

Labelling and Branding of Plant Material

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When labelling or advertising plant material for sale, it is recommended that the varietal name, plant variety rights number, and trade mark be represented so that your trade mark and plant variety rights are less likely to be infringed. If you have a trade mark or trade name, it is essential that this be used in a manner distinct from the varietal name. Use the initials “TM” after the trade mark, always represent it in capital letters or a distinctive form, use the trade mark as an adjective, not a noun, and do not abbreviate it.

INTRODUCTION

Three main issues will be addressed. Firstly the labelling requirements under the Plant Variety Rights Act 1987. Secondly branding, and specifically what is a trade mark, and how can it be protected. Thirdly some guidelines for correct trade mark usage are presented below.

LABELLING REQUIREMENTS UNDER THE PLANT VARIETY RIGHTS ACT 1987

What Exactly is a Denomination or Varietal Name? When you seek a plant variety right (PVR) for a new variety, you must include a varietal name in the application. This name is called the “denomination”. It can be a breeder’s reference or any name you care to select for the new variety. But there are some rules. For instance, the name must conform with international usage relating to the names of cultivated plants. Further, it cannot be a name already registered or applied for as a trade mark in New Zealand, and the name must not be misleading or deceptive about the characteristics or value of the variety.

Every proposed denomination is advertised in the *Plant Variety Rights Journal* along with other details about the application. Anyone may then object to the name chosen by writing to the Commissioner of Plant Variety Rights within 3 months of the date of the *Plant Variety Rights Journal* and setting out their reasons for the objection.

How Must the Denomination be Used? The Plant Variety Rights Act 1987 (the PVR Act) also has rules as to how a variety name of a protected variety is to be used. By “protected variety” I mean any variety, which is under application for or has been granted plant variety rights. If you sell reproductive material of a protected variety, it is necessary to use the varietal name in association with that material. Also you may not use a trade mark on the reproductive material of a protected variety, unless the varietal name is also clearly labelled.

These rules apply even after a variety is no longer protected under the PVR Act. In this way, the varietal name remains in place forever.

Use of the Varietal Name by the PVR Owner. If you own plant variety rights you should make sure that any reproductive material of the variety you are selling is labelled correctly. The label should include the Plant Variety Rights application

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or grant number, as well as the varietal name. The advantage of correct labelling which includes the PVR application or grant number is that if someone allegedly infringes your plant variety rights, they can not argue that they were not aware of the existence of your rights. This means that you will be entitled to claim damages if the infringement is proven.

Recommendation. It is my recommendation that you make sure that reproductive material of your variety that you sell is labelled:

- “Varietal Name” PVR Application No. “123456”, or
- “Varietal Name” PVR Grant No. “XYZ”.

Although action for infringement can not be taken until the plant variety rights have been granted, once this occurs the PVR owner can sue for any infringement that has occurred since the filing date of the application. It is thus worthwhile labelling your variety with its denomination and plant variety rights application number as set out above, even if plant variety rights have not yet been granted for the variety.

Incorrect Use of a Denomination — What Not to Do. You must be careful not to label plant material stating that you have applied for plant variety rights, if you have in fact not done so. It is also not allowable to label plant material using another plant’s varietal name.

Another thing to avoid is using the varietal name as a trade mark. It is best to choose a separate trade mark for your variety, or for a range of your varieties. The trade mark should be distinguishable from the varietal name and should itself be distinctive. Preferably this trade mark should then be registered at the Intellectual Property Office of New Zealand (IPONZ).

To clarify — a trade mark is distinct from a varietal name for the following reason: the varietal name is specific to the variety itself, while the trade mark indicates the person or organisation that produces or sells the variety.

BRANDING — WHAT IS A TRADE MARK AND HOW CAN IT BE PROTECTED?

A trade mark is a sign (or combination of signs) capable of being represented graphically and capable of distinguishing the goods and services of one person from those of another. A trade mark can be registered in New Zealand at the Intellectual Property Office of New Zealand (“IPONZ”) in relation to goods and/or services subject to satisfying a number of conditions. I will refer to these shortly.

The trade marks register is divided into 42 classes of goods and services. The classes most relevant to your industry are class 31 (fresh fruits and vegetables; seeds, natural plants, and flowers) and class 35 (retail and wholesale services). If your goods and services fall into more than one of these 42 classes, it may be necessary to file a trade mark application in each relevant class.

CONDITIONS OF REGISTRATION:

Availability. A trade mark will be considered available for registration provided such mark (or a mark confusingly similar to such a mark) is not already registered in New Zealand in relation to the same or similar goods or services. In order to determine this we can conduct a search of the New Zealand trade marks register.

In addition a more common law search can be conducted that considers registered company names, telephone directories, domain names, and the Business "Who's Who." This would help determine if another party is using the same or a similar trade mark or name in relation to the same or similar services.

Is it Registrable? The register of Trade Marks is divided into two parts, Part A and Part B. Part A registration provides a stronger form of protection than a part B registration. There are a number of additional differences between Part A and Part B registration which I will not comment on in this forum.

To achieve registration of your trade mark in Part A of the Register, it is necessary to convince IPONZ that your mark is **distinctive**, or **adapted to distinguish**, your goods or services from those of another trader. For Part B of the Register there is a slightly lower standard, namely that the mark is **capable of distinguishing** the goods or services for which it is to be used. If your trade mark is descriptive (either directly or indirectly) of the goods or services which you intend to use it on, or have used it on, or if it is a geographical name or surname, it may be difficult to obtain the registration for it. It is for this reason that a trade mark should preferably be distinctive of the goods and services for which it is to be used.

In some cases, however even where a mark is descriptive, or contains a geographical name or surname, it may be eligible for trade mark registration if evidence of substantial use of the mark in New Zealand can be filed at IPONZ. In this way it can be shown that the mark has become well known to persons in the industry as being associated with the applicant and their goods or services.

Once a trade mark application has been filed at IPONZ, an Examiner will consider whether its registrability, availability, and other formality matters during the examination. If it is then accepted for registration it will be advertised in the Patent Office Journal. From such date of advertisement there is then a 3-month period of time during which third parties can object to registration of the trade mark. Assuming no opposition is lodged, the registration fee will then be paid and the trade mark will proceed to registration. A registered trade mark will remain in force for an initial period of 7 years from the filing date. This can be extended by further periods of 14 years by payment of renewal fees. The period of protection can thus be extended indefinitely.

GUIDELINES FOR CORRECT TRADE MARK USAGE

If you have a trade mark registered at IPONZ it is important that the trade mark be represented on labels, promotional, and other advertising material in the same manner as it appears in the trade mark registration because this is what you have obtained protection for. If you have obtained registration for your trade mark at IPONZ in ordinary block letters (the broadest form of protection), then any use of that word, however represented, will be considered to be use of the registered trade mark. One danger of incorrect trade mark usage is that the mark can become generic; for example, the public becomes used to referring to the product or service by its trade marked name. If this occurs it may not be possible to stop other traders from using the name in association with their own brand. This is because the trade mark will be considered to have lost its distinctiveness associated with the product or service. Examples of trade marks that have become generic are SELLOTAPE, JANDAL, and XEROX.

To prevent this happening, the common commercial name for the product should follow the trade mark. For example: PACIFIC ROSE apples or ZESPRI GOLD kiwifruit. Also the trade mark should be used as an adjective, not a noun and should not be used in plural form. For example:

The taste of ZESPRI GOLD kiwifruit is exquisite. — Right

The taste of ZESPRI GOLD'S is exquisite. — Wrong

The trade mark should be displayed in capital letters, or in a distinctive form, and should never be abbreviated.

Trade marks on Labels. It is not compulsory under the Trade Marks Act 1953 for a trade mark to be represented with an indication that trade mark protection has been applied for or obtained. However, it is important to represent a trade mark with the initials "TM" after it, to indicate it is being used as a trade mark rather than a varietal name, and thus to indicate to purchasers the origin of the plant material. If registration of the trade mark is obtained from IPONZ, the symbol "®" can and should be used directly after the registered trade mark. However, it is an offence to indicate that a trade mark is registered when this is not so, even if one has applied for trade mark registration.

REFERENCES

Intellectual Property Office of New Zealand (IPONZ). Lower Hutt, Wellington, New Zealand.

New Zealand Business Who's Who. 1999. New Zealand Financial Press Ltd, Wellington, New Zealand.