another person or by another application for a similar good.³⁷⁴ This is a relevant consideration on trade mark examination,³⁷⁵ as a ground of opposition³⁷⁶ and as a (limited) ground of revocation.³⁷⁷ For this threshold the term 'deceptively similar' means that the trade mark 'so nearly resembles that other trade mark that it is likely to deceive or cause confusion'.³⁷⁸ The relevant standard for determining 'deceptive similarity' was set out by Justice Windeyer in *Shell Company of Australia Ltd v Esso Standard Oil (Australia) Ltd* in the High Court:

On the question of deceptive similarity a different comparison must be made from that which is necessary when substantial identity is in question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark

³⁶⁷ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [136] (Katzmann J).

³⁶⁸ *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [404] (Rangiah J).

³⁶⁹ *Pfizer Products Inc v Karam* (2006) 70 IPR 599, [53] (Gyles J). See also *Primary Health Care Limited v Commonwealth of Australia* [2017] FCAFC 174, [398] (Rangiah J).

³⁷⁰ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(a).

³⁷¹ *Trade Marks Act 1995* (Cth) s. 43.

³⁷² *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(a).

³⁷³ *Trade Marks Act 1995* (Cth) ss. 44(1)(a) and 44(2)(a).

³⁷⁴ *Trade Marks Act 1995* (Cth) ss. 44(1)(a) and 44(2)(a).

³⁷⁵ *Trade Marks Act 1995* (Cth) s. 44.

³⁷⁶ *Trade Marks Act 1995* (Cth) s. 57.

³⁷⁷ *Trade Marks Act 1995* (Cth) s. 84A(1). Although this is a limited ground because a mere difference of opinion is not sufficient: see, for example, *Aleem Pty Ltd atf The Mini-Tankers IP Trust* (2015) 112 IPR 97, [21]-[26] (Claudia Murray).

³⁷⁸ *Trade Marks Act 1995* (Cth) ss. 6(1) ('deceptively similar') and 10.

that persons of ordinary intelligence and memory would have; and, on the other hand, the impressions that such persons would get from the defendant's [mark].³⁷⁹

The courts have also identified a range of other relevant factors.³⁸⁰ The essence of the inquiry, however, is whether as a question of fact there is a reasonable probability of deception or confusion for a consumer?³⁸¹ As an example, in *PB Foods Ltd v Malanda Dairy Foods Ltd* (1999) the Federal Court decided that the marks 'CHILL' and 'CHOC CHILL' were substantially identical because the essence of the marks was 'CHILL' with the 'CHOC' a descriptor of the milk flavour.³⁸² As a question of fact the reasoning was that 'a prospective purchaser will therefore recognise the word "CHILL" as the badge of origin and will see the word "CHOC" or "COFFEE" ... as nominating nothing more than the flavour of the product'.³⁸³ And as such 'the comparison between "CHILL" and "CHOC CHILL" does lead to a "total impression of similarity"'.³⁸⁴ Another example, in *Deeko Australia Pty Ltd v Décor Corp Pty Ltd* the trade mark 'DEEKO' was sought and opposed by the trade mark owner of 'DÉCOR' on the basis the marks were, in part, 'deceptively similar'.³⁸⁵ The Chief Assistant Registrar concluded that the marks were not deceptively similar because they were different words, with different forms and meanings, and 'that one would have to make some very strained or unlikely assumptions in order to conclude that the two could be pronounced sufficiently similarly so as to be mistaken for each other'.³⁸⁶ Applying this to the *Plant Breeder's Rights Act 1994* (Cth) that a plant variety name must not 'be likely to deceive or cause confusion',³⁸⁷ it is apparent that the *Trade Marks Act 1995* (Cth) 'substantially identical with, or deceptively similar to' is founded in a similar conception of 'likely to deceive or cause confusion'.³⁸⁸ Thus, the application of the *Trade Marks Act 1995* (Cth) 'likely to deceive or cause confusion' is useful in informing the likely scope of the *Plant Breeder's Rights Act 1994* (Cth) 'be likely to deceive or cause confusion'³⁸⁹ and the relevant standard is set out by Justice Windeyer in *Shell Company of Australia Ltd v Esso Standard Oil (Australia) Ltd* in the High Court as the impression a reasonable person would get from the names and whether they are deceptively similar.³⁹⁰

Recommendation 3

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that a plant variety name and synonym must not 'be likely to deceive or cause

³⁷⁹ *Shell Company of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407, 415 (Windeyer J).

³⁸⁰ See, for example, *Combe International Ltd v Dr August Wolff GmbH & Co KG Arzneimittel* (2021) 157 IPR 230, [25]-[33] (McKerracher, Gleeson and Burley JJ).

³⁸¹ See *Australian Woollen Mills Ltd v FS Walton & Co Ltd* (1937) 58 CLR 641, 658 (Dixon and McTiernan JJ).

³⁸² *PB Foods Ltd v Malanda Dairy Foods Ltd* (1999) 47 IPR 47, [31]-[32] (Carr J). See also *Allergan Australia Pty Ltd v Self Care IP Holdings Pty Ltd* (2021) 162 IPR 52 (Jagot, Lee and Thawley JJ), although that decision is subject to appeal to the High Court.

³⁸³ *PB Foods Ltd v Malanda Dairy Foods Ltd* (1999) 47 IPR 47, [38] (Carr J) citing the examiner's decision.

³⁸⁴ *PB Foods Ltd v Malanda Dairy Foods Ltd* (1999) 47 IPR 47, [38] (Carr J) citing the examiner's decision.

³⁸⁵ *Deeko Australia Pty Ltd v Décor Corp Pty Ltd* (1988) 11 IPR 531, 532-533 (S Farquhar).

³⁸⁶ *Deeko Australia Pty Ltd v Décor Corp Pty Ltd* (1988) 11 IPR 531, 534-535 (S Farquhar).

³⁸⁷ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(a).

³⁸⁸ *Trade Marks Act 1995* (Cth) ss. 6(1) ('deceptively similar'), 10, 44(1)(a) and 44(2)(a).

³⁸⁹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(a).

³⁹⁰ See *Shell Company of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407, 415 (Windeyer J).

confusion’ informed by the *Trade Marks Act 1995* (Cth) standard ‘substantially identical with, or deceptively similar to’.

The *Plant Breeder’s Rights Act 1994* (Cth) provides that a plant variety name or synonym must not ‘be contrary to law’.³⁹¹ As an example of what ‘contrary to law’ might entail, in *Advantage Rent-a-Car Inc v Advantage Car Rental Pty Ltd* the Federal Court found that an application for a trade mark under the *Trade Marks Act 1995* (Cth) that included copyright in an artistic work that would be infringed by publication under the *CopyRights Act 1968* (Cth) and this was contrary to law even through this was ‘the expression of opinion upon a hypothesis and does not amount to a finding of any actual breach’.³⁹² Relevantly for the *Plant Breeder’s Rights Act 1994* (Cth), the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws provide that ‘[a] person must not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive’.³⁹³ The expression ‘misleading or deceptive’ is not defined and has been considered extensively in litigation. Essentially, the approach is a two-step analysis: ‘first, to consider whether each alleged representation was conveyed; and secondly, whether such representation as was conveyed was misleading or deceptive or likely to mislead or deceive’.³⁹⁴ And this is a ‘quintessential question of fact’.³⁹⁵ The plain meaning of ‘mislead’ is ‘[t]o lead astray in action or conduct; to lead into error; to cause to err’ and ‘deceive’ is ‘[t]o cause to believe what is false; to mislead as to a matter of fact, to lead into error, to impose upon, delude, take in’.³⁹⁶ Applying this to the *Plant Breeder’s Rights Act 1994* (Cth) that a plant variety name must not ‘be contrary to law’,³⁹⁷ it is apparent that a plant variety name or synonym must not be ‘misleading or deceptive or is likely to mislead or deceive’ under the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws.³⁹⁸

Recommendation 4

IP Australia should update the IP Australia, *Plant Breeder’s Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that a plant variety name and synonym must not be ‘misleading or deceptive or is likely to mislead or deceive’ under the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws.

Recalling the concern that closely related names and synonyms for different plant varieties under the *Plant Breeder’s Rights Act 1994* (Cth) are possible and that they may be desirable for naming thickets for the same PBR holder and problematic for competitors. For example,

³⁹¹ *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(b).

³⁹² *Advantage Rent-a-Car Inc v Advantage Car Rental Pty Ltd* [2001] FCA 683, [22] (Madgwick J). A list of possible contrary laws is set out IP Australia – Trade Marks Manual, above n. 133, [30.3] and Annex 1A.

³⁹³ *Competition and Consumer Act 2010* (Cth) s. 131 and sch. 2 (Australian Consumer Law, cl. 18(1)); and equivalent State and Territory consumer laws.

³⁹⁴ *AFT Pharmaceuticals (AU) Pty Ltd v Reckitt Benckiser (Australia) Pty Ltd* [2021] FCAFC 222, [45] (Nicholas, Markovic and Burley JJ).

³⁹⁵ *Australian Competition and Consumer Commission v Telstra Corp Ltd* [2007] FCA 1904, [15] (Gordon J).

³⁹⁶ *Weitmann v Katies Ltd* (1977) 29 FLR 336, 343 (Franki J). See also *Puxu Pty Ltd v Parkdale Custom Built Furniture Pty Ltd* (1979) 27 ALR 387, 395 (Keeley J).

³⁹⁷ *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(b).

³⁹⁸ *Competition and Consumer Act 2010* (Cth) s. 131 and sch. 2 (Australian Consumer Law, cl. 18(1)); and equivalent State and Territory consumer laws.

the thicket for soybean and cotton variety names including ‘DELTAPINE 50’, ‘DELTAPINE 20’, ‘DELTAPINE 105’ and ‘DELTAPINE 506’ for the same varieties.³⁹⁹ The question then is how to maintain the interests of competitors?

The *Trade Marks Act 1995* (Cth) applies a standard of ‘substantially identical’ or ‘deceptively similar’ as a mandatory ground of rejecting an application in two related circumstances:

1. Where ‘a trade mark registered by another person in respect of similar goods or closely related services’.⁴⁰⁰
2. Where ‘a trade mark whose registration in respect of similar goods or closely related services is being sought by another person’.⁴⁰¹

The standard of ‘deceptively similar’ means a trade mark that ‘so nearly resembles that other trade mark that it is likely to deceive or cause confusion’⁴⁰² (see **§5.2**) and ‘similar goods/services’ means ‘same as the other goods/services’ or ‘of the same description as that of the other goods/services’⁴⁰³ The term ‘substantially identical’ is a comparison of the ‘essential feature of the registered mark’ and ‘a total impression of resemblance or dissimilarity that emerges from the comparison’.⁴⁰⁴ For present purposes, however, these are standards applied to the trade marks of ‘another person’, and that will not be the same person applying for the ‘substantially identical’ or ‘deceptively similar’ trade marks. In other words, the *Trade Marks Act 1995* (Cth) does provide for the same person developing trade mark thickets.

Applying this to the *Plant Breeder’s Rights Act 1994* (Cth), the limits on a plant variety name are that the name must not ‘be likely to deceive or cause confusion, including confusion with the name of another plant variety of the same plant class’.⁴⁰⁵ The apparent lacuna is in allowing the *same* person to register a name or synonym that is ‘substantially identical’ or ‘deceptively similar’ to an existing name where that might be commercially desirable – the example being ‘DELTAPINE 50’, ‘DELTAPINE 20’, ‘DELTAPINE 105’ and ‘DELTAPINE 506’ for the same varieties.⁴⁰⁶ As presently drafted, the *Plant Breeder’s Rights Act 1994* (Cth) does not appear to allow this. Therefore, IP Australia might consider whether a standard similar to the *Trade Marks Act 1995* (Cth) ‘substantially identical’ or ‘deceptively similar’ of ‘another person’ as a ground of rejecting PBR applications should be adopted so that only those names or synonyms of others are rejected, and the same person can develop their naming thickets. This appears to be a current practice and has been accepted by UPOV according to the names recorded in their respective naming databases. This might be acceptable within the current *Plant Breeder’s Rights Act 1994* (Cth) scheme where it is about deception and confusion, including confusion about the plants in the same class.⁴⁰⁷ The ‘DELTAPINE ##’ series

³⁹⁹ *In re Delta & Pine Land Co.*, 26 U.S.P.Q.2d 1157 (T.T.A.B. 1993).

⁴⁰⁰ *Trade Marks Act 1995* (Cth) ss. 44(1)(a)(i) (‘goods’) and 44(2)(a)(i) (‘services’).

⁴⁰¹ *Trade Marks Act 1995* (Cth) ss. 44(1)(a)(ii) (‘goods’) and 44(2)(a)(ii) (‘services’).

⁴⁰² *Trade Marks Act 1995* (Cth) s. 10 (‘deceptively similar’).

⁴⁰³ *Trade Marks Act 1995* (Cth) ss. 14(1) and (2).

⁴⁰⁴ *Shell Co of Australia Ltd v Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407, 415 (Windeyer J).

⁴⁰⁵ *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(a).

⁴⁰⁶ *In re Delta & Pine Land Co.*, 26 U.S.P.Q.2d 1157 (T.T.A.B. 1993).

⁴⁰⁷ *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(a).

illustrates. The same owner of an application of a grant of the 'DELTAPINE' series is unlikely to be deceptive or cause confusion as the 'DELTAPINE' reveals the same, as opposed to different owner, and the number in addition to the common series identifier, 'DELTAPINE 50', 'DELTAPINE 20', and so on, uniquely identifies the variety from other varieties and avoids confusion about the varieties in the same plant class.

Recommendation 5

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that plant varieties with the same owner can be a naming thicket with similar but distinct names so as not to deceive or cause confusion.

Problem: The policy problem is uncertainty about the naming thresholds in the *Plant Breeder's Rights Act 1994* (Cth) of 'likely to deceive or cause confusion' and 'contrary to law' and whether the related provisions in the *Trade Marks Act 1995* (Cth) and the *Competition and Consumer Act 2010* (Cth) should inform the *Plant Breeder's Rights Act 1994* (Cth)?

Preferred solution: The preferred solution is for IP Australia to update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines informed by related provisions in the *Trade Marks Act 1995* (Cth) and the *Competition and Consumer Act 2010* (Cth), including clarifying the practice of naming thickets. While amendments to the *Plant Breeder's Rights Act 1994* (Cth) are possible, this is not considered necessary as practical, example-based guidelines are a simpler solution with the insights from the existing *Trade Marks Act 1995* (Cth) court rulings. Amendments might be preferred by the Australian Government in the longer term.

Benefits: The benefits are likely to be better informed applicants addressing relevant considerations for examiners and examiners better able to make good decisions about appropriate plant names for the purposes of the *Plant Breeder's Rights Act 1994* (Cth).

Costs: The costs are likely to be the hidden costs of determining and navigating complex and uncertain legal thresholds and standards. Clarifying the legal thresholds and standards should avoid some of that complexity and uncertainty with PBR owners clearer about those legal thresholds and standards and avoiding contestation at examination and afterwards.

5.3 Plant variety names or synonyms that 'be or include' a trade mark

The *Plant Breeder's Rights Act 1994* (Cth) provides that a plant variety name or synonym must not 'be or include' a registered trade mark or current application for a trade mark under the *Trade Marks Act 1995* (Cth) 'in respect of live plants, plant cells and plant tissues'.⁴⁰⁸ The further limitations under the *Plant Breeder's Rights Act 1994* (Cth) are that a plant variety name or synonym must be 'a word or words (whether invented or not) with or without the addition of either or both' of 'a letter or letters that do not constitute a word' and/or 'a figure or figures'⁴⁰⁹ and 'comply with the International Code of Botanical Nomenclature and

⁴⁰⁸ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(e).

⁴⁰⁹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(4).

subsidiary codes'.⁴¹⁰ This is operationalised at the time of assessing a PBR application⁴¹¹ and can be a ground for opposition⁴¹² or revocation.⁴¹³

At examination, the PBR examiner, as a delegate of the Registrar of Plant Breeder's Rights,⁴¹⁴ is required to search the trade mark register and reject the application if the proposed name or synonym is either a trade mark or includes a trade mark recorded in the trade mark register (the Australian Trade Mark Search,⁴¹⁵ formerly the ATMOSS database: see Attachment 4). As a consequence of the *Trade Marks Act 1995* (Cth) limiting trade marks to particular classes, plant variety names of 'live plants, plant cells and plant tissues'⁴¹⁶ will only appear in Class 31:⁴¹⁷ 'Agricultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables; natural plants and flowers; live animals; foodstuffs for animals; malt'.⁴¹⁸ Thus, invalid plant variety names or synonyms under the *Plant Breeder's Rights Act 1994* (Cth) will only be those words that appear listed on the trade mark register within the Class 31 for live plant materials. Once a word or words have been identified, the issue for the PBR examiner is to assess how different does a name have to be to be a valid plant variety name or synonym? This is a complicated problem and has been addressed, at least in part, through practice guidelines.

Before addressing the practice guidelines, a strict interpretation of the *Plant Breeder's Rights Act 1994* (Cth) 'be or include'⁴¹⁹ is that this addresses a narrow class of trade marks. For the trade mark to be relevant it must be a word, and that word must either *be* the trade mark or *include* the trade mark. Therefore, trade marks that are more than the proposed plant variety name or synonym, such as comprising additional letters and figures, composites (see **§5.4**), and so on, will not be captured by this interpretation. For example, the trade mark 'SUNRISE' would be relevant for assessing the proposed plant variety name *Prunus salicina* 'Autumn Sunrise' because the plant variety name *includes* the trade mark, while the trade mark 'SUNRISE 118' will not because it is neither the plant variety name nor included in the plant variety name.

The practice guidelines provide that the plant variety name or synonym must be distinguishable from the trade mark with illustrative examples (see Table 2). Essentially, there needs to be an observable difference between the presentation of the words, whether words, letters, spaces, hyphens, order, phonetics, and so on. While this is helpful, there will always be borderline cases. For example, the practice guidelines provide that 'SunriseARG' is an acceptable plant variety name or synonym where 'SUNRISE' appears as a live plant material on the the trade mark register. This might, however, also be characterised as an identifiable whole word in the plant variety name or synonym and considered not acceptable because it *includes* the trade mark. The practice guidelines do not, therefore, appear to comply with a

⁴¹⁰ *Plant Breeder's Rights Act 1994* (Cth) s. 27(6).

⁴¹¹ *Plant Breeder's Rights Act 1994* (Cth) ss. 26(2)(f) and 30(2)(b).

⁴¹² *Plant Breeder's Rights Act 1994* (Cth) s. 35(1).

⁴¹³ *Plant Breeder's Rights Act 1994* (Cth) s. 50(1).

⁴¹⁴ *Plant Breeder's Rights Act 1994* (Cth) s. 59(3).

⁴¹⁵ See IP Australia – Trade Mark Search, above n. 111.

⁴¹⁶ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(e).

⁴¹⁷ *Trade Marks Act 1995* (Cth) s. 19(3); *Trade Marks Regulations 1995* (Cth) reg. 3.1 and sch. 1.

⁴¹⁸ *Trade Marks Regulations 1995* (Cth) sch. 1 (Class 31).

⁴¹⁹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(e).

strict interpretation of the *Plant Breeder’s Rights Act 1994* (Cth) ‘be or include’ standard, although whether ‘SunriseARG’ includes ‘SUNRISE’ is a matter of judgement and open to reasonably held different views.

Table 2: Summary of IP Australia practice notes about the distinctions between acceptable and not acceptable plant variety names or synonyms and trade marks.

Accepted trade mark	Proposed plant variety name or synonym	
	Acceptable	Not acceptable
SUNRISE	Purple-Sunrise	
	PurpleSunrise	
	SunriseARG	
	Risesun	
		Sun-rise
		Sun rise
		Purple Sunrise
		Sunrises
	SUN RISE	Sunrise
	SUNRISE’S	Sunrises’
SAVVI	Savvy	

Finding a bright line distinction between a plant variety name or synonym and a trade mark is uncertain given the diversity of potential forms and presentations of plant variety names or synonyms⁴²⁰ and trade marks.⁴²¹ The resolution is, therefore, likely through PBR examiners applying clear processes (such as those detailed in the Variety Denomination Assessment: Attachment 4) with clear criteria, and then detailing their possible objections and hearing the applicant’s perspectives. An important tool in making this assessment will be the current *Plant Breeder’s Rights Act 1994* (Cth) related requirements that a name and synonym must not ‘be likely to deceive or cause confusion’⁴²² or ‘contrary to law’ (hence mislead or deceive)⁴²³ (see §§5.2 and 5.5) because the ‘be or include’⁴²⁴ standard only addresses a narrow class of trade marks.

Recommendation 6

IP Australia should update the IP Australia, *Plant Breeder’s Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines about the forms of trade marks that are likely to either co-exist or conflict with plant variety names or synonyms under the *Plant Breeder’s Rights Act 1994* (Cth).

Problem: The problem is how to apply the *Plant Breeder’s Rights Act 1994* (Cth) standard that a plant variety name or synonym must not ‘be or include’ a registered trade mark or current application for a trade mark under the *Trade Marks Act 1995* (Cth)?

Preferred solution: The preferred solution is for IP Australia to update the IP Australia, *Plant Breeder’s Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include

⁴²⁰ See *Plant Breeder’s Rights Act 1994* (Cth) s. 27(4).

⁴²¹ See *Trade Marks Act 1995* (Cth) ss. 6(1) (‘sign’) and 17.

⁴²² *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(a).

⁴²³ *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(b). See also *Competition and Consumer Act 2010* (Cth) s. 131 and sch. 2 (Australian Consumer Law, cl. 18(1)); and equivalent State and Territory consumer laws.

⁴²⁴ *Plant Breeder’s Rights Act 1994* (Cth) s. 27(5)(e).

practical, example-based guidelines like the current practice guidelines. While amendments to the *Plant Breeder's Rights Act 1994* (Cth) are possible, this is not considered necessary as practical, example-based guidelines are a simpler solution of more assistance to PBR applicants and stakeholders. Amendments might be preferred by the Australian Government in the longer term.

Benefits: The benefits are likely to be better informed applicants addressing relevant considerations for examiners and examiners better able to make good decisions about appropriate plant names for the purposes of the *Plant Breeder's Rights Act 1994* (Cth).

Costs: The costs are likely to be the hidden costs of determining and navigating complex and uncertain legal thresholds and standards. Clarifying the legal thresholds and standards should avoid some of that complexity and uncertainty with PBR owners clearer about those legal thresholds and standards and avoiding contestation at examination and afterwards.

5.4 The problem of composite trade marks

A possible problem arises where a trade mark includes in combination of words with any devices, shapes, sounds, scents and/or colour elements as a composite trade mark. For such a composite to be registered the trade mark must be 'capable of distinguishing the applicant's goods or services'.⁴²⁵ For example, in *Blount Inc v Registrar of Trade Marks* the application was for a trade mark for the word the 'OREGON' plus an oval device around that word for use in the business of power tool accessories, and particularly accessories for chainsaws.⁴²⁶ The application had been rejected because of the geographic significance of the word 'OREGON' did not distinguish the applicant's goods or services, the delegate concluding:

The delegate went on to note that Oregon is a state on the Pacific coast, north of California, in the United States of America. She further noted that forest-products manufacturing, such as lumber, plywood and hardboard, pulp and paper, ranks as the State of Oregon's leading industry, and that instrument making is one of its main industries. The delegate concluded that in such circumstances, it is highly likely that the word 'Oregon' would be required by other manufacturers of goods of a similar kind to those of the applicant so as to indicate the origin of those goods. She consequently concluded that applicant's trade mark was not capable of distinguishing the goods in respect of which the applicant sought its registration.⁴²⁷

On appeal, Justice Branson reasoned that the word 'OREGON' within the oval device was not capable of distinguishing the applicant's goods because of the word 'OREGON':

I must conclude that the particular manner in which the applicant's trade mark presents the word 'Oregon' does not give it inherent adaptability to distinguish the designated goods, the word 'Oregon' alone lacking such inherent adaptability ... These aspects of the trade mark, whether viewed singly or together, are not, in my view, sufficiently distinctive to give the trade mark a significance other than its ordinary geographic significance or its significance in respect of a particular kind of timber.⁴²⁸

The result, however, was that the trade mark was found to be inherently adapted to distinguish the designated goods from the goods of another person because of other evidence

⁴²⁵ *Trade Marks Act 1995* (Cth) s. 41(1).

⁴²⁶ *Blount Inc v Registrar of Trade Marks* (1998) 40 IPR 498, 499 (Branson J).

⁴²⁷ *Blount Inc v Registrar of Trade Marks* (1998) 40 IPR 498, 502 (Branson J).

⁴²⁸ *Blount Inc v Registrar of Trade Marks* (1998) 40 IPR 498, 507 (Branson J).

about the promotion and use of the trade mark before the filing date.⁴²⁹ Without that evidence of promotion and use the composite mark would have been refused.⁴³⁰ The important point for this analysis is that the composite trade mark with the word 'OREGON' plus an oval device around that word was deconstructed to consider the effect of the word 'OREGON' by itself.

Similarly, in *Bayer Pharma Pty Ltd v Farbenfabriken Bayer Aktiengesellschaft* the trade mark was a composite of the word 'BAYER' printed in capital letters horizontally and vertically intersecting at the 'Y' and enclosed within a circle.⁴³¹ On appeal against the Deputy Registrar of Trade's rejection of the applications for the same mark by similarly named companies under different classes, one medicine and the other agricultural, Justice Kitto found the marks were not distinctive because the composite was merely 'a fancy method of presenting the name "Bayer", and it has no greater aptitude than has the name itself for distinguishing the proprietor's goods from those of other people who happen to be known as "BAYER"'.⁴³² Significantly, the word was 'the feature which stands out as the operative thing in it, and to which everything else is merely assistant',⁴³³ and as such, the word 'BAYER' did not inherently distinguish the goods of the applicants.⁴³⁴ On appeal to the Full High Court, Justices Taylor and Owen expressly agreed with Justice Kitto and no other justices contradicted that approach.⁴³⁵ Again, the composite trade mark was deconstructed to consider the effect of the word 'BAYER' by itself.

The problem arises for the *Plant Breeder's Rights Act 1994* (Cth) when the plant variety name and synonym are a part of the composite trade mark, and then how to apply the *Plant Breeder's Rights Act 1994* (Cth) provision that a name or synonym not 'be or include a trade mark ... in respect of live plants, plant cells and plant tissues'.⁴³⁶ The trade mark cases show that words can be considered in isolation from the other parts of the composite trade mark. The *Plant Breeder's Rights Act 1994* (Cth) provision, however, will apply differently. The *Plant Breeder's Rights Act 1994* (Cth) provision is about whether the proposed plant variety name and synonym is itself a trade mark (hence 'be'), or the trade mark is included within the proposed plant variety name and synonym (hence 'include'). Interpreted this way, a composite trade mark that includes a word will never be relevant under the *Plant Breeder's Rights Act 1994* (Cth) because the proposed plant variety name and synonym must comply with the International Code of Botanical Nomenclature and subsidiary codes⁴³⁷ that requires cultivar, Group, or grex names to be transliterated or translated into Roman script.⁴³⁸ As such, the plant variety name and synonym will never 'be or include'⁴³⁹ the combination of words with any devices, shapes, sounds, scents and/or colour elements, because it can only be 'a

⁴²⁹ *Blount Inc v Registrar of Trade Marks* (1998) 40 IPR 498, 509-510 (Branson J).

⁴³⁰ See *Blount Inc v Registrar of Trade Marks* (1998) 40 IPR 498, 507 (Branson J).

⁴³¹ *Bayer Pharma Pty Ltd v Farbenfabriken Bayer Aktiengesellschaft* (1965) 120 CLR 285, 285 (Kitto J).

⁴³² *Bayer Pharma Pty Ltd v Farbenfabriken Bayer Aktiengesellschaft* (1965) 120 CLR 285, 293 (Kitto J).

⁴³³ *Bayer Pharma Pty Ltd v Farbenfabriken Bayer Aktiengesellschaft* (1965) 120 CLR 285, 293 (Kitto J).

⁴³⁴ *Bayer Pharma Pty Ltd v Farbenfabriken Bayer Aktiengesellschaft* (1965) 120 CLR 285, 315 (Kitto J).

⁴³⁵ See *Bayer Pharma Pty Ltd v Farbenfabriken Bayer Aktiengesellschaft* (1965) 120 CLR 285 (Barwick CJ, Taylor, Menzies, Windeyer and Owen JJ).

⁴³⁶ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(e).

⁴³⁷ *Plant Breeder's Rights Act 1994* (Cth) s. 27(6).

⁴³⁸ Shenzhen Plant Code, Recommendation 27F.1.

⁴³⁹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(e).

word or words (whether invented or not) with or without the addition of either or both' of 'a letter or letters that do not constitute a word' and/or 'a figure or figures'⁴⁴⁰ and 'comply with the International Code of Botanical Nomenclature and subsidiary codes'.⁴⁴¹

The remaining problem, and this is not addressed by the *Plant Breeder's Rights Act 1994* (Cth), is the alternative where the proposed plant variety name and synonym is included within a composite trade mark? This is addressed above in the current requirement under the *Plant Breeder's Rights Act 1994* (Cth) that a name and synonym must not 'be likely to deceive or cause confusion'⁴⁴² (see §5.2).

Recommendation 7

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) and other materials to clarify the treatment of words in composite trade marks as they apply plant variety names or synonyms under the *Plant Breeder's Rights Act 1994* (Cth).

Problem: The problem is how should the *Plant Breeder's Rights Act 1994* (Cth) deal with a plant variety name and synonym that is a part of a composite trade mark? This is a potential avenue for a plant name to be trade marked as a name as part of a composite trade mark.

Preferred solution: The preferred solution is for IP Australia to update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that make it clear that a plant name as part of a composite trade mark will be unacceptable under the *Plant Breeder's Rights Act 1994* (Cth) because it will 'be likely to deceive or cause confusion'.

Benefits: The benefits are likely to be better informed applicants addressing relevant considerations for examiners and examiners better able to make good decisions about appropriate plant names for the purposes of the *Plant Breeder's Rights Act 1994* (Cth).

Costs: The costs are likely to be the hidden costs of determining and navigating complex and uncertain legal thresholds and standards. Clarifying the legal thresholds and standards should avoid some of that complexity and uncertainty with PBR owners clearer about those legal thresholds and standards and avoiding contestation at examination and afterwards.

5.5 Misleading names and synonyms

UPOV 1991 provides, in part, that a variety denomination 'must not be liable to mislead ... concerning the characteristics, value or identity of the variety or the identity of the breeder'.⁴⁴³ The concern is that the current *Plant Breeder's Rights Act 1994* (Cth) does not obviously include this UPOV requirement. This is not correct. The current *Plant Breeder's Rights Act 1994* (Cth) provides a broad requirement that a valid name or synonym must not 'be contrary to law'.⁴⁴⁴ This will include the *Competition and Consumer Act 2010* (Cth) and

⁴⁴⁰ *Plant Breeder's Rights Act 1994* (Cth) s. 27(4).

⁴⁴¹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(6).

⁴⁴² *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(a).

⁴⁴³ UPOV 1991, Article 20.2.

⁴⁴⁴ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(b).

equivalent State and Territory consumer laws that provide '[a] person must not, in trade or commerce, engage in conduct that is misleading or deceptive or is likely to mislead or deceive'.⁴⁴⁵ The expression 'misleading or deceptive' is not defined and has been considered extensively in litigation. Essentially, the approach is a two-step analysis: 'first, to consider whether each alleged representation was conveyed; and secondly, whether such representation as was conveyed was misleading or deceptive or likely to mislead or deceive'.⁴⁴⁶ And this is a 'quintessential question of fact'.⁴⁴⁷ The plain meaning of 'mislead' is '[t]o lead astray in action or conduct; to lead into error; to cause to err' and 'deceive' is '[t]o cause to believe what is false; to mislead as to a matter of fact, to lead into error, to impose upon, delude, take in'.⁴⁴⁸ Applying this to the *Plant Breeder's Rights Act 1994* (Cth) that a plant variety name must not 'be contrary to law',⁴⁴⁹ it is apparent that a plant variety name or synonym must not be 'misleading or deceptive or is likely to mislead or deceive' under the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws.⁴⁵⁰ Thus, while the current *Plant Breeder's Rights Act 1994* (Cth) requirement that a name or synonym must not 'be contrary to law'⁴⁵¹ does address the UPOV 1991 requirement that variety denomination 'must not be liable to mislead ... concerning the characteristics, value or identity of the variety or the identity of the breeder',⁴⁵² it is not clear that this is a part of the PBR examination assessment (see Attachment 4).

Recommendation 8

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) and other materials to clarify the role of the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer laws as they apply plant variety names or synonyms under the *Plant Breeder's Rights Act 1994* (Cth).

Problem: The problem is that the current *Plant Breeder's Rights Act 1994* (Cth) does not expressly include the UPOV 1991 requirement that a variety denomination 'must not be liable to mislead ... concerning the characteristics, value or identity of the variety or the identity of the breeder'.

Preferred solution: The preferred solution is for IP Australia to update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that make it clear the current *Plant Breeder's Rights Act 1994* (Cth) requires a valid name or synonym not 'be contrary to law' and that this will include the *Competition and Consumer Act 2010* (Cth) and equivalent State and Territory consumer

⁴⁴⁵ *Competition and Consumer Act 2010* (Cth) s. 131 and sch. 2 (Australian Consumer Law, cl. 18(1)); and equivalent State and Territory consumer laws.

⁴⁴⁶ *AFT Pharmaceuticals (AU) Pty Ltd v Reckitt Benckiser (Australia) Pty Ltd* [2021] FCAFC 222, [45] (Nicholas, Markovic and Burley JJ).

⁴⁴⁷ *Australian Competition and Consumer Commission v Telstra Corp Ltd* [2007] FCA 1904, [15] (Gordon J).

⁴⁴⁸ *Weitmann v Katies Ltd* (1977) 29 FLR 336, 343 (Franki J). See also *Puxu Pty Ltd v Parkdale Custom Built Furniture Pty Ltd* (1979) 27 ALR 387, 395 (Keeley J).

⁴⁴⁹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(b).

⁴⁵⁰ *Competition and Consumer Act 2010* (Cth) s. 131 and sch. 2 (Australian Consumer Law, cl. 18(1)); and equivalent State and Territory consumer laws.

⁴⁵¹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(5)(b).

⁴⁵² UPOV 1991, Article 20.2.

laws about ‘misleading or deceptive or is likely to mislead or deceive’. The current *Plant Breeder’s Rights Act 1994* (Cth) does require a plant variety name must not ‘be contrary to law’ and this would address likely misleading or deceptive names and synonyms. As such, an amendment to the *Plant Breeder’s Rights Act 1994* (Cth) is not required, although the Australian Government might prefer this in the longer term to make it very clear that Australia does comply with UPOV 1991.

Benefits: The benefits are likely to be better informed applicants addressing relevant considerations for examiners and examiners better able to make good decisions about appropriate plant names for the purposes of the *Plant Breeder’s Rights Act 1994* (Cth). Further, a clear articulation of the relevant UPOV 1991 standard addresses both UPOV compliance and examination requirements.

Costs: The costs are likely to be the hidden costs of determining and navigating complex and uncertain legal thresholds and standards. Clarifying the legal thresholds and standards should avoid some of that complexity and uncertainty with PBR owners clearer about those legal thresholds and standards and avoiding contestation at examination and afterwards.

5.6 The apparent requirement for a synonym

The concern is that the application form provided by IP Australia seeks a synonym when this is not necessarily a requirement under the *Plant Breeder’s Rights Act 1994* (Cth) (see Attachment 1).⁴⁵³ The *Plant Breeder’s Rights Act 1994* (Cth) *only* requires a synonym when a PBR has been granted in another UPOV jurisdiction using a name that does not satisfy the *Plant Breeder’s Rights Act 1994* (Cth) requirements for a word or words with letters and figures, comply with international naming codes and satisfy various other standards such as not be contrary to law and not include the name of a deceased person.⁴⁵⁴ The consequence is that novice applicants might be compromising their future uses of possible trade mark words as valuable marketing tools by using the words as a PBR synonym rather than as a trade mark under the *Trade Marks Act 1995* (Cth).

The *Plant Breeder’s Rights Act 1994* (Cth) as originally drafted defined ‘synonym’ as:

in relation to the name of a plant variety in which PBR has been granted in another contracting party, means a name, additional to the name of the variety, by which the variety will be known and sold in Australia.⁴⁵⁵

This was amended by the *Plant Breeder’s Rights Amendment Act 2002* (Cth) as a part of enhancing access to the PBR scheme for breeders.⁴⁵⁶ The provision was recast in the amendment to mean ‘in relation to the name of a plant variety’ a name that ‘is included in an application in addition to the name of the variety’ and ‘is a name by which the variety will be known or sold in Australia’.⁴⁵⁷ The purpose of this amendment was to address the problem

⁴⁵³ See *Plant Breeder’s Rights Act 1994* (Cth) s. 27(2)(b).

⁴⁵⁴ *Plant Breeder’s Rights Act 1994* (Cth) ss. 27(2), (4), (5), (6) and (7).

⁴⁵⁵ *Plant Breeder’s Rights Act 1994* (Cth) s. 3(1) (‘synonym’).

⁴⁵⁶ House of Representatives – Hansard (Main Committee), above n. 121, p. 10589; Senate – Hansard, above n. 121, p. 603.

⁴⁵⁷ *Plant Breeder’s Rights Act 1994* (Cth) s. 3(1) (‘synonym’) as amended by *Plant Breeder’s Rights Amendment Act 2002* (Cth) s. 3 and sch. 1 (item 1).

that those varieties first registered in other jurisdictions got the protected synonym in Australia while those varieties first registered in Australia did not automatically get protection for the synonym where registration was not yet granted for the same variety in another UPOV member jurisdiction.⁴⁵⁸ This was considered disadvantageous to Australian breeders because they could not necessarily get international coverage for their synonym.⁴⁵⁹ The consequence of the amendment, however, has been to raise the prominence of synonyms and their consideration in the application form where that prominence might not necessarily be required. Put simply, apparently asking an applicant to nominate a synonym may be causing problems for applicants, particularly those with low knowledge of the PBR system, and who may then be compromising their future uses of possible trade mark words as valuable marketing tools.

A possible solution would be to change the application form so that the parts addressing synonyms are much less prominent and provide explanatory materials about when and where a synonym may be required. UPOV 1991 makes clear that a synonym is only required where a plant variety has already been submitted with a denomination (that can include a synonym) in another Contracting Party,⁴⁶⁰ and in those circumstances, the synonym only has to be accepted (registered) 'unless it considers the denomination unsuitable within its territory' whereupon the Contracting Party 'shall require the breeder to submit another denomination'.⁴⁶¹ This suggests a synonym is only required if there is a prior application/registration in another Contracting Party using a denomination that includes a synonym. And importantly, this makes space for what might have been used as a synonym to be a trade mark for the variety under the *Trade Marks Act 1995* (Cth).

Recommendation 9

IP Australia should amend the application form and other guidance and practice materials and information to make it clear that a synonym is not necessarily required for a successful PBR grant unless a synonym has been granted in another UPOV jurisdiction.

Problem: The problem is that the application form provides for an applicant to nominate a synonym when one is not necessarily required. A synonym is only required if a PBR has been granted in another UPOV jurisdiction that does not comply with the requirements of a name under the *Plant Breeder's Rights Act 1994* (Cth).

Preferred solution: The application form synonym requirement is an artefact of an amendment to address a different synonym problem and so the current treatment of synonyms in the *Plant Breeder's Rights Act 1994* (Cth) should be retained. The preferred solution is for IP Australia to amend the application form to make it clear that a synonym is not necessarily required for a successful PBR grant unless a synonym has been granted in another UPOV jurisdiction. This should be accompanied by other guidance and practice

⁴⁵⁸ See *Plant Breeder's Rights Act 1994* (Cth) s. 27(3A); *Plant Breeder's Rights Amendment Act 2002* (Cth) s. 3 and sch. 1 (item 9).

⁴⁵⁹ Explanatory Memorandum to the *Plant Breeder's Rights Amendment Bill 2002* (Cth) p. 4.

⁴⁶⁰ UPOV 1991, Article 20.5.

⁴⁶¹ UPOV 1991, Article 20.5.

materials and information to make it clear that a synonym is not necessarily required for a successful PBR grant unless a synonym has been granted in another UPOV jurisdiction.

Benefits: The benefits of the current arrangements are that they satisfy the UPOV 1991 requirement to use consistent names where needed and also protect the interests of Australian breeder's using synonyms. The preferred solution will add to these benefits as novice applicants will not be compromising their future uses of possible trade mark words as valuable marketing tools by using the words as a PBR synonym rather than as a trade mark under the *Trade Marks Act 1995* (Cth).

Costs: IP Australia will need to amend the application form and advise the stakeholders about the changes. These are, however, likely to be minimal.

5.7 Codes as Names

A long running debate in UPOV has been about variety denominations in the form of figures rather than names comprising words, letters and figures and combinations such as 'AX350'.⁴⁶² Essentially, UPOV 1972 provided that a variety denomination could not be comprised only of figures rejecting the practices of many breeders who used figures alone as code to identify and distinguish their varieties: denominations 'may not consist solely of figures',⁴⁶³ specifically just numbers like '91150'.⁴⁶⁴ Again at UPOV 1978 the argument was made to allow variety denominations in the form of only figures and this was again rejected although there was recognition of breeding practices: denominations 'may not consist solely of figures except where this is an established practice for designating varieties'.⁴⁶⁵ Then at UPOV 1991 this was repeated agreeing that a variety denominations could include some figures: denominations 'may not consist solely of figures except where this is an established practice for designating varieties'.⁴⁶⁶ The problem remains, however, that there is a practice among some breeders to use variety denominations comprised only of figures and this can create problems for registering variety denominations:

Mr. HOINKES (United States of America) introduced the proposal of his Delegation ... and stated that his Delegation was in favor of the deletion of the second sentence of paragraph (2), which provided that the denomination could not consist solely of figures except where this was an established practice. The problem was that this practice was established in the United States of America; an American breeder who filed an application for protection in another country and was to comply with the spirit of Article 20 – which was that the variety denomination should be the same in all countries – would thus immediately run into a problem in the countries which did not accept variety denominations consisting solely of figures: he would have to change the denomination. The change of denomination was quite often

⁴⁶² See UPOV/EXN/DEN/1, above n. 86, [2.2.1]. See also Sanderson, above n. 53, pp. 153-154.

⁴⁶³ *International Convention for the Protection of New Varieties of Plants* done at Geneva on of 2 December 1961 and revised 10 November 1972, Article 13.2.

⁴⁶⁴ UPOV/EXN/DEN/1, above n. 86, [2.2.1].

⁴⁶⁵ *International Convention for the Protection of New Varieties of Plants* done at Geneva on of 2 December 1961 and revised 10 November 1972 and 23 October 1978 [1989] ATS 2, Article 13.2.

⁴⁶⁶ UPOV 1991, Article 20.2. This has been addressed in some UPOV Members through clearly addressing what are suitable codes. For example, the United Kingdom *Plant Breeders' Rights (Naming and Fees) Regulations 2006* (UK) reg 3B(3) provides: 'If a proposed name is in the form of a code, the Controller must not accept it as suitable, on the ground that it may commonly cause its users difficulties as regards recognition or reproduction, if it: (a) consists of a number or numbers only; (b) consists of a single letter; (c) contains more than ten letters, or letters and numbers; (d) contains more than four alternating groups of a letter or letters and a number or numbers; (e) contains a punctuation mark or other symbol, subscript, superscript or a design'.

artificial since the applicable provision could be satisfied simply by adding a letter before the figures. The fact remained, however, that one would have to change the variety denomination.⁴⁶⁷

The proposal was eventually rejected because it was not supported from any other members.⁴⁶⁸ Australia was a part of this UPOV 1991 Diplomatic Conference and did not support this proposal. If the Australian Government decides to take up this proposal, then the *Plant Breeder's Rights Act 1994* (Cth) will require amendment to include the plant variety name or synonym can consist solely of figures 'where this is an established practice for designating varieties'.⁴⁶⁹ An 'established practice' might be among specialist circles of, for example, inbred lines, or particular plant types and genera or species.⁴⁷⁰ There does not appear, however, to be any need for such an amendment among stakeholders.

Recommendation 10

The Australian Government should retain the current *Plant Breeder's Rights Act 1994* (Cth) requirement that PBR names and synonyms be a word or words, with or without letters or figures but not just figures.

Problem: The problem is that the current *Plant Breeder's Rights Act 1994* (Cth) does not allow names comprised *only* of figures (numbers) when some breeders may prefer such a practice in place.

Preferred solution: There does not appear to be any need for such an amendment among stakeholders and so nothing should be done. Further, where breeders do want to use codes for names (denominations), then codes comprising letters and numbers are acceptable as it is *only* number-only codes that are excluded. IP Australia should monitor developments among stakeholders and the Australian Government might prefer amendments in the longer term where a need is determined.

Benefits: The continuity of the current arrangements are desirable because there is no apparent need for changes and stakeholders do not need incur any costs to engage and implement changes.

Costs: There may be some stakeholders that prefer to use codes consisting of figures only that are not able to do this. This seems unlikely and using a letter with their figures is all that is required. As such, the costs of maintaining the status quo appear minimal.

5.8 Non-Roman characters and transliterations of names and synonyms

The *Plant Breeder's Rights Act 1994* (Cth) provides that a plant variety name and synonym must be 'a word or words (whether invented or not) with or without the addition of either or both' of 'a letter or letters that do not constitute a word' and/or 'a figure or figures'.⁴⁷¹ The examination of an application under the *Plant Breeder's Rights Act 1994* (Cth) includes

⁴⁶⁷ International Union for the Protection of New Varieties of Plants, *Records of the Geneva Diplomatic Conference on the Revision of the International Convention for the Protection of New Varieties of Plants*, UPOV Publication No. 346(E) (UPOV, 1992) [694.1].

⁴⁶⁸ *Ibid.*, [696].

⁴⁶⁹ UPOV 1991, Article 20.2.

⁴⁷⁰ UPOV/EXN/DEN/1, above n. 86, [2.2.2].

⁴⁷¹ *Plant Breeder's Rights Act 1994* (Cth) s. 27(4).

checking details about the proposed name (and synonym) with searches of the UPOV GENIE Database and any additional searches required in the GRIN, APNI and IPNI databases (see Attachment 3), and conducting relevant additional searches of the UPOV, IP Australia and trade mark databases, and stepping out an assessment of all the relevant thresholds for accepting a suitable name or synonym – a variety denomination assessment (see Attachment 4). The concern is that the current *Plant Breeder's Rights Act 1994* (Cth) scheme assumes these names and figures will conform with Roman characters and many of the checks on examination are using databases that only include Roman characters and transliterations of names and synonyms in Roman characters. For example, the Chinese characters 白虎 transliterate in Hanyu Pinyin Fang'an to 'BAIHU' and translate into Australian English as 'WHITE TIGER'.⁴⁷² In the UPOV and IP Australia databases (Pluto database and PBR databases respectively), only the transliterated 'BAIHU' and translated 'WHITE TIGER' will appear for searches. Further, there may be different ways to present (such as 'the 黑体 i.e. Heiti typeface in contrast to the usual 宋体 i.e. Songti typeface') ... Thus Rosa PEACE ('Madame A. Meilland') might be written as 和平月季 ('Madame A. Meilland') or [和平]月季 ('Madame A. Meilland').⁴⁷³

Noting that the *Plant Breeder's Rights Act 1994* (Cth) also provides that '[a] name (including a synonym), in respect of a plant variety must comply with the International Code of Botanical Nomenclature and subsidiary codes'.⁴⁷⁴ The *Cultivated Plant Code* recommends that cultivar, Group, or grex names 'that have been established in non-Roman script should be transliterated or translated into Roman script using one of the standards recommended in the *Cultivated Plant Code*.⁴⁷⁵ Therefore, to ensure the integrity of the plant name and synonym searching, names should be recorded with the International Cultivar Registration Authorities in their original scripts and with any transliterations, transcriptions or translations in Roman script.⁴⁷⁶

Recommendation 11

The Australian Government should seek to harmonise plant variety names and synonyms under the *Plant Breeder's Rights Act 1994* (Cth) to exclude non-Roman characters and retain the practice of requiring original Roman character scripts and any non-Roman characters be accompanied with transliterations, transcriptions or translations into Roman scripts.

Problem: Plant naming under the *Plant Breeder's Rights Act 1994* (Cth) is founded on names in Roman characters, and reliance on transliterations, transcriptions or translations into Roman scripts for names in other characters. So, should the *Plant Breeder's Rights Act 1994* (Cth) accommodate these other characters?

Preferred solution: The preferred solution is to maintain the current practices relying on Roman character scripts and any non-Roman characters be accompanied with transliterations, transcriptions or translations into Roman scripts and monitor developments

⁴⁷² See IP Australia – Trade Marks Manual, above n. 133, [32A.2.6].

⁴⁷³ *Cultivated Plant Code*, Article 17.3 (Example 2).

⁴⁷⁴ *Plant Breeder's Rights Act 1994* (Cth) s. 27(6).

⁴⁷⁵ Shenzhen Plant Code, Recommendation 27F.1.

⁴⁷⁶ Shenzhen Plant Code, Recommendation 27F.2.

at UPOV and other fora. IP Australia should monitor developments among stakeholders and the Australian Government might prefer amendments in the longer term where a need is determined.

Benefits: Continued alignment with Australian and international name databases, such as the UPOV PLUTO database, means that plant variety names have the best chance of being unique and retaining their role as unique identifiers for a particular variety. As such, names in Roman scripts are the most simple to compare using algorithms and interoperability between databases.

Costs: There are undoubtedly costs, both financial and cultural, in limiting plant naming under the *Plant Breeder's Rights Act 1994* (Cth) and UPOV to Roman scripts because those applicants wishing to use names with non-Roman scripts will continue to be unable to do so.

5.9 Formal signage of PBR protected names and synonyms

The *Plant Breeder's Rights Act 1994* (Cth) provides that a PBR is infringed if the name or synonym entered on the Register of Plant Varieties⁴⁷⁷ is used for 'any other plant variety of the same plant class' or 'a plant of any other variety of the same plant class'⁴⁷⁸ being plants in the same genus or belonging to 'a group of closely related genera'.⁴⁷⁹ The effect of this provision is to make the name and synonym protected names. Unlike copyrights (©) or trade marks (™ and ®), PBRs do not have similar universal notices of their protected name status.

The ideal of the copyrights symbol © was as a way of providing notice about a claim to copyright. The *Universal Copyright Convention* (UCC)⁴⁸⁰ provided:

Any Contracting State which, under its domestic law, requires as a condition of copyright, compliance with formalities ... shall regard these requirements as satisfied ... if from the time of the first publication all the copies of the work published with the authority of the author or other copyright proprietor bear the symbol © accompanied by the name of the copyright proprietor and the year of first publication placed in such manner and location as to give reasonable notice of claim of copyright.⁴⁸¹

While Australia has joined the UCC, its relevance has been taken over by the TRIPS Agreement and the requirement to comply with the *Berne Convention for the Protection of Literary and Artistic Works*⁴⁸² that does not require the use of such symbols.⁴⁸³ These symbols for copyrights (©) or trade marks (™ and ®), however, remain useful to put others on notice about an intellectual property claim, help stave off innocent infringement and act as evidence against the defence in alleged infringement proceedings that the defendant didn't know or was not aware of the intellectual property claim (innocent infringement). There are, however, offences and remedies for false, misleading or deceptive representations where these

⁴⁷⁷ *Plant Breeder's Rights Act 1994* (Cth) s. 61(1).

⁴⁷⁸ *Plant Breeder's Rights Act 1994* (Cth) ss. 53(1)(c) and (1A).

⁴⁷⁹ *Plant Breeder's Rights Act 1994* (Cth) s. 3(1).

⁴⁸⁰ [1978] ATS 2 (UCC).

⁴⁸¹ UCC, Article III.1

⁴⁸² [1972] ATS 13.

⁴⁸³ TRIPS Agreement, Article 9.1.

symbols are misused.⁴⁸⁴ For example, the *Trade Marks Act 1995* (Cth) provides that ‘the use in Australia in relation to a trade mark’ involving ‘the word registered’ or ‘any other word or any symbol referring (either expressly or by implication) to registration’, then this is ‘taken to be a representation that the trade mark is registered in Australia in respect of the goods or services in relation to which it is used ...’.⁴⁸⁵

Applying this thinking to the *Plant Breeder’s Rights Act 1994* (Cth), an option may be to make this innocent infringement defence clearer. Currently, use of a plant variety name or synonym is an infringement,⁴⁸⁶ with a defence of innocent infringement that ‘the person was not aware of, and had no reasonable grounds for suspecting, the existence of that right’.⁴⁸⁷ Where the ‘propagating material ... has been sold to a substantial extent before the date of the infringement’ and has been labelled then ‘the person against whom the action for infringement is brought is taken to have been aware of the existence of PBR in the variety, unless the contrary is established’.⁴⁸⁸ It also an offence to represent that a PBR has been granted when it has not.⁴⁸⁹ These provisions will address the uses of the plant variety name or synonym on a label attached to propagating material. The current labelling provisions are not mandatory and IP Australia only provides industry guidelines for use of the symbol ‘(D)’ to ‘be displayed next to the protected varieties’ with directions for use on seed bag packaging, ‘tie-on’ or ‘push-in’ labels and catalogues.⁴⁹⁰ The lacuna is where the name or synonym is used in other contexts such as offering for sale, selling, exporting, and so on,⁴⁹¹ where the plant variety name or synonym is used and there is no associated label. This might arise, for example, in publicity materials where there has been no contact or engagement with the materials made available and it might be difficult to establish that a person is otherwise aware of the existence of the PBR.⁴⁹² And importantly here, the associated label is about the protected status of the PBR’ed plant, and not necessarily the protected plant name.⁴⁹³

This might be addressed by including a provision in the *Plant Breeder’s Rights Act 1994* (Cth) to clarify that a plant variety name or synonym accompanied by some form of symbol protects that name under the *Plant Breeder’s Rights Act 1994* (Cth) and addresses the innocent infringement defence. As an example, the United States the *Trade Marks Act* provides:

a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words ‘Registered in U.S. Patent and Trademark Office’ or ‘Reg. U.S. Pat. & Tm. Off.’ or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no

⁴⁸⁴ See, for example, *Trade Marks Act 1995* (Cth) s. 151; *Competition and Consumer Act 2010* (Cth) s. s. 131 and sch. 2 (Australian Consumer Law, cl. 18(1)) and equivalent State and Territory consumer laws.

⁴⁸⁵ *Trade Marks Act 1995* (Cth) s. 151(5).

⁴⁸⁶ *Plant Breeder’s Rights Act 1994* (Cth) ss. 53(1)(c) and (1A).

⁴⁸⁷ *Plant Breeder’s Rights Act 1994* (Cth) s. 57(1).

⁴⁸⁸ *Plant Breeder’s Rights Act 1994* (Cth) s. 57(2). See also IP Australia, *Industry Guidelines for Labelling* (2022) available at

<https://www.ipaustralia.gov.au/sites/default/files/industry_guidelines_for_labeling.pdf?acsf_files_redirect>.

⁴⁸⁹ *Plant Breeder’s Rights Act 1994* (Cth) s. 75(4).

⁴⁹⁰ IP Australia – Industry Guidelines above n. 488.

⁴⁹¹ See *Plant Breeder’s Rights Act 1994* (Cth) s. 11.

⁴⁹² See *Plant Breeder’s Rights Act 1994* (Cth) s. 57(2).

⁴⁹³ IP Australia – Industry Guidelines above n. 488, p. 2.

damages shall be recovered under the provisions of this chapter unless the defendant had actual notice of the registration.⁴⁹⁴

Recommendation 12

The Australian Government should monitor developments among stakeholders and at UPOV and other fora whether the names and synonyms entered on the Register of Plant Varieties should have some indication of the protected status of the name like copyrights (©) or trade marks (™ and ®).

Problem: The names under the *Plant Breeder's Rights Act 1994* (Cth) are protected and there is presently no way to indicate that protected status unless the 'propagating material' is accompanied by a label. So, should there be some symbol to accompany the protected name to identify its status like copyright and trade marks?

Preferred solution: The preferred solution is to maintain the current practices and retain the ideal that plant names should not be subjected to any proprietary limits. The current *Plant Breeder's Rights Act 1994* (Cth) infringement provision has the effect of avoiding any deception or confusion that might result from a person using the protected name for a different plant variety, as opposed to granting any property interest to the PBR owner in the name *per se*. In contrast, the copyrights (©) or trade marks (™ and ®) symbols are communicating the intellectual property interests of the owners. IP Australia should therefore monitor developments among stakeholders and at UPOV and other fora, and the Australian Government might prefer amendments in the longer term where a need is determined.

Benefits: The continuity of the current arrangements are desirable because there is no apparent need for changes and stakeholders do not need incur any costs to engage and implement changes. Most importantly, not having a symbol like the copyrights (©) or trade marks (™ and ®) symbols for plant variety names means that the variety name does not gain anything like a proprietary interest.

Costs: There are undoubtedly some costs where the protected name is used without association with the PBR'ed materials, and that association would have resulted in someone paying royalties. This seems, however, like a minimal cost.

5.10 Using the PBR protected name in marketing

UPOV 1991 requires that any person offering for sale or marketing a PBR'ed variety 'shall be obliged to use the denomination of that variety, even after the expiration of the breeder's right in that variety'.⁴⁹⁵ Further, a trade mark, trade name or other indication can be associated with the PBR name, although the PBR name must 'nevertheless be easily recognisable'.⁴⁹⁶ The *Plant Breeder's Rights Act 1994* (Cth) does not presently require the use of the protected name whenever a PBR protected variety is sold, offered for sale or marketed. The important distinction here is not that the protected name *must* be used, rather it is if a name is used for the PBR'ed variety then it should be the PBR protected name, including after the PBR ends. The problem manifests itself in marketing arrangements where a PBR'ed

⁴⁹⁴ *Trade Marks Act*, 15 U.S.C. §1111.

⁴⁹⁵ UPOV, Article 20.7.

⁴⁹⁶ UPOV, Article 20.8.

variety is marketed using a name that is not the PBR name, and often it is a trade marked name. This is contrary to the ideal that a plant variety have only one name that can be used without limitation.

To address this apparent problem, other jurisdictions, such as the United Kingdom⁴⁹⁷ and New Zealand⁴⁹⁸ have implemented measures to require the PBR'ed name be used. The United Kingdom *Plant Varieties Act 1997* (UK) illustrates how this matter might be addressed, subject to an innocence defence:⁴⁹⁹

- (1) Where a name is registered under section 18 [Selection and registration of names] above in respect of a variety, a person may not use any other name in selling, offering for sale or otherwise marketing propagating material of the variety.
- (2) Subsection (1) above shall have effect in relation to any variety from the date on which plant breeders' rights in respect of that variety are granted, and shall continue to apply after the period for which the grant of those rights has effect.
- (3) Subsection (1) above shall not preclude the use of any trade mark or trade name (whether registered under the *Trade Marks Act 1994* [(UK)] or not) if —
 - (a) that mark or name and the registered name are juxtaposed, and
 - (b) the registered name is easily recognisable.
- (4) A person who contravenes subsection (1) above shall be liable on summary conviction to a fine not exceeding level 3 on the standard scale [approximately £1,000].
- (5) In any proceedings for an offence under subsection (4) above, it shall be a defence to prove that the accused took all reasonable precautions against committing the offence and had not at the time of the offence any reason to suspect that he was committing an offence.⁵⁰⁰

The *Plant Breeder's Rights Act 1994* (Cth) seeks a delicate compromise between the use of the plant name and synonym with the uses of other commercial marking arrangements including the *Trade Marks Act 1995* (Cth). To ensure a clear demarcation between the PBR'ed name, being one name for a defined variety that can be used without limitation, and other names and marks, such as trade marks under the *Trade Marks Act 1995* (Cth), the *Plant Breeder's Rights Act 1994* (Cth) should require the selling, offering for sale or marketing to include the easily recognisable PBR name together with any associated names and marks. This is important because the trade marks, trade names and other signifiers are not necessarily associated with the particular named plant variety. For example, the trade mark for 'PINK LADY' applies to the fruits, plant material and trees of the genera Citrus, Prunus, Pyrus and Vitis.⁵⁰¹ The United Kingdom *Plant Varieties Act 1997* (UK) provides a suitable model, although it only applies to the 'selling, offering for sale or otherwise marketing' of the 'propagating material' of the PBR'ed variety.⁵⁰² Materials that are harvested from 'propagating material' with the intention of final consumption, such as apples can be sold, offered for sale or marketed without the registered name, although material to be propagated, such as seeds for growing a crop would be required to use the registered name.

⁴⁹⁷ *Plant Varieties Act 1997* (UK) s. 19.

⁴⁹⁸ *Plant Variety Rights Act 1987* (NZ) ss. 22.

⁴⁹⁹ *Plant Varieties Act 1997* (UK) s. 20

⁵⁰⁰ *Plant Varieties Act 1997* (UK) s. 19.

⁵⁰¹ Apple and Pear Australia Limited, above n. 70.

⁵⁰² *Plant Varieties Act 1997* (UK) s. 19(1).

Recommendation 13

The Australian Government should amend the *Plant Breeder's Rights Act 1994* (Cth) to require the use of the PBR protected name whenever a PBR protected variety is sold, offered for sale or marketed with a variety name for the purposes of propagation as opposed to final consumption, and this should not preclude associated names and marks so long as the PBR protected name is easily recognisable.

Problem: The problem is that plant names should be the formal and freely available name and not replaced by trade marked and other protected marketing names. The current *Plant Breeder's Rights Act 1994* (Cth) does not presently require the use of the protected name whenever a PBR protected variety is sold, offered for sale or marketed. So, when a name is being used should the PBR name be disclosed when selling, offering for sale or marketing a PBR'ed variety?

Preferred solution: The preferred solution is that a plant variety should be readily identified by its PBR name where that material is going to be used for propagation as opposed to final consumption, and so where a name is used then it should be the PBR name because plant varieties should have only one name that can be used without limitation. This does not mean that other names must not be used together with the PBR name, only that the PBR protected name is easily recognizable. The United Kingdom *Plant Varieties Act 1997* (UK) provides a suitable model illustrating the limited scope of the requirement and a linked offence and penalty to reinforce that correct plant identification is an important policy objective. The form of the disclosing and labelling is not addressed here.

Benefits: It is critical for efficient and effective markets that plants have consistent names and not have to engage in complicated descriptions – a unique identifier and description of the plant variety. While PBR holders may prefer other names, and especially names protected under the *Trade Marks Act 1995* (Cth), this undermines the integrity of one plant variety one name, and limited to the important policy objective that the correct plant has been identified and selected.

Costs: There are financial costs and practical difficulties associated with requiring PBR protected names being used for propagation. The likely quantum of these costs is not presently apparent, although they are conceivably significant for some sectors and will stabilize over time as the standard practices develop.

5.11 UPOV harmonisation of plant naming

There is variation in naming varieties for PBRs in different jurisdictions with the possibility that a name in one jurisdiction might be rejected in another. To address this, UPOV has considered developing a broader harmonisation process like the *Patent Cooperation Treaty* system to enable the filing of PBR applications in several countries with a single application that will include variety denominations.⁵⁰³ The proposal was, in part, to standardise the

⁵⁰³ See International Union for the Protection of New Varieties of Plants, *Report by the President on the Work of the Eighty-Sixth Session of the Consultative Committee; Adoption of Recommendations, if any, Prepared by that Committee* (2014) C/48/19, [33]-[34]. See also International Union for the Protection of New Varieties of Plants, *Matters raised by the International Seed Federation (ISF)* (2013) CC/86/11.

denomination rules for variety naming through a central approval system.⁵⁰⁴ There was no resolution at UPOV. In the meantime, however, UPOV is developing the PRISMA on-line tool to assist in making plant variety protection applications to participating UPOV members.⁵⁰⁵ Australia is already a part of this program. The effect of PRISMA is likely to be a harmonisation process for naming as the application through PRISMA requires a denomination that will be relevant to the different participating member offices. Similarly, the UPOV PLUTO database for comparing names of granted variety rights, that examiners also consult in Australia (see Attachments 3 and 4), is also a harmonisation process for naming.⁵⁰⁶

Recommendation 14

The Australian Government should continue supporting a harmonization process to enable the filing of PBR applications in several countries with a single application. This will introduce consistent variety naming rules across UPOV members and harmonise naming practices.

Problem: The problem is how to promote the same name and form of name being used in different jurisdictions?

Preferred solution: The preferred solution is for the Australian Government to advocate in relevant forums, like UPOV, for a harmonization process. The current UPOV PRISMA on-line tool is appropriate and Australia should continue as a part of this program.

Benefits: Developing consistent naming practices and the same name for a variety across different jurisdictions is beneficial for plant variety protection worldwide as breeders, marketers and consumers will have a clear unique identifier and description of the plant variety.

Costs: The costs to stakeholders are likely to be minimal as it is the Australian Government that is spending on developing the harmonization tools through UPOV. In the longer term, however, there might be higher costs associated with applications as the actual costs of harmonization flow through the systems.

5.12 Trade names, designations or references and trade marks and plant names

The basic distinction between a trade mark and a trade name (or trade designation or trade reference) is that the former is protected by the *Trade Marks Act 1995* (Cth) while the latter is protected through an action for passing off or unfair competition. A useful distinction is:

The criterion of whether a given brand is a trade mark or trade name is etymological. A trade mark must be fanciful, arbitrary, unique, distinctive, non-descriptive – the synonyms are legion. On hand, words descriptive of qualities or attributes, generic designations, personal, partnership and corporate names, geographical terms, marks common to the trade, and the like are trade names or non-technical marks.⁵⁰⁷

⁵⁰⁴ CC/86/11, *ibid.*, [13].

⁵⁰⁵ See International Union for the Protection of New Varieties of Plants, *UPOV PRISMA* <<https://www.upov.int/upovprisma/en/index.html>>. See also Ben Rivoire, 'Plant Variety Rights in the Digital Age: UPOV PRISMA' [2021] *CIOPORA Chronicle* 64.

⁵⁰⁶ See UPOV/EXN/DEN/1, above n. 86, [2.5.3] (p. 8).

⁵⁰⁷ See Milton Handler and Charles Pickett, 'Trade-Marks and Trade Names – An Analysis and Synthesis: I' (1930) 30 *Columbia Law Review* 168, 169.

The *Cultivated Plant Code* provides that a trade designation is not a name regulated under the *Cultivated Plant Code*, but rather, 'is a device that has been used for marketing a cultivar, Group, or grex in place of or in addition to its accepted or adopted name or names'.⁵⁰⁸ Importantly, this cannot be the synonym⁵⁰⁹ and where cited 'must always be accompanied by their accepted or adopted names'.⁵¹⁰ As an example, the *Cultivated Plant Code* provides that 'a rose named with the cultivar epithet 'Korlanum' and marketed as "rose Surrey", "Rose Sommerwind" and "rose Vent d'Été" in different countries' should be named as trade designations 'rose SURREY ('Korlanum')', 'Rose SOMMERWIND ('Korlanum')' and 'rose VENT D'ÉTÉ ('Korlanum')' respectively.⁵¹¹

The issue for this analysis is that a trade name (or trade designation or trade reference) can appear like a plant name and will often be used in a trade mark application. Such a name may be capable of distinguishing trade sources of a named plant variety and so might also be a valid to distinguish varieties for the purposes of the PBR name. As the facts in *Re SFR Holdings Inc* showed, a trade reference is often considered together with a plant name as the application for a trade mark was for the name 'SEADWARF PASPALUM SDX-1'⁵¹² being a particular plant of the genus *Paspalum*, namely '*Paspalum vaginatum* Swartz'.⁵¹³ The trade mark examiner raised grounds for rejecting the trade mark on the basis that:

SDX-1 is the name of a variety of *Paspalum*, namely *Paspalum vaginatum* Swartz. As such it has been granted PBR rights. You are the owner of those rights and they were granted in December 2008. The term SEADWARF is the commonly used name for this variety of *paspalum*. In other words SEADWARF is, at least, a synonym for the variety in question.⁵¹⁴

The examiner's concern was that using the name 'SEADWARF PASPALUM SDX-1' for plants and plant material that was not 'the variety of *Paspalum* called SDX-1 it would be misleading to buyers of your goods and would cause confusion in the marketplace'.⁵¹⁵ To resolve this the trade mark specification could be limited to 'Natural turf, reinforced turf, turf grasses, turf seedlings, grass seeds; all being plants or plant material of the variety SDX-1 of the genus *Paspalum*'.⁵¹⁶ This did not, however, resolve the remaining issue that the trade mark needed to distinguish the goods of the applicant from the goods of others that might be addressed through information about any use of the trade mark.⁵¹⁷ In review the examiner determined that the name 'SEADWARF PASPALUM SDX-1' was to some extent inherently adapted to distinguish, but 'to no extent inherently adapted to distinguish' because 'the trade mark is a

⁵⁰⁸ Cultivated Plant Code, Article 13.1.

⁵⁰⁹ Cultivated Plant Code, Article 13.2.

⁵¹⁰ Cultivated Plant Code, Article 17.2.

⁵¹¹ Cultivated Plant Code, Article 13.1 (Example 1).

⁵¹² Noting that earlier applications for the word 'SEADWARF' for 'natural turf, reinforced turf, turf grasses, turf seedlings, grass seeds' had been rejected under the *Trade Marks Act 1995* (Cth) ss. 41 and 43 and withdrawn, although a trade mark was registered for 'SEADWARF' for 'non-artificial turf grasses' in the United States: *Re SFR Holdings Inc* (2013) 103 IPR 190, [9]-[10].

⁵¹³ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

⁵¹⁴ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

⁵¹⁵ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

⁵¹⁶ *Re SFR Holdings Inc* (2013) 103 IPR 190, [2] (A. Windsor).

⁵¹⁷ *Re SFR Holdings Inc* (2013) 103 IPR 190, [4] and [6] (A. Windsor). See also *Trade Marks Act 1995* (Cth) s. 41.

simple description of the designated goods'.⁵¹⁸ The trade mark was unused in Australia and therefore there was no evidence to distinguish the goods of the applicant:⁵¹⁹

The primary descriptive meaning of the trade mark is that of a particular kind of Paspalum grass. It has no secondary meaning, and is not capable of developing any secondary meaning. The whole purpose behind the genesis of the trade mark is to identify the grass which the applicant has developed and intends to market in Australia. Given that the trade mark is clearly composed of a registered variety name, the trade name for the same plant (recorded on the PBR register) and the name of the genus of grass in respect of which the two previously mentioned names are to be applied, the combination of words serves a single purpose and that is to define exactly which grass the name refers to. It can have no other purpose. As such, it is a mere description of the relevant goods, it has no inherent adaptation to distinguish those goods.⁵²⁰

The point here is that a trade name (or trade designation or trade reference) can, depending on the evidence, distinguish the goods or services of a trade mark applicant and be a trade mark under the *Trade Marks Act 1995* (Cth). Clearly, however, a trade name (or trade designation or trade reference) must be distinguished from a plant variety name that cannot itself be a trade mark *per se*.

Recommendation 15

IP Australia should update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines about the uses of trade names (or trade designations or trade references) together with plant variety names for the purposes of the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth).

Problem: The problem is that a trade name (or trade designation or trade reference) can appear like a plant name and will often be used in a trade mark application. How can the distinction between a plant variety name for the purposes of the *Plant Breeder's Rights Act 1994* (Cth) be distinguished from an appropriate use of a trade name (or trade designation or trade reference) together with a plant variety name (so, trade name + genus and species name + variety) that distinguishes the trade source for the purposes of the *Trade Marks Act 1995* (Cth)?

Preferred solution: The preferred solution is for IP Australia to update the IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) to include practical, example-based guidelines that make it clear when and how a trade name (or trade designation or trade reference) might be used together with a plant variety name. While there are other stakeholders, such as trade mark examiners applying the *Trade Marks Act 1995* (Cth) that might have different interests, it is important that there be a clear statement from IP Australia to *all* stakeholders about the preferred usages of trade names (or trade designations or trade references). The intention is to inform applicants and PBR examiners (and trade mark examiners and other more removed stakeholders) about the appropriate uses of protected plant variety names. This is particularly important as IP Australia and the

⁵¹⁸ *Re SFR Holdings Inc* (2013) 103 IPR 190, [24] (A. Windsor). See also *Trade Marks Act 1995* (Cth) s. 41(4)(a).

⁵¹⁹ *Re SFR Holdings Inc* (2013) 103 IPR 190, [24] (A. Windsor). See also *Trade Marks Act 1995* (Cth) s. 41(4)(b).

⁵²⁰ *Re SFR Holdings Inc* (2013) 103 IPR 190, [32] (A. Windsor).

PBR examiners are upholding a public interest in plant variety names remaining free to be used to identify a particular variety.

Benefits: The benefits are likely to be better informed applicants addressing relevant considerations for examiners and examiners better able to make good decisions about appropriate plant names for the purposes of the *Plant Breeder's Rights Act 1994* (Cth) and the *Trade Marks Act 1995* (Cth). It is also important that other stakeholder, including trade mark examiners and the other more removed stakeholders, appreciate the policy objective that plant variety names remain free to be used to identify a particular variety.

Costs: The costs are likely to be the hidden costs of determining and navigating complex and uncertain legal thresholds and standards. Clarifying the legal thresholds and standards should avoid some of that complexity and uncertainty with PBR owners clearer about those legal thresholds and standards and avoiding contestation at examination and afterwards. There is also the concern that the *Trade Marks Act 1995* (Cth) is not necessarily addressing the broader concerns of the *Plant Breeder's Right Act 1994* (Cth) and the need to keep plant variety names free to be used to identify a particular variety.

Part 6: Final words

Plant variety names and synonyms under the *Plant Breeder's Rights Act 1994* (Cth) are essential to identifying plant varieties and distinguishing between different plant varieties. The essence of this function is for each plant variety to have a unique name and the current name and synonym provisions do this. There are, however, conflicting purposes for plant variety names and synonyms, the key one being as a trade mark under the *Trade Mark Act 1995* (Cth). To balance these different purposes reflected in these different schemes there is a compromise. How successful this compromise is will always be contested. This report finds the balance is probably appropriate under the current *Plant Breeder's Rights Act 1994* (Cth) with the recommendations being about the application of the existing standards, mostly through better information and education for stakeholders.

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United States

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Attachment 1

IP Australia, *Application for Plant Breeder's Rights, Part I (2021)* p 4 available at <https://www.ipaustralia.gov.au/sites/default/files/pbr00001_1119_0.pdf>.

Section 2 - General information about the variety

4. Botanical name of the variety

5. Common name of the species

Does the species have a common name?

No

Yes Provide details

6. Proposed name for the variety - If an application for this variety has already been lodged overseas then you must propose the same name. Please note that before a name is accepted it must conform with section 27 of the PBR Act. When accepted, the variety name is protected under the PBR Act.

7. Synonym - A synonym is an alternative name for a variety. Please note that once accepted, the synonym is also protected. A synonym must also conform with section 27 of the PBR Act.

No

Yes Provide details

8. Other names - Please list any other names under which the variety has been known in Australia or overseas.

Do other names exist?

No

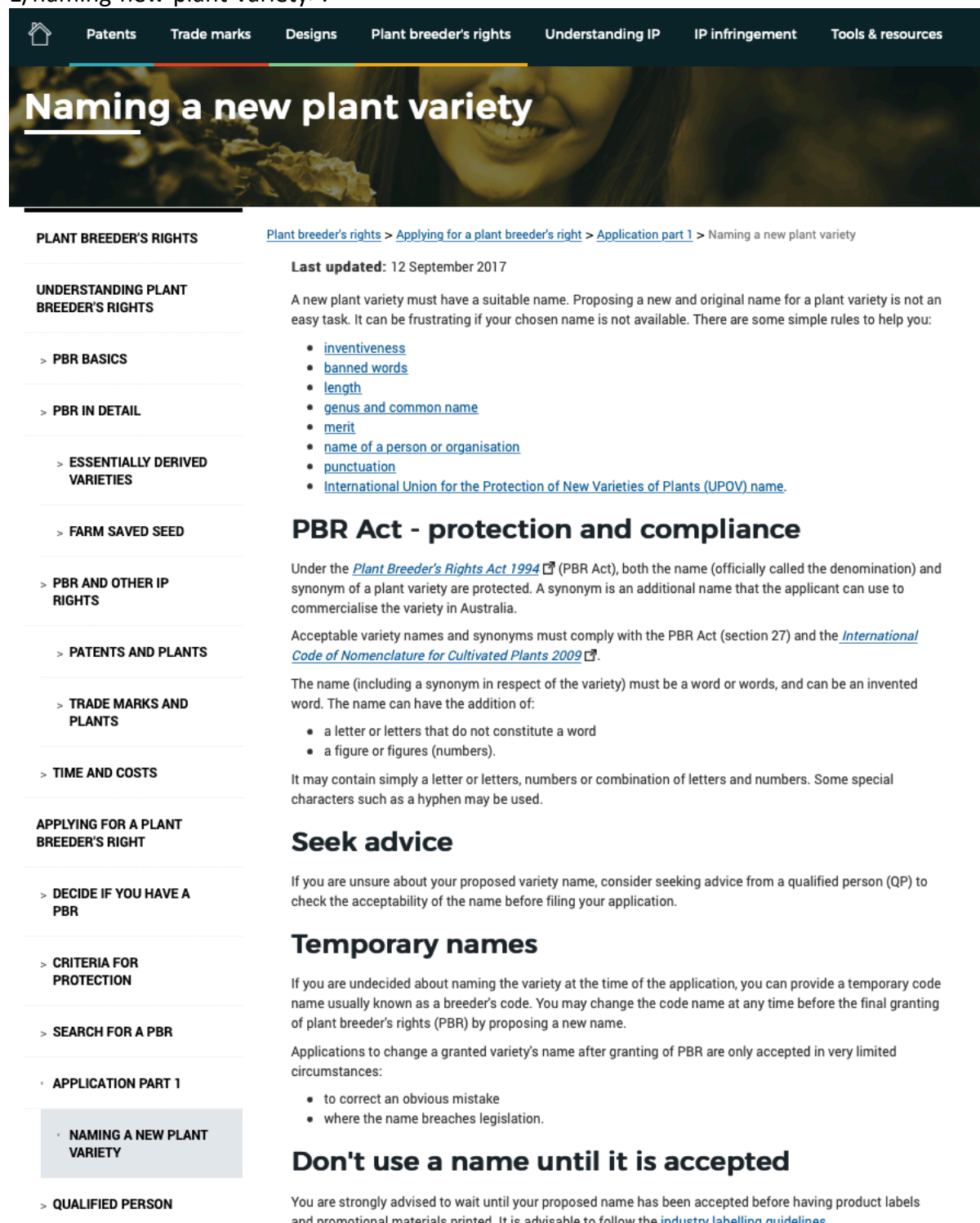
Yes Breeder's code

Trade name

Other name

Attachment 2

IP Australia, *Naming a New Plant Variety* (2017) available at <<https://www.ipaustralia.gov.au/plant-breeders-rights/applying-pbr/application-part-1/naming-new-plant-variety>>.



The screenshot shows the IP Australia website's navigation menu at the top, including links for Patents, Trade marks, Designs, Plant breeder's rights, Understanding IP, IP infringement, and Tools & resources. The main header features the title 'Naming a new plant variety' over a background image of a smiling woman. A breadcrumb trail reads: 'Plant breeder's rights > Applying for a plant breeder's right > Application part 1 > Naming a new plant variety'. The page is divided into two main sections: a left-hand navigation menu and a main content area. The navigation menu lists various topics under 'PLANT BREEDER'S RIGHTS' and 'APPLYING FOR A PLANT BREEDER'S RIGHT', with 'NAMING A NEW PLANT VARIETY' highlighted. The main content area includes a 'Last updated' date of 12 September 2017, a paragraph explaining that naming a new plant variety is not an easy task and provides simple rules to help. A bulleted list of rules includes inventiveness, banned words, length, genus and common name, merit, name of a person or organisation, punctuation, and the UPOV name. A section titled 'PBR Act - protection and compliance' explains that the name and its synonym are protected under the Plant Breeder's Rights Act 1994 and must comply with the International Code of Nomenclature for Cultivated Plants 2009. It details that the name must be a word or words and can be an invented word, with examples of what is not allowed (a letter or letters that do not constitute a word, and a figure or figures). It also notes that special characters like hyphens can be used. A 'Seek advice' section suggests consulting a qualified person (QP) to check the name's acceptability. A 'Temporary names' section explains that a breeder's code can be used as a temporary name, which can be changed before the final granting of PBR. It lists limited circumstances for changing a granted name: to correct an obvious mistake or where the name breaches legislation. Finally, a 'Don't use a name until it is accepted' section advises waiting for acceptance before printing labels and promotional materials, and refers to industry labelling guidelines.

PLANT BREEDER'S RIGHTS

UNDERSTANDING PLANT BREEDER'S RIGHTS

- > PBR BASICS
- > PBR IN DETAIL
 - > ESSENTIALLY DERIVED VARIETIES
 - > FARM SAVED SEED
- > PBR AND OTHER IP RIGHTS
- > PATENTS AND PLANTS
- > TRADE MARKS AND PLANTS
- > TIME AND COSTS

APPLYING FOR A PLANT BREEDER'S RIGHT

- > DECIDE IF YOU HAVE A PBR
- > CRITERIA FOR PROTECTION
- > SEARCH FOR A PBR
- APPLICATION PART 1
 - **NAMING A NEW PLANT VARIETY**
- > QUALIFIED PERSON

[Plant breeder's rights](#) > [Applying for a plant breeder's right](#) > [Application part 1](#) > Naming a new plant variety

Last updated: 12 September 2017

A new plant variety must have a suitable name. Proposing a new and original name for a plant variety is not an easy task. It can be frustrating if your chosen name is not available. There are some simple rules to help you:

- [inventiveness](#)
- [banned words](#)
- [length](#)
- [genus and common name](#)
- [merit](#)
- [name of a person or organisation](#)
- [punctuation](#)
- [International Union for the Protection of New Varieties of Plants \(UPOV\) name](#).

PBR Act - protection and compliance

Under the [Plant Breeder's Rights Act 1994](#) (PBR Act), both the name (officially called the denomination) and synonym of a plant variety are protected. A synonym is an additional name that the applicant can use to commercialise the variety in Australia.

Acceptable variety names and synonyms must comply with the PBR Act (section 27) and the [International Code of Nomenclature for Cultivated Plants 2009](#).

The name (including a synonym in respect of the variety) must be a word or words, and can be an invented word. The name can have the addition of:

- a letter or letters that do not constitute a word
- a figure or figures (numbers).

It may contain simply a letter or letters, numbers or combination of letters and numbers. Some special characters such as a hyphen may be used.

Seek advice

If you are unsure about your proposed variety name, consider seeking advice from a qualified person (QP) to check the acceptability of the name before filing your application.

Temporary names

If you are undecided about naming the variety at the time of the application, you can provide a temporary code name usually known as a breeder's code. You may change the code name at any time before the final granting of plant breeder's rights (PBR) by proposing a new name.

Applications to change a granted variety's name after granting of PBR are only accepted in very limited circumstances:

- to correct an obvious mistake
- where the name breaches legislation.

Don't use a name until it is accepted

You are strongly advised to wait until your proposed name has been accepted before having product labels and promotional materials printed. It is advisable to follow the [industry labelling guidelines](#).

> GROWING TRIAL

> APPLICATION PART 2

> PLANT BREEDER'S
RIGHTS (PBR) FAQs

MANAGING YOUR PBR

> DEALING WITH
OPPOSITIONS

> INTERNATIONAL PBR

Naming rules

Inventiveness

Make sure your proposed name is unique and it can't be confused, either in spelling or pronunciation, with the name of another variety.

Banned words

Certain words (or their equivalents in any language) are banned words and they cannot be used in the name (including their plural forms). These are:

- cross
- hybrid
- grex
- group
- form
- maintenance
- mutant
- seedling
- selection
- sport
- strain
- variety
- improved
- transformed.

Length

The name should not have more than 10 syllables and 30 characters (excluding spaces and single quotation marks).

Genus and common name

If your name is a single word, make sure that the word is not the same as that of a genus, whether in botanical Latin or in a modern language.

Erica, Daphne, Iris and Veronica happen to be Latin names of genera and are not permitted as cultivar names, even though they are personal names as well. Similarly, Rose and Violet are common names of the genera and they too are not permitted.

Such words may be used in a name of two or more words, but not as the final word of the name. So 'Erica Smith', 'Iris Jones' and 'Rose Queen' are acceptable names but 'Queen Rose' is not acceptable.

The variety name should not contain the botanical or common name of its genus or the common name of any species in that genus. So names like 'Rosa Christmas Rose', 'Potato Jim's Spud' and 'Primula White Cowslip' are not acceptable.

Merit

The name should not exaggerate the merits of the cultivar. Names like 'Best Ever', 'The Greatest' and 'Tastiest of All' are not acceptable.

It should not be made up of simple descriptive words only, like 'Red', 'Giant White' or 'Small'.

Name of a person or organisation

When the proposed name is the name of a living person, written consent will be required from that person.

If the name is that of a person who died less than 10 years before the application is filed, written consent will be required from the legal representative of that person.

If the name is the name of a corporation or other organisation, written consent will be required from that organisation.

Punctuation

The only punctuation marks allowed are: apostrophe, comma, hyphen, full-stop and a single exclamation mark.

UPOV name

If an application for plant protection has previously been filed overseas, the name (denomination) used in the first filing in a UPOV member country should be the official registered name in Australia. This aims to have the variety known by the same name worldwide.

An exception can be made if the name:

- is already in common use in Australia within the same denomination class
- is a trade mark in Australia in respect of live plants, plant cells and plant tissues.

If you intend to market the variety under another commercial name (a name that is not the UPOV name) it is useful to consider including that name as the synonym in the Australian application.

More information

- [International Union for the Protection of new Varieties of Plants \(UPOV\)](#) 

Attachment 3

IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) Part 3 at <<https://manuals.ipaustralia.gov.au/pbr/part-3.-acceptance#examiner-assessment-of-application>>.

Examiner assessment of application

To comply with Customer Service Charter requirements, applications must be assessed and a Part 1 Examination – Report No 1 issued within 8 weeks of receipt of the application with IP Australia (not including public holidays or closures).

1. Determine if the applicant is entitled to make the application for PBR. According to the PBR Act 1994 only the breeder or their agent can apply for PBR for a variety. If the applicant is not the breeder then proof of transfer of rights from the breeder to the applicant must be provided in writing to IP Australia.
2. Check the application for the following:
 - if there is **more than one applicant**, 'Supplementary Pages to Part 1 application Form' ([PBR00003](#)) has been submitted for each additional applicant.
 - the **name and address** of the applicant/s and, if required, their agent has been supplied.
 - if the **applicant is from overseas**, check that they have an Australian or New Zealand postal address or an Australian or New Zealand agent. It is a requirement of the PBR Act that applicants must either have a postal address in Australia or New Zealand for the service of notices or have an agent in Australia or New Zealand.
 - the **applicant is the breeder** of the variety and a statement of that effect has been made.
 - if the **applicant is not the breeder** of the variety, confirm that the name and address of the breeder are the same as those on the legal transfer of rights.
3. Check the following details of the variety:
 - the **correct botanical name** (genus and/or species) has been used by searching the [Genie database](#) on the UPOV website. If the botanical name is not available in the [Genie database](#), then additional searches are required in [GRIN](#), [APNI](#) and [IPNI](#) databases.
 - if the plant is a tree or vine. A list of trees can be found on [CAJ/41/4](#). (The notion of trees and vines for the purposes of the provisions on novelty and the duration of protection) in relation to taxa that are to be treated (deemed) as trees. Taxa included in the list but not preceded with an asterisk, need to be assessed on a case by case basis as to whether the variety can be treated as a tree.
 - Australia accepts five genera as vines: Actinidia (Kiwifruit), Bougainvillea, Campsis, Hedera and Vitis (grapevine).
 - if a **common name** of the plant has been provided, check if the correct common name for the taxon has been used by searching the [Genie database](#) on UPOV website.
 - if a **name for the variety** has been proposed check if it is acceptable under the [section 27](#) of the PBR Act 1994. See [Variety Denomination Assessment](#) to determine if the proposed name is acceptable.
 - if a **synonym for the variety** has been proposed and if it is acceptable under the [section 27](#) of the PBR Act 1994. Under the PBR Act a synonym is an additional name of the variety by which the variety will be known and sold in Australia. See [Variety Denomination Assessment](#) to determine if the proposed synonym is acceptable.
 - if the **variety has been known by any other names** (e.g. trade names, breeders references or others) and record them as needed.
 - if the **variety is an Australian native species**. If yes, check if a herbarium specimen has been submitted or will be submitted to the Australian Cultivar Registration Authority (ACRA). It is mandatory to submit a herbarium specimen to ACRA for Australian native species.

- if the species has been **declared a noxious weed** in any Australian State or Territory. If yes, have details been provided.
4. Check if the applicant has made a statement in regards to their obligation to notify the supplier/owner of the original germplasm of the their intention to obtain PBR for the variety
 5. Check if the applicant has made a statement in regards to their obligation to notify their current employer/funding agency, of their intention to acquire PBR for the variety
 6. Check the [UPOV Pluto database](#) to see if an application for PBR in this variety has been lodged in a country other than Australia.
 - if **Australia is not the country of first lodgement**, check if details of previous overseas applications have been provided
 - if a **priority claim** has been made, check if certified copies of the earliest overseas application lodged with a UPOV member state have been provided. If not, they must be provided within 3 three months from the date when the Australian application was lodged. Copies must be certified by the Authority that received the foreign application to be a true copy of the documents.
 7. Check if the variety has been sold in Australia or overseas:
 - If sold in **Australia** with the breeder's consent check if the date of first sale and the name under which it was sold has been provided. The prior sale limit for any Australian sale is one year from the date of lodgement of the application.
 - If sold **overseas** with the breeder's consent, check if the date of first sale and the name under which it was sold has been provided. The prior sale limit for any overseas sale is four years from the date of lodgement of the application for most species, except for trees and grape vines, where a six year prior sale limit applies.
 8. Determine if the variety has been exploited or not, and if so, if it has only been recently exploited by taking into account first sale dates in Australia and overseas.
 9. Check if details of the origin and parentage of the variety have been provided.
 10. Check if information on the seed and pollen parents have been provided.
 11. If selection from source material has been indicated as the origin of variety, check if the details of germplasm used have been provided.
 12. Check if the prima facie case for **breeding** has been established from the characteristics or combination of characteristics which makes the candidate variety clearly distinguishable from its parents or source material.

Check this [document](#) for further guidance on the prima facie case for breeding.
 13. Check if the prima facie case for **distinctness** has been established from the characteristics or combination of characteristics which makes the candidate variety clearly distinguishable from its parents or source material and from the 'most similar Varieties of Common Knowledge (VCK)' (the comparators).

Check this [document](#) for further guidance on the prima facie case for distinctness.
 14. Check if the details of the breeding procedures used to initiate the new variety have been provided. Ideally the applicant should provide:
 - where observations were first made (property and/or town and country);
 - where other work was conducted (if applicable);
 - main selection criteria used to develop the variety;
 - mode of propagation between generations;
 - the number of generations the variety has been maintained in its present form;
 - the occurrence of any off types;
 - brief outline of the procedures employed to develop the variety.
 15. If there is any doubt about the breeding procedures used to initiate the new variety check the Breeding Panel Report for further clarification.
 16. Check if a statement has been made with respect to whether the variety is a genetically modified organism or not. For genetically modified organisms a reference number from the Office of the Gene Technology Regulator is required.
 17. Check if the name and location of the Genetic Resource Centre (GRC) has been provided (this is where the propagating material for the variety will be maintained). A GRC must be in Australia except where the Registrar has given written permission for an overseas GRC. A post box address is not acceptable as GRC location.

18. Confirm how the applicant has proposed the DUS test will be conducted (e.g., based on overseas test data, a comparative growing trial in Australia or a verification trial in Australia).

- **If DUS test is based on overseas data**, check if the test dates and name of the testing country have been provided and a date when the official overseas test data will be available has been provided.
- **If the DUS test report availability date is within 6 months**, include a note in the first report explaining that if the official DUS test report is not received by the due date or is deemed not suitable then the Pre-Examination Trial Agreement form (see "Pre-Examination Trial Agreement" below) needs to be completed at that time.
- **If the DUS test report will not be available until after 6 months**, the Pre-Examination Trial Agreement form needs to be completed by the QP at the time of acceptance. This is to ensure that an appropriate field trial in Australia is established and progressing if the overseas DUS test report is found to be unsuitable.

19. Check if the applicant has provided a suitable date when the PBR office will be able to examine the comparative growing trial or the verification trial in Australia or examine the overseas test data for DUS. Examination is done to verify the distinguishing characteristics claimed in this application and to verify that they are stable and uniform. It is mandatory to provide a proceed date.

20. Check if the applicant has made a declaration that the information given in all parts of the application and attachments is true and correct. If there is more than one applicant, check if a 'Supplementary Pages to Part 1 application' form ([PBR00003](#)) has been submitted for each additional applicant.

21. Check if a qualified person accredited to test the variety has been nominated using the 'Nomination of a Qualified Person' form ([PBR00005](#)).

22. Check if appropriate fees have been paid and the receipt is on file before the application is recommended for acceptance.

23. If any deficiencies are identified in the application, then a request for Additional Information is sent to the Applicant or Agent and QP and the report saved as "Part 1 Examination – Report No 1" in the relevant EDMS case file.

24. The Applicant or Agent and QP are given 30 days in which to respond.

Attachment 4

IP Australia, *Plant Breeder's Rights (PBR) Manual of Practice and Procedure* (IP Australia, 2022) Part 3.1 at <<https://manuals.ipaustralia.gov.au/pbr/part-3.1-variety-denomination-assessment>>.

Part 3.1 Variety Denomination Assessment

Date Published 16 Dec 2020

[Database search reports](#)

- [PLUTO database search report](#)
- [ATMOSS database search report](#)
- [PBR database search report](#)

1. Check if a name and/or synonym for the variety has been proposed in the application.
2. Check to ensure that the proposed name and synonym is a word or words (whether invented or not) with or without the addition of a letter or letters (that do not constitute a word) and a figure or figures or both
3. Check if application for PBR in this variety has been lodged in another UPOV member country by searching the Pluto database on UPOV website. (see [UPOV report](#) for details).
 - If an application for PBR in another UPOV member country exists, check the status of the application(s)
 - Check if PBR has been granted in another UPOV member country
 - If, PBR has been granted in that variety in another UPOV member country, the name of the variety in the Australian application must be the name under which PBR was first granted in another UPOV member country
4. From Pluto database search results, check if the proposed name and/or synonym will deceive or cause confusion, including confusion with the name of another plant variety of the same plant class.
5. Search [ATMOSS database](#) to ensure that the proposed name and/or synonym is not or does not include a trade mark that is registered, or whose registration is being sought, under the Trade Marks Act 1995, in respect of live plants, plant cells and plant tissues
6. Search the [PBR record](#) to check if the proposed name and/or synonym will deceive or cause confusion with the name of another plant variety of the same plant class
7. Check if the proposed names and synonyms comply with the International Code of Botanical Nomenclature and subsidiary codes.
8. Check to ensure that the proposed names and synonyms are not contrary to law or prohibited by regulations
9. Check to ensure that the proposed names and synonyms does not contain scandalous or offensive matter
10. Check to ensure that the proposed names and synonyms does not contain the name of a corporation or other organisation, unless the corporation or other organisation has given its written consent to the name of the variety
11. Check to ensure that the proposed names and synonyms does not contain the name of a natural person living at the time of the application unless the person has given written consent to the name of the variety
12. Check to ensure that the proposed names and synonyms does not contain the name of a natural person who died within the period of 10 years before the application unless the legal representative of the person has given written consent to the name of the variety

Database search reports

The [Pluto](#), [ATMOSS](#) and [PBR acceptance](#) databases must be searched with the proposed variety name and synonym (if applicable) to determine their suitability and results saved in appropriate folders.

PLUTO database search report

1. Log into the [Pluto database](#)
2. Search the database with the proposed variety name against the Denomination, Breeders Ref and Trade Name fields (Ensuring that the "OR" operator is used for Breeders Ref and Trade Name). The columns in search result should at least include the following:
 - UPOV Code
 - Botanical Name
 - App. No.
 - App. Date
 - Grant date
 - Denomination
 - Breeder's Ref.
 - Trade Names
3. Print the search results and save as a pdf file in appropriate folders
4. Check the relevant individual records (results that have the same denomination in same plant class) by clicking on them from the search results and save them as pdf files.
5. Check prior applications in the results against question 13 of the Part 1 Application for consistency of information.
6. Check the status of prior applications – has the variety been granted rights overseas?
7. Check that the proposed name of the variety in the Part 1 Application is consistent with prior applications over seas.
8. Check the suitability of the proposed variety name –if the denomination has already been used for another variety in the same plant class (indicated by its UPOV code), then it is likely to cause confusion and is not acceptable under Sect 27 of the PBR Act.
9. If a synonym has been proposed then repeat the process for the synonym.

ATMOSS database search report

1. Log into the [ATMOSS database](#)
2. Search the database with the proposed variety name.
3. Ensure that the search fields are set as following:
 - Word/Image field - Part word
 - Class/es field - 31 and Single;
 - Trade Mark Status field - Pending or Registered

Basic Search

Fill in one or more of the fields below:

WARNING: Please note that the results of any search you conduct are not binding and that any subsequent application made will still be subject to a search by a trade mark examiner.

Word/Image: (3) Part word And (3) Part word

Non-Wildcard search containing %,*,? and _ (valid on Exact Word only)

If searching for an image, you need to use the appropriate [Image Terms](#)

Class/es: 31 Single For example: 1,3,5-10

Find the correct [class/es](#) for your goods or services

Trade Mark Status: Pending and Registered [Search Tips](#)

TM number range: Greater Than to

You can also search by trade mark number:

TM Number List: For example: 123456,654321,700000

1. Click the Print Friendly Page button and print the search results as a pdf file and save the in appropriate folder.
2. Identify and print as pdf the trade mark details of exact matches
3. Check details for status, type of mark and description of goods and services.
4. Where information about the status is missing, the PBR examiner will need to contact the Trade Mark office to confirm that the mark has never been registered and therefore can be ignored for the purposes of s25(5)(e). Record advice from the Trade Mark office on a note to file.
5. If the proposed variety name is composed of multiple words (composite names), the ATMOSS data base must be searched for each part of the name by repeating the steps described above.
6. If needed then repeat the process for any proposed synonym.

PBR database search report

1. [Search the PBR records](#) with the proposed variety name and/or synonym as the search criteria. The result should at least show the candidate variety
2. Print to PDF and save the result in the appropriate folder.