



KU LEUVEN CAMPUS BRUSSELS
FACULTY OF LAW
Academic year 2019-2020

**The Interface between Trade Marks and Plant Variety Denominations:
Towards Clearer Coexistence at International and EU level**

Promoter: Prof. Dr. Marie-Christine JANSSENS

Co-reader: Prof. Dr. Geertrui VAN OVERWALLE

Master's thesis, submitted by

Ángela H. MARTÍNEZ LÓPEZ

as part of the final examination for the

MASTER OF INTELLECTUAL PROPERTY AND ICT LAW

Word count: 19.857 (word-limit extension granted)

Plagiarism declaration

I confirm that this thesis is my own work, that all ideas contained in the thesis are expressed in my own words and that I have not literally or quasi-literally taken anything over from other texts, except for fragments cited between quotes for which I provided full and accurate bibliographical data.

Ángela H. Martínez López

Abstract

This study explores, from both a theoretical and empirical perspective, the coexistence between trade marks and plant variety denominations at International and EU level. It will be opened with a historical introduction to International plant nomenclature, followed by a description of the International and EU legal framework for the protection of trade marks and of plant variety rights, respectively.

The analysis will then examine the interplay between EU plant variety legislation and EU trade mark legislation. More precisely, it will focus on impediments to the registration of plant variety denominations on account of earlier trade marks, as well as on impediments to the registration of EU trade marks on account of earlier plant variety denominations. In this connection, attention will be drawn to the incorporation into the EU trade mark regulation of a new absolute ground for refusal of EU trade marks consisting of, or reproducing in their essential elements, an earlier registered plant variety denomination. The relevant EU case law on the said matter will be cited and commentaries thereon provided. Likewise, illustrative examples are showcased throughout the text for the sake of a clearer conceptual understanding.

This study will also delve into the international inter-institutional cooperation mechanisms currently in place for the harmonisation of the examination practices of plant variety denominations, as well as into the bilateral cooperation established between the Community Plant Variety Office (CPVO) and the European Union Intellectual Property Office (EUIPO). Some suggestions to strengthen the existing forms of cooperation will be made.

Later on, light will be shed on how can plant breeders make use of the advantages offered by combining EU trade mark and plant variety rights' protection, account being taken of the specific features of the plant-related market.

The gates of this garden of research will be closed with some conclusions summarising the main points to take home.

Finally, a case study gathering together many of the elements explored throughout the text is annexed to the thesis.

Acknowledgements

The author warmly thanks the following experts for their insightful suggestions for the research and drafting of this thesis:

- **Michaela Filippo**

Legal Counsel at Communauté Internationale des Obtenteurs de Plantes Ornamentales et Fruitières à Reproduction Asexuée (CIOPORA) [International Community of Breeders of Asexually Reproduced Ornamental and Fruit Varieties]

- **Francesco Mattina**

Vice-President of the Community Plant Variety Office (CPVO)

- **Jesús Manuel Oviedo Aranda**

Head of Department at Oficina Española de Variedades Vegetales (OEVV) [Spanish Plant Variety Office], Spanish Ministry of Agriculture, Fisheries and Food

- **André Pohlmann**

Member of the Fifth Board of Appeal of the European Union Intellectual Property Office (EUIPO), Mediator at EUIPO, and Member of the Board of Appeal of the CPVO

- **Philipp von Kapff**

Member of the First Board of Appeal of the EUIPO and Mediator at EUIPO

Table of Contents

1. Introduction.....	1-3
1.1.Context and Relevance of the Investigation.....	1
1.2.Objectives.....	2
1.3.Research Questions.....	2-3
1.4.Methodology.....	3
2. Historical Background to International Plant Nomenclature.....	4-10
3. Legal Framework for the Protection of Trade Mark and Plant Variety rights in the European Union.....	11-24
3.1.A Glimpse into the EU Trade Mark Rights' System.....	11-18
3.2.A Glimpse into the Community (EU) Plant Variety Rights' System.....	19-24
4. Legal Nature and Functions of the Plant Variety Denomination.....	25-32
4.1.Legal Nature of the Plant Variety Denomination.....	25-27
4.2.Functions of the Plant Variety Denomination: Comparative Study with Trade Marks.....	27-32
5. Through the Prism of EU Plant Variety Rights' Law: Plant Variety Denominations and the Interface with Trade Marks.....	33-54
5.1.Suitability of Plant Variety Denominations.....	33-35
5.2.Impediments to the Registration of Plant Variety Denominations.....	35-46
5.2.1. <i>Analysis of Impediments in Article 63(3) CPVRR</i>	36-44
5.2.2. <i>Case Law of the Board of Appeal of the CPVO on Impediments to the Registration of Plant Variety Denominations</i>	45-46
5.3.Coexistence between Plant Variety Denominations and Trade Marks...	47-48
5.4.Fancy Names Versus Codes: A Polarised Debate.....	48-50
5.5.Databases and Search Tools for Plant Variety Denominations.....	51-52
5.6.International Cooperation in the Examination of Plant Variety Denominations.....	53-54
6. Through the Prism of EU Trade Mark Rights' Law: Trade Marks and the Interface with Plant Variety Denominations.....	55-74
6.1.Impediments to the Registration of EU Trade Marks based on earlier Plant Variety Denominations.....	55-68

6.1.1.	<i>Introduction of Article 7(1)(m) EUTMR as Absolute Ground for Refusal of Marks including earlier Plant Variety Denominations</i>	55-57
6.1.2.	<i>Practice of EUIPO Examiners under Article 7(1)(m) EUTMR</i>	57-61
6.1.3.	<i>Landmark Joint-Cases of the Boards of Appeal of the EUIPO</i>	61-66
6.1.4.	<i>Judgement ‘Kordes’ Rose Monique’ of the General Court of the EU on the Interpretation of Article 7(1)(m) EUTMR</i>	66-68
6.2.	Cancellation Actions against EU Trade Marks affecting earlier Plant Variety Denominations.....	69-73
6.2.1.	<i>Invalidity Actions based on Bad Faith Grounds</i>	69-71
6.2.2.	<i>Revocation of EU Trade Marks that become known as the Generic Designation for a Plant Variety</i>	71-73
6.3.	Bilateral Cooperation between the CPVO and the EUIPO.....	74
7.	A Glimpse into the Reality and Features of the Plant-Related Market..	75-79
8.	Conclusions.....	80-82
9.	Bibliography.....	83-91
9.1.	Legislation.....	83-84
9.1.1.	<i>International</i>	83
9.1.2.	<i>European Union</i>	83-84
9.2.	Soft Law.....	84
9.3.	Doctrine.....	84-87
9.3.1.	<i>Books</i>	84-85
9.3.2.	<i>Articles</i>	85-87
9.4.	Case Law.....	88-89
9.4.1.	<i>Court of Justice of the European Union and General Court</i>	88-89
9.4.2.	<i>Board of Appeal of the CPVO</i>	89
9.4.3.	<i>Boards of Appeal of the EUIPO</i>	89
9.4.4.	<i>EUIPO Examination Division</i>	89
9.5.	Databases.....	90
9.5.1.	<i>International</i>	90
9.5.2.	<i>European Union</i>	90
9.6.	Online Tools, Academic Materials, Blog Posts and Other Resources....	90-91
9.7.	Personal Interviews.....	91
Annex I -	Case Study of the ‘Cripps Pink’ Apple Variety	92-95

List of Abbreviations

AC	Administrative Council
ARS	American Rose Society
CIOPORA	Communauté Internationale des Obtenteurs de Plantes Ornamentales et Fruitières à Reproduction Asexuée [International Community of Breeders of Asexually Reproduced Ornamental and Fruit Varieties]
CJEU	Court of Justice of the European Union
CPVO	Community Plant Variety Office
CPVR	Community Plant Variety Right
CPVRR	Community Plant Variety Rights' Regulation [Council Regulation No 2100/94 of 27 July 1994 on Community plant variety rights]
CTM	Community Trade Mark
CTMR	Community Trade Mark Regulation [Council Regulation No 207/2009 of 26 February 2009 on the Community trade mark]
EEA	European Economic Area
EPO	European Patent Office
EU	European Union
EUIPO	European Union Intellectual Property Office
EUTMR	European Union Trade Mark Regulation [Regulation 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark]
DUS	Distinctness, Uniformity and Stability
ICNCP	International Code of Nomenclature for Cultivated Plants
ICNAFP	International Code of Nomenclature for Algae, Fungi, and Plants
IP	Intellectual Property
IPR	Intellectual Property Right
IRA	International Registration Authority
ISF	International Seed Federation
OECD	Organisation for Economic Co-operation and Development
OEPM	Oficina Española de Patentes y Marcas [Spanish Patent and Trade Mark Office]

OEVV	Oficina Española de Variedades Vegetales [Spanish Plant Variety Office]
PVD	Plant Variety Denomination
PVR	Plant Variety Right
R&D	Research and Development
TM	Trade Mark
TMR	Trade Mark Right
UPOV	Union Internationale pour la Protection des Obtentions Végétales [International Union for the Protection of New Varieties of Plants]
WIPO	World Intellectual Property Organization

1. Introduction¹

1.1. Context and Relevance of the Investigation

1. The four segments of the plant industry (agriculture, vegetable, fruit, and ornamental) of the European Union (EU) represent an enormous share of the internal market, both in economic and societal terms.² The dedication of this industry reverberates in turn at global scale. Developing novel plant varieties is a time-consuming and costly endeavour: solid Intellectual Property (IP) protection schemes contribute to the fuelling of plant-related innovation. In this context, the combination of trade mark and plant variety rights can represent an attractive symbiosis for plant breeders to recoup the investments incurred in.

2. Against this background, a historical introduction to International plant nomenclature will be presented (*Chapter 2*), followed by a general description of the International and EU legal framework for the protection of trade marks and of plant variety rights, respectively (*Chapter 3*) and then by an analysis of the legal nature and functions of the plant variety denomination (*Chapter 4*).

The core of the study will consist in a parallel exploration on how EU plant variety legislation envisages trade mark rights (*Chapter 5*), and how EU trade mark legislation envisages plant variety denominations (*Chapter 6*).

The next section will be devoted to the plant-market commercial realities and to how can EU plant breeders possibly take advantage of the options offered by the described IP schemes to maximise the benefits emanating thereof (*Chapter 7*).

The study will be closed with some conclusions summarising the main lessons to take home (*Chapter 8*). Thereinafter, the bibliography used throughout the course of this research is listed (*Chapter 9*).

Lastly, for those readers who may be left wanting some more, an illustrative case study awaits, exhibiting many of the here-explored relevant elements (*Annex I to this thesis*).

¹ Disclaimer 1: The author declares that all the views and opinions here expressed are her own, and do not represent those of the CPVO, the EUIPO, Euroseeds, UPOV; nor those of any other institution, agency or body cited throughout the text.

Disclaimer 2: The author declares that all cited plant varieties, as well as trade marks, are merely alluded to for illustrative and educational purposes. No advertisement intention whatsoever underlies this research, which is guided only by the public interest.

Disclaimer 3: The expression “the author” as appearing throughout this text must be understood as referring to the student drafting this thesis, namely, Ms Martínez López.

² The development of new improved varieties and fostering of plant-genetic diversity bring along countless benefits, such as ensuring food security or contributing to tackling climate change.

1.2.Objectives

3. This thesis aims at providing further clarity and guidance in the arena of the interface between trade marks and plant variety denominations. As opposed to the interface between plant-related patents and plant variety rights, which is quite a high-profile topic,³ the interface between the latter and trade marks remains a relative unexplored area. Yet, such an area of convergence, constitutes a matter of utmost importance, on account of the worldwide economic and societal impact that the plant breeding industry represents.

An in-depth holistic overview is much needed, for the sake of facilitating the daily endeavours of both the examiners of plant variety rights (and plant variety denominations) and the examiners of trade marks, as well as for offering practical guidance to plant breeders who are considering applying for the cited rights. Hence, in terms of addressees, this thesis is targeted at public IP-registration Offices, plant breeder organisations, plant breeder applicants and titleholders, lawyers, and scholars interested in the matter.

1.3.Research Questions

4. The overarching research question addressed by this thesis is the following:

- How is the coexistence between trade marks and plant variety denominations regulated at International and EU level, and how can said coexistence be used to the benefit of the EU plant breeding industry and of the public interest?

The sub-questions emanating from the pivotal question are the following:

- What are the legal nature and functions of a plant variety denomination, as compared to those of a trade mark?
- What inter-institutional cooperation mechanisms are there in place to harmonise the examination procedures for the registration of plant variety denominations at International and EU scale? Is there leeway for improvement, to foster closer cooperation resulting in increased efficiencies?
- Can the incorporation into EU trade mark law of a specific ground for refusal of EU trade marks consisting of, or reproducing in their essential elements, a plant variety denomination, as interpreted by the General Court of the EU, be held to

³ See, for instance, the Saga on the regulatory and legal developments concerning the patentability (or non-patentability) of products obtained by essentially biological processes, which last “episode” for the time being is Opinion G3/19 of the Enlarged Board of Appeal of the European Patent Office (EPO).

have had a legal and practical impact, in relation to the situation prior to the overhaul of EU trade mark law?

- About which problematic aspects should a breeder be especially wary of when applying for trade marks in relation to plant-related products, and when using registered trade marks in the plant marketplace?
- How can EU plant breeders benefit from the legal protection for trade marks as combined with legal protection for plant variety rights and denominations? In this connection: Which specific features of the segment of the plant-industry in question must be considered when deciding what IP-strategic approach fits better the business model of the breeder-applicant?

1.4. Methodology

5. Following a theoretical background for a necessary contextual framing, this thesis mostly constitutes an empirical approximation to the interface between trade marks and plant variety denominations. A comparative approach is adopted to demarcate the differences between the regulation, legal nature and functions of trade marks and of plant variety denominations, respectively.

The methodology employed with a view to answer the above-cited questions, consists in a multifaceted exploration based on the following elements:

- International and EU Legislation on trade mark and on plant variety rights, the emphasis being placed on the cross-references between such.
- The legal guidance published by ad hoc bodies to develop and interpret certain aspects in the relevant legislation (e.g.: CPVO Guidelines on Plant Variety Denominations from the CPVO Committee on Plant Variety Denominations).
- Existing case law from the Court of Justice of the European Union and the EUIPO and its Boards of Appeal, as well as from the Board of Appeal of the CPVO.
- Relevant Doctrine on the convergence between trade marks and plant variety denominations at International and EU level.
- Personal interviews and consultation of legal experts in the field of trade marks and of plant variety rights and denominations at EU level.

2. Historical Background to International Plant Nomenclature

6. Throughout the course of history, plant nomenclature has helped to “transform local knowledge of plants into a comprehensive system of naming, of ordering and classifying, which now embraces every known plant in the world”.⁴ This discipline consists in the naming of groups of plants according to rules developed for such process, and aims at ensuring that every plant has a name that is unambiguous, refers only to that particular kind of plant, and is understood globally.⁵

7. The origins of plant nomenclature can be traced back to 160 B.C., as evinced by the record entitled “De Agri Cultura” written by the Roman agriculturist Marcus Procius Cato (234-149 B.C.).⁶ This record included up to 120 cultivated plant varieties (of apples, figs and grapes, amongst others), and the names therein included consisted mostly of one word that was easy to remember.⁷

8. Plant nomenclature uses were also popular during the Middle Ages. A well-known piece of evidence is the *oeuvre* “Capitulare de Villis et Cortis Imperialibus” of the Emperor Charlemagne (742-814) concerning the management of imperial residences, of which a section was devoted to recommendations for the planting of several apple varieties, which were each designated by a name.⁸ Other glimpses of the use of names throughout the Middle Ages are found in records of payments for fruits and plants.⁹

9. Some centuries later, from the 16th century onwards, a myriad of new exotic plant varieties was being brought to Europe from expeditions undertaken to unexplored parts of the world.¹⁰ In addition, the discovery of printing and the use of wood-block illustration led to the first illustrated botanical encyclopaedias, what facilitated the expansion of botanical knowledge. This context was characterised by an imperious need to identify

⁴ David Gledhill, *The Names of Plants*. Cambridge University Press (2008, 4th Ed.), p. 4.

⁵ Brad Sherman, *Taxonomic Property*. (2018) *Cambridge Law Journal*, Vol. 67, Issue 3, p. 568.

⁶ Marcus Procius Cato was also a soldier, politician, and magistrate. See Joan Sadie, *The Essence of Naming Cultivars*. (2001) *Acta Horticulturariae 545 [Proc.V Int. Protea Symp.]*, p. 35.

⁷ William Thomas Stearn, *Historical survey of the naming of cultivated plants*. (1986) *Acta Horticulturariae 182*, p. 19. More evidence of the use of plant denominations by the romans is provided with the compilations “*Rerum rusticarum Libri*”, written by the scholar Marcus Terentius Varro (116-27 B.C.), and “*Naturalis Historiae Libri* of Pliny the Elder”, written by the roman author Gaius Plinius Secundus (23-79 A.D.).

⁸ William Thomas Stearn, *Historical survey of the naming of cultivated plants*. (1986) *Acta Horticulturariae 182*, p. 20.

⁹ William Thomas Stearn, *Historical survey of the naming of cultivated plants*. (1986) *Acta Horticulturariae 182*, p. 20.

¹⁰ Joan Sadie, *The Essence of Naming Cultivars*. (2001) *Acta Horticulturariae 545 [Proc.V Int. Protea Symp.]*, p. 35.

novel plants and provide order in such process: from being a local matter, plant nomenclature had become a global concern. The leading representative of this period of “Botanical Renaissance” was the botanist Rembert Dodoens (1517-1585), who has been referred to as “the Father of Botany”. Dodoens was born in Mechelen (Belgium) and studied medicine, cosmography and geography at the University of Leuven. His masterpiece “Crvydt-Boeck” (“Herb Book” in English), with 715 images, became a work of worldwide renown, and the second most translated work of its times (the first being the Bible).¹¹ In this book, Dodoens divided the plant kingdom into six groups, based on their properties and affinities, instead of following the traditional method of arranging the plants by alphabetical order.

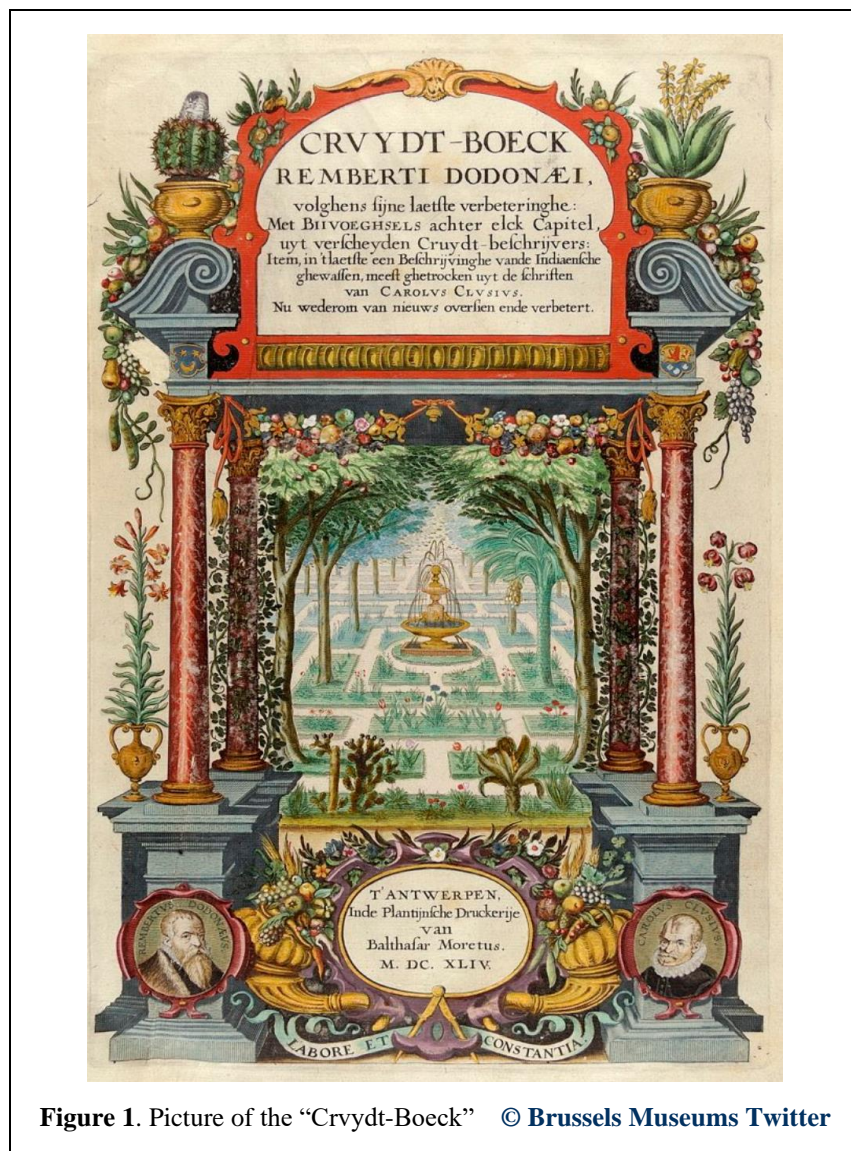


Figure 1. Picture of the “Crvydt-Boeck” © Brussels Museums Twitter

¹¹ *Rembert Dodoens: iets over zijn leven en werk – Dodoens' werken*, Project Rembert Dodoens, Plantaardigheden Stichting Kruidenhoeve/Plantaardigheden. Balkbrug (the Netherlands), available at <https://bit.ly/2WA812i> [accessed: 6 November 2020].

Later on, the advent of modern botanical nomenclature was proclaimed in 1753 with the publication of the *chef-d'oeuvre* “Species Plantarum” by the Swedish scientist and botanist Carolus Linnaeus (1707-1778).¹²

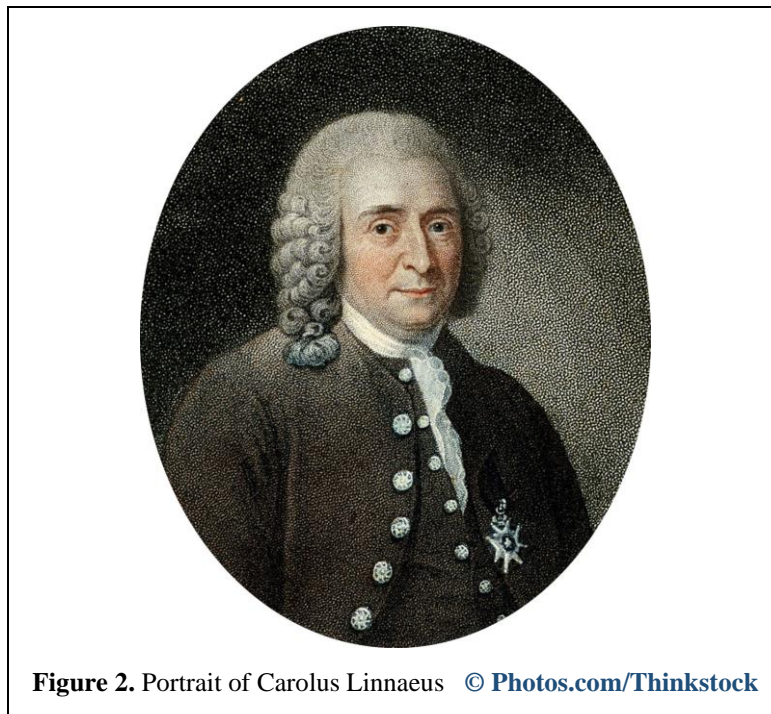


Figure 2. Portrait of Carolus Linnaeus © Photos.com/Thinkstock

The most revolutionary contribution of Linnaeus was his binomial nomenclature for plant species, that is, the assigning two-word names to each species, where a third word is added to distinguish plant varieties within species.¹³ Prior to the introduction of the binomial system, plant names often included epithets setting out the descriptive features of the species (*nomen specificum legitimum*), whereas the scheme promoted by Linnaeus, rather than describing, designated the plants in question.¹⁴

This standardisation of plant names, which lives on today, has played a crucial role in facilitating the circulation of plants as objects of exchange. As Linnaeus himself wrote in 1737: “the generic name has the same value on the market of botany, as the coin has in commonwealth, which is accepted as a certain price and is received by others on a daily basis”.¹⁵

¹² William Thomas Stearn, Historical survey of the naming of cultivated plants. (1986) *Acta Horticulturae* 182, p. 21.

¹³ In general, the first word in the binomial nomenclature is capitalized and identifies the plant genus, followed by a second term which is not capitalized, and identifies the species. For new varieties within a genus, the relevant terms to designate them must be artificially created, that is, a plant variety denomination must be assigned. See John McNeill, Nomenclature of Cultivated Plants: A historical botanical standpoint. (2004) *Acta Horticulturae* 634, p. 30.

¹⁴ Brad Sherman, Taxonomic Property. (2018) *Cambridge Law Journal*, Vol. 67, Issue 3, p. 569.

¹⁵ Carolus Linnaeus, *Critica Botanica*. (1737), p. 204; Staffan Müller-Wille, Nature as Marketplace: The Political Economy of Linnaean Botany. (2003) *History of Political Economy*, Vol. 35, Issue 5, p. 154.

10. International trade of plants kept expanding at a very fast pace throughout the eighteenth and nineteenth centuries. This brought along issues such as those concerning synonyms (a plant variety is given different names in different territories) and homonyms (different plant varieties are given the same name).¹⁶ There was a call for closer cooperation amongst countries, with a view to setting up a consistent system of nomenclature for the recording and communication of plant names at global level.¹⁷

At this juncture, botanists and taxonomists from all over the world gathered together to develop transnational rules and procedures governing the naming of plants. At the International botanical congress held in Paris in 1867, the International Code of Botanical Nomenclature (renamed as “International Code of Nomenclature for algae, fungi, and plants”, henceforth, “ICNAFP”) was adopted as the global standard by which plants were to be classified.¹⁸

Thereinafter, on occasion of the 15th International horticultural congress held in London in 1952, the International Code of Nomenclature for Cultivated Plants (henceforth, “ICNCP”) was adopted.¹⁹

These codes (henceforth, jointly referred to as “International Codes”) must be regarded as essentially distinct: the ICNAFP serves a classificatory purpose by design, whilst the ICNCP serves horticultural selection, that is, ensuring that every newly-created variety is assigned a name.²⁰

¹⁶ Example of “synonym”: in France, during the 1920s, the same variety of wheat was sold under four different plant names (‘Vilmorin 23’, ‘St Michel’, ‘Hybride 23’, and ‘Hybride d’automne’). Example of “homonym”: the same name (‘Mountain Ash’) was given to trees from different varieties [Piatti, M., and Jouffray, M., *Plant variety names in national and international law: Part I.* (1984) *European Intellectual Property Review (E.I.P.R.)*, p. 283; and Jay Sanderson, ‘Bringing Order and Stability to Variety Denomination’ in *Plants, People and Practices: The Nature and History of the UPOV Convention.* (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, p. 139].

¹⁷ Anna Pavord, *The Naming of Names: The Search for Order in the World of Plants.* Bloomsbury Publishing PLC (2005, 1st Ed.). p. 26; and Joan Sadie, *The Essence of Naming Cultivars.* (2001) *Acta Horticulturae 545 [Proc.V Int. Protea Symp.]*, p. 35.

¹⁸ Hitherto, the Botanical Code has been amended a dozen times. During the International botanical congress held in Melbourne in July 2011, its name was changed from “International Code of Botanical Nomenclature” to “International Code of Nomenclature for algae, fungi, and plants”. The last edition of the Code dates of 2017.

¹⁹ Since then, the ICNCP has undergone several revisions, the latest edition being the Ninth edition, published in 2016 [Joan Sadie, *The Essence of Naming Cultivars.* (2001) *Acta Horticulturae 545 [Proc.V Int. Protea Symp.]*, p. 36].

²⁰ The aim of the ICNCP is to promote uniformity, accuracy, and stability in the naming of agricultural, forestry, and horticultural plants” (See Principle 1 of the ICNCP) [H. J. Welch, On the difference between botanical and horticultural nomenclature and the status of botanical combinations based solely on the description of a cultivar. (1978) *Taxon (Journal of the International Association for Plant Taxonomy)*, Vol. 27, Issue 2, p. 187].

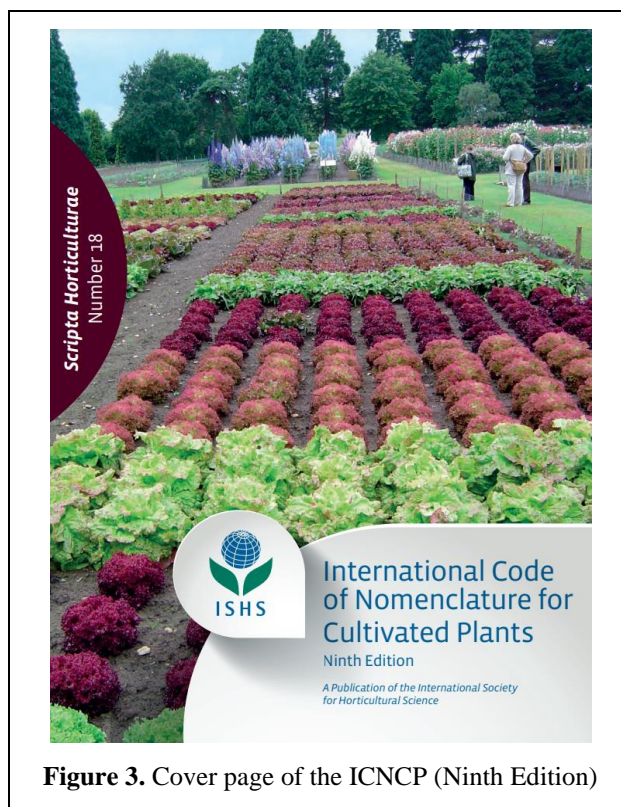


Figure 3. Cover page of the ICNCP (Ninth Edition)

The ICNCP contains a set of principles, rules, and recommendations, according to which agricultural, forestry and horticultural varieties should be named at International level.²¹ In compliance with these provisions, novel and acceptable plant variety names are registered under a voluntary system relying on the so-called International Registration Authorities (henceforth, “IRAs”). The IRAs are agencies representing a wide range of specialist societies and institutions, and are located in many countries around the world.²²

11. The practical effectiveness of the International Codes has been questioned, as the operation of these codes essentially relies on the good will and consensus of plant breeders, traders and marketers, that is, the provisions of the International Codes have no legally binding effect nor do they put in place effective enforcement mechanisms.²³

²¹ Preamble (first paragraph) of the ICNCP.

²² The IRAs are appointed by the Council of the International Society for Horticultural Science (ISHS) and carry out their duties under the guidance of the ISHS Commission for Nomenclature and Registration. The ISHS Secretariat is located in Leuven (Belgium). The list with the names of the currently appointed IRAs is found in Appendix I to the ICNCP [“Directory of International Cultivar Registration Authorities”, p. 69; Freek Vrugtman, *Directory of International Registration Authorities for Cultivar Names (IRAs)*. (1995) *Acta Horticulturae 413*; and C. Brickell, ‘The International Code of Nomenclature for Cultivated Plants: Its role in stabilizing the nomenclature of cultivated plants’ in B. T. Styles, *Infraspecific Classification of Wild and Cultivated Plants*. Oxford University Press (1986, 1st Ed.), p. 352].

²³ Pursuant to Principle 10 of the ICNCP, “this Code [the ICNCP] has no force beyond that deriving from the free assent of those concerned with the naming of cultivated plants. However, the Rules and Recommendations of this Code should be endorsed and applied by all those responsible for the formation and use of names for cultivated plants.”

This issue is further exacerbated by the increasing number of plant varieties being introduced by plant breeders.²⁴

In view of the described limitations, the setting up of the *Union Internationale pour la Protection des Obtentions Végétales* (henceforth, “UPOV”)²⁵ in 1961 burst into the scene to fill a crucial *lacunae*.²⁶ UPOV, with headquarters in Geneva (Switzerland), is the intergovernmental organization competent for regulating and harmonising the international legal framework for the protection of plant variety rights (henceforth, “PVRs”).²⁷ It was established by the UPOV Convention, adopted in Paris in 1961 and later revised in 1972, 1978 and 1991.²⁸ UPOV has legal personality and enjoys the legal capacity necessary for the fulfilment of the UPOV obligations in the territory of the Contracting Parties.²⁹

The legal framework established by the UPOV Convention sets out rules facilitating the consistent and effective naming of plants, which all Contracting Parties of UPOV (henceforth, “UPOV Members”) must implement in their national laws. The fact that UPOV provisions are of a binding legal nature, coupled with UPOV’s expanding membership,³⁰ resulted in a notorious harmonisation in the field of Plant Variety Denominations (henceforth, “PVDs”), rapidly surpassing the harmonisation achieved

²⁴ Jay Sanderson, ‘Bringing Order and Stability to Variety Denomination’ in *Plants, People and Practices: The Nature and History of the UPOV Convention*. (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, p. 140.

²⁵ In English: International Union for the Protection of New Varieties of Plants.

²⁶ Jay Sanderson, ‘Bringing Order and Stability to Variety Denomination’ in *Plants, People and Practices: The Nature and History of the UPOV Convention*. (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, p. 156.

²⁷ The mission of UPOV is “to provide and promote an effective system of plant variety protection, with the aim of encouraging the development of new varieties of plants, for the benefit of society”. UPOV concluded an agreement with WIPO pursuant to which the Director General of WIPO is the Secretary General of UPOV and WIPO provides administrative services to UPOV.

²⁸ The majority of countries that are UPOV Members are parties to the 1978 or 1991 Acts of the UPOV Convention. UPOV currently has 76 Members. The list of UPOV Members, as updated lastly in 3 February 2020, is available at <https://bit.ly/3oUymoR> [Accessed: 6 November 2020].

²⁹ Article 24(2) of UPOV Convention. Unless otherwise specified, any references to the “UPOV Convention” being made here must be understood as referring to the last version of it, also known as the “1991 Act”.

³⁰ An impetus for countries to join UPOV can be explained by the entry into force in 1994 of the Agreement on Trade Related Aspects of Intellectual Property Rights (“TRIPS Agreement”), administered by the World Trade Organization (WTO). The TRIPS Agreement constitutes a major historical breakthrough in the development of international intellectual property rights, by setting minimum required standards of protection for several forms of intellectual property. By virtue of Article 27(3)(b) of the TRIPS Agreement, plant varieties must be protected either by means of a *sui generis* system, a plant-patent system, or a combination thereof. Historically, countries were unable to reach agreement about the way in which this subject matter had to be protected, so the three options mentioned crystallised into the TRIPS Agreement.

with the International Codes.³¹ This is reflected by the increasing use of a single PVD for each plant variety at worldwide level. In sum, the industrial property protection for plant varieties acted as a catalyst for the standardisation of plant names.³²

The provisions on variety denominations in the UPOV Convention are implemented in conjunction with other principles and practices in botany and taxonomy, including those found in the International Codes, seed certification and national listing schemes, and legislation for Trade Mark Rights (henceforth, “TMRs”).³³ It is interesting to observe that the relationship between PVDs and TMRs was already envisaged at the time of the original drafting of the UPOV Convention and has been attracting attention ever since.³⁴ At the Diplomatic Conference for the creation of UPOV (held during the years 1957 to 1961), TMRs were regarded as a valuable means for obtaining plant-related industrial property protection and especially relevant in those countries not acceding to UPOV.

Although scientific communities have tended to disfavour Trade Marks (henceforth, “TMs”) for the identification of plants, TMRs are not incompatible with the aims of PVR law, as long as they are properly used.³⁵ This thesis will precisely navigate through the legal compatibility between, on the one hand, TMRs and, on the other hand, PVRs and PVDs.

³¹ Jay Sanderson, ‘Bringing Order and Stability to Variety Denomination’ in *Plants, People and Practices: The Nature and History of the UPOV Convention*. (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, p. 140.

³² Brad Sherman, *Taxonomic Property*. (2018) Cambridge Law Journal, Vol. 67, Issue 3, p. 580.

³³ Jay Sanderson, ‘Bringing Order and Stability to Variety Denomination’ in *Plants, People and Practices: The Nature and History of the UPOV Convention*. (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, p. 142.

³⁴ A “Group of Experts on the Relations Between Protection of the Names of New Plant Varieties and Trademark Protection” was set up within the remit of the UPOV Diplomatic Conference. The experts of this group believed that if someone was permitted to obtain TMR protection for a PVD (generic name), they would be bestowed of an unfair advantage over competitors, since it would make it difficult for competitors to adequately describe their plant variety. In order to balance the interests of plant breeders and consumers in UPOV Members, it was decided that the UPOV Convention (1961 Act) should establish that PVR titleholders would be required to relinquish any such TMRs over their PVRs and related PVDs. This approach was opposed by those who advocated for a more permissive combination of both PVR and TMR law (the United States of America and several plant breeding organisations). The 1978 review of the UPOV Convention resulted in PVR titleholders no longer been required to renounce their TMs coinciding with or including their concerned PVDs. Instead, they were prevented from asserting their right to the TM over a plant name. It was acknowledged that TMRs were crucial to the trade of plant varieties and not incompatible with the use of PVDs, so both should be permitted to coexist in the marketplace of plant varieties [Jay Sanderson, ‘Bringing Order and Stability to Variety Denomination’ in *Plants, People and Practices: The Nature and History of the UPOV Convention*. (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, pp. 145-147; André Heitz, ‘Plant variety protection and cultivar names under the UPOV Convention’ in Andrews, S., Leslie, A., and Alexander, C., *Taxonomy of Cultivated Plants: Third International Symposium*. Royal Botanic Gardens. (2000, 1st Ed.), p. 76].

³⁵ Vincent Gioia, Using and Registering Plant Names as Trademarks. (1995) *Acta Horticulturae* 413, p. 19.

3. Legal Framework for the Protection of Trade Mark and Plant Variety rights in the European Union

This chapter is devoted to a brief overview of descriptive nature of the respective legal frameworks for the protection of TMRs and of PVRs in the European Union, for the purposes of setting the general context within which the interrelation between EUTMs and PVRs and PVDs is circumscribed.³⁶

3.1.A Glimpse into the EU Trade Mark Rights' System

12. To begin with, a Trade Mark can be defined as a distinctive sign enabling to identify the products or services with which it appears as originating from a unique source.³⁷ TMs can enjoy legal protection, which can be attained at national, regional, or international level, in conformity with the principle of territoriality.

In the EU territory, the system in place for the protection of EU TMRs coexists with the different national TMR systems, as well as with the regional Benelux-TMR system for Belgium, the Netherlands and Luxembourg.³⁸

National TMR regimes are based on national law, so registration of TMRs at national level must be conducted in accordance with the corresponding applicable national legislation. The national TMR laws of the EU Member States are harmonised by Directive 2015/2436 (henceforth, “TMD”),³⁹ by dint of which the requirements for obtaining TMR protection through registration are substantially equivalent in all EU Member States.

13. The EU Trade Mark system consists in an autonomous regime for the EU-wide protection of TMs (henceforth, “EUTMs”),⁴⁰ which is erected on the base of Regulation

³⁶A comprehensive study of both the EUTM and the EU PVR system is here not deemed necessary and not aimed at, departing from the assumption that the reader interested in this thesis (as covering such a niche-topic) already has a basic understanding of the cited systems. Rather, this thesis would be incomplete if a brief depiction of both systems is not offered, for the purposes of a clearer understanding of the interrelation between, on the one hand, EUTMs and, on the other hand, PVRs and PVDs. To learn more about the EU TM system (after the latest legislative reform) *see*, for instance, Verena von Bomhard and Alexander von Muhlendahl, *Concise European Trade Mark Law*. (2018) Kluwer Law International.

³⁷ *EUTM in a Nutshell (course)*, Module 1 (p. 1), EUIPO Academy Portal [Accessed: 6 November 2020].

³⁸ The United Kingdom is no longer Member State of the EU since 1 February 2020.

³⁹ Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks. The harmonisation process has been progressive. The first Directive to approximate the laws of the Member States relating to TMRs dates from 1988. In addition, the EU, as well as its Member States, are Members of the World Trade Organization (WTO) and must thus adhere to the TRIPS Agreement, setting out minimum standards for the protection of TMRs.

⁴⁰ Article 17(1) EUTMR.

No 2017/1001 on the European Union trade mark (henceforth, “EUTMR”).⁴¹ Applications for EUTMs must be lodged before the European Union Intellectual Property Office (EUIPO),⁴² the official agency of the EU responsible for the registration and management of EUTM and Community Design titles.⁴³ EUIPO has its seat in Alicante (Spain) and has been operating since 1994.



Figure 4. Picture of the EUIPO premises

© EUIPO

The main benefit of the EU TM system is that it enables traders to protect their TMs by means of a single EUTM registration which is valid and enforceable throughout the entire territory of EU,⁴⁴ and which is obtained by means of a single application process. Any natural or legal person (from any country in the world) is entitled to apply and to be the proprietor of an EUTM.⁴⁵

An EUTM may consist of any sign, in particular words (including personal names) or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or

⁴¹ Regulation No 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, in force since 6 July 2017. Two Commission Regulations complete the legal framework of the EU TM system: Commission Delegated Regulation 2018/625 of 5 March 2018 (EUTMDR); and Commission Implementing Regulation 2018/626 of 5 March 2018 (EUTMIR).

⁴² Article 30 EUTMR. Applications for EUTMs may be filed in any of the official languages of the Member States (first language), and a second language must also be indicated, which must be one of the official languages of the EUIPO, namely, English, French, German, Spanish or Italian (Article 146 EUTMR).

⁴³ The core business of EUIPO consists in examination, registration, opposition and cancellation procedures on EUTM- and Community Design titles. EUIPO is supervised by the European Commission but has legal, administrative and financial autonomy. The Council of Ministers decides on the appointment of the Executive Director, and of the Deputy Executive Director (as well as on the appointment of the President of the Boards of Appeal and of the chairpersons of the Boards of Appeal). The Executive Director is responsible for the management of EUIPO and there is also a Management Board and a Budget Committee.

⁴⁴ According to Article 1(2) EUTMR, “an EU trade mark shall have a unitary character. It shall have equal effect throughout the Union: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Union”.

⁴⁵ Article 5 EUTMR.

sounds. Such sign must fulfil two conditions: i) they must distinguish the goods or services of one undertaking from those of other undertakings; and ii) they must be capable of being represented on the Register of EUTMs.⁴⁶

14. An application for an EUTM⁴⁷ is subject to the payment of a fee⁴⁸ and must contain: (a) a request for the registration of the EUTM; (b) information identifying the applicant; (c) a list of the goods or services in respect of which the registration is requested; and (d) a representation of the mark.⁴⁹

In what concerns particularly the goods and services in respect of which EUTMs are applied for, these must be classified in conformity with the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 (henceforth, “Nice Classification”).⁵⁰

EUTM applications are examined by EUIPO *ex officio* for compliance with the formal requirements.⁵¹ In addition, the EUIPO verifies whether the EUTM applied for does not

⁴⁶ Article 4 EUTMR. Pursuant to Article 3(1) EUTMR, “the trade mark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner”. The third indent of the same article lists different types of marks: Word marks, figurative marks, 3D marks (shape marks), position marks, pattern marks, colour marks, sound marks, motion marks, multimedia marks and holograms. It is also important to emphasize in this regard that the CJEU has held that the concept of “sign” has been stretched beyond what is visually perceptible so as to encompass both sounds and smells [*See, for instance, Sieckmann* (C-273/00) [2002], ECLI:EU:C:2002:748, paragraphs 43-44].

⁴⁷ It is possible to apply for an EUTM via a “fast-track” process. In order to qualify for this procedure, two main conditions must concur: i) the goods and services in respect of which the EUTM is applied must be selected from the HDB database; and ii) the application fee must be paid upfront [EUIPO page on “Fast-Track”, available at <https://bit.ly/3o7J3U6> [Accessed: 6 November 2020]].

⁴⁸ In accordance with Article 31(2) EUTMR, the application for an EUTM “shall be subject to the payment of the application fee covering one class of goods or services and, where appropriate, of one or more class fees for each class of goods and services exceeding the first class and, where applicable, the search fee”. As established in Annex I to the EUTMR, the basic fee for the application for an individual EUTM by electronic means amounts to EUR 850 (EUR 1000 if the application is filed in paper). The fee for the second class of goods and services for an individual EU trade mark is of EUR 50, while the fee for each class of goods and services exceeding two for an individual EUTM amounts to EUR 150.

⁴⁹ Article 31(1) EUTMR. In applying for an EUTM, the applicant may claim the priority date of an earlier filing in a country member of the Paris Convention or of the World Trade Organization (WTO), within a period of six months from the date of filing of the first TM application (Articles 34 and 35 EUTMR). If the claim is accepted, the date of priority shall count as the date of filing of the EUTM application for the purposes of establishing precedence of rights, where necessary (Article 36 EUTMR).

It is also possible for applicants to claim seniority, where the titleholder of an earlier trade mark registered in a Member State or registered under international arrangements having effect in a Member State, applies for an identical trade mark for registration as EUTM for goods or services which are identical with or contained within those for which the earlier trade mark has been registered [Article 39(1) EUTMR].

⁵⁰ Article 33(1) EUTMR.

⁵¹ The formal requirements are set out in Articles 31(3) and 32 EUTMR, as well as to the payment of the application fee due. If EUIPO identifies any deficiency in the application, the applicant is notified and invited to remedy such within two months from the receipt of the notification (Article 41 EUTMR).

fall foul of any of the absolute grounds for refusal foreseen in Article 7 EUTMR.⁵² For instance,⁵³ protection is excluded for signs devoid of distinctive character,⁵⁴ descriptive of characteristics of the goods or services,⁵⁵ or generic^{56,57}. Nor is EUTM registration available for signs which stand against public policy or accepted principles of morality,⁵⁸ which are deceptive,⁵⁹ or which conflict with an earlier protected geographical indication or appellation of origin,⁶⁰ or an earlier PVD (*our emphasis*).⁶¹

Where no objection is raised and EUIPO finds that the EUTM application at stake fulfils all due requirements, the application is published in the European Union Trade Marks Bulletin.⁶² Following the publication of the EUTM application, third parties can formulate observations in regard of such application,⁶³ and titleholders of earlier trade marks (or authorised licensees) may file a notice of opposition against the proposed

⁵² Article 42 EUTMR. EUIPO must first notify the applicant of the identified infringed grounds for refusing the registration and then allow him/her to withdraw or amend the application or to submit observations [Article 42(2) EUTMR]. Important is to note that absolute grounds for refusal to registration apply to an EUTM application even if they arise only in part of the EU [Article 7(2) EUTMR].

⁵³ Note for the sake of completeness: to learn about the whole catalogue of absolute grounds for refusal please refer to Article 7(1) letters (a) to (m) EUTMR.

⁵⁴ Article 7(1)(b) EUTMR. The analysis of distinctive character follows from how the TM is perceived by the relevant public (consumers) [*Linde and Others* (C-53/01) [2003], ECLI:EU:C:2003:206, paragraph 47]. A minimal degree of distinctive character suffices to escape the absolute ground [*SAT.1 SatellitenFernsehen GmbH v EUIPO* (T-323), ECLI:EU:T:2002:172, paragraph 35].

⁵⁵ Characteristics such as the nature, quality or geographical origin of the goods or services (Article 7(1)(c) EUTMR). The rationale underlying this ground for refusal is that where there are a limited number of possible ways of describing some goods, the provision of legal monopolies over such signs might enable one trader to keep other traders completely out of the market. The CJEU names this fact as “the requirement of availability” [*Adidas AG v Marca Mode* (C-102/07) ECLI:EU:C:2008:217, paragraph 23].

⁵⁶ Article 7(1)(d) EUTMR. The CJEU’s “requirement of availability” also underpins this exclusion.

⁵⁷ In accordance with Article 7(3) EUTMR, a sign that is excluded from protection as not distinctive, descriptive or generic, may nevertheless be protected if distinctiveness has been acquired through use. An applicant must be able to demonstrate that his/her sign now operates as a TM, that the sign has acquired through use a “secondary meaning” identifying the commercial source of the goods and/or services relating to the TM. This would mean that the designation has gained new significance and its connotation, justifying its registration [*Windsurfing Chiemsee* (C-108/97) [1999], ECLI:EU:C:1999:230, paragraphs 47-48].

⁵⁸ Article 7(1)(f) EUTMR. “Public policy” and “accepted principles of morality” are two different concepts that often overlap. Both notions must in any case be interpreted not only with reference to the circumstances common to all EU Member States but also by taking into account “the particular circumstances of individual Member States which are likely to influence the perception of the relevant public within those States” [*Couture Tech v OHIM* (T-232/10) [2011], ECLI:EU:T:2011:498, paragraph 34].

⁵⁹ Article 7(1)(g) EUTMR. It applies to TMs containing an inaccurate allusion. The risk of deception must be real and relate to the TM itself [*Elizabeth Emanuel* (C-259/04) [2006], ECLI:EU:C:2006:215].

⁶⁰ Article 7(1)(j) EUTMR, which provides for the refusal of EUTM applications that are excluded from registration pursuant to national or EU legislation or to international agreements to which the EU or the Member State concerned is party and that protect designations of origin and geographical indications.

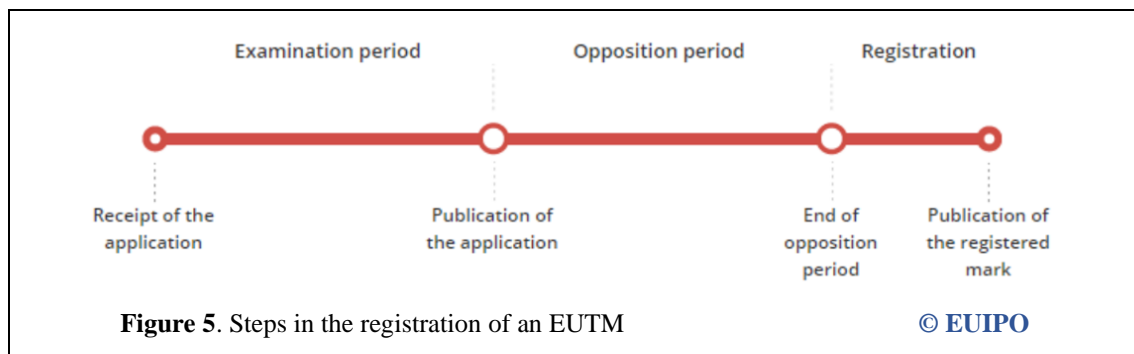
⁶¹ Article 7(1)(m) EUTMR. This provision is subject to detailed analysis in *Section 6.1.* of this thesis.

⁶² Article 44(1) EUTMR. Where an application is finally rejected or withdrawn, it may be converted into national applications (except in those country or countries where grounds for refusal apply), which retain the date of filing before EUIPO [Article 139(1)(a) EUTMR]. The same conversion process can be requested for EUTM registrations which have ceased to have effect [Article 139(1)(b) EUTMR].

⁶³ Article 45 EUTMR.

EUTM application within three months of the cited publication, invoking the application of any of the relative grounds for refusal (of the concerned EUTM application) set out in Article 8 EUTMR.⁶⁴ An opposition fee must as well be paid.⁶⁵ Once the adversarial proceedings begin, EUIPO invites the parties, as often as necessary, to file observations.⁶⁶ It is then for the Opposition Division of EUIPO to conduct an overall assessment where all relevant elements in the case are taken into consideration.⁶⁷

If no opposition arises or if the opposition proceedings are concluded without rejection of the application, the EUTM applied for is successfully registered, and the registration published.⁶⁸ EUIPO issues a certificate of registration for the EUTM titleholder.⁶⁹



⁶⁴ Article 46 EUTMR.

⁶⁵ Article 46(3) EUTMR. In accordance with Annex I to the EUTMR, this fee is fixed at EUR 320. When an opposition action is found admissible, EUIPO sends a notification to the parties to that effect. EUIPO also informs the parties that the adversarial part of the proceedings is deemed to commence two months after receipt of the notification. This two-month period serves as a so-called ‘cooling-off’ period before commencement of the adversarial part of the proceedings. During this period, the parties are encouraged to negotiate an agreement in order to settle the opposition amicably. Where this is the case and if certain conditions are met, the opposition fee will be refunded. The cooling-off period may be extended up to a total of 24 months if both parties submit requests for an extension before the period expires. Where the parties do not resolve the conflict, the adversarial process is opened, with the Opposition Division of EUIPO as arbitrator [EUIPO Guidelines for Examination of European Union Trademarks, Part C (Opposition), Section 1 (Opposition Proceedings), Chapter 3, *Cooling-off Period* (February 2020)].

⁶⁶ Article 47(1) EUTMR. Pursuant to Article 47(2) EUTMR, “if the applicant so requests, the proprietor of an earlier EU trade mark who has given notice of opposition shall furnish proof that, during the five-year period preceding the date of filing or the date of priority of the EU trade mark application, the earlier EU trade mark has been put to genuine use in the Union in connection with the goods or services in respect of which it is registered”.

⁶⁷ TMs are regarded as a whole, namely, in the way in which an average consumer would see them. EUIPO examines the degree of aural, visual and conceptual similarity between the confronted signs. Attention is drawn to the inherent or acquired distinctiveness of the sign is taken into account, as well as to the dominant and distinctive components of the sign [*Picasso v OHIM* (C-361/04) [2006] ECLI:EU:C:2006:25; and *Sabel v Puma* (C-251/95) [1997], ECLI:EU:C:1997:528]. The goods and/or services in respect of which the confronted signs have been applied for are also compared, where all the relevant factors should be taken into consideration. These include, amongst others, their nature, their end users, their method of use and method of distribution, and whether they are in competition with each other or they are complementary [*Canon Kabushiki v Metro-Goldwyn-Mayer* (C-39/97) [1998], ECLI:EU:C:1998:442, paragraph 17; *Ampafrance (monBeBé)* (T-164/03) [2005], ECLI:EU:T:2005:140, paragraph 53]. The “interdependency principle” is applied in the overall assessment: for example, a high degree of similarity between the signs may be offset by a low degree of similarity between the confronted goods and/or services.

⁶⁸ Article 51(1) EUTMR.

⁶⁹ Article 51(2) EUTMR.

15. EUTM Registrations are valid for ten years,⁷⁰ and can be renewed indefinitely for further periods of ten years, subject each time to the payment of a fee.⁷¹

Registered EUTMs can be subject to cancellation by revocation⁷² or invalidity.⁷³ Actions may be brought on application to EUIPO, or as a counterclaim in infringement proceedings before an EUTM-specialised court.

16. Decisions taken by the EUIPO Examination, Opposition and Cancellation Divisions, are subject to appeal before the Boards of Appeal of the EUIPO,⁷⁴ which are bodies of a quasi-judicial nature.⁷⁵ In deciding, the concerned Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.⁷⁶

The decisions adopted by the Boards of Appeal can be further appealed before the General Court,⁷⁷ which has jurisdiction to annul or alter the contested decision, and then in second instance on points of law to the Court of Justice of the European Union (henceforth, “CJEU”).⁷⁸

⁷⁰ Article 52 EUTMR. The date of registration is the date of filing of the EUTM application.

⁷¹ Article 53 EUTMR. In accordance with Annex I to the EUTMR, the basic fee for the renewal of an individual EU trade mark by electronic means amounts to EUR 850 (EUR 1000 if request filed in paper).

⁷² Article 58 EUTMR. The invocable grounds for revocation actions are absence of genuine use and development of the EUTM into a generic designation or into a deceptive indication [Article 58(1)(a)(b) and (c) EUTMR]. Where an EUTM is revoked, the EUTM is deemed as not to have had effects as from the date of the application for revocation (or of the counterclaim) [Article 62(1) EUTMR].

⁷³ Articles 59 and 60 EUTMR. The grounds for invalidity actions that can be claimed embrace all absolute and relative grounds which lead to refusal of registration, as well as other earlier rights in conflict with the registered EUTM [Article 60(2) EUTMR]. Moreover, bad faith from the part of the applicant at the time of filing the controverted EUTM application constitutes a ground for invalidity [Article 59(1)(b) EUTMR]. Where an EUTM is declared invalid, the consequence is that such EUTM is deemed as not to have had effects as from the outset [Article 62(2) EUTMR].

⁷⁴ Article 66 EUTMR. The notice of appeal must be filed in writing within two months of the date of notification of the decision, and the written statement setting out the grounds of appeal within four months of the same date [Article 68(1) EUTMR]. An appeal fee of EUR 720 must be paid (Annex I to the EUTMR).

⁷⁵ There are five Boards of Appeal, four of which are competent for deciding on EUTM matters and the other (Third Board) is concerned with Community design matters. The Boards of Appeal are governed by a President and each Board is also directed by an appointed Chairperson. The President of the Boards of Appeal and all members of the Boards must be independent. In their decisions, they shall not be bound by any instructions [166(7) EUTMR]. Decisions of the Boards of Appeal are taken by three members, at least two of whom are legally qualified. In certain specific cases, decisions are taken by the Grand Board chaired by the President of the Boards of Appeal or by a single member, who must be legally qualified (Article 165 EUTMR).

⁷⁶ Article 71(1) EUTMR. In the latter case, the concerned department is bound by the ratio decidendi of the Board of Appeal [Article 71(2) EUTMR].

⁷⁷ The appeals must be filed within two months of the date of decision of the Board of Appeal. They may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the TFEU, infringement of the EUTMR or of any rule of law relating to their application or misuse of power (Article 72 EUTMR).

⁷⁸ The Protocol on the Statute of the CJEU and the Rules of Procedure of the CJEU were last amended on 1 May 2019, and one of the novelties introduced is that now appeals brought against a decision of the General Court concerning a decision of a Board of Appeal of EUIPO will not proceed unless the CJEU first

17. By virtue of Article 9(2) EUTMR, the titleholder of an EUTM obtains the exclusive right to use the EUTM in the course of trade and is entitled to prevent all third parties not having his/her consent from using in the course of trade:

- any sign which is identical with the EUTM in relation to goods or services which are identical with those for which the EUTM is registered (double-identity);
- any sign where, because of its identity with, or similarity to, the registered EUTM, and the identity or similarity of the goods or services covered by said EUTM and the sign, there exists a likelihood of confusion on the part of the public.⁷⁹ Accordingly, under Article 9(3) EUTMR, the following acts may be prohibited by the titleholder:

- (a) affixing the sign to the goods or to the packaging of those goods;
- (b) offering the goods, putting them on the market, or stocking them for those purposes under the sign, or offering or supplying services thereunder;
- (c) importing or exporting the goods under the sign;
- (d) using the sign as a trade or company name or part of a trade or company name;
- (e) using the sign on business papers and in advertising;
- (f) using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC⁸⁰.

Enforcement actions concerning EUTMs must be brought before EUTM-specialised courts,⁸¹ which are national courts designated by the Member States to handle cases concerning EUTMs.⁸² The EUTM courts must apply the provisions of the EUTMR and,

decides that it should be allowed to do so. The same applies to the Boards of Appeal of three other EU Agencies, including the Community Plant Variety Office (CPVO). In those cases, according to Article 58(a) of the Statute of the CJEU, EUIPO must accompany the appeal by a request that the appeal be allowed to proceed, setting out how the issue raised by the appeal is significant to the unity, consistency or development of EU law. If there is no such request, the appeal itself will be declared inadmissible.

⁷⁹ The likelihood of confusion includes the likelihood of association between the sign and the EUTM. According to Article 9(2)(c) EUTMR, the EUTM titleholder is also entitled to prevent third parties from using the EUTM where the sign is identical with, or similar to, the EUTM, irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the EUTM is registered, where the latter has a reputation in the Union and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the EUTM.

⁸⁰ Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising.

⁸¹ Chapter X of the EUTMR is devoted to jurisdiction and procedure in legal actions relating to EUTMs. EUTM specialised courts have EU-wide competence when the case is brought in the Member State where the defendant is domiciled or established, or, failing this, where the claimant is domiciled or established. If neither claimant nor defendant are domiciled or have an establishment in the EU, the EUTM specialised court in Alicante (seat of EUIPO) is also endowed of EU-wide competence. Actions may also be brought before the courts of that Member State where acts of infringement have been committed or are threatened to be committed. In that situation the competence of the court is limited to the territory of such Member State (*forum delicti commissi*).

⁸² Article 123(1) EUTMR.

on those TM matters not covered by it as well as on procedural matters, the relevant national law must be applied.⁸³

18. Finally, at International level, applicants can turn to the Madrid System for the international registration of marks.⁸⁴ The Madrid System is legally based on the Madrid Agreement (1891) and the Madrid Protocol (1989), and is administered by the International Bureau of the World Intellectual Property Organization (henceforth, “WIPO”), with headquarters in Geneva (Switzerland).

The main advantage of the international registration route is that applicants for TMs, instead of having to file separate applications in each of the jurisdictions in which they seek protection, are able to obtain protection in any of the jurisdictions of the Members of the Madrid Union by means of a single streamlined application (for a single set of fees), which results in a bundle of TM registrations in separate national jurisdictions.⁸⁵

The EU itself is party to the Madrid Union, so EUIPO can thus act as Office of Origin where an international application is based on an EUTM, or as Designated Office if the EU is being designated in an international application originating elsewhere.⁸⁶

⁸³ Article 129 EUTMR.

⁸⁴ Applicants for TMs must have their business in, be domiciled in, or be nationals of a Contracting Party to the Madrid Union. The Madrid Union is made up of Contracting Parties to the Madrid Agreement and the Madrid Protocol. As of 12 October 2020, the Madrid Union counts on 107 Members, covering 123 countries [See “List of Members to the Madrid Protocol”, WIPO Official website, available at <https://bit.ly/3rYUcco> [Accessed: 6 November 2020]].

⁸⁵ An international registration requesting protection in several Members of the Madrid Union must be based on an application or registration of the same TM in one of the Members of the Madrid Union and must be filed through the Office of origin. The Office of origin then submits the international application to the International Bureau of WIPO. WIPO examines only the formalities of the international application and if these are respected, notifies the Office of the Members designated in the application. Each national Office designates examines the substance of the application as if it had been filed directly in that country (principle of national treatment). An international TM so registered is equivalent to a registration of the same TM effected directly in each of the countries designated [See “How to Monitor your International Application”, WIPO Official website, available at <https://bit.ly/2MFWH3f> [Accessed: 6 November 2020]].

⁸⁶ By designating the EU in an international application, an applicant can obtain protection with the same effects as those arising from a direct EUTM application.

3.2.A Glimpse into the Community (EU) Plant Variety Rights' System⁸⁷

19. The Community Plant Variety Rights' system (henceforth, "CPVR system") is a *sui generis* system for the industrial protection of plant varieties in the EU. It was established by Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights (henceforth, "CPVRR")⁸⁸ as "the sole and exclusive form of Community (EU) industrial property rights for plant variety rights (henceforth, "CPVRs")."⁸⁹ The CPVR system coexists with the national systems for the protection of plant varieties of EU Member States.⁹⁰ In addition, the EU as such joined UPOV as member in 2005, the UPOV Convention becoming since then part of the *acquis communautaire*.

The CPVR system is managed by the Community Plant Variety Office (henceforth, "CPVO"), established for such purpose and operational since 1995. The CPVO is an official agency of the European Union, with seat in Angers (France), independent legal status and fully self-financed.⁹¹ It is governed by its President, who is appointed by the Administrative Council of the CPVO (henceforth, "AC").⁹²

The CPVO is responsible for the granting and the managing of titles for the legal protection of CPVRs.⁹³ These titles are valid and enforceable throughout the totality of the EU territory (principle of unitary character).⁹⁴ The subject matter of a CPVR title is a plant variety, where "variety", within the meaning of the CPVRR, is understood as "a plant grouping within a single botanical taxon of the lowest known rank".⁹⁵

⁸⁷ For an exhaustive analysis of the CPVR system, see Gert Würtenberger, Martin Ekvad, Paul van der Kooij, and Bart Kiewiet; *European Union Plant Variety Protection*. (2015). Oxford Univ. Press (2nd Ed.).

⁸⁸ The main legal basis for the CPVR system is the CPVRR. The substantive part of the CPVRR models on the UPOV Convention. Three implementing regulations of the European Commission develop certain provisions of the CPVRR. These are Regulation No 874/2009 on proceedings before the CPVO; Regulation No 1238/95 on fees payable to the CPVO; and Regulation No 1768/95 on the agricultural exemption.

⁸⁹ Article 1 CPVRR.

⁹⁰ These systems are not harmonised and they are each based on a different version of the UPOV Convention. Not all EU Member States foresee a national system for the legal protection of plant varieties: Cyprus, Greece, Malta and Luxembourg have not adopted plant variety rights' legislation. The remaining twenty-three EU Member States are members to UPOV and have their own plant variety rights' system.

⁹¹ The mission of the CPVO is "to deliver and promote an efficient Intellectual Property Rights system that supports the creation of new plant varieties for the benefit of Society". The statement is available on the official website of the CPVO and can be accessed at <https://bit.ly/2U4n8Qn> [Accessed: 6 November 2020].

⁹² The CPVO also has a Vice-President and a Senior Adviser. The AC is made up of representatives of the EU Member States, a representative of the European Commission and the Observer Members. The AC is also responsible for the monitoring of the CPVO, the approval of the CPVO Budget, and the entrustment of the CPVO Examination Offices, amongst others.

⁹³ In its 25 years-lifetime, the CPVO has processed more than 70.000 applications and granted more than 55.000 CPVR titles, of which more than 28.000 remain in force [Rachel Wakefield, CPVO celebrates its Silver Jubilee. (2020) *FloraCulture International* (AIPH), p. 22].

⁹⁴ Article 2 CPVRR.

⁹⁵ Pursuant to Article 5(2) CPVRR, a variety is defined as "a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a breeder's



Figure 6. Picture of the premises of the CPVO

© CPVO

The hierarchy of taxonomic classes of plants runs as follows, in descending order: Kingdom, Division, Class, Order, Family, Genus, Species and Varieties (i.e.: each variety belongs to a species, each species to a genus, each genus to a family, etc.). Varieties of all botanical genera and species may be protected by a CPVR, including, inter alia, hybrids between genera or species.⁹⁶



Figure 7. Graphic representation of plant taxonomy: Kingdom, Species, Varieties

20. Any physical and legal person whose domicile or headquarters is located in the EU can apply for a CPVR title before the CPVO;⁹⁷ and the person entitled to the CPVR is the person who bred, or discovered and developed the variety (or his successor in title).⁹⁸

right are fully met, can be: i) defined by the expression of the characteristics resulting from a given genotype or combination of genotypes; ii) distinguished from any other plant grouping by the expression of at least one of the said characteristics; and iii) considered as a unit with regard to its suitability for being propagated unchanged". The term "variety" is also referred to as "cultivar" by botanical and taxonomic experts.

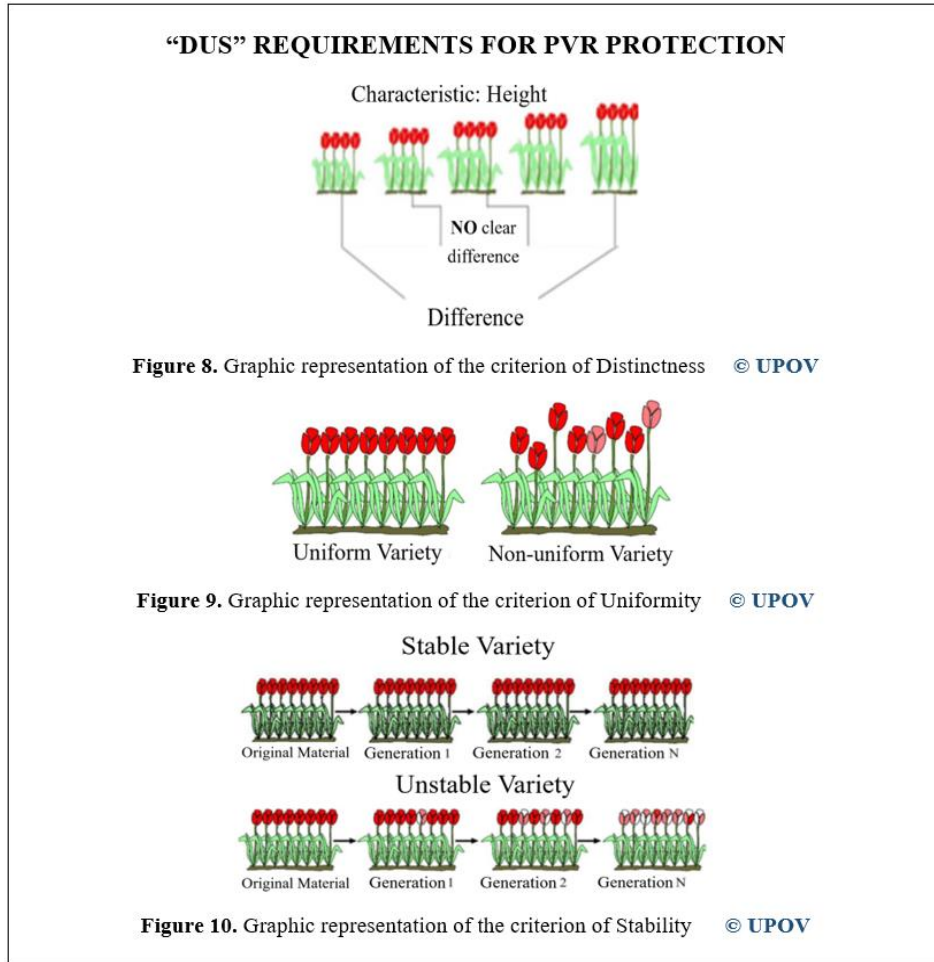
⁹⁶ Article 5(1) CPVRR. Since its inception, the CPVO has received applications for more than 1900 species.

⁹⁷ Articles 12 and 49 CPVRR. A claim of priority can be made in the application. Pursuant to Article 52(2) CPVRR, if the applicant has already applied for a property right for the variety in an EU Member State or UPOV Member, and the date of application is within 12 months of the filing of the earlier application, the applicant shall enjoy a right of priority as regards the application for the CPVR, provided the earlier application still exists on the date of application.

⁹⁸ Article 11(1) CPVRR. According to the second indent of this same article, if two or more persons bred, or discovered and developed the variety jointly, the entitlement shall be vested jointly in them or their respective successors in title.

In order to be eligible for CPVR protection, a variety must fulfil the following conditions:⁹⁹

- Distinctness,¹⁰⁰ Uniformity,¹⁰¹ and Stability¹⁰² (known as “DUS requirements”);
- Novelty;¹⁰³
- The designation of a suitable PVD.¹⁰⁴



⁹⁹ Article 6 CPVRR.

¹⁰⁰ By virtue of Article 7 CPVRR, a variety shall be deemed to be distinct if it is clearly distinguishable by reference to the expression of the characteristics that results from a particular genotype from any other variety whose existence is a matter of common knowledge on the date of the application.

¹⁰¹ By virtue of Article 8 CPVRR, a variety shall be uniform if it is sufficiently uniform in the expression of its characteristics (as established in the variety description).

¹⁰² By virtue of Article 9 CPVRR, a variety shall be deemed to be stable if the expression of the characteristics (as established in the variety description) remains unchanged after successive propagations or multiplications or, in the case of a particular cycle of propagation, at the end of each such cycle.

¹⁰³ By virtue of Article 10 CPVRR, a variety shall be deemed new if, at the date of application, variety constituents or harvested material of the variety have not been sold, or otherwise disposed of to others, by or with the consent of the breeder for the purposes of the exploitation of the variety:

- i) earlier than one year before the application date, within the EU territory; or
- ii) earlier than four years (six years in the case of trees or of vines) before the application date, outside the EU territory.

The notion of “novelty” under the CPVRR is understood as “commercial novelty”, that is, the concept is linked to the availability of the plant material on the market for commercial exploitation purposes.

¹⁰⁴ Article 63 CPVRR.

Regarding the PVD, it is for the applicant to propose one and for the CPVO to assess the suitability of the proposal.¹⁰⁵ The proposal for a PVD can, but needs not, be submitted at the time of the CPVR application, albeit a “provisional designation” serving as reference does need to be submitted already at the application stage.¹⁰⁶ The proposal must in any case be filed with the CPVO before the results of the technical examination of the variety concerned (below-described) are received by the CPVO. The designation of a suitable PVD for a plant variety is *conditio sine qua non* for the successful grant of a CPVR title.¹⁰⁷

An application for a CPVR is subject to the payment of the established application fee¹⁰⁸ and to a triple-fold examination:

- Formal examination;¹⁰⁹
- Substantive examination;¹¹⁰ and
- Technical examination.¹¹¹

The formal examination revolves around the purely formal aspects of the application, and the substantive examination is aimed at the verification of fulfilment of the required conditions relating to entitlement, novelty, and assignation of a PVD. Both examinations are carried out by the CPVO itself. As for the technical examination, the CPVO delegates this exam in a decentralised manner in the Examination Offices, which are entrusted by the AC and altogether constitute a network of offices distributed throughout the territory of the EU. The technical examination serves to verify that the plant variety at stake meets the DUS requirements.¹¹² The evaluations can take up to several years, depending on the

¹⁰⁵ Article 50(3) CPVRR. The CPVO assesses over 11.000 PVDs per year! Benedicte Legrand (Variety Denomination expert), Recorded Webinar ‘The name of a plant variety in the Community plant variety right system’. (2019) *EUIPO Academy*, available at <https://bit.ly/387vUVU> [Accessed: 6 November 2020].

¹⁰⁶ See the CPVO “Notes for applicants”, which contain useful guidance on how to submit an application for a CPVR. They are available at <https://bit.ly/2UbnV1P> [Accessed: 6 November 2020]. If submitted later on, the PVD must be proposed by using the form “Proposal for a variety denomination”. The form is available in all the EU languages on the CPVO website at <https://bit.ly/3o8mwa0> [Accessed: 6 November 2020]. The form must include the following elements: name and address of applicant, provisional PVD, botanical taxon, file number, and an indication on whether the PVD constitutes fancy name or a code. Preceding PVD proposals for entry or PVDs entered in an official register in an EU Member State or UPOV Member must be declared. If applicable, the applicant must declare whether the proposed PVD has been filed by or registered as a TM in the EU, UPOV Member, or with the International Bureau of WIPO in respect of products that are identical or similar (to the variety) within the meaning of TMR law.

¹⁰⁶ Pursuant to Article 21(2)(b) CPVRR, a CPVR will be cancelled by the CPVO if the holder of that right fails to propose a suitable PVD. See also Articles 20(3) and 22(1)(b)(iii) UPOV Convention.

¹⁰⁷ Pursuant to Article 21(2)(b) CPVRR, a CPVR will be cancelled by the CPVO if the holder of that right fails to propose a suitable PVD. See also Articles 20(3) and 22(1)(b)(iii) UPOV Convention.

¹⁰⁸ Article 113(2) CPVRR and Article 7 Fees’ Regulation. The (online) application fee is set at EUR 450.

¹⁰⁹ Article 53 CPVRR.

¹¹⁰ Article 54 CPVRR.

¹¹¹ Article 55 CPVRR. Fees for arranging and carrying out the technical examination of a variety are due.

¹¹² The Examination Offices are bound in their examinations by “Technical Protocols”, enacted by the AC (Article 56 CPVRR). The Protocols are available at <https://bit.ly/3sEFiZc> [Accessed: 6 November 2020].

species analysed, and conclude with a technical report issued by the Examination Office concerned, which can be positive (if the DUS requirements are met) or negative (if the cited requirements are not met). If the application succeeds all the examinations, the CPVR title is granted and published, along with an official description of the variety.¹¹³ It is noted that between the time of publication of the application for a CPVR and the grant of the title thereof, objections may be lodged with the CPVO by any person.¹¹⁴

21. Once granted, the CPVR title is valid for a term of 25 years (30 in the case of vine, potato and tree varieties) following the year of the grant.¹¹⁵ Granted CPVRs can be subject to nullity¹¹⁶ or cancellation¹¹⁷ actions before the CPVO. Decisions of the CPVO can in turn be appealed before the Board of Appeal of the CPVO.¹¹⁸

Pursuant to Article 13 CPVRR,¹¹⁹ the CPVR titleholder is endowed with the exclusive right [in respect of variety constituents¹²⁰ or harvested material¹²¹ of the variety protected by the CPVR] to authorise or prohibit the following acts:

- a) production or reproduction (multiplication);
- b) conditioning for the purpose of propagation;
- c) offering for sale;
- d) selling;
- e) exporting from the EU
- f) importing to the EU;
- g) stocking for any of the cited acts.

¹¹³ Article 62 CPVRR. If the application does not succeed the examinations, the CPVR title cannot be granted (Article 61 CPVRR).

¹¹⁴ Article 59 CPVRR. It must be remarked that, by virtue of Article 95 CPVRR, provisional protection is foreseen for the period running from the publication of the application until the time of the CPVR grant.

¹¹⁵ Article 19 CPVRR. An annual fee of EUR 330 must be paid yearly for the CPVR title to be maintained.

¹¹⁶ Article 20 CPVRR. If the action prospers, the CPVR title is declared null and void (*ex tunc* effects).

¹¹⁷ Article 21 CPVRR. If the action prospers, the CPVR title is cancelled (with effect *in futurum*).

¹¹⁸ Just like under the EU TM system, decisions of the Board of Appeal of the CPVO are appellable before the General Court, and as last instance (on points of law) before the CJEU.

¹¹⁹ The exclusive right granted are however subject to the limitations enshrined in Articles 14 (“agricultural exemption) and 15 CPVRR. Particularly relevant is the so-called “breeder exemption” enshrined in Article 15(c) CPVRR, according to which the scope of the CPVR does not extend to “acts done for the purpose of breeding, or discovering and developing other varieties.”

¹²⁰ By virtue of Article 5(3) CPVRR, “variety constituents” are understood as “a plant grouping consisting of entire plants or parts of plants as far as such parts are capable of producing entire plants”. In simpler terms: propagating material such as seeds or vegetative parts intended for the production of specific plants.

¹²¹ In what concerns harvested material of the protected variety and pursuant to Article 13(3) CPVRR, the exclusive right of the CPVR titleholder applies only if the material was obtained through the unauthorised use of variety constituents of the protected variety, and unless the holder has had reasonable opportunity to exercise his right in relation to the said variety constituents. The CJEU has recently shed light on the interpretation of this article in *Club de Variedades Vegetales Protegidas* (C-176/18) of December 2019.

CPVR titleholders can enforce their rights against infringing actions concerning their protected variety or the PVD thereof by suing an infringer to enjoin the infringement or to pay reasonable compensation or both.¹²² Provisional protection is also recognised during the time lapsing between the publication of the application for a CPVR and the grant thereof, time during which reasonable compensation may be claimed.¹²³ Jurisdiction in legal actions relating to civil law claims concerning CPVR titles lies with the national courts of the Member States.¹²⁴ The competent courts have jurisdiction in respect of infringements alleged to have been committed in any of the Member States.¹²⁵

22. Having explored both the TMR and the PVR EU systems in a nutshell, the following table summarises side-by-side the most characteristic features of both TMRs and PVRs.

	INTELLECTUAL PROPERTY RIGHT	
CHARACTERISTICS	TRADEMARK RIGHT	PLANT VARIETY RIGHT
Time from application for right until grant thereof	A few months	Can take several years depending on the species
Material Scope of protection	Wider perimeter of protection: Possible registration for several Nice Classes + enforceable against identical/similar TMs	Protection against unauthorised propagation of variety constituents (and of harvested material of the protected variety, subject to the fulfilment of requirements laid down in Article 13 CPVRR)
Geographical Scope of protection (Global view)	Wider (many Contracting Parties to the Madrid system, streamlined application process)	More limited (costly to protect in many countries + not all have PVR legislation)
Term of protection	Possible indefinite term (as long as “proper usage”)	Limited term: from 20 to 30 years depending on country

¹²² Article 94 CPVRR. The possibility to launch infringement actions is time-barred in accordance with the deadlines established in Article 96 CPVRR.

¹²³ Article 95 CPVRR. In *Club de Variedades Vegetales Protegidas*, the CJEU has made clear that this provisional protection must be regarded as a mere compensatory mechanism scheme, as opposed to the proper enforcement remedy recognised in Article 94 CPVRR, once the CPVR title has been granted.

¹²⁴ The basic conditions regarding civil claims, infringements and jurisdiction are set out in Articles 94 to 107 CPVRR. The provisions of Directive 2004/48/EC on the enforcement of IPRs are complementary to those in the CPVRR concerning enforcement.

¹²⁵ Article 101 CPVRR. The competent courts must apply the rules of procedure of the relevant State governing the same type of action relating to corresponding national property rights (Article 103 CPVRR).

4. Legal Nature and Functions of the Plant Variety Denomination

4.1. Legal Nature of the Plant Variety Denomination

23. As already exposed, a variety to be protected by a PVR must be designated by a unique denomination which will become its generic designation.¹²⁶ A novel plant variety is thereby christened with a name (product-name) serving an identification-function whereby a specific plant variety can be distinguished from others.¹²⁷

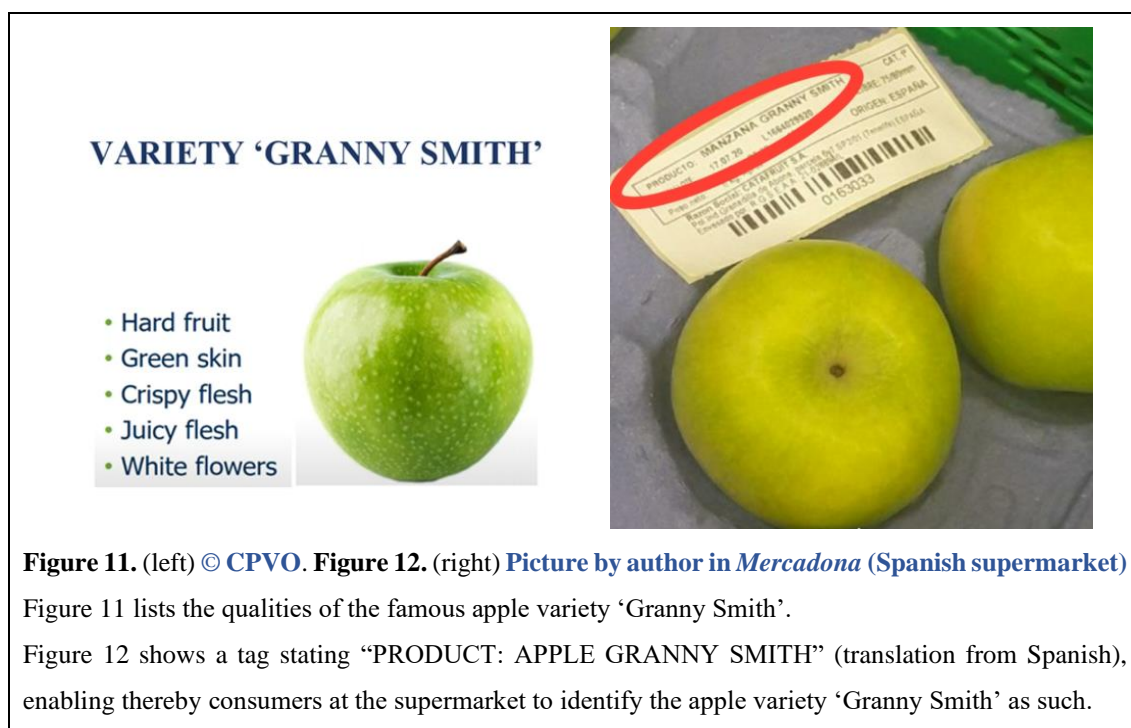


Figure 11. (left) © CPVO. **Figure 12.** (right) Picture by author in Mercadona (Spanish supermarket)

Figure 11 lists the qualities of the famous apple variety 'Granny Smith'.

Figure 12 shows a tag stating "PRODUCT: APPLE GRANNY SMITH" (translation from Spanish), enabling thereby consumers at the supermarket to identify the apple variety 'Granny Smith' as such.

According to the UPOV Convention, a variety must be submitted to all UPOV Members under the same PVD.¹²⁸ The authority of each UPOV Member must register the PVD so submitted, unless it considers the PVD unsuitable within its territory pursuant to national law. If such is the case, the breeder is required to submit another proposal for a PVD.

The use of the designated PVD is mandatory for any person who offers or disposes of to others for commercial purposes variety constituents of a protected variety, this requirement applying even after the expiration of the breeder's right in that variety.¹²⁹

¹²⁶ Article 20(1)(a) UPOV Convention.

¹²⁷ Brad Sherman, *Taxonomic Property*. (2018) Cambridge Law Journal, Vol. 67, Issue 3, p. 573.

¹²⁸ Article 20(5) UPOV Convention.

¹²⁹ Article 20(7) UPOV Convention, Article 17(1) CPVRR. The use of the PVD is only obligatory in respect of the propagating material, and not in respect of harvested products to be sold to consumers (e.g.: cut flowers or fruits). Article 17(2) CPVRR foresees however that "any person effecting such acts in respect of any other material of the variety, must inform of that denomination in accordance with other provisions

The mandatory use of the PVD contributes to the regulation of the market and the safety of transactions in the agricultural and food sector, preventing counterfeiting and any potential misleading of the public.¹³⁰ At EU level, the titleholder of a CPVR is entitled to claim injunctive relief and compensation from a third party not using the PVD correctly.¹³¹ Moreover, nor the CPVR titleholder him/herself nor third parties shall hamper, by means of a right granted in respect of a designation that is identical with the PVD (e.g.: a TMR), the free use of the PVD in connection with the variety in question.¹³² An exception to this rule is foreseen: third parties may hamper the free use of a PVD if their [conflicting] right was granted prior to the PVD proposal.¹³³ This marks a distinction between third parties and the CPVR titleholder: whereas the “use-hampering” prohibition is absolute for the latter,¹³⁴ for third parties the date of grant of the earlier right is determinant to escape the “use-hampering” prohibition.

24. Five fundamental assertions on the legal nature of a PVD can be extracted from the above-exhibited provisions:

- i) The PVD should not be regarded as a right, but rather as a legal construct entailing an obligation of use that binds not just the concerned PVR titleholder but also third parties (personal element);¹³⁵
- ii) The registered PVD is related to, but independent from the PVR: the PVD is somehow “taken out of the hands of the breeder” and, from then onwards, it is associated not with the rights of said breeder, but with the existence of the variety (independency element);¹³⁶

in law or if a request is made by an authority, by the purchaser or by any other person having a legitimate interest”. The expression “any other material of the variety” can be seen as covering harvested material, the door being thus opened to making mandatory, where appropriate, informing about PVDs in regard of such material, pursuant to other provisions in law or on request by the cited actors.

¹³⁰ EUIPO Guidelines for Examination of European Union Trademarks, Part B (Examination), Section 4 (Absolute Grounds for Refusal), Chapter 13, *Trademarks in conflict with earlier Plant Variety Denominations [Article 7(1)(m) EUTMR]* (February 2020), available at <https://bit.ly/2JPtUHZ> [Accessed: 6 November 2020]. *See also* EUIPO’s decision *Ruby* (application No 016922791) [2018], p. 2.

¹³¹ Article 94(1)(b) CPVRR. This provision covers breaches of Article 17(1) and (2) CPVRR.

¹³² Article 20(1)(b) UPOV Convention, Article 18(1) and (2) CPVRR.

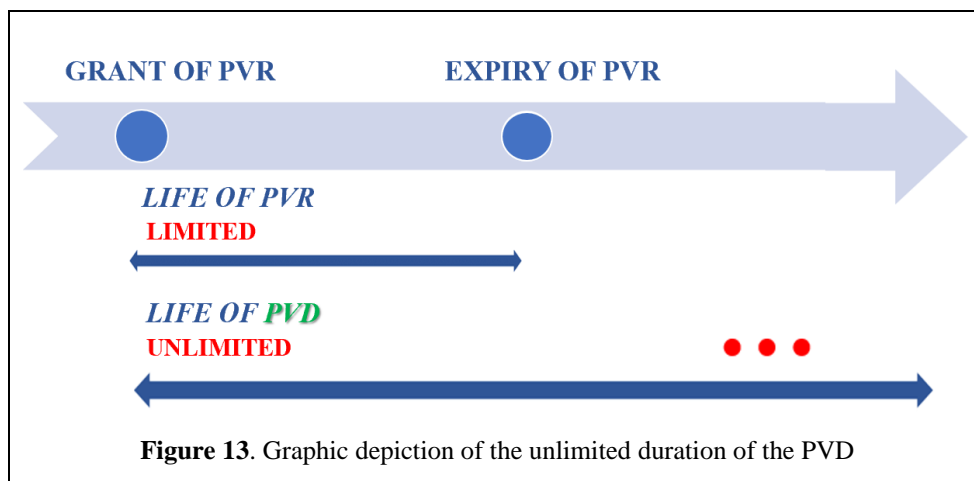
¹³³ Article 18(2) CPVRR.

¹³⁴ This prohibition is commonly known as the “enforcement ban”, and is understood as restricting the rights of a person who simultaneously enjoys protection in respect of a name that is identically protected as PVD and as another right such as a TM.

¹³⁵ According to Dr. Hildebrandt: “The PVD is more of a regulatory instrument than an IP right” [Ulrich Hildebrandt, *Marken und andere Kennzeichen: Handbuch für die Praxis. [Trade marks and other signs]*. Carl Heymanns (2015, 3d Ed.), paragraph 33].

¹³⁶ U. Löscher, *Variety Denomination according to Plant Breeders’ Rights*. (1986) *Acta Horticulturae* 182, p. 60.

- iii) The PVD is destined to become the generic designation of the concerned variety not just during the period of PVR-protection, but also after the expiration of such protection, that is, it outlives the PVR (temporary element);
- iv) While PVRs are primarily intended to benefit the breeder, the PVD serves the public interest of enabling the identification of plant varieties by users (teleological element);¹³⁷
- v) Regardless of the country of registration of the PVR to which it is associated (and the corresponding territorial scope of protection of such PVR), the PVD deploys international effects. This is quite a peculiar feature, underlining how globalisation and trade-market realities shape the IP-related and regulatory landscape (universality element).



4.2.Functions of a Plant Variety Denomination: Comparative Study with Trade Marks

25. It has been made clear that the pivotal function performed by a PVD consists in the generic designation of a concrete plant variety. Besides, PVDs can also perform other functions, and it is interesting to delve into such in parallel with those functions that TMs can perform, in order to draw analogies and dissimilarities between such.

To this end, the analysis begins with a commentary on the different functions that a TM is capable of performing. The recognition of these functions has mostly been shaped by jurisprudential developments and constitutes an interesting referential point from which to identify and compare the functions of PVDs.

¹³⁷ U. Löscher, Variety Denomination according to Plant Breeders' Rights. (1986) *Acta Horticulturae* 182, p. 60.

26. At the outset, it must be noted that the very nature of a TM is dictated by its ability to identify the origin of a product or service from a specific undertaking.¹³⁸ This means that, while the protection underlying other IPRs (such as copyrights or patents) lies on the object itself (e.g.: the work, the invention), TMRs concern the manner in which signs are used to designate commercial objects.¹³⁹ TMR protection is thus not related to what TMs are, but to what they do: it is a functions-based type of protection.¹⁴⁰ This surely explains the extensive academic and jurisprudential interest that TM-functions have sparked.

The essential function of a TM is the so-called “origin function”, namely, the function of guaranteeing that goods or services bearing a registered mark have been placed on the market with the authority of the proprietor.¹⁴¹ A TM distinguishes goods or services from a particular undertaking from those of other undertakings,¹⁴² and a TMR titleholder is thus entitled to prevent other traders from using signs that are likely to cause confusion with his/hers and thereby harm the source-identifier function of the TM.

The CJEU has been expanding the scope of protection conferred to the TMR titleholder far beyond that provided by the “origin function”, arguably exceeding the original aim of the EU legislator. In *L’Oréal v Bellure*, the CJEU established that the functions protected under a TMR include “not only the essential function of the trade mark [...], but also its other functions, in particular that of guaranteeing the quality of the goods or services in

¹³⁸ Slides for presentation by Prof. Dr. Marie-Christine Janssens during her course of “International and European Union Trade Mark Law” (LL.M. in Intellectual Property and ICT Law of KULeuven). The CJEU has switched, in its interpretation of the TM-functions, from a merely deception-based approach, where the scrutiny in cases of infringement of TMRs revolved exclusively around the origin function of a TM, to a property-based approach that covers also other TM-functions.

¹³⁹ Annette Kur, Trademark Functions in European Union Law. (2019) *Max Planck Institute for Innovation and Competition Research Paper No. 19-06*, available at SSRN, p. 2.

¹⁴⁰ Annette Kur, Trademark Functions in European Union Law. (2019) *Max Planck Institute for Innovation and Competition Research Paper No. 19-06*, available at SSRN, p. 2.

¹⁴¹ In *Hoffman-La Roche*, the CJEU held that “the essential function of the trade-mark [...] is to guarantee the identity of the origin of the trade-marked product to the consumer or ultimate user, by enabling him without any possibility of confusion to distinguish that product from products which have another origin. This guarantee of origin means that the consumer or ultimate user can be certain that a trade-marked product which is sold to him has not been subject at a previous stage of marketing to interference by a third person, without the authorization of the proprietor of the trade-mark, such as to affect the original condition of the product. The right attributed to the proprietor of preventing any use of the trade-mark which is likely to impair the guarantee of origin so understood is therefore part of the specific subject-matter of the trademark right” [*Hoffman-La Roche v Centrafarm* (C-102/77) [1978], ECLI:EU:C:1978:108, paragraph 7; *Arsenal Football Club* (C-206/01) [2002], ECLI:EU:C:2002:651, paragraph 51; Recital 16 of the Preamble to the TMR Directive].

¹⁴² Articles 3(a) TMD and 4(a) EUTMR. The CJEU has held that the essential function of TMs has been incorporated by the Community legislature into Article 3(a) TMD [*Merz & Krell* (C-517/99) [2001] ECLI:EU:C:2001:510, paragraph 23].

question and those of communication, investment or advertising”.¹⁴³ The cited functions merit being scrutinised one by one as follows:

Quality-Assurance function. In *SA-CNL*, the CJEU observed that an undertaking should be in a position to keep its customers by virtue of the quality of its products or services, something which is possible only if there are distinctive marks which enable customers to identify products and services.¹⁴⁴ For the TM to be able to fulfil its role, it must offer a guarantee that all goods bearing it have been produced under the control of a single undertaking which is accountable for their quality. In what concerns particularly luxury goods, the CJEU held in *Copad* that quality is not confined to the physical or material characteristics of such goods, but must be seen as including also an aura of luxury.¹⁴⁵

Communication function. A TM can convey to consumers various kinds of information about the goods identified by it. In *L’Oréal v Bellure*, the Advocate General Mengozzi conceived the communication function as encompassing “informative advertising and communications that cultivate an image of the product (such as quality, trustworthiness, reliability, luxury, strength)”.¹⁴⁶

Advertising function. The advertising function of a TM refers to those uses for advertising purposes, which are designed to inform and persuade consumers.¹⁴⁷ The TM can thereby play a prominent role in sales promotion or in commercial strategies.

Investment function. The investment function concerns those uses of the TM by its titleholder to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty.¹⁴⁸

Finally, TMs can even evoke a sense of belonging in their minds.¹⁴⁹ In addition, the list of functions of a TM must be envisaged as a *numerus apertus* list, as further functions may be recognised in the future.

¹⁴³ *L’Oréal v Bellure* (C-487/07) [2009], ECLI:EU:C:2009:378, paragraph 58; Opinion of Advocate General F.G. Jacobs in *Hölterhoff v Freiesleben* (C-2/00) [2001], ECLI:EU:C:2001:468, paragraphs 43-44.

¹⁴⁴ *SA-CNL SUCAL v HAG* (C-10/89) [1990] ECLI:EU:C:1990:359, paragraph 13.

¹⁴⁵ *Copad v Christian Dior Couture et al* (C-59/08) [2009], ECLI:EU:C:2009:260, paragraph 24.

¹⁴⁶ Opinion of Advocate General Mengozzi in *L’Oréal v Bellure* (C-487/07) [2009], ECLI:EU:C:2009:70, paragraph 54.

¹⁴⁷ *Google France v. Louis Vuitton et al.* (joint cases C-236/08 to C-238/08) [2010], ECLI:EU:C:2010:159, paragraphs 91-92.

¹⁴⁸ *Interflora v Marks & Spencer* (C 323/09) [2011], ECLI:EU:C:2011:604, paragraphs 60-62. The CJEU also pointed out that, albeit the definition of investment largely overlaps with the advertising function as defined in *Google France*, it is nonetheless distinct from the latter. The CJEU explained that, when a TM is used to acquire or preserve a reputation, not only advertising is employed, but also various commercial techniques [*Interflora v Marks & Spencer* (C 323/09) [2011], ECLI:EU:C:2011:604, paragraph 61].

¹⁴⁹ *EUTM in a Nutshell (course)*, Module 1 (p. 1), EUIPO Academy Portal [Accessed: 6 November 2020].

27. When examining the functions performed by PVDs, an intrinsic differentiation with TMs must be again emphasised upon: whereas the essential function of a TM is to indicate a commercial origin, the essential function of a PVD is designating a generic product.

This notwithstanding, some analogies between them can also be observed. To begin with, both PVDs and TMs constitute relevant factors in trade, providing purchasers with the option of effectively selecting the variety with the concrete characteristics they desire.¹⁵⁰ They both assist consumers in making a choice between a range of similar products, by “communicating” with the targeted customers.

Just like TMs, PVDs can also play a role of quality-assurance, since quality is attributed to the variety that is identified by means of its denomination.¹⁵¹ This role mostly consists in indicating “true-to-type” varieties in sales, that is, in enabling consumers (such as seed propagators or growers) to know with certitude that the variety constituents that they are purchasing correspond to the specific plant variety for which they are looking. As regards the quality function performed by TMs for plant-related products, this function rather guarantees that the variety/varieties concerned meet certain quality specifications, such as specific market-differentiation attributes (e.g.: colour, size, flavour).¹⁵²

Moreover, as opposed to the PVD, which is confined exclusively to the specific variety designated, a TM may concern not just one but a whole range of plant varieties. It is possible for applicants to apply for TMs in relation to Class 31 of the Nice Classification (henceforth, “Class 31”) as a whole, the class covering plant-related products, as well as in relation to further classes of the Nice Classification (e.g.: services in Class 35).¹⁵³ In practice, breeders often take advantage of the far-reaching scope of TM-protection provided under Class 31, and an “overarching TM” is used for promoting a product-range of varieties sharing similar characteristics (e.g.: appearance, flowering times, resistance).¹⁵⁴ This brings along a number of benefits:¹⁵⁵

¹⁵⁰ U. Löscher, Variety Denomination according to Plant Breeders’ Rights. (1986) *Acta Horticulturae* 182, p. 59.

¹⁵¹ Margaret Llewelyn and Mike Adcock, *European Plant Intellectual Property*. (2016) Bloomsbury Publishing, p. 174.

¹⁵² *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 30. This is often witnessed in the apple industry, with TMs such as Pink Lady ® and Jazz ® [Maria Luisa Badenes and David H. Byrne, (2012). *Fruit Breeding*, Springer Science, p. 79].

¹⁵³ Class 31: (Natural agricultural products) Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt. The Explanatory Notes on Class 31 are available in the Official page for the Nice Classification system and can be accessed at <https://bit.ly/3k3gILW> [Accessed: 6 November 2020].

¹⁵⁴ Rose-Marie Borges, Les conditions de la coexistence d’une marque et d’une dénomination variétale. (2016) *ResearchGate*, available at <https://bit.ly/2GtN4So> [Accessed: 6 November 2020].

¹⁵⁵ Maria Luisa Badenes and David H. Byrne, *Fruit Breeding* (2012) Springer Science, p. 79.

- i) The TM is coupled with a special feature rather than with a single product;¹⁵⁶
- ii) The reputation gained with the TM is extended to several plant varieties;
- iii) The TM can outlive the commercial life span of a certain variety and be used again unlimitedly to promote new improved varieties;
- iv) Flexibility is gained for a company wishing to promote a number of early, mid, and late-season varieties under one TM to keep up with supplies of a fruit that is recognized by the user to be the same or similar in key characteristics.

PVDs can also perform advertising and investment functions. Where a variety enjoys widespread reputation, the PVD may play an important advertising role, something perfectly compatible with plant variety law.¹⁵⁷ In general, however, it is only the older varieties that are more likely to be presented with greater visibility of the PVD, due to the already built-up consumer association.¹⁵⁸

In any case, since PVRs have an expiration date, and a PVD is a generic designation to be freely used by anyone, PVR titleholders draw no strong direct commercial benefit from the consumers' association with the PVD.¹⁵⁹ TMs burst in here to bring an added value: any long-term advertisement or investment in the TM will fall back on its titleholder. For instance, varieties of "premium market value" projecting a remarkable consumer-appeal (goodwill)¹⁶⁰ are often paired with the use of a TM.¹⁶¹

However, from a competition-law standpoint, some experts have warned about the existence of a particular situation amounting to unfair practice: that where a consumer is faced with the same variety side-by-side on the retailers' shelf, where one is trademarked (marketed as "premium") whereas the other not (marketed as "generic"), and these are sold for a different price.¹⁶²

¹⁵⁶ This helps in avoiding that the TM becomes generic, an issue that will be delved into in detail later on.

¹⁵⁷ Philipp von Kapff and Francesco Mattina, Trademarks and variety denominations. (2018) *Issue No 31 on Agribusiness*, European IPR Helpdesk, p. 11.

¹⁵⁸ Newer varieties appear to struggle to attain the same levels of variety name recognition and loyalty in the market. A TM only has value if the product is presented to the buyer under such and successfully promotes brand loyalty [*Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 42].

¹⁵⁹ *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 43.

¹⁶⁰ Goodwill refers to a form of intangible property that can be defined as that "magnetism" that leads customers to return to the same business or buy the same brand.

¹⁶¹ James J. Luby, and David S. Bedford, Cultivars as Consumer Brands: Trends in Protecting and Commercializing Apple Cultivars via Intellectual Property Rights. (2015) *Crop Science*, Vol. 55, p. 2510. Some companies (mostly in the fruit sector) also opt for trademarking their company-name to commercialise their line of products (e.g.: Dole®, Driscoll's®, Tropicana®, Chiquita®).

¹⁶² *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 55.

28. By way of conclusion for this section, the divergences between the functions performed by PVDs and by TMs, respectively, is graphically summarised as follows:¹⁶³

FUNCTIONS	TRADE MARK	PLANT VARIETY DENOMINATION
Indication of Commercial Origin	Yes	No
Generic-Designation of Product	No	Yes
Quality Assurance	Yes (for meeting quality specifications, e.g.: colour or firmness of variety)	Yes (for indicating true-to-type varieties in sales)
Advertising	Yes (performed more effectively than with PVD)	Yes (for commercially successful or well-reputed/older plant varieties)
Investment	Yes (titleholder draws direct benefit)	Yes (weaker in terms of drawing commercial benefits)
Communication	Yes	Yes

¹⁶³ This table is inspired on the tables exhibited in the *Study on market-related issues regarding plant variety protection*, Deloitte for EUIPO (2016), p. 46 (Figure 22); and in James J. Luby, and David S. Bedford, *Cultivars as Consumer Brands: Trends in Protecting and Commercializing Apple Cultivars via Intellectual Property Rights*. (2015) *Crop Science*, Vol. 55, p. 2505 (Table 1).

5. Through the Prism of EU Plant Variety Rights' Law: Plant Variety Denominations and the Interface with Trade Marks

Now that the CPVR system has been introduced, along with a description of the legal nature and functions of the PVD, it is time to analyse how EU Plant Variety Law envisages the interrelation between, on the one hand, PVDs and, on the other hand, TMs. This chapter explores the EU legal framework governing the suitability of PVDs and the grounds of impediment to the registration of such, which cover earlier conflicting TMRs.

5.1. Suitability of Plant Variety Denominations in the European Union

29. Article 63 CPVRR is the backbone governing the suitability of PVDs. The effects of this provision are not merely limited to procedures within the CPVR legal framework, but also projected onto other EU norms requiring as well the registration and utilisation of PVDs. Indeed, Article 63 CPVRR is implemented by means of the Commission Regulation 637/2009 of 22 July 2009 establishing implementing rules as to the suitability of the denominations of varieties of agricultural plant species and vegetable species (henceforth, “PVD Regulation”). The PVD Regulation establishes rules for the application of certain criteria [concerning the eligibility of PVDs] set out in Article 63 CPVRR for the purposes of the application of the following directives (henceforth, jointly referred to as “Common Catalogue Directives”) concerning the marketing of varieties:

- Council Directive 2002/53 of 13 June 2002 on the common catalogue of varieties of agricultural species; and
- Council Directive 2002/55 of 13 June 2002 on the marketing of vegetable seed.

The Common Catalogue Directives concern two specific segments of the plant market: agricultural and vegetable crops, respectively. Registration is mandatory for the commercialisation of variety constituents (seeds) belonging to vegetable and agricultural species, regardless of whether they are protected or not by a CPVR.¹⁶⁴ The varieties listed

¹⁶⁴ Jean Maison, *The Implementation of Statutory Rules for Variety Denominations in the EU*. (2018) *Acta Horticulturae* 799. For a variety to be accepted in the catalogues, it must be distinctive, stable, sufficiently uniform. A variety must, in addition, be of “satisfactory value for cultivation and use” in the case of agricultural crops. *See* Article 5(4) of Council Directive 2002/53: “The value of a variety for cultivation or use shall be regarded as satisfactory if, compared to other varieties accepted in the catalogue of the Member State in question, its qualities, taken as a whole, offer, at least as far as production in any given region is concerned, a clear improvement either for cultivation or as regards the uses which can be made of the crops or the products derived therefrom”. The value for cultivation and use is mostly based on the following criteria: yield, resistance to harmful organisms, response to the environment and quality characteristics.

in the Common Catalogues for marketing in the territory of the EU are published in the Official Journal of the European Union.

The Common Catalogues are compiled on the basis of the national catalogues of the EU Member States: Each Member must establish one or more catalogues of the varieties officially accepted for certification and marketing in its territory.¹⁶⁵ Article 9(6) in both Common Catalogue Directives includes a cross-reference to Article 63 CPVRR, stipulating that the latter provision applies to matters concerning the suitability of PVDs falling under the scope of said directives. In sum: whether a variety enters the Common Catalogues and/or plant variety protection is sought, the same set of rules applies and the PVD must be the same in both registers.¹⁶⁶

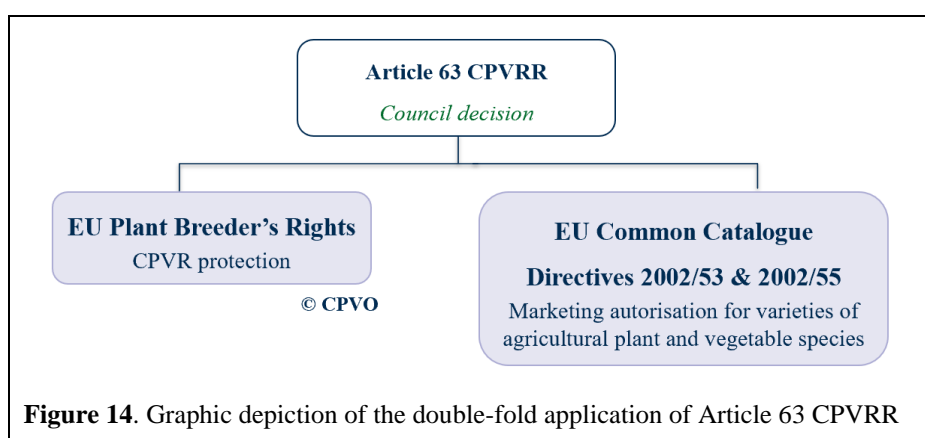


Figure 14. Graphic depiction of the double-fold application of Article 63 CPVRR

Article 63 CPVRR is interpreted in the “CPVO Guidelines on Article 63 CPVRR”,¹⁶⁷ as endorsed by the AC. In addition, the CPVO has developed some Explanatory Notes to these guidelines with the purpose of illustrating with practical examples the criteria of assessment of the suitability of PVDs. These notes stay in consonance with the “UPOV Explanatory Notes on Variety Denominations under the UPOV Convention” (UPOV/INF/12),¹⁶⁸ setting out guidance for the harmonic implementation by UPOV Members of the provisions of the UPOV Convention relevant to PVDs.

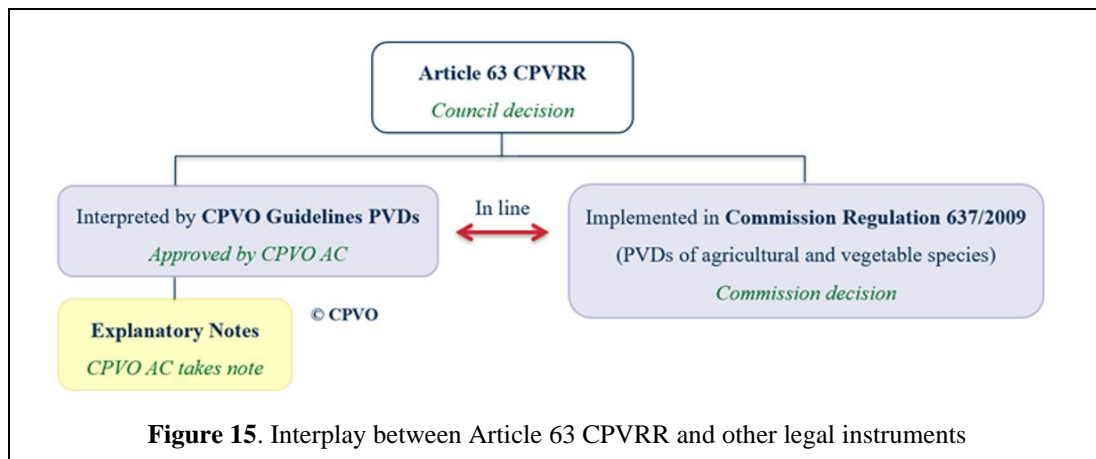
Around 3.500 new varieties are authorized for marketing in the EU yearly, and there are currently around 42.000 different varieties of agricultural and vegetable species available to farmers in the EU.

¹⁶⁵ See, for instance, the case of Spain. The Spanish Plant Variety Office (“OCVV”, within the remit of the Spanish Ministry of Agriculture) counts on two organisms competent for the registration of plant varieties: the “Registro de Variedades Protegidas” (compiling national PVR titles), and the “Registro de Variedades Comerciales” (compiling plant varieties apt for commercialisation).

¹⁶⁶ Benedicte Legrand (Variety Denomination expert at CPVO), Recorded Webinar ‘The name of a plant variety in the Community plant variety right system’. (2019) *EUIPO Academy*, available at <https://bit.ly/387vUVU> [Accessed: 6 November 2020].

¹⁶⁷ These CPVO PVD Guidelines are available at <https://bit.ly/34UZ9JO> [Accessed: 6 November 2020].

¹⁶⁸ The UPOV Explanatory Notes (UPOV/INF/12)” are available at <https://bit.ly/38aBLtx> [Accessed: 6 November 2020]. UPOV counts on a Working Group on Variety Denominations, which reviews the Notes from time to time. See ‘Module 6: Examining the Variety Denomination’ in *DL-305 - Examination of applications for plant breeders’ rights* (UPOV-WIPO Distance Learning Course).



The CPVO also counts on its own “Variety Denomination Committee”.¹⁶⁹ This committee is integrated by legal and technical experts of the CPVO and is regularly summoned to reach decisions on PVD proposals or on amendments within the frame of complex cases, mostly relating to impediments to the registration of PVDs.

5.2. Impediments to the Registration of Plant Variety Denominations

30. If found suitable, the PVD proposed is approved by the CPVO.¹⁷⁰ A PVD is deemed suitable if no impediment exists against its registration.¹⁷¹ The CPVO verifies the suitability of the PVD and, besides, third parties may lodge an objection to the PVD within a time-limit of three months from the publication of the proposed PVD in the Register of Applications for CPVRs.¹⁷² An objection can lead to two outcomes: either the PVD is refused,¹⁷³ either it is finally recorded in the Register of CPVRs.¹⁷⁴

31. The impediments for the registration of a PVD under EU PVR law can be regarded as equivalent to absolute and relative grounds for refusal of EUTM applications under EU TMR law. They are laid down in the third and fourth indents of Article 63 CPVRR.

Regarding the fourth indent of Article 63 CPVRR,¹⁷⁵ it envisages a scenario where a variety for which CPVR protection is sought has already been registered in an EU

¹⁶⁹ The CPVO currently counts on five Committees, which are set up by the AC pursuant to Articles 35(2) and 36(1)(c) CPVRR. See the announcement on the CPVO website, available at <https://bit.ly/32da8MV> [Accessed: 6 November 2020].

¹⁷⁰ Article 63(1) CPVRR.

¹⁷¹ Article 63(2) CPVRR.

¹⁷² Article 59(3)(b) and (4)(b) CPVRR.

¹⁷³ Article 61(1)(c) CPVRR.

¹⁷⁴ Article 87(2)(a) CPVRR.

¹⁷⁵ Article 63(4) CPVRR reads:

“There is another impediment where, in the case of a variety which has already been entered: (a) in one of the Member States; or (b) in a Member of the International Union for the Protection of New Varieties of Plants; or (c) in another State for which it has been established in a Community act that varieties are

Member State or UPOV Member with a PVD different from that which the CPVR applicant is proposing before the CPVO. The proposal for PVD must then be rejected in order to preserve the universal character of the PVD, and a new PVD must be proposed.¹⁷⁶

Regarding the third indent of the same article, it lists six grounds which are worthy of an individualised analysis. A decision of the Board of Appeal of the CPVO applies some of the grounds in Article 63(3) CPVRR and it is also interesting to have a look at it.

5.2.1. Analysis of Impediments in Article 63(3) CPVRR

32. For the sake of clarity, the text of Article 63(3) CPVRR is here-below reproduced.

Article 63(3) CPVRR

There is an impediment for the designation of a variety denomination where:

- (a) its use in the territory of the Community is precluded by the prior right of a third party;*
- (b) it may commonly cause its users difficulties as regards recognition or reproduction;*
- (c) it is identical or may be confused with a variety denomination under which another variety of the same or of a closely related species is entered in an official register of plant varieties or under which material of another variety has been marketed in a Member State or in a Member of the International Union for the Protection of New Varieties of Plants, unless the other variety no longer remains in existence and its denomination has acquired no special significance;*
- (d) it is identical or may be confused with other designations which are commonly used for the marketing of goods or which have to be kept free under other legislation;*
- (e) it is liable to give offence in one of the Member States or is contrary to public policy;*
- (f) it is liable to mislead or to cause confusion concerning the characteristics, the value or the identity of the variety, or the identity of the breeder or any other party to proceedings.*

evaluated there under rules which are equivalent to those laid down in the Directives on common catalogues; in an official register of plant varieties or material thereof and has been marketed there for commercial purposes, and the proposed variety denomination differs from that which has been registered or used there, unless the latter is the object of an impediment pursuant to paragraph 3”.

¹⁷⁶ An exception is foreseen in those cases where the PVD, as registered originally with other national PVR authorities, cannot be registered with the same designation at EU level because an impediment arises pursuant to Article 63(3) CPVRR. In this case the CPVO creates a “synonym” for such PVD and informs all concerned parties (including the concerned national PVR authorities).

[Article 63(3)(a) CPVRR] The use of the PVD in the EU territory is precluded by an earlier right of a third party.¹⁷⁷

33. The pivotal element in this provision is the date: for a third party's right to prevail over the use of the PVD, such right must have been born prior (by registration or common use) to the date of application for the PVD. The said earlier right can be the following:

- Trade mark
- Geographical Indication
- Designation of Origin
- Plant Patent

The most commonly encountered prior-right impediment is a registered TMR.¹⁷⁸ Actually, Article 2(1) PVD Regulation expressly envisages this scenario.¹⁷⁹

Article 63(3)(a) CPVRR is interpreted as meaning that the impediment is not to be examined by the CPVO of its own motion (*ex officio*), but constitutes instead a relative ground for refusal of proposed PVDs.¹⁸⁰ By publishing the proposed PVDs in the Register of Applications for CPVRs,¹⁸¹ the CPVO gives the possibility for titleholders of prior rights with which the proposal for PVD potentially conflicts, to assert said rights.

The CPVO always informs the CPVR applicant about the existence of such prior rights. This enables the applicant to consider whether the concerned earlier rights represent a genuine risk or if, *a contrario*, the interests of the concerned titleholder are in a different

¹⁷⁷ This wording is modelled on Article 20(4) UPOV Convention, which reads: "Prior rights of third persons shall not be affected. If, by reason of a prior right, the use of the PVD is forbidden to a person who is obliged to use it, the authority shall require the breeder to submit another PVD for the variety". Article 63(3)(a) CPVRR also stays in consonance with Article 18(2) CPVRR, according to which a third party may use a right granted in respect of a designation that is identical with the PVD to hamper the free use of that denomination only if that right was granted earlier than the PVD.

¹⁷⁸ The consideration of infringement is automatic where the TM and the PVD are identical and the goods for which the TMR is registered cover the variety at stake. In cases of mere similarity, confusion on the part of the consumer needs additionally to be shown by the TM titleholder. A TM with a reputation may be infringed by a PVD even where the concerned variety is dissimilar to the goods for which the TM was registered where the PVD takes unfair advantage of, or has a detrimental effect on, the character or reputation of the TM ["CPVO Explanatory Notes on Article 63 CPVRR", available at <https://bit.ly/38aBAyr> [Accessed: 6 November 2020]].

¹⁷⁹ Article 2(1) PVD Regulation reads: "In the case of a trade mark as a prior right of a third party, the use of a variety denomination in the territory of the Community shall be considered to be precluded by the notification to the competent authority for the approval of the variety denomination of a trade mark, which has been registered in one or more Member States or at Community level prior to the approval of the variety denomination, and which is identical or similar to the variety denomination and registered in relation to goods which are identical or similar to the plant variety concerned".

¹⁸⁰ Philipp von Kapff, 'Vesuvius und FEZ 007 - Marken und/oder Sortenbezeichnungen für Pflanzen' in W. Büscher, et al., *Festschrift für Karl-Heinz Fezer zum 70. Geburtstag: Marktkommunikation Zwischen Geistigem Eigentum Und Verbraucherschutz*. (2016) C. H. Beck, p. 755.

¹⁸¹ Article 87 CVPRR.

segment of the plant market and no objection to the registration of the PVD is likely to be raised. The impediment is regarded as removed where the consent of the titleholder of the prior right to the use of the PVD is obtained by means of a declaration of waiver of rights by such titleholder.¹⁸²

The final decision as to whether the registration procedure for the proposal for a PVD must proceed thus lies in the hands of the CPVR applicant. The CPVO relies thereby on the responsible practice and good will of plant breeders who, from their part, do not perceive such an examination approach as problematic.¹⁸³

At national level, different examination approaches are followed in this regard. In Spain,¹⁸⁴ an applicant for a Spanish PVR-title must first request the Spanish Patent and Trademark Office (OEPM¹⁸⁵) the issuance of a search report with TMRs identified as conflicting with the proposed PVD, and then present this report, in conjunction with the proposal for a PVD, before the Spanish Plant Variety Office (OEVV¹⁸⁶). The Spanish PVR legislator seems to have opted for placing legal certainty at the core of the examination process.

34. Another element meritorious of scrutiny is that of earlier registered TMRs that are actually not used in practice in relation to the concerned designated products in Class 31. Just like any other, these TMRs are taken into consideration by the CPVO as earlier rights when assessing impediments to the registration of PVDs, and the TMR titleholder may accordingly invoke his/her rights. The CPVR applicant can always walk the belligerent path of requesting the revocation of the TMR on grounds of non-use (for the whole or for a part of Class 31) before the competent TMR authority. This does seem quite a cumbersome procedure for the CPVR applicant. On the flip side of the coin, it must be borne in mind that many TMRs are not used in connection with some or all of the goods and/or services in relation to which they were registered. The CPVO seems to take due account of this reality, by adopting an examination-approach where (conflicting) earlier TMRs should not constitute an *ex lege* impediment to the registration of PVDs.

¹⁸² Article 2(3) of PVD Regulation. The waiver must be accompanied by a written consent of the titleholder of the earlier right that he/she will not hamper the free use of that denomination in connection with the variety, even after the termination of the CPVR. Another option is that the TM titleholder and the CPVR applicant enter into a licensing arrangement on the use of the designation.

¹⁸³ Judith de Roos, A rose by any other name would smell as sweet. (2016) *Prophyta Annual*, p. 23.

¹⁸⁴ Pursuant to Article 48(5) of “Ley 3/2000, de 7 de enero, de régimen jurídico de la protección de las obtenciones vegetales” (Spanish law establishing the legal regime for the protection of plant varieties).

¹⁸⁵ Original name in Spanish: Oficina Española de Patentes y Marcas.

¹⁸⁶ Original name in Spanish: Oficina Española de Variedades Vegetales.

35. Another question that arises, is what happens when the identified conflicting earlier right belongs to the CPVR applicant. UPOV recommends PVR Offices to refuse a proposal for PVD if the applicant already has an earlier right for that same designation and does not renounce it prior to the proposal for PVD.¹⁸⁷ Yet, this scenario is not regulated by Article 63(3)(a) CPVRR, which is limited to third party's earlier rights.

It cannot then be discarded that a breeder may strategically apply first for a TMR and later for a PVD,¹⁸⁸ in order to benefit from TMR protection in respect of the concerned designation during the period running from the date of application for a CPVR until the granting thereof.¹⁸⁹ The fact that the CPVO does not refuse of its own motion a PVD proposal when a TM has been registered for the same designation, can *prima facie* be seen as a sort of legal loophole to the benefit of the applicant. This notwithstanding, applying for the same designation as TM and as PVD is tantamount to conceding that the TM is the name of the product.¹⁹⁰ Hence, such TM cannot fulfil the essential function of a TM (indication of commercial origin). Accordingly, it would not be expected from a breeder to “shoot him/herself in the foot” by becoming a “double (TM-PVR) titleholder” and consequently living under the Damocles’ sword of *TM-genericism*.¹⁹¹

[Article 63(3)(b) CPVRR] The PVD cannot commonly cause its users difficulties as regards recognition or reproduction.

36. A PVD is not suitable if it is not recognisable as such, difficult to reproduce or does not enable the identification of a variety.¹⁹² It must firstly be clarified that the term “users” refers to professionals/specialists.

The PVD can be in the form of a code or a fancy name.¹⁹³ A code can consist of letters or of a combination of letters and numbers, adding up to no longer than 10 characters (e.g.:

¹⁸⁷ UPOV Explanatory Notes on Variety Denominations under the UPOV Convention” (UPOV/INF/12).

¹⁸⁸ A procedure following the reverse order, that is, applying for a CPVR (PVD) first and later for a TM, cannot prosper, by virtue of the absolute grounds for refusal set out in TMR law. This scenario will be further explored in next chapter, dedicated to collisions between EU TMs and PVDs under EU TMR law.

¹⁸⁹ Rudolf Nirk and Eike Ullmann, *Patent-, Gebrauchsmuster- und Sortenschutzrecht [Patent, Design, and Plant variety protection law]*. C. F. Müller Start (2007, 3d Ed.), p. 201.

¹⁹⁰ Philipp von Kapff, ‘Vesuvius und FEZ 007 - Marken und/oder Sortenbezeichnungen für Pflanzen’ in W. Büscher, et al., *Festschrift für Karl-Heinz Fezer zum 70. Geburtstag: Marktkommunikation Zwischen Geistigem Eigentum Und Verbraucherschutz*. (2016) C. H. Beck, p. 770.

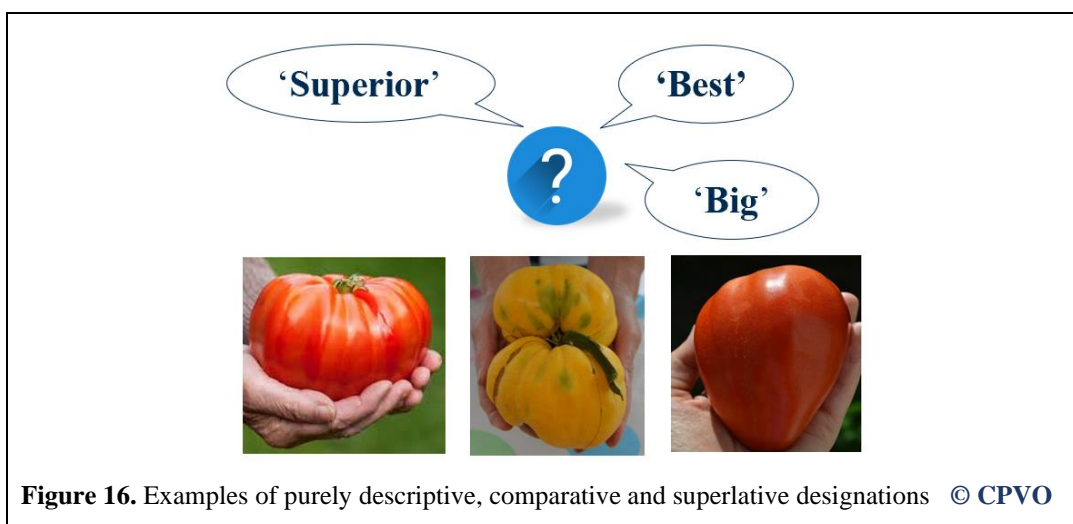
¹⁹¹ The issue of TM-genericism is presented in more detail in Section 6.2.2. of this Thesis.

¹⁹² A PVD should not contain too many elements, punctuation marks, symbols or figurative elements. Likewise, a PVD is regarded as difficult to identify if consisting of a single letter or numeral.

¹⁹³ Upon submission of the proposal for a PVD, the applicant should declare whether the proposed PVD is intended to be in the form of a “fancy name” or of a “code”. If no declaration is made, the PVD is regarded as a “fancy name”.

‘PZ342’). A fancy name must be pronounceable and consist of letters, adding up to no more than five words (e.g.: ‘Silver Night’).

Further, a PVD cannot be purely descriptive nor consist of comparative or superlative designations, as this would not enable the recognition of the variety. For example, the designations ‘Superior’, ‘Best’ or ‘Big’, would not function as PVD, because they refer to characteristics that are or could be common to several varieties.¹⁹⁴



In addition, Latin botanical names may not be recognizable as denominations and create confusion with other taxonomic rank. For example: ‘Triticu’ for a wheat variety, where *Triticum* is the name of a genus.

Lastly, a PVD cannot consist of a breeding or technical term unless this term is combined with other elements in a way that the PVD conveys a completely different meaning.¹⁹⁵

[Article 63(3)(c) CPVRR] A PVD cannot be identical to or be confused with a PVD under which another variety of the same or of a closely related species is entered in an official PVR register or under which material of another variety has been marketed in a EU Member State or UPOV Member, unless the other variety no longer remains in existence and its PVD has acquired no special significance.

37. In a similar vein to that under EU TMR law, likelihood of confusion is assessed under EU PVR law from the perspective of visual, phonetic and conceptual confusion. The

¹⁹⁴ Benedicte Legrand (Variety Denomination expert at CPVO), Recorded Webinar ‘The name of a plant variety in the Community plant variety right system’. (2019) *EUIPO Academy*, available at <https://bit.ly/387vUVU> [Accessed: 6 November 2020].

¹⁹⁵ Benedicte Legrand (Variety Denomination expert at CPVO), Recorded Webinar ‘The name of a plant variety in the Community plant variety right system’. (2019) *EUIPO Academy*, available at <https://bit.ly/387vUVU> [Accessed: 6 November 2020].

assessment however differs in that PVDs mostly target a specialised expert public, so the examination takes place in a more “mechanical” manner.¹⁹⁶

The key expression in this indent is “closely related species”, which means that varieties belonging to different species but within the same genus are “closely related” (in botanical terms).¹⁹⁷ UPOV establishes the general rule that each genus is to be regarded as a single differentiated “Class”. This is known as the Rule “one genus, one class”. Thence, two identical denominations for varieties belonging to the same or to “closely related species” are considered as liable to give rise to confusion. *Contrario sensu*, the same denomination may be chosen for varieties in different genera/UPOV Classes.

There are however exceptions to the general rule, as listed in Annex 1 to the “UPOV Explanatory Notes on PVDs”.¹⁹⁸ For a number of plants, the UPOV Classes have been fixed in a different manner to reflect specific market realities. On the one side of the spectrum, some plants belonging to the same genus are not considered as closely related species and are thus allocated to different UPOV Classes (Annex 1, Part I) whereas, on the other side of the spectrum, different genera are combined under one single UPOV Class (Annex 1, Part II).

Example of Exceptions in Annex 1, Part 1. Species belonging to the same genus but in different UPOV Classes: Potatoes (*Solanum tuberosum*), Tomatoes (*Solanum lycopersicum*), Eggplants (*Solanum melongena L.*). Varieties from these species **can** be assigned the same PVD.



© CPVO

¹⁹⁶ For example, under EU PVR practice, a difference of just two letters is usually enough by default to exclude the existence of likelihood of confusion [Philipp von Kapff, ‘Vesuvius und FEZ 007 - Marken und/oder Sortenbezeichnungen für Pflanzen’ in W. Büscher, et al., *Festschrift für Karl-Heinz Fezer zum 70. Geburtstag: Marktkommunikation Zwischen Geistigem Eigentum Und Verbraucherschutz*. (2016) C. H. Beck, p. 760].

¹⁹⁷ The term “genus” refers to “any group of objects having one or more properties in common and which distinguish themselves from other groups or objects”.

¹⁹⁸ Article 63(5) CPVRR also foresees that the CPVO must publish the species which it considers closely related. An equivalent list with the same numbering as that exhibited in the UPOV Explanatory Notes on Variety Denominations (Annex 1, Parts I and II) is annexed to the CPVO Guidelines on Article 63 CPVRR.

Example of Exceptions in Annex 1, Part II. Species belonging to different genera but in the same UPOV Class: *Petunia* (*Petunia Juss.*) and *Calibrachoa* (*Calibrachoa Cerv.*). Varieties from these species **cannot** be assigned the same PVD.



© CPVO

Figure 17. Exceptions to Rule “one genus, one class” [Annex 1 to UPOV & CPVO Guidelines on PVDs]

For the earlier PVDs to constitute an impediment, it is also required that these correspond to varieties that have entered an official register of plants or have been commercialised within the EU or in a UPOV Member.¹⁹⁹

UPOV discourages the re-use of a PVD for the same or closely related species under any circumstance. However, under EU PVR practice, an exemption is foreseen: a designation is allowed to be registered again as PVD and re-used where the former PVD “has not acquired special significance” and the designated variety is “no longer in existence”.²⁰⁰

[Article 63(3)(d) CPVRR] A PVD cannot be identical or likely to be confused with other designations which are commonly used for the marketing of goods or which have to be kept free under other legislation.

¹⁹⁹ “An official register of plant varieties” is considered as a reference to the Common Catalogues, or to any register compiled and maintained by the CPVO, by an official body of the Member States of the EU or of the European Economic Area (EEA), or by a UPOV Member. The wording also covers the “List of Varieties Eligible for Certification” maintained by the Organisation for Economic Cooperation and Development (OECD). This is an official list of varieties which have been accepted by National Designated Authorities as eligible for certification in accordance with the Rules of the OECD Seed Schemes [Rules of the OECD Seed Schemes, available at <https://bit.ly/2I5YmMS> [Accessed: 6 November 2020]].

²⁰⁰ “A variety no longer in existence” is understood in commercial terms: what must be ascertained is whether the variety is out of cultivation on a commercial basis. As for “denominations that have not acquired special significance”, it is noted that despite “significance” is as a general rule presumed as acquired upon registration, the CPVO considers that the expiry of a ten-year period since the variety was deleted from the register may result in a PVD losing any significance conferred thereby.

The ICNCP also regulates this matter and in a very precise fashion. Article 30(2) of the ICNCP establishes that an IRA may only accept re-use of a designation if that authority is satisfied that the original designated: “(a) is no longer in cultivation; (b) has ceased to exist as breeding material; (c) may not be found in a gene or seed bank; (d) is not a known component in the pedigree of other varieties; (e) the name has rarely been used in publications; and (f) re-use is unlikely to cause confusion”.

38. Terms that are commonly applicable to plant varieties in the commercial context as well as designations which, by virtue of legislation, cannot be used for purposes other than those envisaged by that legislation, constitute an impediment to the suitability of a PVD. For example: terms referring to currencies such as “Euro”, weight/measures like “Kilo”, or terms which use is strictly governed by specific laws, like “Bio” or “Eco”.²⁰¹

[Article 63(3)(e) CPVRR] A PVD cannot be liable to give offence in one of the Member States or is contrary to public policy.

39. This indent targets names of unsavoury characters from history and words with an offensive or abusive meaning in a language of the EU.²⁰²

[Article 63(3)(f) CPVRR]²⁰³ A PVD cannot be liable to mislead or to cause confusion concerning the characteristics, the value or the identity of the variety, or the identity of the breeder.²⁰⁴

40. According to this indent, a PVD should not convey the impression that the variety has particular characteristics which it actually does not have. For example: ‘Early Yellow’ cannot be accepted as a PVD for a late-flowering, red tulip variety.²⁰⁵

In the assessment, account must be taken of the sector to which the plant variety belongs. For example: the PVD ‘Blue Star’ for a flower of a fuchsia shade is not acceptable because the colour is a relevant characteristic in the ornamental sector, whereas the PVD is acceptable for a wheat variety as the colour is not of relevance for this agricultural species.

²⁰¹ Benedicte Legrand (Variety Denomination expert at CPVO), Recorded Webinar ‘The name of a plant variety in the Community plant variety right system’. (2019) *EUIPO Academy*, available at <https://bit.ly/387vUVU> [Accessed: 6 November 2020].

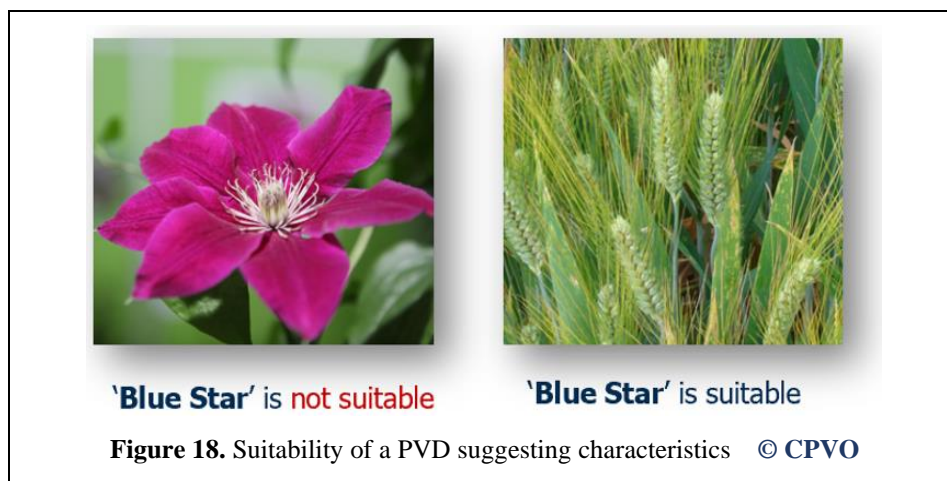
²⁰² CPVO Explanatory Notes, p. 13. This indent mirrors the wording of Article 7(1)(f) EUTM, according to which “trade marks which are contrary to public policy or to accepted principles of morality shall not be registered”.

²⁰³ This indent implements the prohibition in Article 20(2) UPOV Convention.

²⁰⁴ *Mutatis mutandis*, this indent can be defended to share some similarities with the absolute ground for refusal of EUTMs embodied in Article 7(1)(g) EUTMR, which reads:

“The following shall not be registered: [...] g) trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service”.

²⁰⁵ Paul van der Kooij, Use and Misuse of Trade Marks in European Nursery Industry. (2004) *Acta Horticulturae 634 [IVth Int. Symp. Taxonomy of Cultivated Plants]*, p. 38. Another example: a PVD containing the term “dwarf” for a variety which is of normal height, when a dwarfness trait exists within the species, but is not possessed by the variety at stake.



In a similar vein, a PVD cannot give the impression that the variety it designates is the only one possessing a character when, in fact, more varieties possess such character. For example, ‘Sweet’ for a fruit variety.²⁰⁶

Likewise, a PVD could be misleading if it suggests that the designated variety has a biologic relation with another existing variety of the same species when that is not the case.²⁰⁷ For example: a breeder proposes ‘Dark Secret’ for a *Lilium* variety, where the PVD ‘Secret’ already exists for another variety of the same species.

A PVD can also project a false impression in relation to the identity of the breeder where an applicant uses an element identifying a series of PVDs from another breeder. For example: if a breeder possesses the series of PVDs for the rose varieties ‘Samba Patio’, ‘Samba Pleasure’ and ‘Samba Delight’; another breeder cannot use the PVD ‘Samba Treasure’ for his/her new rose variety.²⁰⁸ The latest breeder would here be making unfair profit from the success of the earlier breeder with his/her set of plant varieties.

²⁰⁶ Another example: the PVD ‘Tropica’ for a mango variety cannot be accepted, as this word is similar to the word “tropical” and would thus convey such message, where the condition of being tropical is common to varieties belonging to mango species [example provided by Jesús M. Oviedo Aranda, *Head of Department at OEVV*]. A PVD can also induce confusion, if it contains the botanical name of another species in the same crop sector. For example, ‘Lilac Beauty’ is not suitable for a wisteria variety, as “Lilac” is the common name of *Syringa*, which is another species in the same ornamental crop sector [Benedicte Legrand (Variety Denomination expert at CPVO), Recorded Webinar ‘The name of a plant variety in the Community plant variety right system’. (2019) *EUIPO Academy*, available at <https://bit.ly/387vUVU> [Accessed: 6 November 2020]].

²⁰⁷ It is recalled that PVDs are allowed to have a similar name within the same species when they have a close biologic relation. For example: when one variety is predominantly derived from another, what is known as “essentially derived variety” (EDV).

²⁰⁸ Benedicte Legrand (Variety Denomination expert at CPVO), Recorded Webinar ‘The name of a plant variety in the Community plant variety right system’. (2019) *EUIPO Academy*, available at <https://bit.ly/387vUVU> [Accessed: 6 November 2020].

5.2.2. *Case Law of the Board of Appeal of the CPVO on Impediments to the Registration of Plant Variety Denominations*

41. So far, the only decision of the Board of Appeal of the CPVO (henceforth, “CPVO Board”) concerning PVDs is decision ‘GINPENT’ of 2005.²⁰⁹ the Board had here the occasion to rule on a request for the amendment of a PVD in relation to impediments to the registration of PVDs as enshrined in Article 63 CPVRR.

Factual Background. Mr A. Giovanni was granted a CPVR for the variety ‘GINPENT’ belonging to the species *Gynostemma pentaphyllum*. An objection was lodged against the grant decision, where the appellant invoked Article 66 CPVR²¹⁰ for an amendment to the PVD ‘GINPENT’ based on the allegation that such PVD was contrary to the provisions laid down in Article 63(3)(c) and (f) CPVRR. The CPVO rejected the appellant’s claims.²¹¹ No motive for amending the PVD was found, so the PVD was maintained. The appellant appealed the CPVO’s decision.

Arguments by the appellant. The appellant’s grounds of appeal in support of the PVD’s amendment were the following:

- The appellant had been marketing since 1995 the variety ‘QUIBA’ belonging to the species *Gynostemma pentaphyllum*.
- The name ‘GINPENT’ constitutes an abbreviation of the species *Gynostemma pentaphyllum* and is thus indistinguishable from such species-name, hence, this name should be kept free for the marketing of goods [Article 63(3)(c) CPVRR].
- The PVD ‘GINPENT’ could lead to confusion over the characteristics of the designated variety and the species *Gynostemma pentaphyllum* as well as over other varieties of this species [Article 63(3)(f) CPVRR].

²⁰⁹ *Vegetal Progress S.r.l. vs Ambrogio Giovanni and CPVO* (‘GINPENT’), A 4/2004 [2005], concerning the CPVR No 1998/1034 (‘GINPENT’), which was granted on 3 December 2001.

²¹⁰ The CPVO must amend a PVD in those cases where such is no longer suitable [Article 66(1) CPVRR]. The procedure may be initiated by the CPVO on its own motion at any time and is thus not dependent on the actions of third parties. The concerned CPVR titleholder has the opportunity to propose an amended PVD [Article 66(2) CPVRR] and, upon publication, the amended PVD is subject to objection by third parties within the three-months-time-limit.

²¹¹ See decision of the CPVO No VD 00176 (dated 23 February 2004). A procedural remark must be made in regard of this case. Indeed, the CPVO here observed that the deadline for objections had since long elapsed [pursuant to Article 59(3)(b) and (4)(b) CPVRR]. The publication of the proposed PVD dated of 15 October 1998, and the objection by the appellant was filed on 23 October 2003, that is, almost five years later. In consequence, the submission by the appellant was regarded as a mere suggestion. The CPVO however agreed to take the suggestion of the appellant and examine the compatibility of the PVD at stake with Article 63(3) CPVRR, yet without formally admitting the appellant as a participant in the procedure. The contested decision was thus directed at the CPVR titleholder and not at the appellant.

- The CPVR titleholder is marketing the variety under the TM ‘GINPENT’, what runs counter to the relevant Italian law [Article 63(3)(d) CPVRR].

Reasoning and findings of the CPVO Board. The appeal was dismissed. It was held admissible²¹² but unfounded. The conclusions reached boil down to the following:

- Article 63(3)(c) CPVRR cannot apply, as it aims at avoiding confusion among PVDs, and not between a PVD and a species’ name.
- Article 63(3)(d) CPVRR is also inapplicable. Despite a species-name must be kept free and not used as PVD, there is no evidence that referring to a species-name by an abbreviation derived from such is a customary practice in the sector. Hence, even consumers familiarised with the species-name would not get confused and simply perceive the PVD as a fanciful name.²¹³
- Article 63(3)(f) CPVRR cannot apply. The variety ‘GINPENT’ and the species *Gynostemma pentaphyllum* cannot be confused with each other, as their respective characteristics cannot be considered misleading.
- Regarding the simultaneous use of the PVD ‘GINPENT’ and a TM with an identical designation, no obstacle arises pursuant to Article 17(1) CPVRR as long as the PVD is readily distinguishable in the commercialisation of the variety.²¹⁴

Commentary. The author is of the opinion that the case was solved following a reasonable line of argumentation, from which a logical outcome stemmed.

It is nevertheless strongly recommended to applicants for CPVRs not to propose PVDs alluding to species or genus names, even if the reference included is “camouflaged” under a fancy construction such as the one in the case at hand. Confusion with other taxonomic ranks should be avoided at all costs.

²¹² The appeal was found admissible following a broad as to the entitlement to lodge appeals. The CPVO Board found that the appellant was entitled to appeal because he could be considered as directly and individually affected by the contested decision of the CPVO, since he had since long been marketing the variety ‘QUIBA’, belonging to the same species as the contested PVD ‘GINPENT’.

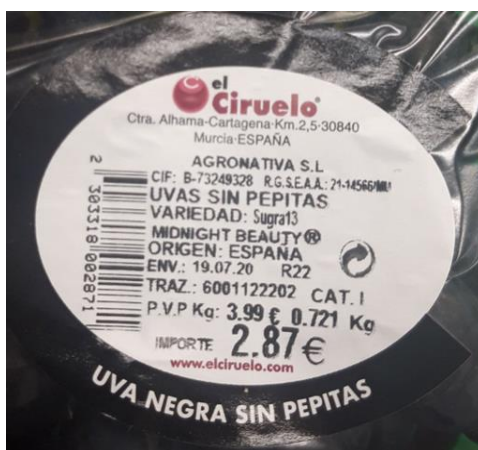
²¹³ The assessment by the CPVO Board echoed that under EU TM law (namely: visual, aural and conceptual comparisons in inter-partes cases based on claims of likelihood of confusion): “since ‘GINPENT’ is a fanciful name far removed from *Gynostemma pentaphyllum* in terms of sound, written appearance and concept, no confusion arises between it and the species denomination which is to be kept free”.

²¹⁴ The CPVO Board added that, whether or not a risk of confusion arose between both rights, that was not an issue to be settled within the framework of this procedure.

5.3.Coexistence between Plant Variety Denominations and Trade Marks

42. The legal compatibility between PVDs and TMs is proclaimed in Article 20(8) UPOV Convention: where a variety is offered for sale or marketed, it shall be permitted to associate a TM, trade name or other similar indication with a registered PVD.²¹⁵ If a TM is so associated, the PVD must be easily recognizable.

The recommendations established in the ICNCP are usually followed in this regard. Pursuant to Article 17(1) ICNCP, TMs cannot be placed within demarcating quotation marks (ideally, a registered TMR is to be accompanied by the notice ®). This is to avoid confusion with PVDs, which are usually reproduced within single quotation marks. PVDs should be accompanied by the word “Variety” or the abbreviation “Var”. Article 17(3) ICNCP adds that trade designations must be distinguished typographically from PVDs.



- **EI CIRUELO** is the TMR of a firm (producer of fruits) in Murcia (Spain);
- **UVAS SIN PEPITAS [Seedless grapes]** refers to a grape-characteristic attractive to consumers;
- **VARIEDAD [variety] ‘Sugra13’** is the PVD designating the grape plant variety at stake;
- **MIDNIGHT BEAUTY ®** is the registered TM under which the variety ‘Sugra13’ is marketed.

Figure 19. Example of market-coexistence between PVDs and TMRs

43. In this connection, it is to be regretted that no “official universal notice” such as that for copyrights (©) or for TMs (™ and ®), exists for PVRs. Dr van der Kooij proposed the introduction, preferably at International level, of a notice indicating that a plant variety is protected by a PVR.²¹⁶ Such a notice should ideally have the character of an “official recommendation” (e.g.: by UPOV) and its use could be promoted by regional and national

²¹⁵ Indeed, TM protection does not restrict propagation or any use of plant materials. Maria Luisa Badenes and David H. Byrne, *Fruit Breeding*. (2012) Springer Science, p. 78.

²¹⁶ Dr van der Kooij is the current chairperson of the CPVO Board of Appeal [Paul van der Kooij, Defending PBR: P, B, or R?. (2002) *European Intellectual Property Review (E.I.P.R.)*, Vol. 24, Issue 1, p. 2].

PVR offices and by plant breeding organisations.²¹⁷ The author fully supports this initiative and goes further to suggest that said notice could consist, for example, of a circle embracing a simplified fancy seedling such as this one:



A sign exclusively devoted to registered PVRs would certainly enhance the market visibility of PVDs and reduce potential conflicts of perception with TMs from the part of users. Besides, it could serve the policy of raising awareness on PVRs, an important IPR which regrettably does not occupy much of the spotlight in IP forums.

5.4.Fancy Names Versus Codes: A Polarised Debate

44. As already shown, a PVD can be in the form of a code or of a fancy name. Yet, the identification of plant varieties by means of PVDs consisting of codes, has historically been one of the hot potatoes discussed within UPOV.²¹⁸ The UPOV 1961 Act [Article 13(2)] prohibited PVDs consisting solely of figures, as these would make difficult the effective recognition of PVDs as generic designation of plant varieties. Restricting the use of figures was however seen as contrary to the practice of breeders in many countries. At the Diplomatic Conference of 1978, the removal of this restriction was proposed. The breeders' organisation CIOPORA²¹⁹ was one of the strong proponents of the use [as PVDs] of codes over fancy names. CIOPORA expressed this marked preference for instance in ICNCP forums, where the following grounds were adduced:

- i) Codes are readily available, whereas fancy names are limited in number;
- ii) Codes can be used internationally in a uniform manner because they are meaningless (they also minimise issues associated with translations), whereas fancy names that are suitable in one country may be inadequate in others;
- iii) Codes minimise the risk of opposition from titleholders of prior PVDs or TMs based on identity or likelihood of confusion.²²⁰

²¹⁷ Paul van der Kooij, Defending PBR: P, B, or R?. (2002) *European Intellectual Property Review (E.I.P.R.)*, Vol. 24, Issue 1, p. 2.

²¹⁸ Jay Sanderson, 'Bringing Order and Stability to Variety Denomination' in *Plants, People and Practices: The Nature and History of the UPOV Convention*. (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, p. 153; and James M. Weatherly and Barbara Campbell, A Plant by Any Name is Not the Same. (2011) *Grower Talks*, p. 2.

²¹⁹ CIOPORA is the International Community of Breeders of Asexually Reproduced Horticultural Plants, bringing together plant breeders, national breeder associations, and IP experts and consultants from 27 countries, aiming at the development of national and international PVR systems.

²²⁰ Mark Janis, Supplemental Forms of Intellectual Property Protection for Plants. (2004) *Minnesota Journal of Law, Science & Technology*, Vol. 6, Issue 1; André Heitz, 'Plant variety protection and cultivar

It was finally agreed that the restriction on figures would be reduced, although not entirely. Accordingly, the final wording [embodied in the current Article 20(2) UPOV Convention [1991 Act] ended up reading: “It [the PVD] may not consist solely of figures except where this is an established practice for designating varieties”. The UPOV 1978 Act provided thereby a “limited opening for PVDs consisting of figures”. Some questions may instinctively arise from this outcome:

- i) When is a given designation-practice considered “an established practice” in order to qualify for the exception of using PVDs consisting solely of figures?
- ii) How far can the limited opening recognised in the UPOV Convention be overstretched? Is there a risk that this opening becomes a sort of *catch-all bag* that results in turning an *ex lege* exception into a general rule *de facto*?

There seems to be no clear-cut answer to these questions. Regarding the first quest, it can be defended that “established practice” refers to those practices that have been traditionally used and have become a consolidated practice in a particular plant sector.

An example of “established practice” that one may think of is that of the rose industry, which seems to have been the first sector to use “nonsensical” names for rose varieties.²²¹ The rose industry usually applies a designation policy consisting in employing a recognised prefix to denote the breeder of a rose variety [the first three letters of their names, e.g.: ‘NOA’ (for Noack), ‘KOR’ (for Kordes), ‘TAN’ (for Tantau)], to which another syllable is added.²²² The PVD thereby turns into a sort of identification code.

As for the second formulated quest, there seems to be evidence that the opening provided in the UPOV Convention may have been “overstretched” and applied in practice in a manner which may run counter to what the UPOV legislator had in mind at the time.²²³

45. TMs are no strangers to this discussion about *fancy names versus codes* as PVDs. In fact, much of this policy pandemonium has to do with improper use of TMRs. Indeed, breeders may be tempted to choose codes or “nonsensical” names for PVDs whereas the designations that are fancier and easier to remember are reserved to TMs, so that the latter take centre stage in the eyes of the potential purchaser of the plant varieties.

names under the UPOV Convention’ in Andrews, S., Leslie, A., and Alexander, C., *Taxonomy of Cultivated Plants: Third International Symposium*. Royal Botanic Gardens. (2000, 1st Ed.), p. 64; and R. Royon, *Cultivated Variety Denominations and Trademarks*. (1986) *Acta Horticulturae* 182, p. 273-275.

²²¹ Tony Avent, Name that Plant: The Misuse of Trademarks in Horticulture. (2013) *The Azalean*, p. 36.

²²² Gert Würtenberger, ‘Marke und Sortenbezeichnung - zur Auslegung des Artikels 7 Abs. 1 lit. m) UMV’ in Hacker, F., et al, *Festschrift für Paul Ströbele zum 75. Geburtstag*. (2019) C. H. Verlag, p. 579.

²²³ Tony Avent, Name that Plant: The Misuse of Trademarks in Horticulture. (2013) *The Azalean*, p. 37.

Some voices have even warned about the practice, when commercialising varieties, of reproducing the PVD in a print in advertisement and tags that is notably small in comparison with the TM or marketing name.²²⁴ The aim behind this practice is for the TM to become the generic designation of the concerned plant variety in the mind of the consumer, so that the titleholder draws the benefits from the marketing appeal of such TM in connection with the variety.

However, such a practice risks leading to a downward spiral where the mandatory use of PVDs is not respected or is wrongly applied, where TMs are used improperly and become liable for revocation for becoming generic, and where consumers in the plant-related market end up disinformed as to the precise generic designation of the variety at stake.



²²⁴ Tony Avent, Name that Plant: The Misuse of Trademarks in Horticulture. (2013) *The Azalean*, p. 36.

²²⁵ It is observed that all TMs consist of a compound of three words: an attractive word and the words “Babylon Eyes” (followed by the TMR registration notice ®). As for the PVDs, they consist of a long word with no meaning, composed of the elements “Inter” (first letters of the firm’s name), “bab” (first letters of “Babylon”) and the three first letters of the first element of the TM in reverse order (e.g.: for “QUEEN”, “equ”). The firm duly indicates that these are PVDs by the mention “Denomination” before each.

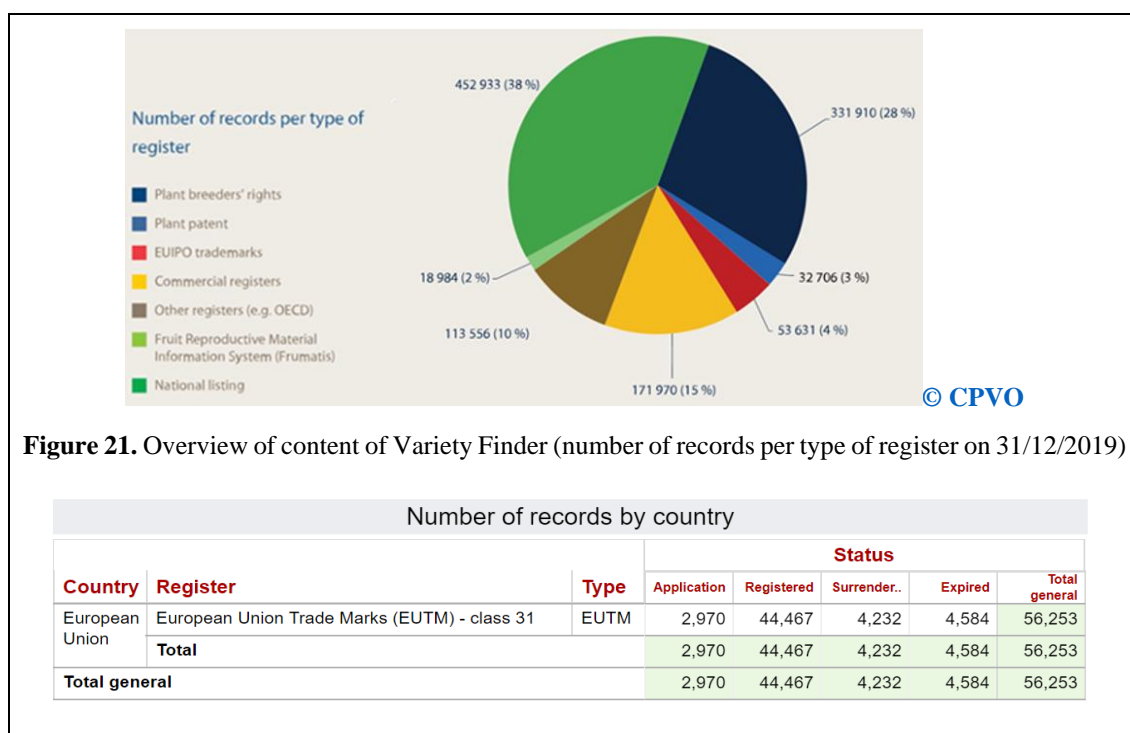
5.5. Databases and Search Tools for Plant Variety Denominations

46. UPOV developed and maintains international-wide databases such as GENIE and PLUTO, consisting in a repository of information on PVRs, including PVDs.²²⁶

These databases provide easily accessible information about PVDs to the authorities of UPOV Members, what has proved helpful in resolving, for instance, concerns around synonyms and homonyms in different geographies.

47. From its part, the CPVO put in place in 2005 the “CPVO Variety Finder database” (henceforth, “Variety Finder”), containing more than one million plant-related records, including PVRs, originating from UPOV and EU Members.²²⁷

Variety Finder is equipped with search tools to look for existing PVDs. There is also a “Similarity testing tool” designed to display identical or similar EUTMs registered for plant-related products in Class 31. Several search-criteria are at disposal and upon a simple click on the desired PVD or EUTM in the lists of results, the corresponding details are displayed in a datasheet providing key information.



²²⁶ The UPOV GENIE database is accessible via the UPOV website at <https://www.upov.int/genie/en/>, and the PLUTO database at <https://www.upov.int/pluto/en/>. UPOV developed and maintains a code of rules for the purpose of identifying PVDs.

²²⁷ The data is retrieved from official registers, like PVR, commercial, TM and Plant Patent registers. Over 400 records from over 60 countries are yearly introduced into the database. A Memorandum of Understanding has been signed with UPOV to share the task of collecting data from countries [Annual Report of the CPVO, available at <https://bit.ly/3l9j9hz>, p. 61]. The database is accessible via the CPVO website at <https://bit.ly/3jP7Zgk> and requires the creation of an account with a user name and a password.

		Number of records by country								
Country	Register	Type	Status							
			Application	Registered	Withdrawn	Rejected	Surrender..	Terminated	Expired	Total general
European Union	Official Publication of the Community Plant Variet..	PBR	5,685	28,796	6,964	1,596	25,225	1,126	251	69,643
	Total		5,685	28,796	6,964	1,596	25,225	1,126	251	69,643
Total general			5,685	28,796	6,964	1,596	25,225	1,126	251	69,643

Figure 19. Number of records of EUTMs (Class 31) and CPVRs as of 01/10/2019 © Variety Finder

Variety Finder - Search varieties

Denomination: contains

Species Latin name: starts with

Country: EU NonEU

Breeder's reference:

Breeder:

Denomination nature:

Variety status:

Register type:

Variety data sheet < Back

Species list
Field explanation
Test data

Country:

Register name: [Japanese Plant Breeder's Rights Journal](#)

Species latin name:

Variety status:

Application/filing Number:

Date:

Published on:

Expiration:

Expiry actual:

Future expiry date:

Breeder's reference:

Breeder:

Applicant:

Maintainer:

Holder:

Other parties:

Remarks:

Extra data url:

Register type:

Class(es):

Grant/registration Number:

Date:

Published on:

Renewal on:

Denominations list

Denomination	<input type="text" value="LA MARIE"/>	Denomination type	<input type="text" value="Undefined"/>
Proposed on	<input type="text" value="09/11/2009"/>	Denomination status	<input type="text" value="Proposed"/>
Published on	<input type="text"/>	End date	<input type="text"/>
Approved on	<input type="text"/>		
Denomination	<input type="text" value="2009 KAWAMO SAKURA PINK"/>	Denomination type	<input type="text" value="Undefined"/>
Proposed on	<input type="text"/>	Denomination status	<input type="text" value="Approved"/>
Published on	<input type="text" value="18/03/2010"/>	End date	<input type="text"/>
Approved on	<input type="text" value="14/03/2013"/>		

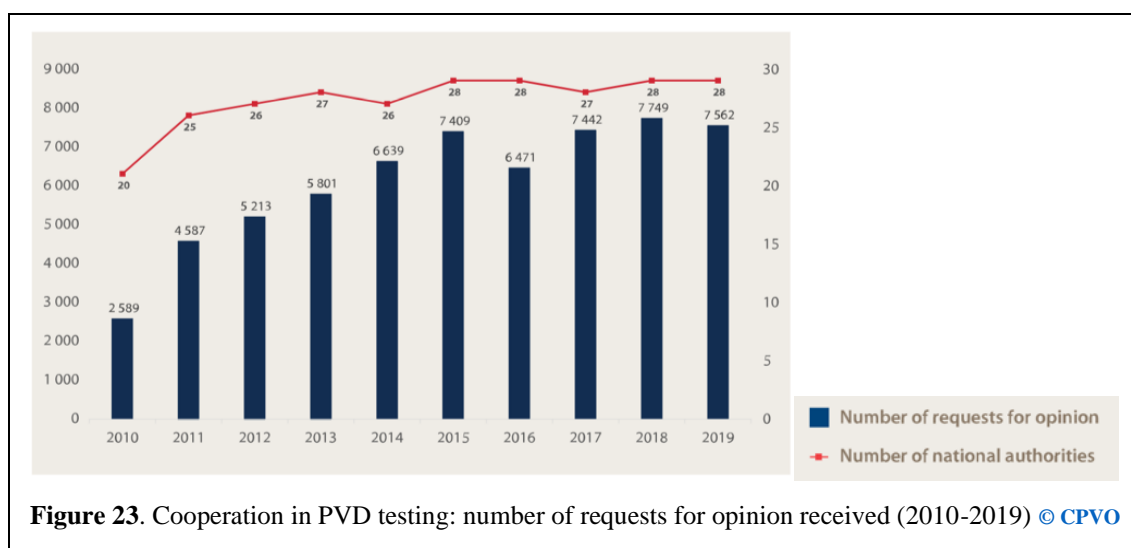
Figure 22. Overview of a Datasheet for a PVR in Variety Finder © Variety Finder

52

5.6. International Cooperation in the Examination of Plant Variety Denominations

48. Article 20(6) UPOV Convention enshrines a “cooperation clause” serving the purpose of ensuring that the authorities competent for the granting of PVRs inform one another of matters concerning PVDs.²²⁸ This provision underpins the emphasis of the UPOV legislator in assuring that any given PVD deploys a universal effect.²²⁹ The suitability of a PVD, which must be recognisable as such to the users targeted, is influenced by different traditions or by specific market situations in a given territory in respect of certain species. UPOV Members are encouraged to reach agreement on PVDs to the extent possible.

As to the EU level, the CPVO launched in 2010 an online-service for the cooperation in PVD matters with the national PVR authorities of EU Member States. The service contributes to the harmonisation of procedures for the examination of PVDs within the EU and has proved very effective in avoiding divergent decisions by national PVR authorities. EU Member States can consult the CPVO on the suitability of the proposals for PVD that they receive.²³⁰



²²⁸ In particular, the submission, registration, and cancellation of PVDs. Additionally, Article 30(1)(iii) UPOV Convention requires UPOV Members to adopt all measures necessary for guaranteeing that the public is informed through the regular publication of information concerning proposed and approved PVDs.

²²⁹ Cooperation tools also contribute to simplifying procedures for the granting of PVR titles, by serving as legal basis for a UPOV Member to deem as valid and adopt the evaluations conducted by another UPOV Member in relation to a plant variety and its designated PVD. This helps in reducing the cost, time, and bulk of administrative work in the examination of applications lodged in multiple countries [Maria Luisa Badenes and David H. Byrne, *Fruit Breeding*. (2012) Springer Science, p. 72].

²³⁰ The CPVO observes a trend of decrease in number of observations regarding non-suitable PVDs, which is to be interpreted as a valuable indicator of constructive cooperation between national PVR authorities. The service is used as a tool for dialogue and interaction. The CPVO can also be requested to assist in difficult cases requiring mediation in relation to PVDs [Annual Report of the CPVO, available at <https://bit.ly/319j9hz>, p. 63 [Accessed: 6 November 2020]].

49. The quest that lingers on is whether, beyond these *ad hoc* cooperation measures, more initiatives could be jointly taken towards a more holistic standardisation of the rules and practice for naming varieties.

Interestingly, on occasion of the 88th session of the UPOV Consultative Committee held in Geneva in 2014, the International Seed Federation (ISF)²³¹ proposed the setting up of a “Patent Cooperation Treaty-like” system for PVRs to enable a one-stop shop approach (*guichet unique*) in the filing of applications for PVRs in several countries.²³²

One of the specific pillars under this project was precisely the creation of a central approval system for PVDs, aimed at achieving stability and consistency in the naming of PVDs worldwide. The project was then duly considered by the UPOV Council, but somehow vanished amidst certain concerns being voiced.²³³

The author is of the opinion that this project could be re-visited. In what concerns exclusively PVD-examination matters, the advantages are conspicuous: the golden rule “one variety, one denomination” could be more effectively safeguarded. As to the project as a whole and although the ISF proposal is outside the scope of this study, the author is inclined to believe, *prima facie* at least, that from a mere international integrationist perspective, the proposed system could bring along benefits of administrative, economic and social nature.

²³¹ ISF is a non-governmental, non-profit making organization representing the interests of the plant breeding and seed industry at International level and regarded as the voice of the global seed industry.

²³² Third World Network, UPOV: To consider industry wish list on plant breeders’ right, available at <https://bit.ly/32shc8n>; and UPOV Report by the President on the work of the Eighty-Eighth Session of the Consultative Committee, available at <https://bit.ly/2JHfNEo> [Accessed: 6 November 2020].

²³³ Third World Network, UPOV: To consider industry wish list on plant breeders’ right, available at <https://bit.ly/32shc8n> [Accessed: 6 November 2020].

6. Through the Prism of EU Trade Mark Rights' Law: Interface with Plant Variety Denominations

50. Now that a clear overview of the impediments faced by proposals for PVDs at EU level has been offered, and that the references to TMRs in EU PVR legislation have been duly identified, it is time to inspect “the other side”, namely, how does EU TMR legislation envisage conflicts between EUTMs and PVDs.

6.1. Impediments to the Registration of EU Trade Marks based on earlier Plant Variety Denominations

This section is centred around analysing the impediments to the registration of EUTMs based on earlier PVDs. The context scrutinised is the EUIPO-examination level.

6.1.1. Introduction of Article 7(1)(m) EUTMR as Absolute Ground for Refusal of Marks including earlier Plant Variety Denominations

51. Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark²³⁴ introduced Article 7(1)(m) as an absolute ground of refusal for the registration of EUTMs in conflict with earlier PVDs.²³⁵ The same provision (and numbering thereof) has been kept in the currently applicable EU TM regulation, namely, Regulation 2017/1001 (EUTMR). An equivalent provision with identical wording is embedded in Article 4(1)(l) TMD.²³⁶

Each absolute ground for refusal has its own sphere of application and must be interpreted in the light of the specific public interest it seeks to protect.²³⁷ The European Commission (henceforth, “Commission”) did not expressly justify the proposal of elevating “conflicts between EUTMs and earlier PVDs” to an independent absolute ground in its own right. It can nonetheless be reasonably assumed that what was sought was formalising

²³⁴ Regulation 2015/2424 entered into force on 23 March 2016.

²³⁵ This absolute ground also constitutes harmonised law amongst the EU Member States, by dint of the introduction of an equivalent wording in Article 4(1)(l) TMD.

²³⁶ Article 4 TMD relates to absolute grounds for refusal or invalidity to be implemented into national legislation by EU Member States.

²³⁷ *SATI v OHIM* (C-329/02 P) [2004], EU:C:2004:532, paragraph 25 [Verena von Bomhard and Alexander von Muhlendahl, *Concise European Trade Mark Law*. (2018) Kluwer Law International].

compliance with the international obligations emanating from Article 20(1) UPOV Convention.²³⁸ Accordingly, Article 7(1)(m) EUTMR pursues the general interest of preserving the availability of a PVD to all traders offering plant-related products. This aim is strengthened by the implication that any claim based on acquired distinctiveness is excluded by default in cases confronting EUTM applications with earlier PVDs.²³⁹

Interestingly, whilst some EU Member States, in line with the Commission, advocated for the insertion of this absolute ground, others expressed their preference for the insertion of a relative ground for refusal instead.²⁴⁰ In the end, the absolute-ground proposal prevailed. The three EU legislative bodies (Commission, European Parliament, Council of the European Union) agreed then on the final wording without much difficulty.

52. Article 7(1)(m) EUTMR reads as follows:

[The following shall not be registered:] trade marks which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or national law, or international agreements to which the Union or the Member State concerned is a party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species.

This provision can be dissected into the therein laid out requirements, which must be cumulatively fulfilled.

- Regarding conflicting earlier PVDs, such must have been registered:
 - i) at national, EU, or international scale (third countries vis-à-vis the EU that are party to the UPOV Convention);²⁴¹ and

²³⁸ Philipp von Kapff, 'Vesuvius und FEZ 007 - Marken und/oder Sortenbezeichnungen für Pflanzen' in Büscher, W., et al, *Festschrift für Karl-Heinz Fezer zum 70. Geburtstag: Marktkommunikation Zwischen Geistigem Eigentum Und Verbraucherschutz*. (2016) C. H. Beck, p. 765.

²³⁹ Stefan Martin, General Court clarifies for the first time the scope of protection of plant variety denominations under Article 7(1)(m) of the European Trade Mark Regulation. (2019) *Journal of Intellectual Property Law and Practice (JIPLP)*, Oxford University Press, p. 749. Article 7(3) EUTMR establishes that "paragraph 1(b), (c) and (d) [of the same article] shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it". Accordingly, titleholders of well-known and commercially successful PVRs were traditionally tempted to register the concerned PVD as TM by relying on acquired distinctiveness in consequence of use. This type of situation is now ruled out with Article 7(1)(m) EUTMR.

²⁴⁰ United Kingdom and Ireland preferred the insertion of a relative ground for refusal [See the position of the delegations in footnote on "Article 7(1)(l)" in p. 20 of "Presidency compromise proposal of 18 July 2014 for discussion in the Coreper meeting on 23 July 2014 (Doc. No 11826/14)", available at <https://bit.ly/3ldesD8> [Accessed: 6 November 2020]].

²⁴¹ The wording chosen reveals the will of the EU legislator to achieve a uniform and universal registration of PVDs in all UPOV Members. Accordingly, within the meaning of Article 7(1)(m) EUTMR, the

- ii) prior to the time of filing of the EUTM application at stake.²⁴²
- Regarding the EUTM applied for, such must:
 - iii) consist of, or reproduce in its essential elements, the earlier PVD; and
 - iv) be applied for in relation to plant varieties of the same species as, or of species closely related to, those protected by the registered PVD.

53. The rationale underpinning this new provision is that, because PVRs are limited in duration whereas the life of a TM can be perpetuated endlessly, a breeder may feel tempted, once his/her PVR expires, to apply for an EUTM identical/similar to the PVD associated with said expired PVR with a view to “artificially” expand by means of a TMR the monopoly acquired with the PVR.²⁴³ It is precisely to avoid this from happening that such stringent examination approach has crystallised in the EUTMR.

6.1.2. Practice of EUIPO Examiners under Article 7(1)(m) EUTMR

54. In order to verify whether the cited conditions are satisfied, EUIPO examiners resort in practice to the Variety Finder database as main tool for consultation.

Examiners should be especially wary of EUTMs applied for in relation to live plants, agricultural seeds, fresh fruits, fresh vegetables (or an equivalent wording) in Class 31. What should be first checked is whether the term(s) making up the EUTM applied for or the essential elements of said sign coincide(s) with a registered PVD or with the

concerned earlier PVD may have been registered: i) by the CPVO; ii) by a national PVR Office of an EU Member State; iii) by the relevant PVR Office of a third country (vis-à-vis the EU) that is a UPOV Member; iv) under the framework of an international agreement to which the Member State concerned is a party. In what concerns this last option iv), it is unclear which international agreement(s) is actually being referred to. The EU has a shared competence with the Member States in the area of plant variety law, yet, no EU Member State is party to an international agreement providing for the protection of PVRs other than the UPOV Convention [Verena von Bomhard and Alexander von Muhlendahl, *Concise European Trade Mark Law*. (2018) Kluwer Law International]. In any case, this mention could be regarded as a sort of *in futurum* category and as an emphasis on the international dimension of PVDs.

²⁴² In line with the standard examination practice: the examination of absolute grounds must always be based on the time of application of the EUTM applied for (or the priority date, if priority is claimed) [*Flugbörse* (C-332/09 P) [2010] EU:C:2010:225].

²⁴³ See above pp. 37-38 of this thesis. The reverse order, that is, applying for an EUTM first, and then for a PVR, does not present a threat of comparable magnitude. On account of the inherent differences between, on the one hand, TMRs and, on the other hand, PVRs and PVDs, the author holds the view that no *ex officio* refusal equivalent to that enshrined in the EUTMR seems necessary in the CPVRR. Consequently, pursuing a “perfect symmetry” between the CPVO and the EUIPO examination approaches should not be aimed at.

denomination of a variety for which protection has expired, or been surrendered or terminated.²⁴⁴

55. It must be emphasized in this regard that, in compliance with Article 20(1)(b) UPOV Convention, the EUTM applied for should not hamper the free use of the concerned PVD in connection with the variety, what applies even after the expiration of the PVR at stake. Hence, not only PVDs in force but also those appearing in the Variety Finder database with the status “expired”, “surrendered” or “terminated” are covered by Article 7(1)(m) EUTMR. This essential aspect was recalled in the EUIPO Examination decisions “TOCHIOTOME”,²⁴⁵ “ROYAL FLOWERS”²⁴⁶ and “SKJOLD”,²⁴⁷ where the EUIPO examiners remarked that what was relevant is whether such PVDs had been registered at some point before the filing of the EUTM application, regardless of their current status at that moment (in the cases in question: expired, surrendered, and terminated, respectively). It is also irrelevant whether the concerned earlier PVR is registered in the name of the EUTM applicant or a third party since, again, Article 7(1)(m) EUTMR pursues the public interest of preventing any in compliance with Article 20(1)(b) UPOV Convention.²⁴⁸

56. The EUIPO examiner must next ascertain whether the plant variety designated by the conflicting PVD corresponds to the same or to a closely related species as those plants covered by the EUTM application. The general rule to be applied is that the objection to the EUTM registration concerns the genus to which belongs the conflicting earlier variety (the genus covering varieties of the same or of closely related species).²⁴⁹ It is noted that the system of UPOV Classes (including the exceptions) is here used as reference.

²⁴⁴ EUIPO Guidelines for Examination of European Union Trademarks, Part B (Examination), Section 4 (Absolute Grounds for Refusal), Chapter 13, *Trademarks in conflict with earlier Plant Variety Denominations* [Article 7(1)(m) EUTMR] (February 2020).

²⁴⁵ Decision TOCHIOTOME (application No 018030647) [2019], EUIPO Examination Division. The term ‘TOCHIOTOME’ corresponds to the PVD of a PVR that was registered in Japan and, therefore, protected at International level under the UPOV Convention (current status of PVR: expired).

²⁴⁶ Decision ROYAL FLOWERS (application No 017022922) [2018], EUIPO Examination Division. The term ‘ROYAL’ corresponds to the PVDs of several PVRs that were registered at EU level with the CPVO (current status of PVRs: surrendered).

²⁴⁷ Decision SKJOLD (application No 18089857) [2019], EUIPO Examination Division. The term ‘SKJOLD’ corresponds to the PVD of a PVR that was registered at EU level with the CPVO (current status of PVR: terminated).

²⁴⁸ In several decisions taken by EUIPO and by its Boards, it is observed that the EUTM applicant is also the titleholder of the conflicting earlier PVD.

²⁴⁹ Taking as example the scientific name for the product “oats”, “*Avena sativa*”. The term “*Avena*” describes the genus and in principle includes the closely related species *Avena abyssinica*, *Avena byzantine*, *Avena fatua*, *Avena nuda*, etc. [EUIPO Guidelines for Examination of European Union Trademarks, Part B (Examination), Section 4 (Absolute Grounds for Refusal), Chapter 13, *Trademarks in conflict with earlier Plant Variety Denominations* [Article 7(1)(m) EUTMR] (February 2020)].

The nub of the issue lies in that an EUTM is usually registered for the whole Class 31, that is, in relation to “all living plants” and embracing thereby all genera and species.


In order to overcome confrontations with earlier PVDs, the EUIPO examiner provides the EUTM applicant with the possibility to exclude the conflicting plant-related products from the list of products covered by the EUTM application.

57. As to the sign applied for, Article 7(1)(m) EUTMR comprises two distinct situations:

- First, that where the EUTM applied for is identical with an earlier PVD (“consist of”). This scenario is quite straightforward: the application must be rejected.²⁵⁰
- Second, the EUTM applied for can be composed of several elements, one or some of which coincide with an earlier PVD. This scenario requires a closer scrutiny from EUIPO examiners. The EUTM application must be refused where, following an overall assessment of the sign, the PVD is regarded as constituting an essential element of the said sign. The aim pursued with the wording “reproduce in its essential elements” is preventing the circumvention of the prohibition in Article 7(1)(m) EUTMR by adding or modifying subordinate non-essential elements.²⁵¹

A term identical to a PVD will be considered one of the essential elements of the EUTM application when the other elements are visually secondary, or when the conceptual meaning of the sign reinforces the perception of the term as a PVD, for instance, if the other elements in the sign are perceived as mere qualifiers of a plant variety.²⁵²

For illustrative purposes, it is worth reproducing the graphical examples showcased in the EUIPO Guidelines on the examination of EUTMs in conflict with earlier PVDs:²⁵³

EUTM applied for (Class 31)	Decision by EUIPO
	<p>‘AZAHAR’ is a PVD registered for <i>Gossypium hirsutum</i> L. The additional element ‘BIO’ is visually secondary and could be an additional indication that merely qualifies the plant</p>

²⁵⁰ Assuming, of course, that the other requirements for Article 7(1)(m) to be applicable are also met.


²⁵¹ Verena von Bomhard and Alexander von Muhlendahl, *Concise European Trade Mark Law*. (2018) Kluwer Law International.

²⁵² For example: terms referring to colour, size, growth or season indicators [EUIPO Guidelines for Examination of European Union Trademarks, Part B (Examination), Section 4 (Absolute Grounds for Refusal), Chapter 13, *Trademarks in conflict with earlier Plant Variety Denominations [Article 7(1)(m) EUTMR]* (February 2020)].

²⁵³ EUIPO Guidelines for Examination of European Union Trademarks, Part B (Examination), Section 4 (Absolute Grounds for Refusal), Chapter 13, *Trademarks in conflict with earlier Plant Variety Denominations [Article 7(1)(m) EUTMR]* (February 2020).

	variety (organically-grown AZAHAR). EUIPO objected and proposed a limitation excluding agricultural products of the genus <i>Gossypium</i> .
	'GIOIA' is a PVD registered for <i>Dianthus L.</i> The size and position of the PVD enhance its visual relevance in the sign. The elements 'CREA BONTÀ' ("creates good things") are in a secondary position and their meaning neither contradicts nor would be seen as diluting the relevance of the PVD itself. EUIPO objected and the application was limited so as to exclude plants belonging to the botanical genus <i>Dianthus</i> .
	'CHOICE' is a registered PVD. The verbal elements ('BUTCHER'S CHOICE') and the figurative elements (the knife and the meat cleaver) constitute a logical unit with a clear conceptual meaning, which does not point to any possible perception of the PVD. The sign can be registered.
	'QUALITY' is a registered PVD. Considering the size of the term 'quality' and its position in the overall arrangement of the sign, it cannot be seen as an essential element of the sign.

Decisions "GroMax by DLF"²⁵⁴ and "microclover by DLF"²⁵⁵ of the Second Board of Appeal are as well representative of what conflicts between EUTM applications and earlier PVDs look like.


In "GroMax by DLF", the Board confirmed the rejection by EUIPO of the EUTM application  on the basis of the earlier registered PVD 'MAX'.²⁵⁶ According to the Board, the earlier PVD 'MAX' could not be regarded as a secondary component of the sign. First, 'Gro' and 'Max' have the same font size and length. Second, the element 'Max' is perceived at the visual level as being separate from the element 'Gro', due to the

²⁵⁴ *Gro Max by DLF (fig.)*, R 2541/2017-2 [2018], Second Board of Appeal of EUIPO [The objection was directed against the following products as designated in the EUTM application: agricultural, horticultural and forestry products and cereals (not included in other classes), vegetables, seeds and seeds, natural plants and flowers, foodstuffs for animals, malt (Class 31)].

²⁵⁵ *Microclover by DLF (fig.)*, R 2542/2017-2 [2018], Second Board of Appeal of EUIPO [The objection was directed against the following products as designated in the EUTM application: agricultural, horticultural and forestry products and cereals (not included in other classes), vegetables, seeds and seeds, natural plants and flowers, foodstuffs for animals, malt (Class 31)].

²⁵⁶ *Gro Max by DLF (fig.)*, R 2541/2017-2 [2018], Second Board of Appeal of EUIPO, paragraph 18.

capital letter ‘M’ and the different shades of green.²⁵⁷ The Board went on to consider that such different colours would strengthen the impression that ‘Max’ is a separate element in the sign and thus one of its essential elements.²⁵⁸

In a similar spirit, in “microclover by DLF” the EUTM applied for  was rejected on the grounds that it reproduced, in its essential elements, the earlier registered PVD ‘MICRO’.²⁵⁹

58. A last scenario that must be mentioned, is that of conflicts between EUTMs and non-registered PVDs.²⁶⁰ Albeit this case is not covered by Article 7(1)(m) EUTMR, non-registered PVDs can become customary in the practices of horticultural trade, within the meaning of Article 7(1)(d) EUTMR.²⁶¹ For example: plants are often given common or vernacular names arising from common use by people in contact with the plants.²⁶²

Where a PVD has become a common name to identify exactly a concrete (unregistered) plant variety, an application for an EUTM consisting of the cited PVD, where the concerned variety is covered in the list of goods, must be reasonably rejected. Otherwise, allowing the registration could cause barriers to the free circulation of goods.²⁶³

6.1.3. Landmark Joint-Cases of the Boards of Appeal of the EUIPO

59. Under the former Community Trade Mark Regulation (henceforth, “CTMR”)²⁶⁴ conflicts between applications for Community trade marks (henceforth, “CTMs”) and earlier PVDs were traditionally resolved on the basis of lack of distinctive character

²⁵⁷ *Gro Max by DLF (fig.)*, R 2541/2017-2 [2018], Second Board of Appeal of EUIPO, paragraph 16.

²⁵⁸ *Gro Max by DLF (fig.)*, R 2541/2017-2 [2018], Second Board of Appeal of EUIPO, paragraph 19.

²⁵⁹ *Microclover by DLF (fig.)*, R 2542/2017-2 [2018], Second Board of Appeal of EUIPO, paragraph 18.

²⁶⁰ More precisely: PVDs identifying unprotected PVRs. Registered and/or IP-protected plant varieties are only a part of the vast totality of the existing plant varieties in the world. Indeed, many are simply registered in non-binding listings/catalogues but do not enjoy IP protection.

²⁶¹ Under a similar reasoning, Article 7(1)(b) and (c) EUTMR could also be applied in regard of non-registered PVDs. In “Silverado”, the First Board of Appeal of EUIPO established that the decisive factor in cases concerning earlier PVDs is whether the designation became the name of the variety at the time when the EUTM was applied for, either through the entry in the variety register, *either in general linguistic usage* (our emphasis) [*Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 25]. Likewise, in “Fame”, the same Board established that if the list of goods only covers plants in respect of which no variety denomination is registered *or known* (our emphasis), the ground for refusal of descriptive indication is inapplicable [*Fame*, R 1959/2013-1 [2014], First Board of Appeal of EUIPO, paragraph 31].

²⁶² Jay Sanderson, ‘Bringing Order and Stability to Variety Denomination’ in *Plants, People and Practices: The Nature and History of the UPOV Convention*. (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, p. 155.

²⁶³ Paul van der Kooij, Is something rotten in the Member States?. (2000) *European Intellectual Property Review (E.I.P.R.)*, Vol. 22, Issue 5, p. 190.

²⁶⁴ Council Regulation (EC) No 207/2009 on the Community trade mark.

[Article 7(1)(b) CTMR],²⁶⁵ descriptiveness [Article 7(1)(c) CTMR],²⁶⁶ customary use [Article 7(1)(d) CTMR],²⁶⁷ and/or public policy [Article 7(1)(f) CTMR]^{268, 269}

The case law preceding the entry into force of the latest EUTMR reform is worthy of revisit, as the First Board of Appeal of the EUIPO²⁷⁰ interpreted some key concepts that are still of relevance to the current EUIPO examining practice. Six joint appeal decisions delivered on October 2015 and sharing a similar set of characteristics marked a turning point: “Silverado” (R 279/2014-1), “Ice Tea” (R 895/2014-1), “Geisha” (R 528/2014-1), “Wasabi” (R 691/2014-1), “Skyfire” (R 894/2014-1), and “Goldrush” (R 280/2014-1).²⁷¹

The importance of these cases lies in that the commercial reality of plant-related products was analysed and the conditions under which an EUTM can be associated to PVDs in the marketplace were pinned down. The Board organised a historical public oral hearing (in spring 2015) where, in addition to the lawyer of the appellants, representatives from the CPVO, the European Seed Association (“ESA”, now renamed as “Euroseeds”)²⁷² and Plantum,²⁷³ were invited as experts to shed light on market and labelling practices affecting plant-related products, as well as on the interface between PVR and TMR law.

²⁶⁵ Equivalent to the current Article 7(1)(b) EUTMR, pursuant to which EUTMs devoid of distinctive character shall not be registered. *See Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 44: “the more closely the sign applied for resembles the designation most likely to be used for the product in question, the greater the likelihood of that sign being devoid of any distinctive character”.

²⁶⁶ Equivalent to the current Article 7(1)(c) EUTMR, providing that registration is to be refused in respect of descriptive marks, that is, marks composed exclusively of signs or indications which may serve, in trade, to designate the characteristics of the categories of goods or services in respect of which registration is applied for. It is here interesting to note that, *per se*, a fanciful designation chosen by the breeder to designate a variety as its PVD cannot have descriptive content according to TMR law. The “descriptiveness” of such fanciful designation lies only in the legal significance that it has acquired as a result of being assigned as a PVD in relation to a specific variety [*See, by analogy, Continental* (T-383/10) [2013], ECLI:EU:T:2013:193, paragraphs 40, 52 and 57].

²⁶⁷ Equivalent to the current Article 7(1)(d) EUTMR, pursuant to which trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of trade shall not be registered.

²⁶⁸ Equivalent to the current Article 7(1)(f) EUTMR, which excludes from registration trade marks that are contrary to public policy or to accepted principles of morality. In this context, the public interest to be safeguarded is the unhindered use of the PVD for the sake of market transparency, of avoidance of deception and of protection against infringements of PVRs.

²⁶⁹ Philipp von Kapff, ‘Vesuvius und FEZ 007 - Marken und/oder Sortenbezeichnungen für Pflanzen’ in Büscher, W., et al, *Festschrift für Karl-Heinz Fezer zum 70. Geburtstag: Marktkommunikation Zwischen Geistigem Eigentum Und Verbraucherschutz*. (2016) C. H. Beck, p. 760.

²⁷⁰ Back then, the EUIPO was called “Office for the Harmonisation of the Internal Market” (OHIM).

²⁷¹ All the appeal applications were lodged by the same firm, Rosen Tantau, except for one (“Wasabi”), lodged by the firm Kordes’ Söhne Rosenschulen. Both are widely-known rose-breeding companies.

²⁷² Euroseeds is the voice of the European seed industry, representing the interests of those active in research, breeding, production and marketing of seeds of agricultural, horticultural and ornamental plant species. Euroseeds is composed of over 100 members, mostly National seed associations and seed firms.

²⁷³ Plantum is the Dutch association representing the interests of companies that are active in plant breeding, tissue culture, production and trade of seeds and young plants. The members of Plantum develop their activities in relation to agricultural, horticultural and ornamental species.

60. Factual background. All contested CTM applications were originally applied for in relation to:

Live plants and natural flowers, in particular roses and rose plants; propagation material for plants (Class 31).

Accordingly, all genera were covered under the CTM applications, including those to which belonged the plant varieties designated by the conflicting PVDs. The EUIPO examiner refused the applications based on Article 7(1)(c) (descriptive indication) and (b) CTMR (lack of distinctive character) in regard of products encompassing the concerned plant varieties (“Live plants and natural flowers”, “propagation material for plants”). The examiner then found that the CTM applications should also be rejected in relation to the remaining products (“roses and rose plants”), because “an additional objection would be raised, as the term would then be deceptive”.

Arguments of the appellants. The appellants contested the approach adopted by the EUIPO examiner. They alleged that there was no reason to sustain that a PVD for a variety of a completely different nature from roses could be deceptive as TM for roses. In their view, it could not be assumed that purchasers of a plant of a specific genus would project characteristics associated with a PVD of a different genus onto the product sought, as the reasonably observant average consumer notices the differences between plants of different genera at the time of purchase.²⁷⁴

From their part, the invited experts highlighted the need to keep PVDs available for closely-related species. However, besides such perimeter, they deemed unlikely risks of confusion in case of use of the same designation for plants belonging to different genera.

61. Reasoning and findings of the Board. The Board upheld the appeals, following to a large extent the recommendations of the invited experts. The most relevant findings are grouped into the sections below exhibited:

- *Relevant Public of Plant-Related Products in Class 31*

According to the Board,²⁷⁵ plant-related products in Class 31 target two types of public:

²⁷⁴ See, for instance, *Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 8. Plants and propagation material are offered for sale together with product information, including precise clarification as to which plant genus and/or plant variety are involved. The appellant illustrated his claim with an example: “a consumer seeking plants of particular genera knows that a rose is not a pelargonium, clematis, petunia or malus”.

²⁷⁵ *Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 39.

- i) The general public, made up of average consumers wishing to purchase live plants, natural flowers and propagation material for plants.²⁷⁶
- ii) A specialist public including plant breeders, cultivation companies, and wholesalers and retailers who sell plants, flowers and propagation materials.

The Board held the view that, when selecting the products, both sections of the relevant public pay attention to the designation of the genus and species of the plant, as well as to its characteristics²⁷⁷ and, to a lesser extent, to the PVD.²⁷⁸ The PVD is usually of secondary importance to the end consumer. However, in the case of variety constituents (such as seeds or seedlings) which are intended to be used as propagation material, and where the variety cannot be easily recognised, the PVD plays an essential role.²⁷⁹

The Board also remarked that, when buying plants, consumers are primarily guided by their objective: what type of plant they are looking for, what characteristics that plant should have, or what basic conditions must be considered for the maintenance and development of the plant. Consumers then select, amongst the specific offer range on the market, the variety that comes closest to their objective.²⁸⁰

- *Coexistence between EUTMs and PVDs*

The Board went on to recognise the role performed by labelling regulations and practices in the commercialisation of plant-related products: on the one hand, traders usually offer plants by designating rather technical details (genus, species, PVD, and plant characteristics) and, on the other hand, they make use of a TM or trade name.²⁸¹

In line with the UPOV Convention, the Board acknowledged the possibility of using TMs in association with PVDs, as long as PVDs are easily recognisable.²⁸²

- *The Concept of “Closely Related Species”*

The Board decided to borrow and apply the UPOV-notion of “closely related species”.²⁸³ Accordingly, when comparing the plant-related products (species) in relation to which an

²⁷⁶ The CJEU considers that the average consumer is reasonably well informed and reasonably observant and circumspect [*Lloyd Schuhfabrik Meyer* (C-342/7) [1999], ECLI:EU:C:1999:323, paragraph 26].

²⁷⁷ For example: colour, appearance, flowering time, resistance, soil compatibility and commercial origin.

²⁷⁸ *Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 40. According to settled EU case law, the levels of attentiveness from the part of the consumer vary from sector to sector [*Linde and Others* (C-53/01) [2003], ECLI:EU:C:2003:206, paragraph 41].

²⁷⁹ *Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 49.

²⁸⁰ *Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 45.

²⁸¹ *Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 46.

²⁸² *Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 46.

²⁸³ See Article 63(3)(c) and (5) of the CPVRR. *Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraphs 49 to 58.

EUTMR is applied for with the plant variety designated by the earlier PVD, the term “closely related species” should be interpreted as “plant varieties of species within the same genus in a botanical sense” and the system of UPOV classes duly taken into account.

▪ *Limitations in the List of Designated Products by means of Precise Wording*

The Board remarked that the wording of the designated plant-related products in Class 31 had to be amended in all EUTM applications, in conformity with the notion of “closely related species”. The Board recalled that the wording “in particular” (in relation to roses) in the EUTM applications did not limit the scope demarcated by the designated products, but was rather seen as clarifying example. In “Goldrush”, “Geisha” and “Silverado”, the Board accepted the restriction proposed by the appellant:

*Live plants and natural flowers, ~~in particular~~ **namely** roses and rose plants; rose propagation material ~~for plants~~ (Class 31).*

By deleting the expression “in particular” and using instead the word “namely”, the broad category “live plants and natural flowers” was limited to just “roses and rose plants”.²⁸⁴ The EUTMs applied for were now deemed acceptable, as the conflicting plant species had been excluded.²⁸⁵ The Board then agreed with the appellants in that the reasonably observant consumer could distinguish “roses” from varieties of other genera, so there was no reason to assume deception²⁸⁶ within the meaning of Article 7(1)(g) CTMR.²⁸⁷

²⁸⁴ Goods must be indicated with sufficient clarity and precision in order to be entered in the EUIPO register [*IP Translator* (C-307/10) [2012], EU:C:2012:361].

²⁸⁵ *Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraph 17; *Geisha*, R 528/2014-1 [2015], paragraph 15; and *Goldrush*, R 280/2014-1 [2015], paragraph 16.

²⁸⁶ The Board made reference to settled EU case law, according to which deception requires it to be established that the consumer has been misled or there is a sufficiently serious risk of this [*Elizabeth Emanuel* (C-259/04) [2006], EU:C:2006:215, paragraph 48]. In this context, a TM could be deceptive if conveying the impression that the variety concerned has special attributes, such as a particular colour of flowers, which in reality it does not have [*Silverado*, R 279/2014-1 [2015], First Board of Appeal of EUIPO, paragraphs 62 and 63].

²⁸⁷ In “Wasabi” it was considered that consumers buying propagation material under the contested EUTM “Wasabi” could be under the false impression that they were buying horseradish seeds, because ‘Wasabi’ is a customary designation for Japanese horseradish [*Eutrema wasabi* L.]. The application was reduced to:

Roses and rose plants, and rose-propagating stock (Class 31).

As to “Skyfire” and “Ice Tea”, the species to which the earlier PVDs belonged were explicitly excluded. In “Skyfire”, the application was amended to exclude the genus *Iris* to which the PVD ‘Skyfire’ belongs:

*Live plants and natural flowers, **other than those of the botanical genus ‘Iris’**; propagation material for plants, **other than those of the botanical genus ‘Iris’*** (Class 31).

In “Ice Tea”, as ‘Ice Tea’ is the PVD for a variety within the genus *Dianthus* L., and is also the designation for the cool beverage “Ice Tea”, which is customarily produced from the leaves of the tea plant within the genus *Camellia* L., the EUTM application was limited as follows:

*Live plants and natural flowers, in particular roses and rose plants, **other than those of the botanical genus ‘Dianthus L.’ and ‘Camellia L.’ (tea plant)**; propagation material for plants, **other than that for plants of the genus ‘Dianthus L.’ and ‘Camellia L.’ (tea plant)*** (Class 31).

62. Lessons to be extracted from the decisions. These joint cases bring along implications that extend beyond a mere EU decision-making process. The findings therein exhibited evince how the law’s interpretation is shaped in consonance with the relevant scientific discipline at stake (plant taxonomy in this case). Practical guidance was provided for the sake of a peaceful coexistence between TMRs and PVRs. The Board also led by example in the commitment of the EU vis-à-vis UPOV as Contracting Party. In sum, TMRs are of a polyhedric nature that inherently connects them to different sectorial legislations as well as to particular market realities.

6.1.4. Judgement ‘Kordes’ Rose Monique’ of the General Court of the European Union on the Interpretation of Article 7(1)(m) EUTMR

63. The General Court of the European Union (henceforth, “General Court”) marked a turning point in interpreting for the first time Article 7(1)(m) EUTMR in its judgement “Kordes’ Rose Monique” (T-569/18) of 18 June 2019.²⁸⁸

Factual background. The case concerned the application for the following word mark:²⁸⁹

Kordes’ Rose Monique

The EUTM was applied for in respect of ‘Roses and rose plants, and rose-propagating stock’ in Class 31. The application was rejected pursuant to Article 7(1)(m) EUTMR in relation to all the designated goods, on the basis of the earlier PVD ‘Monique’ associated to a PVR registered in the Netherlands for a rose variety.²⁹⁰

On appeal before the First Board of Appeal, the application was again dismissed.²⁹¹ The Board rejected the EUTM applied for on the grounds that the element ‘Monique’ is an essential element of the sign within the meaning of Article 7(1)(m) EUTMR. The Board held the view that this legal provision should not be interpreted as requiring that the PVD reproduced in a sign be the only essential or dominant element of such.²⁹² It was considered that, from a visual and aural perspective, the three elements of which the contested sign is composed carry equal weight. From a conceptual prism, the word sequence was held to convey a clear content (at least in English or German): “a rose

²⁸⁸ *Kordes’ Rose Monique* (T-569/18) [2019], EU:T:2019:421.

²⁸⁹ The EUTM application was filed on 26 September 2016 by W. Kordes’ Söhne Rosenschulen GmbH & Co KG (the appellant in this case).

²⁹⁰ Registration No ROO2671.

²⁹¹ See *Kordes’ Rose Monique*, R 1929/2017-1 [2018], First Board of Appeal of EUIPO.

²⁹² *Kordes’ Rose Monique*, R 1929/2017-1 [2018], First Board of Appeal of EUIPO, paragraph 14.

bearing the name ‘Monique’ being sold by the firm Kordes”.²⁹³ The appellant contested the Board’s decision before the General Court.

64. Reasoning and findings of the General Court. The General Court upheld the appeal. It took a view diametrically opposed to that of the Board and found that the contested sign does not reproduce, in its essential elements, an earlier PVD. The General Court considered that what must be ascertained is whether the distinctive character of the contested sign lies in the PVD and not in the additional elements composing the sign.²⁹⁴ Accordingly, the General Court established that:

- the element “**Kordes**” is the dominant and only distinctive element of the contested sign, in view of its position (beginning of the sign)²⁹⁵ and of the fact that it is the name of the undertaking from which the flowers originate;
- the element “**Rose**” constitutes a mere supplementary element referring to a plant variety and descriptive of the products in question; and
- the element “**Monique**” is to be understood as a generic designation.

In the light of the above, the General Court found that the sign as a whole conveys the message of a rose with the variety name ‘Monique’ originating from the firm “Kordes”.

65. Practical implications. The General Court has marked a discombobulating precedent by finding that a PVD, by virtue of being a generic designation, cannot in principle constitute an essential element of a sign. This finding may be superfluous and run against the spirit of the EU legislator: it is precisely because PVDs are generic in nature that registration of such designations as EUTMs should be impeded, reason why a tailor-made provision for this situation was introduced in the first place. The snake biting its own tail! The interpretation of the General Court translates into signs including PVD-elements being able to make it to registration by means of the addition of further elements, as long

²⁹³ *Kordes’ Rose Monique*, R 1929/2017-1 [2018], First Board of Appeal of EUIPO, paragraph 15. A similar reasoning is observed in decision ROYAL FLOWERS (application No 017022922) [2018], EUIPO Examination Division. The contested sign was here ‘ROYAL FLOWERS’, which element ‘ROYAL’ (coinciding with an earlier registered PVD) was regarded as constituting an essential part of the sign. The element “FLOWERS” was seen as incapable of performing the essential function of a TM in relation to the concerned designated products (fresh cut flowers).

²⁹⁴ *See Kordes’ Rose Monique* (T-569/18) [2019], EU:T:2019:421, paragraphs 31 and 32: “it is necessary to establish whether the plant variety right occupies an essential position in the complex mark applied for, so that the essential function of origin of the mark, namely that of identifying the commercial origin of the products in question, is based on that plant variety right and not on the other elements that make up the complex mark applied for”.

²⁹⁵ *See Tetra Pharm (1997) v EUIPO (SeboCalm)* (T-441/16) [2017], ECLI:EU:T:2017:747, paragraph 49.

as reasons can be found to sustain that the latter are dominant in the sign and/or endowed of distinctive character. As a corollary, the application of Article 7(1)(m) EUTMR may be easily ruled out (or rather circumvented).²⁹⁶ One can go even further to sustain that the *effet utile* of this provision can be jeopardised, as the way is being paved for potential monopolisations of PVDs through the EU TM system.

This notwithstanding, it is observed that the procedure before the CJEU has not yet been exhausted. A suggested way out of the described crossroads is the lodging by a national court of a preliminary request addressed at the CJEU for further clarifications regarding the interpretation of Article 4(1)(l) TMD, or by a belligerent EUTM applicant determined to go through all the required deciding-instances up to the CJEU [on a case involving an earlier PVD pursuant to Article 7(1)(m) EUTMR].²⁹⁷



Figure 24. Picture of the Rose ‘Monique’ marketed by Kordes © Rosa Plaza

²⁹⁶ This finding also implies that in opposition or infringement proceedings, a finding of likelihood of confusion cannot be justified on the basis of the presence in both signs of the same PVD [Stefan Martin, General Court clarifies for the first time the scope of protection of plant variety denominations under Article 7(1)(m) of the European Trade Mark Regulation. (2019) *Oxford Journal of Intellectual Property Law & Practice (JIPLP)*, Vol. 14, Issue 10, p. 749].

²⁹⁷ As already noted above, admittance of the appeal before the CJEU can only be granted when an appeal raises an issue of significance to the unity, consistency or development of EU law.

6.2.Cancellation Actions against EU Trade Marks affecting earlier Plant Variety Denominations

66. Having navigated through the impediments to registration of EUTMs at examination level, it is now deemed pertinent to examine the commonly invoked grounds for cancellation of registered EUTMs in connection with earlier PVDs.

6.2.1. *Invalidity Actions based on Bad Faith Grounds*²⁹⁸

The *forbidden-fruit* strategy that plant breeders should avoid resorting to is that of attempting to artificially extend the monopoly derived from a PVR by registering, upon its expiration, a TM with an identical/similar designation to the PVD concerned. Since TMRs can be renewed endlessly, a serious obstacle to the free circulation of goods within the internal market could be raised.²⁹⁹ Some authors have referred to this practice of monopolising designations as “an impairment to a trader’s right to *free commercial expression*”.³⁰⁰

In such event, albeit third parties (including competitors) are allowed to freely propagate variety constituents from the formerly protected plant variety, they would be prevented from selling the plant material under the controverted TM. They would then find themselves forced to introduce another TM for the same variety or to enter into negotiations with the TMR titleholder in order to come to a licence agreement.³⁰¹

Furthermore, a TMR could be (mis)used to scare away non-licensees from attempting to produce or propagate variety constituents, even when the latter is perfectly allowable once

²⁹⁸ Another invalidity ground that can be invoked in connection with PVRs and PVDs is that laid down in Article 60(2)(d) EUTMR, pursuant to which “An EU trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right under the Union legislation or national law governing its protection, and in particular: [...] (d) an industrial property right.” The category “industrial property right” must of course be seen as encompassing PVRs.

²⁹⁹ The monopoly granted by some IPRs is limited in time for a reason, and this limitation should under no circumstance be circumvented. This has been made very clear in settled EU case law on occasion of cases concerning the interface between TMRs and designs, and TMRs and patents [See, for example, *Lego Brick* (T-270/06) [2008], EU:T:2008:483]. It is interesting also that in the United States, in the *Dixie Rose* case, the competent court asserted that offering TMR protection in the case under scrutiny would bestow the applicant of an “unfair advantage”, because the applicant also had plant patent protection for roses, so the TM protection would “tend to prolong the applicant’s monopoly, beyond the life of the applicant’s patent, by making it difficult for a newcomer to break into the field” [*Dixie Rose Nursery v. Coe, Comm’r of Patents*, 131 F.2d 446 (D.C. Cir. 1942), 318 U.S. 782 (1943), 447].

³⁰⁰ Pierre N. Leval, ‘Trademark: Champion of Free Speech’ (2004) *Columbia Journal of Law and Arts*, Vol. 27, p. 187.

³⁰¹ Paul van der Kooij, Is something rotten in the Member States?. (2000) *European Intellectual Property Review (E.I.P.R.)*, Vol. 22, Issue 5, p. 190.

the concerned PVR expires. This issue is further exacerbated by the fact that a significant number of commercial nurseries entering into license agreements have poor knowledge of IP, and do not master the essential differences between TMRs and PVRs and PVDs.³⁰²

The described situation is precisely the type envisaged by the notion of “bad faith” under EUTMR law, as recently clarified by the CJEU in *SkyKick*.³⁰³ The CJEU here held that the registration of a TM without any intention to use it in relation to the goods and services covered by that registration may constitute *bad faith*, where it is apparent from relevant and consistent indicia that the proprietor of a TM filed the application not with the aim of engaging fairly in competition but with the intention of undermining the interests of third parties, or with the intention of obtaining an exclusive right for purposes other than those falling within the functions of a TM, in particular, the function of indicating origin.³⁰⁴

Applications for EUTMs are examined on the basis of a presumption of good faith from the part of applicants.³⁰⁵ *Bad faith* grounds may nonetheless be claimed retroactively as referring to the time of the application for an EUTM, by means of an invalidity action against a registered EUTM pursuant to Article 59(1)(b) EUTMR.³⁰⁶ If held invalid, the concerned EUTM is deemed as not to have had, as from the outset, any effect laid down in the EUTMR.

67. The “VESUVIA” invalidity-case of the EUIPO First Board of Appeal, as based on *bad faith* claims concerning a PVD, illustrates the described elements.³⁰⁷ The Board here declared invalid the EUTM “VESUVIA” on the following findings:³⁰⁸

³⁰² John Valleau, *Plant Name Changes: Good Science, Angry Growers and Confused Gardeners*. (2004) *Acta Horticulturae* 634 [Proc. IVth Int. Symp. Taxonomy of Cultivated Plants], p. 65.

³⁰³ *Sky v SkyKick* (C-371/18) [2020], ECLI:EU:C:2020:45.

³⁰⁴ *Sky v SkyKick* (C-371/18) [2020], ECLI:EU:C:2020:45, paragraph 75.

³⁰⁵ In other terms: the EUTMR does not foresee any absolute or relative ground for refusal based on bad faith at the application/examination level.

³⁰⁶ Article 59(1)(b) EUTMR reads: “An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings: [...] (b) where the applicant was acting in bad faith when he filed the application for the trade mark”.

³⁰⁷ *Vesuvia (Vesuvius)*, R 1743/2007-1 [2009], First Board of Appeal of EUIPO.

³⁰⁸ The Board applied here the criteria set out by the CJEU in case *Lindt Goldhase*, in conformity with which the assertion whether the applicant acted in *bad faith* must be the subject of an overall assessment, taking into account all the factors relevant to the particular case which pertained at the time of filing the application for an EUTM. These factors include, in particular: i) the intention of the applicant by reference to the objective circumstances of the particular case, namely, whether the applicant knew that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought; ii) the applicant’s intention to prevent that third party from continuing to use such a sign; and iii) the degree of legal protection enjoyed by the third party’s sign and by the sign for which registration is sought [*Vesuvia (Vesuvius)*, R 1743/2007-1 [2009], First Board of Appeal of EUIPO, paragraph 77; and *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH (Lindt Goldhase)* (C-529/07) [2009], EU:C:2009:361].

- i) The EUTM titleholder knew that ‘Vesuvius’ was the name of a rose variety at the moment of applying for the EUTM “VESUVIA”. The following facts, altogether suggested that the name choice was not innocent but, contrarily, made intentionally to monopolize the generic name ‘Vesuvius’ by means of an EUTM with a highly-similar variant name (“VESUVIA”):
 - the relatively small number of rose breeders (even on a global scale);
 - the highly specialised nature and degree of attention of the TM titleholder when choosing rose names, along with the fact that the PVD ‘Vesuvius’ had been mentioned for decades in a relevant rose encyclopaedia; and
 - the use by the EUTM titleholder of the designation “VESUVIA” for ‘Vesuvius’ type of roses on his website.
- ii) The EUTM titleholder had initiated different infringement proceedings against competitors using rose names such as ‘VESUV’, what reflected an intention to prevent third parties from marketing roses.³⁰⁹
- iii) The attempt to deter competitors from distributing ‘Vesuvius’ roses under the name ‘Vesuvius’ constituted an attempt to sidestep PVD protection.³¹⁰

6.2.2. *Revocation of EU Trade Marks that become known as the Generic Designation for a Plant Variety*

68. One aspect of which plant breeders should be particularly aware when it comes to TM strategies, is that of genericism of a TM. TM-genericism arises in two situations:

- i) some terms are essentially generic by nature and they are refused protection as sign *ab initio* [e.g.: based on Article 7(1)(m) EUTMR];
- ii) other terms might have been registered as valid EUTMs but over time have become generally accepted in the relevant trade as specific designation for the product in relation to which they were registered, thus, they do not serve to perform anymore the essential TM-function of origin-indication.³¹¹

³⁰⁹ *Vesuvia (Vesuvius)*, R 1743/2007-1 [2009], First Board of Appeal of EUIPO, paragraph 79.

³¹⁰ *Vesuvia (Vesuvius)*, R 1743/2007-1 [2009], First Board of Appeal of EUIPO, paragraph 82.

³¹¹ Well-known examples include the former TMs “Yo-Yo”, “Aspirin” and “Cellophane”.

In the latter case, an EUTM may be subject, pursuant to Article 58(1)(b) EUTMR, to an action for revocation based on genericism grounds.³¹² If an EUTM is revoked, it shall be deemed not to have had, as from the date of application for revocation, the effects specified.

The cause of genericism is found in the “acts or inactivity” attributed to the EUTM titleholder him/herself. In this regard, the CJEU has crystallised what is known as “the requirement of vigilant conduct”.³¹³ This means that the proprietor must not only abstain from using a mark in a way that could cause it to become generic, but also take action to ensure that other operators do not jeopardise the distinctiveness of the sign.

The paradox underlying genericism is that it is often the result of a successful brand.³¹⁴ The fact that “fame” is a double-edged sword for TMRs is precisely why genericism has been referred to in TMR expert-circles as “genericide”. The adage “a TM must tell *who you are* and not *what you are*” must thus be borne in mind by any TMR titleholder.³¹⁵

When establishing whether genericism arises, several factors may be considered:³¹⁶

- i) how is the TM being used in the relevant trade;³¹⁷
- ii) how do consumers perceive the TM;
- iii) the harm likely to be caused: for example, if a TM substantially increases ultimate consumer search costs or raises real entry barriers to new firms.³¹⁸

As already pointed out, breeders walk on thin ice when they use PVDs in the form of codes in connection with fanciful visually attractive TMs which somehow “overshadow” the PVD in the eyes of consumers, as these may grasp the TM as the generic designation for the variety at stake.³¹⁹ Hence, the TM falls under the *genericide-trap*! A clear distinction between PVDs and TMRs when marketing a variety is thus not just a legal obligation, but also of utmost interest to the breeder-titleholder.

³¹² Article 58(1)(b) EUTMR reads: “The rights of the proprietor of the EU trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings: [...] (b) if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered”.

³¹³ *Levi Strauss & Co. v Casucci SpA* (C-145/05) [2006], ECLI:EU:C:2006:264, paragraphs 30-34.

³¹⁴ Tyrone Berger, Traders beware: Trade mark genericism and the fault provision. (2016) *Law Institute Journal* (Law Institute of Victoria), p. 42.

³¹⁵ Tony Avent, Name that Plant: The Misuse of Trademarks in Horticulture. (2013) *The Azalean*, p. 36.

³¹⁶ Tyrone Berger, Traders beware: Trade mark genericism and the fault provision. (2016) *Law Institute Journal* (Law Institute of Victoria), p. 43.

³¹⁷ How seed propagators, growers, retailers, wholesalers, manufacturers, and advertisers use the TM.

³¹⁸ Ralph Folsom and Larry Teply, Trademarked Generic Words. (1980) *Yale Law Journal*, Vol.89, p. 1352.

³¹⁹ It is interesting to have a look at the jurisprudence of the United States on genericism of TMRs (in connection with plant varieties). In *Van Well Nursery Inc. et al v. Mony Life Insurance Company et al*, the judge ruled that the registered TMR “Scarlet Spur” was not valid anymore, as it had become known in the public domain as the generic name for the ‘Red Delicious’ variety, so it could not serve to indicate the source of such product anymore. See also *Rebel grass seed (Re Pennington Seed, Inc.)* (Fed. Cir. 2006).

69. Bearing in mind all of the above, a breeder simultaneously owning TMRs and PVRs must stick to the adage “prevention is the best cure”.³²⁰ Accordingly, the following steps can assist breeders in preventing their TMs from becoming generic:³²¹

- Proactive monitoring of the marketplace to prevent improper use by third parties (e.g.: trade publications or dictionaries) and taking immediate action thereon;
- Use of the TM as adjective, and not as noun (e.g.: “Pink Lady apples” instead of “Pink ladies”);
- Assignment of a TM-notice next to the reproduced sign (e.g.: ® symbol);
- Ensuring that the TM stands out when reproduced (e.g.: figurative coloured TMs, capital letters), all the more when used in conjunction with PVDs (which should ideally be reproduced within simple quotation marks, e.g.: variety ‘Cripps Pink’);
- Avoidance of variations of the TM, as this can signal that improper use is tolerated (e.g.: not allowing spelling changes, abbreviations, plurals, etc.);
- Setting of clear guidelines and usage protocols when concluding licenses on TMRs with third parties and, where necessary, adoption of steps to ensure compliance with such (e.g.: launching of warnings or enforcement actions).

70. CIOPORA historically led by example in warning about genericism. In fact, conflicts arose some time ago between CIOPORA and the American Rose Society (henceforth, “ARS”), the latter being the IRA responsible for the registration of rose varieties, and for the publication of the worldwide-known “American Rose Magazine” and “Modern Roses”.³²² ARS intended to register fancy names used by breeders, often corresponding to registered TMRs. The breeders represented by CIOPORA warned that listings where TMs are presented as “generic names” could jeopardise the validity of the cited TMs.³²³ CIOPORA thus requested the ARS to overhaul the registration form and guidelines so as to reflect their expressed concerns.³²⁴

³²⁰ Tyrone Berger, Traders beware: Trade mark genericism and the fault provision. (2016) *Law Institute Journal (Law Institute of Victoria)*, p. 44.

³²¹ Tyrone Berger, Traders beware: Trade mark genericism and the fault provision. (2016) *Law Institute Journal (Law Institute of Victoria)*, p. 44.

³²² Tommy Cairns, Rose Registrations: Nomenclature & Trademark Issues Resolved. (1998) *World Rose News*, p. 16.

³²³ It must be noted in this regard that the United States Patent & Trademark Office (USPTO) invalidated some TMs just because such had been listed in the Modern Roses’ catalogue as generic names. CIOPORA was however fine with indicating in these listings the TMs under which the concerned varieties were marketed, as long as such TMs were recognised as IPRs of their owners and did not appear in a manner that could evoke the impression that such were “rose names” or “synonyms” of generic names.

³²⁴ Pursuant to Article 12 EUTMR, “if the reproduction of an EU trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the

6.3. Bilateral Cooperation between the CPVO and the EUIPO

71. Within the framework of Memorandum of Understandings on bilateral cooperation between the EUIPO and the CPVO, one of the latest priorities agreed was precisely the definition of common approaches in the area of convergence between EUTMs and PVDs. So far, a number of technical workshops have been organised at the EUIPO and at the CPVO headquarters: the CPVO Variety Denominations Team has successfully trained EUIPO examiners and vice versa.³²⁵

The author believes that this cooperation could be topped if the CPVO were to establish, pursuant to Article 30(4) CPVRR,³²⁶ a sub-office (branch) at the EUIPO premises in Alicante (Spain). This would allow PVR and EUTM experts to interact personally on a daily basis when solving any conflicts arising from the clash between EUTMs and PVDs. Users from the plant breeding sector with an IP portfolio including both EUTMs and PVRs could also benefit directly from a single point of contact. Both IPRs represent a high-added value for society, so any gain in efficiency for both should be welcomed.

Further benefits could stem from such synergy. Indeed, EUTMs and Community designs share an essential characteristic with CPVRs: the three types of right deploy unitary effects throughout the whole EU territory. Exchange of best practices and joint efforts could pave the way to progress in these IPR systems.

In addition, it is recalled that beyond EUIPO's core business, other IPRs (such as copyrights) are brought under its wing.³²⁷ For the sake of EU-IPRs consistency, it would seem logic to open a CPVO sub-branch under the auspices of EUIPO, so as to centralise a more exhaustive spectrum of IPRs at EU level.



EU trade mark, ensure that the reproduction of the trade mark at the latest in the next edition of the publication is accompanied by an indication that it is a registered trade mark”.

³²⁵ More precisely, within the framework of the Memorandum of Understanding on bilateral cooperation between the EUIPO and CPVO signed on 2 February 2015 (in force until February 2020), the CPVO experts trained EUIPO examiners on the use of the CPVO Variety Finder and the rules governing the suitability of PVDs under Article 63 CPVRR. Likewise, EUIPO examiners trained the CPVO experts on opposition and revocation proceedings in respect of EUTM applications concerning signs that conflict with earlier PVDs.

³²⁶ Article 30(4) CPVRR reads: “with the consent of the Administrative Council referred to in Article 36, the Office may entrust national agencies with the exercise of specific administrative functions of the Office or establish its own sub-offices for that purpose in the Member States, subject to their consent”.

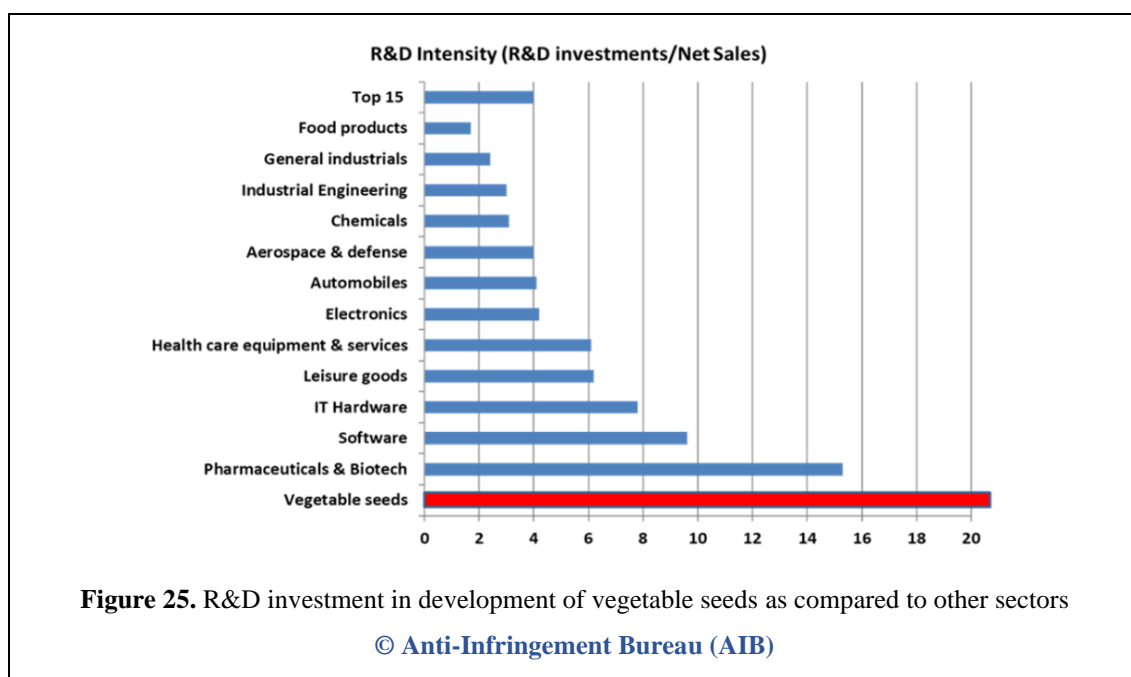
³²⁷ For instance, the EUIPO's Academy and the Observatory on infringements of IPRs carry out studies and organise trainings and cooperation activities covering a broad catalogue of IPRs and related matters.

7. A Glimpse into the Reality and Features of the Plant-Related Market

72. In the EU, the overall size of the four segments of the plant industry (agriculture, vegetable, fruit, and ornamental) represents a value of over EUR 280 billion annually (measured in terms of the value of goods sold to the consumer).³²⁸

Developing new plant varieties is a time-consuming and costly endeavour. Most breeding companies invest on average 15% of their annual turnover on developing new varieties.³²⁹

In the vegetable sector, this percentage can go up to 20%, an investment notably higher than that of other industries focused on Research and Development (R&D).



Robust IP frameworks are needed to recoup the investments incurred in by breeders and to foster plant-related innovation. Breeders count on a number of available schemes for IPR protection, including plant-related patents, PVRs, TMRs and trade secrets, as well on unfair competition legislation. This study will focus on breeder’s business models making use of PVRs, TMRs, or both, in accordance with the different circumstances pertaining to each segment of the plant market.

PVR-protection is generally sought in those countries where the plant material is likely to be “resident”, that is, where the variety is propagated, grown, and sold to the consumer;

³²⁸ One EUR billion is here understood as EUR 1.000 millions. The Industrial-related segments represent around 95% of the market, and the Domestic-related segments just 5% of the market [*Study on market-related issues regarding plant variety protection*, Deloitte for EUIPO. (2016), p. 12].

³²⁹ Out of the approximately 50.000 people the industry employs in Europe, a quarter is dedicated to research activities, with about 750 R&D stations [Research is fundamental for the plant breeding and seed sector, Euroseeds, available at <https://bit.ly/396b7kC> [Accessed: 6 November 2020].

as well as where infringements are likely to occur. As to TMR protection, it is generally sought in those countries where varieties are shipped to and sold, proving even more important in countries lacking PVR systems.³³⁰ Moreover, using different TMRs tailor-adapted to the local language and cultural habits of the concerned territories can prove advantageous for the marketing of varieties at global scale.³³¹

The licensing of both PVRs and TMRs then constitutes a powerful business tool for titleholders to create revenue streams, where licensees can carry out specified activities in relation to the concerned rights.³³²

In what comes to enforcement, the deterring effect brought forth by these IPRs is crucial.³³³ Recent trends show a progressive shifting of organised crime interest towards the production and trade of plant varieties³³⁴ and, beyond the economic prejudice caused to breeders, illicit practices are particularly worrying insofar they entail health and phytosanitary risks. To cite a few examples, some common infringements against PVDs and TMRs are the marketing of propagating material of unknown origin under the PVD and/or TM of a PVR-protected variety, or the marketing of material of a PVR-protected variety without using the corresponding PVD.³³⁵

73. It is clear that the PVR-TMR symbiosis can represent an attractive form of IPR protection, but: when should plant breeders avail themselves simultaneously of both PVR and TMR protection? In practice, this decision largely depends on the competitiveness of the plant segment, the life cycle of the variety, the geographies of interest and the number of years a breeder has within which to make the necessary return on investment.³³⁶

³³⁰ Maria Luisa Badenes and David H. Byrne, *Fruit Breeding*. (2012) Springer Science, p. 80.

³³¹ James J. Luby, and David S. Bedford, Cultivars as Consumer Brands: Trends in Protecting and Commercializing Apple Cultivars via Intellectual Property Rights. (2015) *Crop Science*, Vol. 55, p. 2509.

³³² On the one hand, a breeder can license his/her PVRs exclusively or semi-exclusively to nurseries or growers in return for royalties on propagated plants and, in some cases, on fruit sales. On the other hand, the TM can be licensed, usually under conditions such as product-quality, in different territories to accelerate the acquisition of significant global market shares. This proves particularly relevant in the case of well-known marks, as licensing agreements make possible profiting from the reputation of a such TMs [J.R. Clark and R.J. Jondle, 'Intellectual property rights for fruit crops' in J.F. Hancock, *Temperate fruit crop breeding*. (2008) Springer, p. 439-455; McKee, Voorhees & Sease, PLC, *The Plant Naming Conundrum...Protecting Your Plant Varieties in the Short and Long Term* (2018); and James J. Luby, and David S. Bedford, Cultivars as Consumer Brands: Trends in Protecting and Commercializing Apple Cultivars via Intellectual Property Rights. (2015) *Crop Science*, Vol. 55, p. 2507].

³³³ A reminder in a nutshell: TMRs can be enforced against unauthorised sales of plant material, and PVRs can be enforced against unauthorised propagation of variety constituents.

³³⁴ Marco Musumeci, Counterfeiting and food frauds. (2018) *Issue No 31 on Agribusiness*, European IPR Helpdesk, p. 14.

³³⁵ IP Enforcement Tool-Kit for Vegetable Seed Companies, Euroseeds (2006), available at <https://bit.ly/2Ic5tUd> [Accessed: 6 November 2020].

³³⁶ *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 46.

To begin with, two generic supply chains can be identified in the plant breeding sector:

- i) The food supply chain, concerning the plant industry segments of agriculture, fruit and vegetable. It covers fresh and processed fruits and vegetables as well as grains, wheats and corn used in processed food and drinks.
- ii) The ornamental supply chain, including cut-flowers, house and garden plants.

Regarding the agricultural, fruit and vegetable industrial segments, these are characterised by long variety development cycles (ranging from six to twenty years), and PVRs represent an essential tool to recoup the long-term investment.

As to the ornamental segment, variety development cycles are significantly shorter (ranging from three to five years). The cut-flower market is particularly competitive, where breeders estimate that they generally have over three years to make the return on investment.³³⁷ Rapid introduction of products into the market remains crucial to create a high volume of demand and build brand dominance. Breeders then opt for monetising their creation via a TMR, as such is generally awarded faster than a PVR.

Industry	Relative Competitiveness	Variety Development Cycle
Ornamental Crops	Highest	3-5 years
Vegetables Crops	High	6-7 years
Agriculture Crops	Moderate	6-7 years
Fruit Crops	Lowest	10-20 years

Figure 26. Competitiveness and variety development cycle per crop sector © EUIPO-Deloitte

74. In the plant-related market, distribution systems can be complex, consisting of circular flows between different actors involving both physical transfers of plant material as well as financial interactions.³³⁸ The intermediary actors in the supply chains are professionals engaging in business-to-business transactions (B2B), whereas the end-purchase transactions are made by consumers (B2C). Professionals and end-consumers are essentially distinct in what comes to knowledge and purchasing behaviours.

In what concerns the professional category, it includes the following actors: breeders, seed distributors, seed propagators,³³⁹ plant propagators, growers, brand licensors, merchants, cooperatives, manufacturers, wholesalers and retailers.³⁴⁰

³³⁷ Study on market-related issues regarding plant variety protection, (2016). Deloitte for EUIPO, p. 30.

³³⁸ Study on market-related issues regarding plant variety protection, (2016). Deloitte for EUIPO, pp. 5-6.

³³⁹ Propagation is the means of scaling the newly developed variety ready to sell into the market.

³⁴⁰ Each actor takes purchasing-decisions of plant material based on different criteria. For instance:

Overall, professional buyers have a relatively high technical and biological knowledge of the concerned products. They make rational purchasing-decisions and place emphasis on product performance, technical specifications and on ensuring that the variety that they are buying fits their business model and the requirements of their customers.³⁴¹



As for end-consumers, these consist in the general public that ultimately buys the plant-related end-product. Two categories of consumers can be distinguished:³⁴²

- i) Uninformed consumers purchasing plant-derived products in a generalist retailer (e.g.: supermarket), who are usually not aware of plant variety names.
- ii) Consumers purchasing plants in a specialist retailer within the domestic horticulture and floriculture sector (e.g.: market stall, garden centre), who are likely to seek out specific types of plants and identify such by their PVDs.

Within the agri-food chain, PVDs are especially relevant to seed propagators and growers. In contrast, PVDs are rarely visible to the end consumer at the point of sale.³⁴³ Purchasing decisions by end-consumers are taken on spur of the moment, driven by a combination of rational and emotional feelings based on perception of quality and price. What is more, consumers are often unaware of the intrinsic difference between trademarked names, TMs and PVDs on product packaging.³⁴⁴

Labelling and marketing legislation may play a role in shaping the described context of unawareness of PVDs from a significant part of end-consumers. Regulation 543/2011 on

-
- Growers: crop yield (e.g.: tonnage per hectare, disease resilience) and product demand.
 - Processors and manufacturers: specific attributes such as sweetness, colour, flavour.
 - Merchants, wholesalers and retailers: specific attributes (e.g.: size, shape, colour, flavour) and logistic-aspects (e.g.: transportability, shelf-life and cropping period).

³⁴¹ *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 27.

³⁴² *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 52.

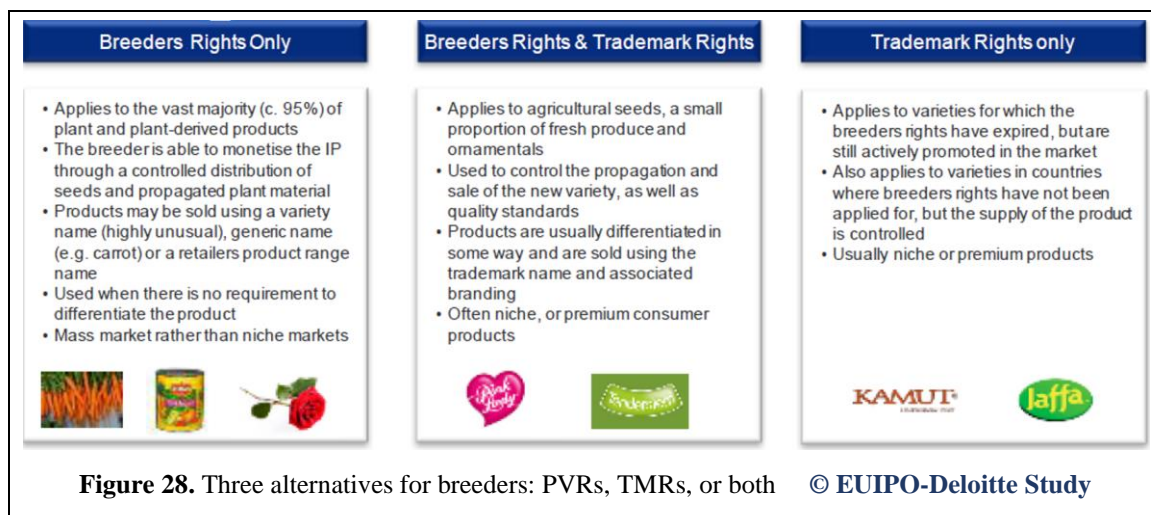
³⁴³ The majority of plant-derived products are either processed into a finished food product, sold as a generic product (e.g.: “red cabbage”) or packaged by retailers to reflect a product quality grading.

³⁴⁴ *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 27.

EU marketing standards for fresh horticultural produce,³⁴⁵ which basically regulates the labelling of fresh produce, distinguishes between general standards (applying to most fresh produce) and specific quality standards (applying to certain products). Where the latter standards apply, it is stipulated that the product label must clearly display product-specific requirements, including the product variety (PVD) or type (e.g.: white peaches).³⁴⁶ However, where general quality standards apply, what is usually the case, there is no legal requirement to fix in the labels the PVD or product-type.³⁴⁷

In addition, two global macro trends contribute to a general decrease in PVD awareness: the increasing globalization of supply chains³⁴⁸ and the rise of supermarket retailers. These trends result in a vast range of varieties on offer, making it almost impossible for most consumers to make rational purchasing decisions based on PVDs, as this would require an understanding of the individual attributes of each variety available. Retailers thus make decisions on variety-selection on behalf of their customers, and create their own product-range names, which may or may not be trademarked.³⁴⁹

In conclusion, TMRs are an interesting means for breeders to recoup their investments in varieties addressed at niche or premium consumer markets, in addition to PVRs or even in the absence of such, if the concerned variety development cycles are particularly short.



³⁴⁵ Commission Implementing Regulation (EU) No 543/2011 of 7 June 2011 laying down detailed rules for the application of Council Regulation (EC) No 1234/2007 in respect of the fruit and vegetables and processed fruit and vegetables sectors.

³⁴⁶ *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 40.


³⁴⁷ *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 40.

³⁴⁸ Following the rapid growth in air transportation, supply chains are more globalised than they have ever been and perishable foods can often be harvested and shipped across the globe to be sold to a consumer within 48 hours. Competition is global rather than local or regional making the range of products available to European consumers increasingly vast and available all year round [*Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 10].

³⁴⁹ *Study on market-related issues regarding plant variety protection*, (2016). Deloitte for EUIPO, p. 41.

8. Conclusions

75. This thesis has consisted in an in-depth legal and practical research on the interface between TMRs and PVDs. From the stroll through this garden, the following flowers can be picked as conclusions:

1. Under PVR law, every new plant variety for which a right is granted must be assigned a generic designation known as “plant variety denomination” (PVD). The use of PVDs is mandatory for anyone commercialising variety constituents of a protected variety. A PVD is born with the PVR, but outlives the latter (once such expires) to live on forever.
2. UPOV endorses the universal rule “one variety, one denomination”: unless unsuitable in a territory, the same PVD for a variety should be registered in all countries. The magic therein lies in that, while being attached to an IPR, which is by design territorial in nature, PVDs are independent from such to cross any border and travel the world.
3. International cooperation mechanisms are in place to harmonise the examination of PVDs. Although said mechanisms seem to work well, examination procedures could be further simplified if an international one-stop-shop filing-system including a central approval system for PVDs were to be set up.
4. The introduction of a universal “official notice” for PVRs is suggested, to raise awareness on PVRs, and to enhance the visibility of PVDs and avoid confusions with TMs in the marketplace. It could consist of a simple fancy design: 
5. The compatibility of PVDs and TMRs is enshrined in the UPOV Convention, as long as PVDs are recognisable and clearly differentiated from TMs when used in the commercialisation of varieties.
6. At EU level, the legal backbone governing the suitability of PVDs is Article 63 CPVRR, and the CPVO Guidelines on this article shed light on how it should be interpreted. In practice, the CPVO does not refuse *ex officio* a proposal for a PVD that is identical (or highly similar) to an earlier registered TM. TMR titleholders

affected by the PVD-proposal can however object to the registration of such. This examination approach seems to seek a pragmatic aim, account taken of the nature and features of a TMR.³⁵⁰

7. Given that PVRs are limited in duration whereas EUTMs can be endlessly perpetuated, a breeder may be tempted, once his/her PVR expires, to apply before EUIPO for an EUTM identical/similar to the PVD associated with such expired PVR. Precisely to prevent this from happening, Article 7(1)(m) has crystallised into the EUTMR. This provision constitutes an absolute ground for refusal of EUTMs consisting of, or reproducing in their essential elements, an earlier registered PVD.
8. It can be defended that the General Court recently interpreted Article 7(1)(m) EUTMR in a manner that jeopardises its *effect utile*. EUTM applications containing an earlier registered PVD may easily make it into the register if further elements are added in the sign. A suggested way out of the described crossroads is the lodging of more actions concerning the interpretation of this matter up to the CJEU for further clarifications, as this route has not yet been exhausted.
9. Conflicts arising between EUTM applications and earlier PVDs may sometimes be practically solved by means of limitations in the list of goods and services in relation to which a given EUTM is applied for.
10. EU TM case law has “transplanted” the UPOV-notion of “closely related species” onto EU TMR law. The term is thus interpreted also under EU TMR law as “plant varieties of species within the same genus in a botanical sense”. UPOV established a “system of classes” to clarify this notion, based on the rule “one genus, one class”, to which exceptions are foreseen.
11. Global PVR-databases such as GENIE, PLUTO and Variety Finder prove useful not just for PVR authorities but also for TMR examiners.

³⁵⁰ For example: TMRs are often registered for the whole Class 31 while not used in practice in relation to some of the designated products, and their potential infinite nature magnifies the threat of their “blocking-capacity” as earlier right.

12. The cooperation between the EUIPO and the CPVO could be topped if the latter were to establish, pursuant to Article 30(4) CPVRR, a sub-office at the EUIPO premises in Alicante. Gains in efficiency would be brought along: i) breeders with an IP portfolio enclosing both PVRs and EUTMs could benefit from a single point of contact; ii) the exchange of best practices between experts from both offices would be fostered; iii) EUIPO would bring under its wing a more complete spectrum of IPRs. In sum, a CPVO “graft” could help an existing splendid tree into reaching more vigour than ever.
13. Breeders should bear in mind that their TMRs are liable to cancellation on account of genericism if these are used in such a manner that, in the eyes of consumers, the TM is seen as the generic designation for the variety. To this end, a list of recommendations of “DOs and DON’T’s” has been provided in this study.
14. Older notorious varieties are more likely to be presented with greater visibility of the PVD. In general, PVR titleholders draw no strong direct commercial benefit from the consumers’ association with the PVD, as the term of duration of a PVR is limited and PVDs must be freely available to all traders. On the opposite hand, any long-term publicity investments in TMRs fall back on the titleholder.
15. In practice, a TMR may be used by breeders to promote a product-range encompassing varieties sharing similar characteristics. This brings along a number of benefits: i) escaping the threat of TMR *genericide*; ii) extending the reputation gained to several varieties; and iii) using the TM for future improved varieties.

Finally, to get a taste of what the juggle between PVDs and TMs is about in practice, the reading of the practical real-life case portrayed in Annex I to this thesis is recommended.



9. Bibliography

9.1. Legislation

9.1.1. *International*

- International Convention for the Protection of New Varieties of Plants (1991 Act, UPOV Convention), available [here](#).
- Madrid Agreement Concerning the International Registration of Marks, available [here](#); and its Protocol, available [here](#).
- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), available [here](#).

9.1.2. *European Union*

- Commission Implementing Regulation (EU) No 543/2011 of 7 June 2011 laying down detailed rules for the application of Council Regulation (EC) No 1234/2007 in respect of the fruit and vegetables and processed fruit and vegetables sectors, available [here](#).
- Commission Regulation (EC) No 874/2009 of 17 September 2009 establishing implementing rules for the application of Council Regulation (EC) No 2100/94 as regards proceedings before the Community Plant Variety Office, available [here](#).
- Commission Regulation (EC) No 637/2009 of 22 July 2009 establishing implementing rules as to the suitability of the denominations of varieties of agricultural plant species and vegetable species, available [here](#).
- Council Directive 2002/53/EC of 13 June 2002 on the common catalogue of varieties of agricultural plant species, available [here](#).
- Council Directive 2002/55/EC of 13 June 2002 on the marketing of vegetable seed, available [here](#).
- Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights, available [here](#).
- Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (no longer in force), available [here](#).

- Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising, available [here](#).
- Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, available [here](#).
- Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, available [here](#).

9.2. Soft Law

- CPVO Application Form ‘Proposal for a Variety Denomination’, available [here](#).
- CPVO Explanatory Notes to the Guidelines on Article 63, available [here](#).
- CPVO Guidelines on Article 63 of Council Regulation (EC) 2100/94 of 27 July 1994 on Community plant variety rights (2012), available [here](#).
- EUIPO Guidelines for Examination of European Union Trademarks, Part B (Examination), Section 4 (Absolute Grounds for Refusal), Chapter 13, *Trademarks in conflict with earlier Plant Variety Denominations [Article 7(1)(m) EUTMR]* (February 2020), available [here](#).
- UPOV Explanatory Notes on Variety Denominations (2015) (UPOV/INF/12/5), available [here](#).

9.3. Doctrine

9.3.1. Books

- Andrews, S., Leslie, A., and Alexander, C., *Taxonomy of Cultivated Plants: Third International Symposium*. Royal Botanic Gardens (2000).
- Badenes, M. L., and Byrne, D. H., *Fruit Breeding*. Springer Science (2012).
- Bently, L., and Sherman, B., *Intellectual Property Law*. Oxford University Press (2014, 4th Ed.).
- Büscher, W., et al., *Festschrift für Karl-Heinz Fezer zum 70. Geburtstag: Marktkommunikation Zwischen Geistigem Eigentum Und Verbraucherschutz*. C. H. Beck (2016).

- Gledhill, D., *The Names of Plants*. Cambridge University Press (2008, 4th Ed.).
- Hacker, F., et al, *Festschrift für Paul Ströbele zum 75. Geburtstag*. Carl Heymanns Verlag (2019).
- Hancock, J. F., *Temperate fruit crop breeding*. Springer (2008).
- Hildebrant, U., *Marken und andere Kennzeichen: Handbuch für die Praxis [Trade marks and other signs]*. Carl Heymanns (2015, 3d Ed.).
- Llewelyn, M., and Adcock, M., *European Plant Intellectual Property*. Bloomsbury Publishing (2006).
- Nirk, R., and Ullmann, E., *Patent-, Gebrauchsmuster- und Sortenschutzrecht [Patent, Design, and Plant variety protection law]*. C. F. Müller Start (2007, 3d Ed.).
- Pavord, A., *The Naming of Names: The Search for Order in the World of Plants*. Bloomsbury Publishing PLC (2005).
- Sanderson, J., *Plants, People and Practices: The Nature and History of the UPOV Convention*. Cambridge Intellectual Property and Information Law, Cambridge University Press (2018).
- Styles, B. T., *Infraspecific Classification of Wild and Cultivated Plants*. Oxford University Press (1986).
- Tuberosa, R., Graner, A., and Frison, E., *Genomics of plant genetic resources*. Springer (2014).
- Von Bomhard, V., and von Muhlendahl, A., *Concise European Trade Mark Law*. Kluwer Law International (2018).
- Würtenberger, G., Ekvad, M., van der Kooij, P., and Kiewiet, B., *European Union Plant Variety Protection*. Oxford University Press (2015, 2d Ed.).

9.3.2. Articles

- Avent, T., Name that Plant: The Misuse of Trademarks in Horticulture. (2013) *The Azalean*, pp. 35-38.
- Berger, T., Traders beware: Trade mark genericism and the fault provision. (2016) *Law Institute Journal (Law Institute of Victoria)*, pp. 42-45.
- Borges, R.-M., *Les conditions de la coexistence d'une marque et d'une dénomination variétale*. (2016) *ResearchGate*, available [here](#).

- Cairns, T., Rose Registrations: Nomenclature & Trademark Issues Resolved. (1998) *World Rose News*, p. 16.
- Cripps, J., Richards, L., and Mairata, A., Pink Lady' apple. (1993) *HortScience*, Vol. 28, Issue 10.
- De Roos, J., A rose by any other name would smell as sweet. (2016) *Prophyta Annual*, pp. 22-23.
- Folsom, R. H., and Teply, L. L., Trademarked Generic Words. (1980) *Yale Law Journal*, Vol.89, pp. 1323-1359.
- Gioia, V. G., Using and Registering Plant Names as Trademarks. (1995) *Acta Horticulturae* 413, pp. 19-25.
- Janis, M., Supplemental Forms of Intellectual Property Protection for Plants. (2004) *Minnesota Journal of Law, Science & Technology*, University of Minnesota Libraries Publishing, Vol. 6, Issue 1, pp. 305-329.
- Kur, A., Trademark Functions in European Union Law. (2019) *Max Planck Institute for Innovation and Competition Research Paper No. 19-06*, SSRN.
- Leval, P. N., Trademark: Champion of Free Speech. (2004) *Columbia Journal of Law and Arts*, Vol. 27, p. 187.
- Löscher, U., Variety Denomination according to Plant Breeders' Rights. (1986) *Acta Horticulturae* 182, pp. 59-61.
- Luby, J. J., and Bedford, D. S., Cultivars as Consumer Brands: Trends in Protecting and Commercializing Apple Cultivars via Intellectual Property Rights. (2015) *Crop Science*, Vol. 55, pp. 2504-2510.
- Maison, J., The Implementation of Statutory Rules for Variety Denominations in the EU. (2008) *Acta Horticulturae* 799.
- Martin, S., Bringing EU Trademark Protection Back into Shape – Lessons to Learn from Keyword Advertising. (2011) *Vrije Universiteit Amsterdam*.
- Martin, S., General Court clarifies for the first time the scope of protection of plant variety denominations under Article 7(1)(m) of the European Trade Mark Regulation. (2019) *Oxford Journal of Intellectual Property Law & Practice (JIPLP)*, Vol. 14, Issue 10, pp. 748-749.
- McNeill, J., Nomenclature of Cultivated Plants: A historical botanical standpoint. (2004) *Acta Horticulturae* 634, pp. 29-36.
- Müller-Wille, S., Nature as Marketplace: The Political Economy of Linnaean Botany'. (2003) *History of Political Economy*, Vol. 35, Issue 5.

- Musumeci, M., Counterfeiting and food frauds. (2018) *Issue No 31 on Agribusiness*, European IPR Helpdesk, p. 14.
- Piatti, M., and Jouffray, M., Plant variety names in national and international law: Part I. (1984) *European Intellectual Property Review (E.I.P.R.)*.
- Royon, R., Cultivated Variety Denominations and Trademarks. (1986) *Acta Horticulturae 182*, pp. 273-275.
- Sadie, J., The Essence of Naming Cultivars. (2001) *Acta Horticulturae 545 [Proc.V Int. Protea Symp.]*, pp. 35-38.
- Sherman, B., Taxonomic Property. (2018) *Cambridge Law Journal*, Vol. 67, Issue 3, pp. 560-584.
- Stearn, W.T., Historical survey of the naming of cultivated plants. (1986) *Acta Horticulturae 182*, pp. 19-24.
- Valleau, J., Plant Name Changes: Good Science, Angry Growers and Confused Gardeners. (2004) *Acta Horticulturae 634 [Proc. IVth Int. Symp. Taxonomy of Cultivated Plants]*, pp. 63-66.
- Van der Kooij, P. A. C. E., Defending PBR: P, B, or R?. (2002) *European Intellectual Property Review (E.I.P.R.)*, Vol. 24, Issue 1, pp. 1-2.
- Van der Kooij, P. A. C. E., Is something rotten in the Member States?. (2000) *European Intellectual Property Review (E.I.P.R.)*, Vol. 22, Issue 5, pp. 189-190.
- Van der Kooij, P. A. C. E., Use and Misuse of Trade Marks in European Nursery Industry. (2004) *Acta Horticulturae 634 [IVth Int. Symp. Taxonomy of Cultivated Plants]*, pp. 37-42.
- Von Kapff, P., and Mattina, F., Trademarks and variety denominations. (2018) *Issue No 31 on Agribusiness*, European IPR Helpdesk, p. 11.
- Vrugtman, F., Directory of International Registration Authorities for Cultivar Names (IRAs). (1995) *Acta Horticulturae 413*.
- Weatherly, J. M., and Campbell, B., A Plant by Any Name is Not the Same. (2011) *Grower Talks*.
- Welch, H. J., On the difference between botanical and horticultural nomenclature and the status of botanical combinations based solely on the description of a cultivar. (1978) *Taxon (Journal of the International Association for Plant Taxonomy)*, Vol. 27, Issue 2, pp. 187-190.
- Wakefield, R., CPVO celebrates its Silver Jubilee. (2020) *FloraCulture International (AIPH)*, pp. 22-24.

9.4. Case Law

9.4.1. Court of Justice of the European Union and General Court

- *Adidas AG and adidas Benelux BV v Marca Mode CV and Others* (C-102/07) [2008], ECLI:EU:C:2008:217.
- *Ampafrance v OHMI - Johnson & Johnson (monBeBé)* (T-164/03) [2005], ECLI:EU:T:2005:140.
- *Arsenal Football Club* (C-206/01) [2002], ECLI:EU:C:2002:651.
- *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* (C-39/97) [1998], ECLI:EU:C:1998:442.
- *Club de Variedades Vegetales Protegidas v Adolfo Juan Martínez Sanchís* (C-176/18) [2019], ECLI:EU:C:2019:1131.
- *Continental* (T-383/10) [2013], ECLI:EU:T:2013:193.
- *Copad v Christian Dior Couture et al* (C-59/08) [2009], ECLI:EU:C:2009:260.
- *Couture Tech v OHIM* (T-232/10) [2011], ECLI:EU:T:2011:498.
- *Elizabeth Emanuel* (C-259/04) [2006], EU:C:2006:215.
- *Flugbörse* (C-332/09 P) [2010], EU:C:2010:225.
- *Google France v. Louis Vuitton et al.* (Joined Cases C-236/08 to C-238/08) [2010], ECLI:EU:C:2010:159.
- *Hoffman-La Roche v Centrafarm* (C-102/77) [1978], ECLI:EU:C:1978:108.
- *Hölderhoff v Freiesleben* (C-2/00) [2001], ECLI:EU:C:2001:468 (Opinion of Advocate General Jacobs).
- *Interflora v Marks & Spencer* (C 323/09) [2011], ECLI:EU:C:2011:604.
- *IP Translator* (C-307/10) [2012], EU:C:2012:361.
- *Kordes' Rose Monique* (T-569/18) [2019], EU:T:2019:421.
- *Lego Brick* (T-270/06) [2008], EU:T:2008:483.
- *Levi Strauss & Co. v Casucci SpA* (C-145/05) [2006], ECLI:EU:C:2006:264.
- *Linde and Others* (C-53/01) [2003], ECLI:EU:C:2003:206.
- *Lindt Goldhase* (C-529/07) [2009], EU:C:2009:361.
- *Lloyd Schuhfabrik Meyer* (C-342/7) [1999], ECLI:EU:C:1999:323.
- *L'Oréal v Bellure* (C-487/07) [2009], ECLI:EU:C:2009:378.

- *L'Oréal v Bellure* (C-487/07) [2009], ECLI:EU:C:2009:70 (Opinion of Advocate General Mengozzi).
- *Merz & Krell* (C-517/99) [2001], ECLI:EU:C:2001:510.
- *Picasso v OHIM* (C-361/04) [2006], ECLI:EU:C:2006:25.
- *Pink Lady America LLC v CPVO and Western Australian Agriculture Authority (Cripps Pink)* (T-112/18) [2019], ECLI:EU:T:2019:679.
- *Ralf Sieckmann v Deutsches Patent- und Markenamt* (C-273/00) [2002], ECLI:EU:C:2002:748.
- *Sabel v Puma* (C 251/95) [1997], ECLI:EU:C:1997:528.
- *SA-CNL SUCAL v HAG* (C-10/89) [1990], ECLI:EU:C:1990:359.
- *SAT.1 SatellitenFernsehen v EUIPO* (T-323) [2002], ECLI:EU:T:2002:172.
- *SAT.1 v OHIM* (C-329/02 P) [2004], EU:C:2004:532.
- *Sky v SkyKick* (C-371/18) [2020], ECLI:EU:C:2020:45.
- *Tetra Pharm v EUIPO (SeboCalm)* (T-441/16) [2017], ECLI:EU:T:2017:747.
- *Windsurfing Chiemsee* (C-108/97) [1999], ECLI:EU:C:1999:230.

9.4.2. Board of Appeal of the CPVO

- *Vegetal Progress S.r.l. vs Ambrogio Giovanni and CPVO* (A 4/2004) [2005]

9.4.3. Boards of Appeal of the EUIPO

- *Ice Tea* (R 895/2014-1); *Geisha* (R 528/2014-1); *Goldrush* (R 280/2014-1); *Silverado* (R 279/2014-1); *Skyfire* (R 894/2014-1); *Washabi* (R 691/2014-1) [2015].
- *Gro Max by DLF (fig.)* (R 2541/2017-2) [2018].
- *Kordes' Rose Monique* (R 1929-2017-1) [2018].
- *Microclover by DLF (fig.)* (R 2542/2017-2) [2018].
- *Vesuvia (Vesuvius)* (R 1743/2007-1) [2009].

9.4.4. EUIPO Examination Division

- Decision *Fancy Plants* (application No W21460773) [2020].
- Decision *Royal Flowers* (application No 017022922) [2018].
- Decision *Ruby* (application No 016922791) [2018].

- Decision *Skjold* (application No 18089857) [2019].
- Decision *Tochiotome* (application No 018030647) [2019].

9.5.Databases

9.5.1. International

- UPOV GENIE, available [here](#).
- UPOV Lex, available [here](#).
- UPOV PLUTO, available [here](#).

9.5.2. European Union

- CPVO Variety Finder, available [here](#).
- CPVO PVR Case law, available [here](#).
- EUIPO eSearch Case law, available [here](#).
- EUIPO eSearch Plus, available [here](#).

9.6.Online Tools, Academic Materials, Blog Posts and Other Resources

- Annual Report 2019 of the CPVO, available [here](#).
- Anti-Infringement Bureau Official Website, available [here](#).
- CPVO Notes for applicants, available [here](#).
- CPVO Official Website, available [here](#).
- EUIPO Academy Portal, EUTM in a Nutshell, available [here](#).
- Explanatory Notes for Class 31, Nice Classification, available [here](#).
- How to Monitor your International Application, WIPO, available [here](#).
- Interplant Roses, Official Website, available [here](#).
- IP Enforcement Tool-Kit for Seed Companies, Euroseeds (2016) available [here](#).
- Lamberti, O. (CPVO) and Dubbini, M. (EURICE) (2019). Recorded Webinar “*a Guide to Geographical Indications, Trademarks & Plant Variety Denominations*” European IPR Helpdesk, available [here](#).
- Lebron-Dykeman, C. (McKee, Voorhees & Sease, PLC), (2018) “*The Plant Naming Conundrum...Protecting Your Plant Varieties*”, available [here](#).
- Legrand, B. (CPVO), (2019) Recorded Webinar “*The name of a plant variety in the Community plant variety right system*”. EUIPO Academy, available [here](#).

- Novagraaf (2019), “*EU General Court clarifies scope of protection for plant variety denominations*”, available [here](#).
- Pink Lady® Story, available [here](#).
- Prof. Dr. Marie-Christine Janssens, Slides for Presentation during her course of “International and European Union Trade Mark Law” (KULeuven).
- Presidency compromise proposal of 18 July 2014 for discussion in the Coreper meeting on 23 July 2014, Council of the European Union, available [here](#).
- *Rembert Dodoens: iets over zijn leven en werk – Dodoens' werken*, Project Rembert Dodoens, Plantaardigheden Stichting Kruidenhoeve/Plantaardigheden. Balkbrug (the Netherlands), available [here](#).
- Study on market-related issues regarding plant variety protection, Deloitte for EUIPO (2016).
- Third World Network (2013), “*UPOV: To consider industry wish list on plant breeders' right*”, available [here](#).
- UPOV Report by the President on the work of the Eighty-Eighth Session of the Consultative Committee, available [here](#).
- UPOV-WIPO Distance Learning Course DL-305 - *Examination of applications for plant breeders' rights* (Module 6 “Examining the Variety Denomination”).

9.7. Personal Interviews

- Filippo, M., *Legal Counsel at Communauté Internationale des Obtenteurs de Plantes Ornamentales et Fruitières à Reproduction Asexuée (CIOPORA) [International Community of Breeders of Asexually Reproduced Ornamental and Fruit Varieties]*.
- Mattina, F., *Vice-President of the CPVO*.
- Oviedo Aranda, J. M., *Head of Department at Oficina Española de Variedades Vegetales (OEVV) [Spanish Plant Variety Office], Spanish Ministry of Agriculture, Fisheries and Food*.
- Pohlmann, A., *Member of the Board of Appeal of the CPVO, Member of the Fifth Board of Appeal of EUIPO and Mediator at EUIPO*.
- Von Kapff, P., *Member of the First Board of Appeal of EUIPO and Mediator at EUIPO*.

ANNEX I

CASE STUDY OF THE 'CRIPPS PINK' APPLE VARIETY

This thesis culminates with a practical case gathering some of the elements hitherto analysed. The history of the notorious apple variety 'Cripps Pink' is here showcased.

Apple varieties have since long been recognized by consumers, who can readily distinguish ones from others because of the large range of genetic variation among them³⁵¹. Unlike other fruit and vegetable varieties which remain largely anonymous, apples are often identified by consumers by means of their respective PVD.

Consumers seek specific visible features (colours, shape), flavours (sweet, acidic) and flesh textures (crisp and juicy, hard and dry, or soft and pulpy), associating such with concrete varieties. Renowned apple varieties include names like 'Delicious', 'Golden Delicious', and 'Granny Smith' (discovered as wild seedlings or mutations derived therefrom); and 'Gala', 'Fuji', and 'Honeycrisp' (developed under breeding programs).



The development under breeding programs of new apple varieties is a costly and lengthy endeavour. Reaching the first commercial planting can take up to 15-20 years, with an additional 5-10 years before a substantial fruit production is available for consumers.³⁵²

³⁵¹ James J. Luby, and David S. Bedford, Cultivars as Consumer Brands: Trends in Protecting and Commercializing Apple Cultivars via Intellectual Property Rights. (2015) *Crop Science*, Vol. 55.

³⁵² S. Kumar et al., 'Breeding for apple (*Malus × domestica* Borkh.) fruit quality traits in the genomics era' in R. Tuberosa et al., *Genomics of plant genetic resources*. (2014) Springer, pp. 387-416.

Long-term investments by breeders are substantial and must be recovered in commercialization.³⁵³ Solid IP-portfolios and marketing strategies play here a crucial role. Two essential characteristics of the apple sector are:³⁵⁴

- i) the global sourcing of produce for year-round supply, as global circulation of apples has led to the worldwide recognition of varieties; and
- ii) the use of TMs, which allows capitalisation based on consumer recognition.

A delicious example of a popular TMR in the apple sector is that of the worldwide-known TM *Pink Lady* ®, associated, amongst others, with the ‘Cripps Pink’ variety.

The ‘Cripps Pink’ variety (species: *Malus domestica* Borkh.) was bred in 1973 under the “Western Australia apple breeding program” by Mr John Cripps, to which it owes its name.³⁵⁵ It was bred by crossing the Australian apple variety ‘Lady Williams’ with the apple variety ‘Golden Delicious’, combining thereby the storing properties of the former and the sweetness and lack of storage damage of the latter.³⁵⁶



PVR protection for ‘Cripps Pink’ was sought in numerous countries. At EU level, the Western Australian Agriculture Authority applied for a CPVR in August 1995, the title being subsequently granted on 15 January 1997.³⁵⁷ As it is clearly shown in the below snapshot from the Variety Finder database, the protection will soon expire (on 1 August 2022). In the United States, New Zealand, South Africa and Argentina, the granted PVR protection already expired.

³⁵³ James J. Luby, and David S. Bedford, Cultivars as Consumer Brands: Trends in Protecting and Commercializing Apple Cultivars via Intellectual Property Rights. (2015) *Crop Science*, Vol. 55.

³⁵⁴ James J. Luby, and David S. Bedford, Cultivars as Consumer Brands: Trends in Protecting and Commercializing Apple Cultivars via Intellectual Property Rights. (2015) *Crop Science*, Vol. 55.

³⁵⁵ J. Cripps, L. Richards, and A. Mairata, Pink Lady’ apple. (1993) *HortScience*, Vol. 28, Issue 10.

³⁵⁶ J. Cripps, L. Richards, and A. Mairata, Pink Lady’ apple. (1993) *HortScience*, Vol. 28, Issue 10.

³⁵⁷ ‘Cripps Pink’ has recently been the object of a nullity action before the CPVO based on the grounds of lack of novelty. The case ended up in the General Court, which dismissed the action in its entirety [*Pink Lady America LLC v CPVO and Western Australian Agriculture Authority (Cripps Pink)* (T-112/18) [2019], ECLI:EU:T:2019:679].

Variety data sheet

Species list Field explanation Test data

Country: QZ - European Union Register type: PBR - Plant Breeders' Rights

Register name: Official Publication of the Community Plant Variety Office

Species latin name: [Malus domestica Borkh.](#)

Variety status: Registered Class(es): MALUS

Application/filing

Number: 19951039 Grant/registration Number: 1640

Date: 29/08/1995 Date: 15/01/1997

Published on: 15/10/1996 Published on: 15/04/1997

Expiration

Expiration actual: Renewal on:

Future expiration date: 01/08/2022

Breeder's reference: Cripps pink

Breeder: Western Australian Agriculture Authority (WAAA)

Applicant: Western Australian Agriculture Authority (WAAA)

Maintainer:

Holder: Western Australian Agriculture Authority (WAAA)

Other parties: Star Fruits Diffusion S.A.S.

Remarks:

Extra data url:

Denominations list

Denomination: Cripps Pink

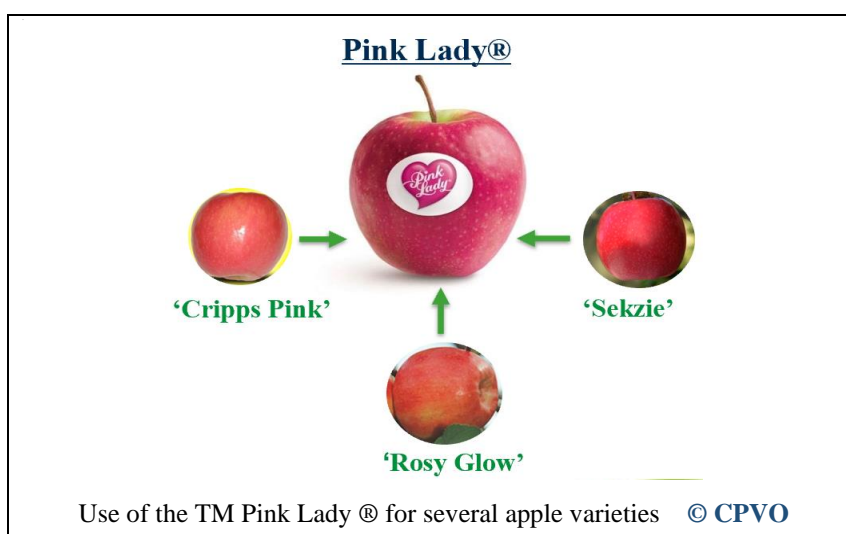
Proposed on: Denomination type: Undefined

Published on: Denomination status: Approved

Approved on: 15/01/1997 End date:

Snapshot of datasheet for the CPVR 'Cripps Pink' © Variety Finder database


On the other hand, Apple and Pear Australia Limited (henceforth, “APAL”), which is the peak representative body in Australia for commercial apple and pear growers, registered the TM *Pink Lady*® in more than 80 countries.³⁵⁸ The TM is primarily used as an indication of quality, this meaning that to be able to use it, the concerned apples must meet certain quality specifications including for sugar content, firmness, and colour. Several apple varieties are sold under this TM, including: ‘Cripps Pink’, ‘Sekzie’, ‘Barnsby’, ‘Maslin’, ‘Rosy Glow’, ‘Ruby Pink’ and ‘Lady in Red’.



³⁵⁸ John Cripps apparently took the Pink Lady® name from his favourite novel, “The Cruel Sea”, written by Nicholas Monsarrat (1951), in which the main character drinks a cocktail called “Pink Lady” [“The Pink Lady® Story”, available at <https://bit.ly/3k7USXP> [Accessed: 6 November 2020]].

The issue with APAL, is that it has been so effective at promoting apples under the TM *Pink Lady*®, that it has been refused TM-registration in several countries. In Australia, attempts to register the plain word mark “Pink Lady” were unsuccessful. The Australian Trade Marks Office viewed “Pink Lady” as descriptive, as the ‘Cripps Pink’ apple was deemed widely-known by the public by the name “Pink Lady”, rather than by its PVD.³⁵⁹ APAL then applied for the word mark “Pink Lady” for “fruits other than apples”, what was then seen acceptable by the Australian Trade Marks Office.³⁶⁰ Interestingly, competitors may ignore that apples are expressly excluded under the TMR registration. Moreover, while this registration does not cover apples, it is nonetheless possible that a TMR registered for fruits that can be regarded as “closely-related” to apples, might be enough to deter those wanting to use the “Pink Lady” name on apples without a licence. Such approach could provide *de facto* protection, as most TMR laws regard as an infringement the use by third parties of a protected TM in relation to goods or services that are similar (closely-related) to those for which the protected TM is registered.³⁶¹

Against this background, one can only wonder what will happen in the EU territory once the CPVR for the ‘Cripps Pink’ variety expires. Anyone will be able to grow and sell the ‘Cripps Pink’ variety,³⁶² however, permission will still be required to successfully commercialise the variety under the TM *Pink Lady*®.

014353262 - PINK LADY [+ info](#)




Trade mark information		Owner information	
Trade mark number	014353262	Owner ID number	52037
Type	Figurative	Owner name	Apple and Pear Australia Limited
Filing date	10/07/2015	Representative information	
Registration date	07/04/2016	Representative ID num...	13142
Nice Classification	29, 30, 31, 32, 33		
Trade mark status	Registered		

Snapshot of one of the several Pink-Lady EUTMs
© EUIPO (eSearch Plus Database)

³⁵⁹ This was the case even if the TM *Pink Lady*® is widely used to market a whole range of apple varieties. In essence, *Pink Lady*® had become generic in relation to the ‘Cripps Pink’ variety [Jay Sanderson, ‘Bringing Order and Stability to Variety Denomination’ in *Plants, People and Practices: The Nature and History of the UPOV Convention*. (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, p. 151].

³⁶⁰ Australian TM registration number 1280838 (May 2011) for ‘fruits, plant material and trees; all being of the genera: Citrus, Prunus, Pyrus or Vitis’ (Class 31).

³⁶¹ Jay Sanderson, ‘Bringing Order and Stability to Variety Denomination’ in *Plants, People and Practices: The Nature and History of the UPOV Convention*. (2018) Cambridge Intellectual Property and Information Law, Cambridge University Press, p. 152.

³⁶² The use of the PVD as commercial identifier of the variety remaining of course mandatory in accordance with the UPOV Convention and the CPVRR.