



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

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**DECISION
of the First Board of Appeal
of 15 October 2015**

In Case R 280/2014-1

Rosen Tantau KG
Tornescher Weg 13
DE-25436 Uetersen
Germany

Applicant / Appellant

represented by **WÜRTEMBERGERKUNZE**, Maximiliansplatz 12b,
DE-80333 Munich, Germany

APPEAL relating to Community trade mark application No 12 100 483

THE FIRST BOARD OF APPEAL

composed of Th. M. Margellos (Chairperson), Ph. von Kapff (Rapporteur) and
C. Rusconi (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

1. By an application filed on 29 August 2013, Rosen Tantau KG ('the applicant') sought to register the word mark

Goldrush

as a Community trade mark for the following goods (some of which are no longer the subject of these proceedings, see paragraph 3):

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

2. By communication of 12 September 2013, the examiner objected to the application on absolute grounds pursuant to Article 7(1)(b) and (c) and (2) CTMR, as the sign is protected as a variety denomination in the European Union, in particular for 'Hebe (botanical)'.
 3. On 6 November 2013, the applicant submitted comments on the objection and requested that the list of goods be restricted as follows (the 'goods that are the subject of these proceedings', emphasis added):

Class 31 – Live plants and natural flowers, ~~in particular~~ namely roses and rose plants; rose propagation material.

It argued that the objection was not correctly substantiated, as it did not explain the varieties to which the examiner referred. 'Goldrush' could at most constitute a descriptive indication in respect of plants of the special variety of the botanical genus 'speedwell' ('Veronica'). As a result of the restriction, these were no longer the subject of the proceedings.

4. By decision of 31 January 2014 (the 'contested decision'), the examiner refused the application pursuant to Article 7(1)(b), (c) and (g) CTMR and Article 7(2) CTMR for all of the goods. The examiner based the decision on the following reasons in particular:
 - The word 'Goldrush' in its entirety makes it immediately clear to consumers that the goods applied for in Class 31 are a specific type of 'Hebe' and propagation material therefor.
 - As the trade mark has a clearly descriptive meaning in relation to the goods in respect of which it was applied for, the trade mark will give the relevant public the impression that it is primarily descriptive, which rules out any assumption that it may be an indication of origin.
 - The sign 'Goldrush' appears as a variety denomination in the database of the Community Plant Variety Office (CPVO), in particular for the plant 'Hebe'. Although this is the designation of a variety, the ground for refusal is still applicable.

- As the sign is a registered plant variety denomination, the restriction of the list of goods to rose plants would firstly be unable to overcome the objection of descriptive character (the term would remain ‘falsely descriptive’) and, secondly, an additional objection would be raised, as the term would then be deceptive.
5. The applicant filed a notice of appeal against the contested decision on 21 January 2014 and submitted its grounds of appeal on 11 March 2014. It requests that the decision be annulled and essentially argues as follows in its grounds of appeal:
- The contested decision disregards the principle of examination of the facts by the Office of its own motion and the principle of a fair hearing.
 - The contested decision is based on flawed reasoning in respect of the descriptive character of the trade mark applied for.
 - According to its legal definition, a variety denomination was not a descriptive indication within the meaning of trade mark law.
 - The Office fails to appreciate the function of the variety denomination as defined in Article 20(1)(a) of the International Convention for the Protection of New Varieties of Plants (‘UPOV Convention’).
 - In practice, it is impossible for a fanciful designation chosen by the breeder to designate a variety as its variety denomination to have a descriptive content according to trade mark law. A fanciful designation remains a fanciful designation, only its legal significance has changed as a result of being ‘dedicated’ as a variety denomination in relation to a specific variety.
 - It is pointed out, as a precaution, that it can furthermore not be seen why a variety denomination for a variety of a completely different nature from roses is supposed to be deceptive as a trade mark for roses and rose plants and rose propagation material.
 - A consumer seeking plants of particular genera knows that a rose is not a pelargonium, a clematis, a petunia or an apple tree.
 - Plants and propagation material of the same type are only offered for sale together with precise product information, particularly a visual representation, which provides consumers with precise clarification as to which plant genus or variety is involved.
 - Irrespective of the fact that there are no seeds in roses (rose propagation material consists of cuttings or buds), the exact type of plant involved is specified on every packet of seeds used as propagation material, and the specific plant is generally depicted.
 - The observant average consumer will always notice the differences between plants of different genera.
6. The applicant has submitted the following articles of evidence in particular:
- Annex 1 – Labels:
0001, Calluna vulg. ‘Melanie’, white bud bloomer, plant variety right, reproduction prohibited!

 Serengeti ® Apricot Pink, Nemesia, Sun to shade, First Class, [plus a picture of a flower]

- Annex 2 – The following extracts from advertising material:

‘Colour for the garden – artificial lawn – banks – riverbanks – borders – hanging baskets – pots. Flowers for months.

Flower Carpet ®, Heidetraum ®, var. Noatraum, ground-covering rose, a new generation Noack rose.

Flower Carpet is a registered trade mark. Unauthorised reproduction prohibited. Plant variety right protected’ [plus picture of roses].

- Annex 3 – Extracts from a rose catalogue:

‘Poesie ®’, ‘Rosenfee ®’, ‘Rosamunde ®’, ‘Rosi Mittermaier ®’, ‘Regensberg ®’, ‘Rosenprofessor Sieber ®’, etc.

Each product was described, for example:

‘Poesie – Jackson & Perkins rose Poesie ®, breeder: Jackson & Perkins 1988, bud: large, classically shaped; flower: salmon pink, deeper pink interior; large, densely packed; foliage: reddish buds, changing to dark green, glossy, robust; plant: bushy, 60 cm high; generally: vigorous and very free-flowering, with long-lasting flowers, flowers profusely, long flowering season, order number ..., Price group 4.’

- Annex 4 – Extracts from the Volmary catalogue for propagation material.
- Annex 5 – Images of ‘Kiepenkerl’ seed packets: ‘Germana’ for garden peas, ‘Bright lights’ for Swiss chard, ‘Pinokkio’ for peppers:



<p>Keimgeschützt verpackt cN-G</p> <p>Standard-Saatgut EG-Norm DE05-500</p> <p>Inhalt: 7 Korn. 4 0001591027558</p> <p>Paprika Pinokkio</p> <table border="1"> <thead> <tr> <th>Ausfaat</th> <th>Keimung</th> <th>Kultur</th> <th>Absand</th> <th>Ernte</th> </tr> </thead> <tbody> <tr> <td>Gewächshaus/ Reihenbau/ Freiland ab März</td> <td>15-20 Tage bei 20-25 °C</td> <td>Pflanzen nach Mitte Juli in Schutzfolie</td> <td>50 x 60 cm</td> <td>Ab Juli</td> </tr> </tbody> </table> <p>Ertragreiche F1-Hybride mit süßaromatischen Früchten. Sehr gutes Aroma. Resistenz gegen Virus.</p> <p>Die zahlreichen Früchte dieser ertragreichen Spitzenzüchtung sind länglich-spitz. Sie reifen früh, zunächst hellgelb und färben sich bald leuchtendorange. Dabei gewinnt der Geschmack enorm – vorliegend ist er eine angenehme Überraschung: zuckerhaft mit obertierlichem Aroma. Pinokkio ist robust, unempfindlich gegen Kühle Witterung und geeignet sowohl fürs Gewächshaus als auch für den Anbau im Freien. Wichtig ist dabei die Resistenz gegen Tomatenmosaikvirus.</p> <p>Standortansprüche: Geben Sie diesem Paprika einen geschützten, sonnigen Platz und einen nährstoffreichen Boden.</p> <p>Tipp: Die mikrobiologischen Früchte schmecken als Partyrezepte besonders lecker in Salaten oder als Vorspeise. Wird die erste Knosppe beizeiten ausgebrochen, erhöht sich der Ertrag.</p> <p>KIEPENKERL. www.nebelung.de Aus Freude am Gärtnern. Saatgut, Blumenzwiebeln, Rasensamen, Pflanzen</p>	Ausfaat	Keimung	Kultur	Absand	Ernte	Gewächshaus/ Reihenbau/ Freiland ab März	15-20 Tage bei 20-25 °C	Pflanzen nach Mitte Juli in Schutzfolie	50 x 60 cm	Ab Juli	<p>Keimgeschützt verpackt cN-G</p> <p>Standard-Saatgut EG-Norm DE05-500</p> <p>Inhalt reicht für ca. 60 Pflanzen. 4 0001591025271</p> <p>Mangold Bright Lights</p> <table border="1"> <thead> <tr> <th>Ausfaat</th> <th>Keimung</th> <th>Kultur</th> <th>Absand</th> <th>Ernte</th> </tr> </thead> <tbody> <tr> <td>Reihenbau/ Freiland, März bis Mai</td> <td>10-14 Tage bei 15-20 °C</td> <td>Vereinzel nach Keimungszeit</td> <td>55 x 45 cm</td> <td>Juni bis Oktober</td> </tr> </tbody> </table> <p>Dekorative Blattstiele in allen Regenbogenfarben. Angenehmer Geschmack. Ertragreich.</p> <p>Dekorativ, orange, rosa, gelb und weiß sind die kräftigen Stiele dieser besonders dekorativen Mangoldzüchtung gefärbt. Abgesehen davon, dass man sie als leckeres, vitaminreiches Gemüse in der Küche und die Blätter wie Spinat verwenden kann, sind die Pflanzen mit ihren großen Blättern sehr attraktiv in Gartenbeeten, Schalen, als Beetrandpflanze oder zwischen Staudenbeeten setzen sie in Gruppen oder Reihen gepflanzt ungewöhnliche Akzente.</p> <p>Standortansprüche: Jeder humose Gartenerde in sonniger oder halbschattiger Lage ist geeignet.</p> <p>Tipp: Die Pflanzen vertragen leichte Fröste. Je tiefer die Nachttemperatur, desto intensiver entwickeln sich die Farben. Diese Mangoldsorte erheut daher besonders am Ende des Gartensjahres.</p> <p>KIEPENKERL. www.nebelung.de Aus Freude am Gärtnern. Saatgut, Blumenzwiebeln, Rasensamen, Pflanzen</p>	Ausfaat	Keimung	Kultur	Absand	Ernte	Reihenbau/ Freiland, März bis Mai	10-14 Tage bei 15-20 °C	Vereinzel nach Keimungszeit	55 x 45 cm	Juni bis Oktober	<p>Keimgeschützt verpackt cN-G</p> <p>Standard-Saatgut EG-Norm DE05-500</p> <p>Inhalt reicht für ca. 10 lfd. Meter. 4 0001591002159</p> <p>Schalerbse Germana - Originalzüchtung Nebelung</p> <table border="1"> <thead> <tr> <th>Ausfaat</th> <th>Keimung</th> <th>Kultur</th> <th>Absand</th> <th>Ernte</th> </tr> </thead> <tbody> <tr> <td>Freiland, März bis April</td> <td>8-14 Tage bei 8-16 °C</td> <td>Anhäufen nach Aufgang</td> <td>Doppelreihen: 3-5 cm 60 cm</td> <td>Juni bis Anfang Juli</td> </tr> </tbody> </table> <p>'Germana' ist eine mittelfrühe, grünkömige Schalerbse mit gesundem, dunkeltem Laub. Bringt eine Menge sehr langer, paariger, schabelförmiger, ziemlich schmaler, hellgrüner Hülsen hervor, die mit 9-11 Körnern pro Hülse gefüllt sind. 'Germana' ist im Geschmack sehr gut und bringt sehr hohe Erträge. Für Konservierung, Frischverbrauch und getrocknete Körner für Suppen bestens geeignet.</p> <p>Standortansprüche: Nicht in frisch gedüngten Boden säen. Bodenverbesserungsmittel vermeiden. Die Erbsen vertragen auf Grund bestimmter Knöllchenbakterien an den Wurzeln den Stickstoff der Luft, darum ist nur eine geringe Nährstoffzufuhr notwendig, aber vor der Aussaat für eine geringe Düngung sehr dankbar.</p> <p>Tipp: Sind die Pflanzen etwa handbreit hoch, werden Reiser (oder Mischendrill) beigesteckt und die Reihen von beiden Seiten etwas angehäufelt. Abgeerntete Beete können nach mit Endvieh, Größtkoh, Kohlrabi, Rosenkohl oder Spinnat besetzt werden. Gut zum Einfräsen geeignet.</p> <p>Wuchshöhe ca. 70 cm.</p> <p>KIEPENKERL. www.nebelung.de Aus Freude am Gärtnern. Saatgut, Blumenzwiebeln, Rasensamen, Pflanzen</p>	Ausfaat	Keimung	Kultur	Absand	Ernte	Freiland, März bis April	8-14 Tage bei 8-16 °C	Anhäufen nach Aufgang	Doppelreihen: 3-5 cm 60 cm	Juni bis Anfang Juli
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7. By communication of 8 September 2014, the applicant was referred to possible misgivings of the Board which militated against registration of the trade mark applied for. The communication was based on the following reasons in particular:

- As there are a large number of different plants – and accordingly propagation material for plants – which, aside from an aesthetic function also fulfil practical functions (as foodstuffs or medicines, providers of shade, protection of privacy, protection against noise, erosion or else pests), there is a certain sensitivity and an associated high level of attention of the consumer upon purchasing the goods applied for.
- Article 20(1)(a) of the UPOV Convention states that the variety denomination is a generic designation (not in the botanical sense). As a generic designation, the variety denomination is a designation of product features which identifies the specific characteristics of the variety per se and is thus a descriptive indication within the meaning of Article 7(1)(c) CTMR.
- Following the restriction of the list of goods, an incorrect factual statement in relation to the present goods can be seen in the fact that the sign applied for, which is intended for a specific plant variety, matches the variety name of another plant variety. It is thus suggested to the relevant consumer that the living plants offered and the propagation material comprise the plants 'Hebe'.
- The use of the relevant variety denomination is in the public interest or in the interest of public certainty within the meaning of Article 7(1)(f) CTMR. This also follows from Article 94(1)(c) of the CPVR Regulation according to which the holder of a variety denomination can sue third parties who, contrary to Article 18(3) of the CPVR Regulation, use the variety denomination or a designation that may be confused with it.
- Pursuant to Article 18(2) of the CPVR Regulation, a third party may use a right granted in respect of a designation that is identical with the variety denomination to hamper the free use of that denomination only if that right was granted before the variety denomination was designated pursuant to Article 63 of the CPVR Regulation.

- Accordingly, the registration of a Community trade mark which could hinder the free use of a variety denomination is contrary to the interests of the public and to public policy.
 - Article 18(3) of the CPVR Regulation states that where a variety is protected by a plant variety right, neither its designated denomination or any designation which might be confused with it can be used, within the territory of the Community, in connection with another variety of the same botanical species or a species regarded as related pursuant to the publication made in accordance with Article 63(5), or for material of such variety.
8. The applicant essentially made the following observations in response to the communication by letter of 16 October 2014:
- In the structure of the international nomenclature, a plant variety is a plant grouping within a single botanical taxon of the lowest rank. The next rank up is the species.
 - For groups of plants newly created by breeding, there are no available terms of general or scientific plant taxonomy in the structure of the nomenclature. The terms for these must be newly created artificially. The variety denomination is merely intended to serve to continue a hierarchy of terms for the purposes of classifying plant units.
 - There is no species or genus ‘Hebe’. Instead the generic name ‘Hebe’ is the botanical name of the group of plants commonly known by the name ‘Shrubby Veronica’.
 - Varieties of different plant genera do not have any common features. A rose has completely different characteristics from a ‘Cape Daisy’ or a ‘Calibrachoa’. Above all, a rose could not contain any plant material from an entirely different botanical species. If reasonably well informed, observant and circumspect consumers who associated specific characteristics with a specific plant genus encountered the same designation for a plant of another plant genus, they would not expect the plants with the designation as a trade mark to have the same characteristics as the plant of a different genus bearing the same designation but as a variety denomination.
 - When consumers ask for and wish to purchase a rose, they seek it out because they know what characteristics roses have in general and corresponding varieties have in particular; and roses, as far as their fundamental nature is concerned, have nothing in common with plants of the genus ‘Hebe Comm.’
 - It is absurd to assume that purchasers of a plant of a specific genus would project characteristics associated with a variety denomination of a completely different genus onto the product sought.
 - Article 18(3) of the CPVR Regulation only provides that, where a variety is protected by a plant variety right, neither its designated denomination nor any designation which might be confused with it can be used in connection with another variety of the same species or a related species.
 - The opinion expressed in the communication conflicts with the perception of the public, legal rules and economic reality. In order to better delimit trade

mark law from plant variety protection law, it is proposed that oral proceedings be held.

9. On 27 April 2015, oral proceedings took place, in which the applicant and the experts F. Mattina, (CPVO), J. de Roos-Blokland (Plantum) and Ch. Dimopoulou (European Seed Association, ESA) were able to make observations on the Board's questions with regard to these proceedings and parallel proceedings (R 279/2014-1, Goldrush, R 280/2014-1, Goldrush, R 528/2014-1, Geisha, R 691/2014-1, Wasabi, R 894/2014-1, Skyfire; R 895/2014-1, Ice Tea). The oral proceedings were intended in particular to clarify market and labelling practices and examine the relationship between plant variety law and trade mark law in relation to the trade marks applied for and the goods covered by trade mark protection.
10. Questions for information purposes and a preliminary report for the oral proceedings were sent to the participants in advance. Among other things, the report contained the following facts for comment:
 - 'Goldrush' is mentioned a number of times in the database of the CPVO, inter alia for:
Species Latin name: Hebe Comm, ex Juss., Country: NL, variety status: registered, denomination status: approved, denomination nature: undefined, Species English name: Shrubby Speedwell'.
 - The trade mark application 'Goldrush' that is the subject of these proceedings is reproduced for the applicant under the heading 'Denomination nature: Trade Name', 'Application Date: 29.08.2013', in 'Denomination Status: approved'.
11. The participants essentially made the following comments in the oral proceedings:
 - Variety denominations are of particular relevance for the designation of variety constituents that are used in particular for producing plants (Article 5(3) of the CPVR Regulation). At this stage of development it is often difficult or even impossible to recognise which plants are involved. In this respect, Article 17 of the CPVR Regulation provides that plant material may fundamentally only be offered with the variety denomination. Furthermore, the variety denomination is of subordinate importance.
 - Trade marks serve in particular to identify the commercial origin of a plant or a category of plants. It can therefore also happen that the same trade mark is used for different varieties, for instance if the variety is further developed, the variety is offered on different geographical markets or if different varieties have certain common characteristics.
 - There is a need to keep the variety denomination available for the variety denomination for closely related varieties. In that regard, the criterion under plant variety protection law of 'closely related species' pursuant to Article 63 of the CPVR Regulation is also a suitable criterion in the scope of trade mark law.

Reasons

12. The appeal complies with Articles 58, 59 and 60 CTMR in conjunction with Rules 48 and 49 CTMIR. It is therefore admissible.
13. The applicant's appeal is also well founded and the contested decision is annulled.

Restriction of the list of goods

14. The applicant declares within the examination proceedings (see paragraph 3), that it is restricting the list of goods as follows (emphasis by the Board):

Class 31 – Live plants and natural flowers, ~~in particular~~ namely roses and rose plants; rose propagation material.

15. Such a restriction is possible at any time pursuant to Article 43 CTMR, but may only be registered if, following the restriction, it is clear which goods remain in the register (12/02/2004, C-363/99, Postkantoor, ECLI:EU:C:2004:86, § 18, 115). Under Article 4 CTMR, in conjunction with Article 26(1) CTMR and Rule 2(2) CTMIR, goods must be indicated with sufficient clarity and precision in order to be entered in the register (19/06/2012, C-307/10, IP Translator, EU:C:2012:361; 11/12/2014, C-31/14 P, Premeno, EU:C:2014:2436, § 36; 09/07/2015, R 863/2011-G, Malta Cross International Foundation / Maltese cross, § 54).
16. Firstly, the deletion of clarifying examples, that is to say the addition 'in particular roses and rose plants', from the generic term 'live plants and natural flowers' is admissible. Furthermore, the generic term 'live plants and natural flowers' as well as 'propagation material for plants' may be limited by the restriction to 'roses and rose plants' by means of the word 'namely'. In that case, only roses and rose plants as live plants, natural flowers and propagation material are still the subject of these proceedings. It is to be assumed in this case that the applicant is referring here to the concept of the plant genus 'Rosa' in the botanical sense and not to roses in the purely colloquial, botanically inaccurate sense. Within the botanical system, the variety is at the lowest level, the variety belongs to a species, the species to a genus, the genus to a family, etc.

Article 7(1)(c) CTMR

17. The examiner firstly uses Article 7(1)(c) CTMR to substantiate his decision. The examination is now to be based on the restricted list of goods.
18. Article 7(1)(c) CTMR provides that registration is to be refused in respect of descriptive marks, that is to say 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. Article 7(1)(c) CTMR therefore pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all. This provision therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 24-25).

19. A trade mark is a descriptive indication pursuant to Article 7(1)(c) CTMR if it either constitutes the designation of the goods or describes characteristics of the goods.
20. The term ‘Goldrush’ for plants and flowers and their propagation material is in itself firstly a fanciful designation. ‘Goldrush’ can be translated into German approximately as ‘Gold-Hatz’ for gold prospecting which, particularly in the 19th Century, was also described in Germany as ‘Goldrausch’. However, this is not a description of characteristic of plants.
21. Nor does any obstacle result from the registration of the variety denomination ‘Goldrush’ in respect of, for instance, a variety of the botanical genus ‘Hebe L.’ (‘Shrubby Veronica’ or ‘Shrubby Speedwell’) at the time of filing application.
22. It is correct that a registered variety denomination designates the corresponding variety, as the variety denomination is precisely the universal denomination of the variety, as the name suggests. This is also expressly apparent from Article 20(1) of the UPOV Convention, to which the European Union has acceded and is bound by the content thereof. Article 20 reads as follows:

Article 20 – Variety Denomination

(1) [Designation of varieties by denominations; use of the variety denomination]

a) The variety shall be designated by a variety denomination which will be its generic designation. [French version: ‘a) La variété sera désignée par une dénomination destinée à être sa désignation générique.’]

b) Each Contracting Party shall ensure that, subject to paragraph (4), no rights in the designation registered as the denomination of the variety shall hamper the free use of the denomination in connection with the variety, even after the expiration of the breeder’s right.

23. Furthermore, a trade mark that was applied for in respect of a broad category of goods must be refused overall if the trade mark only describes a sub-category which is covered by the main category (20/11/2007, T-458/05, Tek, EU:T:2007:349, § 94).
24. The examination must take account of the priority date of the trade mark applied for, in this case 15 April 2013 (03/12/2009, R 1743/2007-1, Vesuvia, § 39, for roses; 01/03/2012, R 1095/2011-5, Sharbati, for rice). The only decisive factor is whether the designation became the name of the variety at that time, be it through entry in the variety register or in general linguistic usage. It is therefore irrelevant whether the applicant or a third party has a (time-restricted) right in respect of the variety with this designation or whether this protection has expired or ended in another way (cf. the application for a trade mark in respect of a breed of dog of the same name 23/06/2010, R 300/2010-1, Continental; appeal dismissed 17/04/2013, T-383/10, Continental, EU:T:2013:193).
25. Nor is there anything different in the CPVR Regulation, in particular Article 18, paragraphs 1 and 2 of which read as follows:

Article 18 – Limitation of the use of variety denominations

(1) The holder may not use any right granted in respect of a designation that is identical with the variety denomination to hamper the free use of that denomination in connection with the variety, even after the termination of the Community plant variety right.

(2) A third party may use a right granted in respect of a designation that is identical with the variety denomination to hamper the free use of that denomination only if that right was granted before the variety denomination was designated pursuant to Article 63.

26. It is true that such a ‘right in respect of a designation’ may be a right resulting from a trade mark. In this respect, the rights of a person who enjoys both a right resulting from a trade mark and from a variety denomination in respect of a designation are permanently limited, that is to say including after the termination of the plant variety right (so-called ‘enforcement ban’). Even third parties which have acquired a right in respect of a trade mark after an identical variety denomination was designated are subject to a restriction of their rights resulting from the trade mark.
27. However, this in no way results in a right to registration in respect of variety denominations as trade marks for these varieties. In this respect, the Court of Justice has already found, with regard to Article 12 CTMR, that the system of the CTMR and of the directive is based on a check carried out by the offices prior to the registration and not on an *a posteriori* interpretation by the courts. Examination regarding absolute grounds for refusal must be stringent and full, in order to prevent trade marks from being improperly registered and, for reasons of legal certainty and good administration, to ensure that trade marks whose use could successfully be challenged before the courts are not registered (06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 59 and 21/10/2004, C-64/02 P, Das Prinzip der Bequemlichkeit, EU:C:2004:645, § 45).
28. ‘Goldrush’ is currently mentioned a number of times in the ‘Varietyfinder’ database of the CPVO.
29. However, the registration as a trade name is irrelevant, and even more so the reference to the trade mark applied for here, which was misleadingly described there as having the status ‘approved’.
30. The applicant also expressly restricted its list of goods such that it only still covers plants of the genus ‘roses’ and therefore no longer ‘Goldrush’ varieties of the genus ‘Shrubby Veronica’ or other relevant varieties. If the list of goods only covers plants in respect of which no variety denomination is registered or known, the ground for refusal of a descriptive indication is inapplicable (cf. 04/09/2014, R 1959/2013-1, Fame, § 25).
31. No further ‘Goldrush’ variety denomination could be found for the goods that are still the subject of these proceedings, either inside or outside the European Union, in particular in a state which is a UPOV Contracting Party.
32. As there are therefore no reasons to indicate that the trade mark applied for constitutes a descriptive indication within the meaning of Article 7(1)(c) CTMR in respect of the goods that are still the subject of these proceedings, the decision is to be annulled in this respect.

Article 7(1)(b) CTMR

33. The examiner also based the decision on lack of distinctive character pursuant to Article 7(1)(b) CTMR. Even though facts which do not lead to a refusal pursuant to Article 7(1)(c) CTMR often do not lead to a refusal pursuant to Article 7(1)(b) CTMR either, this is not automatically the case, as each standard has its own field of application.

34. Pursuant to Article 7(1)(b) CTMR, Community trade marks which are devoid of any distinctive character, i.e. trade marks that are not capable of distinguishing the goods or services specifically applied for by one undertaking from those of other undertakings, shall not be registered (15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 60).
35. The trade mark is supposed to make the plants offered by one producer distinguishable from plants of other producers in terms of their origin.
36. It is therefore questionable whether the fact that the trade mark applied for is identical to the designation of a variety that is assigned to a different genus leads to the trade mark applied for being devoid of any distinctive character.
37. This is to be assessed in individual cases according to trade mark law considerations from the point of view of the relevant public. The consumer of relevance under trade mark law is defined as an average consumer who is reasonably well informed and reasonably observant and circumspect, that is to say neither particularly observant nor particularly unobservant.
38. The goods claimed by the trade mark applied for target firstly the general public wishing to purchase live plants, natural flowers and propagation material for plants. Secondly, the goods also target a specialist public, such as breeders, plant cultivation companies, wholesalers and retailers, which sell such plants and flowers and propagation material for plants. In particular, propagation material primarily targets a specialist public, as was also confirmed in the oral proceedings.
39. When selecting the goods, both sections of the public pay attention to the designation of the more general genus and species of the plant, as well as its characteristics such as colour, appearance, flowering time, resistance, soil compatibility and commercial origin and, to a lesser extent, the variety denomination, for instance so they can repeatedly cultivate a successful variety of a particular species of plant.
40. In this regard, it is necessary to steer a course between two extremes, while taking account of the circumstances of the individual case:
41. On the one hand, it is clear that a trade mark which is identical to a variety denomination will in any case be devoid of distinctive character in respect of plants of the same variety, as it is regarded as a descriptive indication and not as a trade mark. As was found in the examination of Article 7(1)(c) CTMR, the registered trade mark 'Goldrush' is not a descriptive indication for the goods applied for within the meaning of the list of goods.
42. However, a word mark is not automatically distinctive just because it does not constitute a descriptive indication in respect of these goods. Conversely, a trade mark is, however, not automatically devoid of distinctive character either because an identical variety denomination exists for a plant that is only distantly related to it. Genus, species and variety denominations in respect of plants, on the one hand, and trade marks, on the other, also have different functions.
43. However, the more closely related the variety whose name corresponds to the trade mark applied for is to the variety which appears in the list of goods, the more likely it is that the trade mark will be devoid of distinctive character. In this respect, the general principles apply: the more closely the trade mark applied for

resembles the designation most likely to be used for the product in question, the greater the likelihood of that trade mark being devoid of any distinctive character for the purposes of Article 7(1)(b) CTMR. Only a trade mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of that provision (cf. 29/04/2004, C-473/01 P & C-474/01 P, *Tabs*, EU:C:2004:260, § 37; 07/05/2015, C-445/13 P, *Voss Bottle*, EU:C:2015:303, § 91). A criterion must therefore be found that determines those plant varieties regarded by the relevant public as products so similar to the goods applied for that the name of that variety is not regarded as a distinctive trade mark for a different variety.

44. For this purpose, account must be taken of the fact that on the one hand, the variety denomination is generally of secondary importance to the end consumer. The end consumer is firstly guided by their objective, for instance whether they are looking for a useful or an ornamental plant, what characteristics that plant should have, for instance with regard to its appearance, and what basic conditions there are for their plant (what plant will grow in the location available, etc.). As a second step, they select, amongst the specific offer on the market, the variety that comes closest to their objective on the basis of the variety characteristics. This was confirmed by the applicant and experts during the oral proceedings.
45. On the other hand, the labelling regulations and practices also play a part. Traders usually offer plants by designating rather technical details (genus, species and variety denomination as well as plant characteristics) on the one hand, and, as applicable, a trade mark or trade name (company mark, product mark) on the other. 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 usually be easily recognised, the use of the variety denomination is even a mandatory indication for retail purposes. Specifying a trade mark in addition to a variety denomination is expressly allowed when the variety is offered for sale or marketed commercially. If, however, a trade mark is used in association with the variety denomination, the variety denomination must be easily recognisable, for instance through addition of the letter ® for trade marks and/or reproduction in single quotation marks for variety denominations (var.: ‘Goldrush’), etc.
46. Article 20 of the UPOV Convention thus regulates the use of variety denominations and trade marks as follows:

(7) [Obligation to use the denomination] Any person who, within the territory of one of the Contracting Parties, offers for sale or markets propagating material of a variety protected within the said territory shall be obliged to use the denomination of that variety, even after the expiration of the breeder’s right in that variety, except where, in accordance with the provisions of paragraph (4), prior rights prevent such use.

(8) [Indications used in association with denominations] When a variety is offered for sale or marketed, it shall be permitted to associate a trade mark, trade name or other similar indication with a registered variety denomination. If such an indication is so associated, the denomination must nevertheless be easily recognisable.

47. Article 17 of the CPVR Regulation more precisely states in particular:

Article 17 – Use of variety denominations

(1) Any person who, within the territory of the Community, offers or disposes of to others for commercial purposes variety constituents of a protected variety, or a variety covered by the provisions of Article 13(5), must use the variety denomination designated pursuant to Article 63 ; where it is used in writing, the variety denomination shall be readily distinguishable and clearly legible. If a trade mark, trade name or similar indication is associated with the designated denomination, this denomination must be easily recognisable as such.

48. In order to decide whether the variety denomination in respect of a particular variety is devoid of distinctive character as a trade mark in respect of another variety with a different variety denomination, the concept of a 'variety of a closely related species' within the meaning of Article 63(5) of the CPVR Regulation may be suitable as a fundamental examination criterion, even after hearing the applicant and the experts.

49. The concept of a variety of a 'closely related species' is a central concept which is often used in plant variety protection law. Article 20(2) of the UPOV Convention thus provides the following:

(2) [Characteristics of the denomination] The denomination must enable the variety to be identified. It may not consist solely of figures except where this is an established practice for designating varieties. It must not be liable to mislead or to cause confusion concerning the characteristics, value or identity of the variety or the identity of the breeder. In particular, it must be different from every variety denomination which designates, in the territory of any Contracting Party, an existing variety of the same plant species or of a closely related species.

50. Article 63(2)(3)(c) and (5) of the CPVR Regulation more precisely states:

(2) A variety denomination is suitable, if there is no impediment pursuant to paragraphs 3 or 4 of this Article.

(3) There is an impediment for the designation of a variety denomination where ...

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;

(5) The Office shall publish the species which it considers closely related within the meaning of paragraph 3(c).

51. This means that identical variety denominations may be registered several times as long as the species to which the varieties belong have a sufficient botanical difference. It is generally immaterial whether they come from the same breeder.

52. The criterion of the ‘variety of a closely related species’ has firstly been determined in more detail by the UPOV in the ‘Explanatory Notes on Variety Denominations under the UPOV Convention’, 1 November 2012, UPOV/INF/12/4, Annex 1¹:

‘Annex

2.5 Variety denomination classes: A variety denomination should not be used more than once in the same class.

2.5.1 For the purposes of providing guidance on the third and fourth sentences of paragraph 2 of Article 20 of the 1991 Act and of Article 13 of the 1978 Act and the 1961 Convention, variety denomination classes have been developed. A variety denomination should not be used more than once in the same class. The classes have been developed such that the botanical taxa within the same class are considered to be closely related and/or liable to mislead or to cause confusion concerning the identity of the breeder.

2.5.2 The variety denomination classes are as follows:

- a) General Rule (one genus / one class): for genera and species not covered by the List of Classes in this Annex, a genus is considered to be a class;
- b) Exceptions to the General Rule (list of classes):
 - i) Classes within a genus: List of classes in Annex I: Part I;
 - ii) Classes encompassing more than one genus: List of classes in Annex I: Part II.’

53. The implementation by the CPVO pursuant to Article 63(5) of the CPVR Regulation took place in the ‘Guidelines on Article 63’ of the CPVR Regulation²:

‘ANNEX CLOSELY RELATED SPECIES

“Closely related species” as specified in Article 63(3)(c) of Council Regulation 2100/94 and referred to in Article 4(d) of these Guidelines should have the following meaning:

- a) As a general rule, for genera and species not covered by the list of classes in this Annex, the genus is considered to be the class.
- b) If there is more than one class within a genus, Part I of the following list of classes shall apply
- c) If classes encompass more than one genus, Part II of the following list of classes shall apply.’

54. Exceptions to the general rule that varieties in the same genus are to be regarded as closely related species therefore concern particular species of plant (combined in ‘classes’) for which experts considered it necessary to form a grouping which departs from the botanical taxa. In the case of the one group, several sub-groups are formed within the same botanical genus and these are already regarded as closely related species (List I of the Annex to the ‘Explanatory Notes on Variety Denominations under the UPOV Convention’). In the case of the other group, species of several botanical genera are combined in a larger group (List II of that Annex).

¹ http://www.upov.int/edocs/infdocs/de/upov_inf_12_4.pdf.

² http://www.cpvo.europa.eu/documents/lex/guidelines/VD_Guidelines_EN.pdf

55. However, such exceptions do not exist for plants of the genus ‘roses’ (‘Rosa’). Only varieties of the species which belong to this genus are accordingly regarded as ‘closely related species’ pursuant to Article 63(5) of the CPVR Regulation. However, it is precisely all of these that the applicant has removed from the list of goods. The list of goods therefore no longer contains any varieties ‘of closely related species’.
56. It must therefore be stated that, from the perspective of plant variety law, there is nothing to prevent ‘Goldrush’ from being simultaneously registered as a variety denomination for a rose and a variety of another genus, as they in fact belong to different botanical genera and are therefore not of a ‘closely related species’.
57. The demarcation made by the legislator in the case of variety denominations should also fundamentally apply to trade marks in relation to the absolute grounds for refusal.
58. This does not mean that there can be no further grounds on the basis of which it may be found that there is a lack of distinctive character. In particular, the examination of distinctive character under trade mark law is in no way bound by criteria under plant variety protection law. However, further factors must exist for a trade mark corresponding to a variety denomination of non-related species to be devoid of distinctive character. The contested decision does not, however, provide any reasoning in this respect. There are likewise no observations by third parties pursuant to Article 40 CTMR that might introduce other considerations in relation to the goods that are specifically to be examined. It is also pointed out that expert third parties may have this registration reviewed with regard to absolute grounds for refusal in invalidity proceedings pursuant to Article 52 CTMR.
59. The decision is to be annulled in this respect also.

Article 7(1)(g) CTMR

60. The Board also heard the applicant regarding Article 7(1)(g) CTMR. In this case, it takes account of the fact that purchasers who are offered propagation material under the trade mark ‘Goldrush’, does not constitute seeds of the ‘Goldrush’ variety are being deceived.
61. Pursuant to Article 7(1)(g) CTMR, trade marks which are of such a nature as to deceive the public, for instance as to the nature, quality or purpose of the goods, shall not be registered. However, this requires it to be established that the consumer has actually been misled or there is a sufficiently serious risk of this (30/03/2006, C-259/04, Elizabeth Emanuel, EU:C:2006:215, § 48).
62. In this case, it is to be assumed in principle that every applicant uses their trade mark in a non-deceptive manner if this appears possible on the basis of the list of goods. As the reasonably observant consumer can distinguish ‘roses’ from varieties of other genera, and pays attention to the corresponding designations, the Board has no reason to assume a deception.

Article 7(1)(f) CTMR

63. The Board also invited the applicant to submit observations regarding Article 7(1)(f) CTMR in conjunction with Article 20(1) of the UPOV Convention. This provision in particular opens up further scope for refusal of trade marks in respect of which distinctiveness in consequence of use pursuant to Article 7(3) CTMR is

claimed or in which the variety denomination is incorporated in its essential components in another sign. However, since a pure word mark was applied for and distinctiveness in consequence of use pursuant to Article 7(3) CTMR was not claimed here, and since the trade mark is not the designation of a variety covered by the list of goods (see Article 7(1)(c) CTMR), nor that of a related variety within the meaning of Article 18(3) of the CPVR Regulation (see Article 7(1)(b) CTMR), this also does not provide a further reason for refusal of the trade mark applied for.

64. The examiner's decision is therefore to be annulled in its entirety.

Order

On those grounds,

THE BOARD

hereby:

1. Notes that the application was restricted in the examination procedure as follows:

Class 31 – Live plants and natural flowers, namely roses and rose plants; rose propagation material.

2. Annuls the contested decision. Remits the application for the continuation of the registration procedure.

Signed

Th. M. Margellos

Signed

Ph. von Kapff

Signed

C. Rusconi

Registrar:

Signed

H. Dijkema

