

THE USE OF PLANT VARIETY DENOMINATIONS AFTER THE EXPIRATION OF THE BREEDER'S RIGHT

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ABSTRACT: *To obtain Plant Variety Rights (PVRs) protection, a plant variety must have a unique variety denomination (VD) for identification. This VD helps consumers distinguish between varieties and remains necessary for marketing even after PVRs expire. The continued use of VDs raises legal questions about their status post-PVRs, particularly in cases of deceptive use or misuse. This article addresses these issues, focusing on enforcing rights when a VD is used for different varieties or misused. The analysis primarily considers EU law, including recent activities by CPVO, EUIPO, and case law from the Court of Justice of the European Union (CJEU).*

Background

In recent years, the ever-increasing attention paid to issues related to food safety, sustainability, and climate change has put the agribusiness sector in the spotlight. This has highlighted the need at the EU level for a major restructuring of the industry regulatory framework to streamline and update the current regulation, bringing it more in line with the [Farm to Fork strategy](#) and the [UN's Sustainable Development Goals](#).

This prompted the Commission to initiate a series of legislative revision procedures, which led, in particular, to the [review of the existing marketing standards](#) of various agri-food products, including specific fruits and vegetables such as apples, strawberries, and table grapes¹. Also, the Commission revised the [rules governing plant and forest reproductive material](#) and developed a [proposal for a new regulation on plants produced by certain new genomic techniques](#); while the revision of the [Council Regulation \(EC\) No 2100/94 of 27 July 1994](#) on Community plant variety rights (CPVRR) is in the pipeline, in anticipation of which the extension of the scope of PVR protection to harvested material and products resulting thereof and the strengthening of the breeders' rights during the so-called "provisional protection" period (i.e., the period between the filing of the application for PVR and its registration) continue to be hotly debated topics at both international² and European level.

Hence, the key role of variety denominations.

¹ See https://agriculture.ec.europa.eu/farming/crop-productions-and-plant-based-products/fruit-and-vegetables_en

² On March 21, 2023, the Working Group on Harvested Material and Unauthorized Use of Propagating Material (WG-HRV) at UPOV agreed to organize a study to assist its deliberations on the "Scope of the Breeder's Right" in Article 14(1) and (2) of the 1991 Act, including the notions of "unauthorized use" and "reasonable opportunity" and the relationship with the "Exhaustion of the Breeder's Right" in Article 16 of the 1991 Act. Accordingly, a group of experts was appointed to draft the study (see, in particular, the document [WG-HRV/6/2](#) – Prospects of commissioning a study on the "Scope of the Breeder's Right" and the relationship with the "Exhaustion of the Breeder's Right"). In parallel, the WG-HRV is committed to revising the Explanatory Notes on Provisional Protection under the UPOV Convention. The European Union, as a UPOV Member, participates in the UPOV meetings. For more information on relevant past and ongoing discussions at the UPOV level, please consult the "[Meeting Documents](#)" section on the UPOV website.

Variety Denomination (VD), in fact, represents, by definition³, the unique and generic name of a plant variety and fulfills precisely the function of identifying a specific plant variety, enabling users to distinguish it from others. While it is generally permitted to combine in trade a trademark with a variety denomination⁴, the essential (and irreplaceable) public utility role played by the latter in identifying the variety cannot be confused with – and must, therefore, be kept well distinct and separate from – the primary function performed by the trade mark, which – by serving the purpose of distinguishing goods or services from a particular undertaking from those of other undertakings – is of a purely private nature, exclusively aiming to protect the individual interest of the owner⁵. This difference in functions between the two IP assets has often been stressed in the decisions of the competent European IP authorities (e.g., EUIPO and CPVO) and in the case law of the Court of Justice of the European Union (CJEU), as will be seen below.

Due to its nature as a matter of public interest, Article 20 of the 1991 [UPOV Convention](#) (UPOV91) establishes that using variety denominations is mandatory when offering for sale or marketing the propagating material of a protected plant variety. This requirement remains in effect even after the breeder's rights to that variety have expired⁶.

This same obligation is also outlined at the EU level in Article 17 of [Council Regulation \(EC\) No 2100/94 of 27 July 1994](#) on Community Plant Variety Rights (CPVRR). Such regulation complements the UPOV requirement to use the variety denomination when selling or marketing propagating material with a softened obligation to inform about that denomination, in accordance with other legal provisions or if requested by an authority, the purchaser, or any other person with a legitimate interest, when it comes to the commercial use of any other material of the variety, such as *harvested material* and its resulting products.

This adjustment further emphasizes the public interest dimension of the product-identification function of the variety denomination as a means of protecting the general public's interests⁷, represented, in detail, by the consumer's right to be informed, which – especially in the case of foodstuffs, including fruits – also impacts on the right to health. This is all the more confirmed by the references in the EU marketing standards, which state that “*propagating material and fruit plants shall be marketed with a*

³ The [UPOV Convention](#), adopted in Paris in 1961 and then revised in 1972, 1978 and 1991, which encompasses the basic legislation on the protection of the new plant variety rights, expressly provides, under Articles 5(2) and 20 of the 1991 Act, and Articles 6(1)(e) and 13 of the 1978 Act and the 1961 Act, that a variety denomination must be suitable as a generic designation of a variety and must enable such a variety to be identified; 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.

⁴ Article 20(8) of the 1991 Act of the UPOV Convention (in short, UPOV91) in fact reads that “(W)hen a variety is offered for sale or marketed, it shall be permitted to associate a trademark, trade name or other similar indication with a registered variety denomination. If such an indication is so associated, the denomination must nevertheless be easily recognizable”.

⁵ For more information on the coexistence between trademarks and plant variety denominations at International and EU level, see the in-depth article “*Maximising benefits by combining protection measures*” by Ángela H. Martínez López, Legal Advisor of the CPVO, originally published in “*Prophyta* (Journal for breeders and producers of plant material)”, [The Annual 2021, Blue Bird Publishers, July 2021, pp. 18-23](#), and available on the CPVO website at <https://cpvo.europa.eu/en/news-and-events/articles/interface-between-trade-marks-plant-variety-denominations-towards-clearer-coexistence-international-and-eu-level>.

⁶ Article 20(7) of the UPOV91 Act reads as follows: “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”. In similar terms, Article 17(1) CPVRR provides that “(A)ny 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 trademark, trade name or similar indication is associated with the designated denomination, this denomination must be easily recognizable as such”.

⁷ In fact, according to Article 17 of the Regulation (CE) 2100/94 (in short, CPVRR), “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 trademark, trade name or similar indication is associated with the designated denomination, this denomination must be easily recognizable as such. 2. Any person effecting such acts in respect of any other material of the variety, must inform of that denomination in accordance with other provisions in law or if a request is made by an authority, by the purchaser or by any other person having a legitimate interest. 3. Paragraphs 1 and 2 shall apply even after the termination of the Community plant variety right”.

reference to the variety to which they belong. If, in the case of rootstocks, the material does not belong to a variety, reference shall be made to the species or interspecific hybrid in question”⁸.

Hence, ensuring the compliant use of variety denominations is crucial to enabling the proper identification of a given product—specifically, a given variety—on the market. This “product-identification” role of the variety denomination is, in fact, commonly known as the “*what you are*” function, distinguishing it from the traditional role of trademarks, which is identified as the “*who you are*” function emphasizing the productive-commercial origin.

Public-interest Function of Variety Denomination and Duty of Information

Variety Denomination serves a public interest function, which finds expression in the relevant public’s right to be precisely informed about a certain agricultural/horticultural product. This is all the more important for agri-food products, where the end consumer pays increasingly more attention to the origin and characteristics of the food they buy, and health-related issues assume particular relevance.

As a result, the overall responsibilities of product sellers to consumers have become increasingly important, in accordance with the consumers' rights established by relevant EU laws⁹.

In this context, the key role of the variety denomination with respect to the protection of the “*legitimate interest of consumers and producers*” is particularly emphasized by the definition of plant variety denomination provided for in the EUIPO Trade mark Guidelines, which states that “(P)rotection is granted to plant variety denominations in order, inter alia, to protect the legitimate interest of consumers and producers in knowing the variety they are using or purchasing, as well as possibly the breeder and origin of that variety. The obligation to use the variety denominations contributes to the regulation of the market and to the safety of transactions in the agricultural and food sector, thus preventing counterfeiting and any potential misleading of the public”¹⁰.

On the other hand, the entire IP protection system is rooted in the counterbalance with the protection of public interest, expressly including the protection of public health¹¹. The same UPOV Convention saw the light with the declared aim of encouraging the development of new varieties of plants for the benefit of society¹².

Given this context, the mandatory use of variety denominations established by Article 20 of the Basic Regulation cannot but be considered in conjunction with the relevant legal framework concerning consumer protection – and, in particular, the labelling requirements, namely, for fresh fruits or vegetables - with which the obligation of compulsory use of variety denomination share the core public-

⁸ See [Council Directive 2008/90/EC of 29 September 2008 on The Marketing of Fruit Plant Propagating Material and Fruit Plants Intended for Fruit Production](#), Chapter 4 Variety Identification and Labelling - Article 7(1) Variety identification: “*Propagating material and fruit plants shall be marketed with a reference to the variety to which they belong. Where, in the case of rootstocks, the material does not belong to a variety, reference shall be made to the species or interspecific hybrid concerned*”.

⁹ For more information on consumer rights in the EU and to consult the [Consumer Rights Directive](#), please see https://commission.europa.eu/law/law-topic/consumer-protection-law/consumer-contract-law/consumer-rights-directive_en.

¹⁰ According to the [Definition of Plant Variety Denomination](#), under Chapter 13 Trade marks in conflict with earlier plant variety denominations (Article 7(1)(m) EUTMR) of the EUIPO Trade mark guidelines (version 1.2 of 31/03/2024), “*Plant variety denominations identify cultivated varieties or subspecies of live plants or agricultural seeds. A variety denomination must ensure clear and unambiguous identification of the variety and fulfil several criteria (Article 63 CPVRR). The applicant for a CPVR must indicate a suitable variety denomination, which will be used by anyone who markets such variety in the territory of a member of the International Union for the Protection of New Varieties of Plants (UPOV), even after termination of the breeder’s right (Article 17 CPVRR). Protection is granted to plant variety denominations in order, inter alia, to protect the legitimate interest of consumers and producers in knowing the variety they are using or purchasing, as well as possibly the breeder and origin of that variety. The obligation to use the variety denominations contributes to the regulation of the market and to the safety of transactions in the agricultural and food sector, thus preventing counterfeiting and any potential misleading of the public*”.

¹¹ [Article 8](#) of the TRIPS Agreement, in fact, allows members to adopt measures necessary to promote the public interest, including to protect public health – so long as those measures are consistent with the TRIPS Agreement. For a general overview of the topic, see “*Intellectual property and the public interest*” on the WTO website at https://www.wto.org/english/tratop_e/trips_e/trips_and_public_interest_e.htm.

¹² See UPOV Mission Statement at <https://www.upov.int/about/en/index.html>.

interest principle of duty of information, and which in both cases remains as an independent obligation regardless of the existence of breeder's right on a certain plant variety.

In fact, whereas the designation of a suitable denomination at the time of filing a PVR application is a precondition for the granting of PVRs¹³, after the expiration of the PVR, the variety denomination becomes an 'independent' element while continuing to fulfil the product-identification function, allowing users in the marketplace to distinguish and identify a specific variety (and therefore a specific product) from others.

For this very reason, both the 1991 UPOV Act and the CPVRR expressly provide that “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”¹⁴.

Corollary to the above principle is the provision under Article 63(3)(c) CPVRR, which forecloses the possibility of designation of a variety denomination – *inter alia* - where “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”. In this regard, the ‘CPVO Guidelines on Variety Denominations on Article 63 of Council Regulation (EC) 2100/94 of 27 July 1994 on Community plant variety rights’¹⁵ specifies under Article 4 that “(A) variety no longer remains in existence’ shall be considered to mean a variety of which material no longer exists”.

The provision under Article 20(5) of the 1991 UPOV Act likewise responds to the need to clearly identify a variety on the market while stating that, in principle, “(A) variety must be submitted to all Contracting Parties under the same denomination”; this provision having been transposed in similar terms, at European level, in Article 18, (3) CPVRR, which, in paragraph 3, further adds that “(W)here a variety is protected by a Community plant variety right or, in a Member State or in a Member of the International Union for the Protection of New Varieties of Plants by a national property 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”.

The Role of the Variety Denomination in the EU Case Law

The importance of variety denominations, particularly in relation to trademarks, has grown significantly in recent years, as illustrated by case law. Notable rulings from the Court of Justice of the European Union (CJEU) and decisions from the competent European intellectual property authorities highlight this issue.

In this context, the grounds for the decision of the EUIPO Board of Appeal in the 'Vesuvia' case¹⁶ and of the CJEU in the 'Kordes' Rose Monique' case¹⁷ serve as compelling examples.

¹³ As provided for, respectively, by Article 5, UPOV91 and Article 6 in conjunction with Article 63 CPVRR.

¹⁴ The principle is expressed in these terms in Article 20(1)(b), UPOV91. Similarly, Article 18(1), CPVRR reads that “(T)he 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”.

¹⁵ Available at https://cpvo.europa.eu/sites/default/files/documents/cpvo_guidelines_on_art_63_with_explanatory_notes.pdf.

¹⁶ Decision of the First Board of Appeal of 3 December 2009 in Case [R1743/2007-1](#), POULSEN ROSER A/S v VERDIA SARL.

¹⁷ Judgment of 18 June 2019 in Case [T-569/18](#), W. Kordes' Söhne Rosenschulen v EUIPO (Kordes' Rose Monique), ECLI:EU:T:2019:421.

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The issue underlying the first case concerned the application for Community Trade Mark (CTM – now, European Union Trade Mark, EUTM) of the word mark ‘Vesuvia’ for goods in class 31 – namely, “(A)gricultural and horticultural products (except maize), (neither prepared, nor processed); grains (seeds) (except maize); fresh fruits and vegetables (except maize), natural plants (except maize); forestry products (neither prepared, nor processed), fresh fruit, natural flowers”, thus including roses.

An invalidity claim had been made against the title on the grounds that VESUVIUS was a ‘generic term’ for a variety of roses which has been in cultivation and commerce for 80 years and the CTM further deceived the public as far as the trade mark was used for roses other than VESUVIUS in the sense of Article 7(1)(g) CTMR. It had been furthermore complained that the fact that the CTM proprietor had used VESUVIA for VESUVIUS variety roses showed that it had filed the trade mark in bad faith.

The EUIPO Board, in assessing the case, highlighted at the outset the different requirements for the suitability of a variety denomination and the registration of a trademark, pointing out that, in the case at hand, “‘VESUVIA’ would be rejected as a plant variety denomination because it comes too close to ‘VESUVIUS’”¹⁸, while “as a trade mark must be considered falling foul with the rules of generally acceptable behaviour in fair competition, since it must be seen as overturning the regulations of plant variety denominations and misappropriating the variation of a name for a rose variety that is not protectable under plant variety law”¹⁹.

The Board further noted that (added emphasis): “(A) descriptive indication is to be rejected if it is the name of a certain category of products. In principle and at least under modern plant variety law, a new rose variety may be protected on a national level, on a Community level registered at the Community Plant Variety Office (CPVO) in Angers or on an international level registered in Geneva, if the Member State is member of the International Union for the Protection of New Varieties of Plants (UPOV). In each case, the rose variety must be registered under a specific name. The registration of a plant variety is limited in time, which means that the plant variety is no longer protected once that term has expired. Many plant varieties have never been registered anywhere (...) Vesuvius, which is the name of the rose variety, is also the name of the product itself, i.e., roses. Hence, it could even be used as the specification of a product in the list of goods in the context of a trade mark application, worded for example in a way such as ‘natural flowers, namely roses of the Vesuvius variety’. It is clear that VESUVIUS cannot be protected as a trade mark for ‘roses of the Vesuvius variety’, but must be rejected just as ‘daisies’ must be rejected for daisies, ‘birch’ must be rejected for birch trees and ‘boskoop’ must be rejected for boskoop apple trees”²⁰.

By turning attention to the consumer perception, the Board accordingly found that Vesuvia equalled Vesuvius in the perception of the trade and/or the consumers, thus ruling that “the trade mark VESUVIA must be declared invalid in accordance with Article 7(1)(c) CTMR for all goods that may include roses of the Vesuvius variety, variety, namely: Class 31 – Agricultural and horticultural products (except maize), (neither prepared, nor processed); grains (seeds) (except maize); natural plants (except maize); forestry products (neither prepared, nor processed), natural flowers”²¹.

In the ‘Kordes Rose Monique’ case, always on the subject of rose varieties, the CJEU instead held as follows (emphasis added):

“By prohibiting the registration, as an EU trade mark, of marks which consist of such a variety denomination or which reproduce its essential elements, Article 7(1)(m) of Regulation No 207/2009 pursues an aim of general interest, which requires that variety denominations may be freely used by all. That provision therefore prevents variety denominations from being reserved for a single

¹⁸ Decision of the First Board of Appeal of 3 December 2009, cited, p. 10, second indent.

¹⁹ *Ibidem*, third indent.

²⁰ *Ibidem*, § 37 and § 39.

²¹ *Ibidem*, § 54.

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undertaking by reason of their registration as a trade mark, whereas other undertakings might wish to describe their own products by using precisely the terms registered as a trade mark.

*The objective pursued by that provision, which is to safeguard the free disposal of variety denominations and thus **prohibit their monopolisation**, is also apparent from Article 20(1)(b) of the International Convention for the Protection of New Varieties of Plants, adopted in Paris on 2 December 1961, to which the European Union has been a party since 29 July 2005 ('the UPOV Convention'). Indeed, the latter provision provides that '[e]ach Contracting Party shall ensure that ... no right relating to the designation registered as the denomination of the variety hinders the free use of the denomination in connection with the variety, even after the expiry of the breeder's right.*

*In accordance with Article 20(1)(a) of the UPOV Convention, the plant variety will be designated by a name intended to be its generic name. The name assigned by the breeder to the plant variety created by him thus legally becomes the generic name of that variety, **that is, its generic name**. Taking into account Article 20(1)(b) of the UPOV Convention, this generic name cannot be monopolized and must be able to be used by anyone in the marketplace to designate the variety concerned, even after the expiration of the breeder's right relating to this variety. It follows that, regardless of whether the breeder's right is maintained, a variety name becomes the generic name of the plant variety and, as such, **this name must be freely available to other companies to describe their products**'²².*

This jurisprudential orientation should, moreover, not be viewed as isolated, as it recalls the case law of the U.S. Trademark Trial and Appeal Board (TTAB)²³ concerning a well-known California-based table grape breeding company – namely, International Fruit Genetics - who filed a class-31 trademark application composed by its acronym, i.e., 'IFG'. Registration was refused on the ground that the proposed mark identified the prominent portion of a varietal name for the identified goods and, thus, does not function as a trademark to indicate the source of Applicant's goods and to identify and distinguish them from others. In other words, 'IFG' was the initial element of numerous varietal names for grapes, grapevines, grapevine plants, sweet cherry trees and cherries varieties owned by the company itself, referred to precisely as 'IFG FOUR', 'IFG FIVE', 'IFG SIX', 'IFG SEVEN', and so on.

In its 47-page ruling, the Trademark Trial and Appeal Board (TTAB) provided a comprehensive overview of the UPOV principles and relevant U.S. case law in the matter of variety denominations, ultimately upholding the initial decision to deny trademark registration. The Board noted the practice followed by the United States Patent and Trademark Office (USPTO) of prohibiting the registration of marks that represent the prominent portion of a varietal name. This practice is based on Trademark Act Sections 1, 2, and 45, which state that such marks do not function as source indicators because varietal names are considered generic terms. The Board pointed out that (emphasis added):

*“(T)he underlying rationale is the same – **to prevent monopolies and foster competition**: Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status. The reason is plain: To allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold, even when these have become identified with a first user, **would grant the owner of the mark a monopoly**, since a competitor could not describe his goods as what they are”²⁴.*

The Court considered that the Applicant – i.e., IFG - by applying for the 'IFG' trademark registration, sought **“to preserve in perpetuity the fruit of its inventions and exclusive right to IFG**

²² Judgment of 18 June 2019 in Case T-569/18, cited, § 26 and § 28.

²³ Opinion of the UNITED STATES PATENT AND TRADEMARK OFFICE, Trademark Trial and Appeal Board of November 22, 2022, In re International Fruit Genetics, LLC, Serial No. 88711192, available at <https://ttabvue.uspto.gov/ttabvue/ttabvue-88711192-EXA-10.pdf>. We also recommend reading the interesting recent article [“USPTO awkwardly forgets to follow the rules on trademarks for grass varieties... but naming conflict still resolves amicably”](#) by Jocelyn Bosse, commenting on a key US precedent highlighting possible practical problems arising from the relationship between trademarks and variety denominations. The article was published on The IPKat Blog on 8 January 2025.

²⁴ *Ibidem*, p. 24.

through the trademark registration process. If permitted, this would impede free use in the marketplace of a varietal denomination following the expiration of plant patent and PVP certificate rights”; and, on the other hand, “(B)y making a deliberate decision to select IFG as the prominent portion of the varietal names of the identified goods, Applicant self-abrogated its own trademark rights, exposing its prior trademark registration to potential cancellation in an inter partes proceeding”²⁵.

The underlying public interest in the use of the variety denomination is therefore once again emphasised, by recalling the need to leave ‘free to use’ this designation so that it can continue to fulfil the identifying function of a specific variety even after the expiry of the PVR.

The problem of denomination misuse and possible solutions

As any denomination capable of conveying or attracting market value, variety denominations can become a subject of speculation.

According to Art. 94(1)(b) CPVRR, within the PVR lifespan, “(W)hosoever omits the correct usage of a variety denomination as referred to in Article 17(1) or omits the relevant information as referred to in Article 17 (2) may be sued by the holder to enjoin such infringement or to pay reasonable compensation or both”.

However, once a plant variety - and therefore its denomination - enters the public domain, third parties could exploit the ambiguity surrounding who has the legal standing to prevent the misuse of variety denominations of varieties no longer protected by PVRs. This scenario is not merely hypothetical; the commercial success of a variety, along with the effective use of its variety denomination in marketing either propagating or harvested material - as now required by EU marketing standards for fruits, including apples – can indeed make such denominations appealing for speculative market practices²⁶.

As seen, the golden rule for variety identification is "one variety, one denomination". This means that the denomination identifying a variety may only refer to other varieties for informational purposes. Such instances include using the variety denomination as a reference, e.g., for describing the history of a variety developed by crossbreeding parent varieties, with these varieties being identified by their own variety denominations.

This rule also applies – *mutatis mutandis* - in the case of so-called Essentially Derived Varieties (EDVs). Article 17(1) CPVRR, in conjunction with Article 13(5)(a) CPVRR, states that EDVs must adhere to the same regulations as other varieties regarding the use of the variety denomination²⁷.

It follows that an EDV is likewise identified by its specific variety denomination. However, this raises the question of whether referring to the initial variety—especially when distinguishing between informative content and marketing—could lead to concerns. If mentioning the initial variety serves primarily informative purposes, this type of use should generally be permissible. Just as parental varieties are included in the horticultural background of the initial variety, there is a legitimate interest in knowing the parental lines used to develop an EDV.

²⁵ *Ibidem*, pp. 38-39.

²⁶ For instance, speculation might involve using attractive terms as domain names, as seen in the case of ‘orange.com’. According to WIPO rules regarding domain name disputes: “For example, a hypothetical respondent may well have a legitimate interest in the domain name <orange.com> if it uses the domain name for a website providing information about the fruit or the color orange. The same respondent would not however have a legitimate interest in the domain name if the corresponding website is aimed at goods or services that target a third-party trademark (in this example: Orange, well-known *inter alia* for telecommunications and Internet services) which uses the same term as a trademark in a non-dictionary sense”. See <https://www.wipo.int/amc/en/domains/search/overview3.0/>.

²⁷ By making reference to “a variety covered by the provisions of Article 13 (5)”, Article 17(1) CPVRR indeed encompasses all varieties listed in Article 13(5) CPVRR, namely: “(a) varieties which are essentially derived from the variety in respect of which the Community plant variety right has been granted, where this variety is not itself an essentially derived variety; (b) varieties which are not distinct in accordance with the provisions of Article 7 from the protected variety; and (c) varieties whose production requires the repeated use of the protected variety”.

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In this regard, it is worth noting that, under certain conditions, a variety denomination will be deemed to be “suitable” even if it shares some proximity with other denominations: according to the mentioned ‘CPVO Guidelines on Variety Denominations with Explanatory Notes on Article 63 of Council Regulation (EC) 2100/94 of 27 July 1994 on Community plant variety rights’, this case occurs in presence of a “biological relation” between the new variety for which a proposal for denomination has been submitted and the other existing varieties.

A particularly significant example is provided under Article 1 of the same Guidelines – i.e., in the case of “Red Impact \diamond Impact”. According to the Explanatory Notes therein included “(T)he addition of company abbreviations, series identifiers, descriptive characteristics or numbers to an identical or very similar denomination could be considered as an attempt to make an unfair use of the existing denomination. That use is not deemed unfair if it is an addition to the same denomination by the same breeder or if there is a biological relationship between the varieties”²⁸.

Hence, the variety denomination is suitable for registration based on the following reasoning: “A variety ‘Impact’ already exists. Red is a colour characteristic. The addition of a descriptive term to an existing denomination gives the impression that ‘Red Impact’ is a red mutation of ‘Impact’. The proposal is suitable if the varieties are from the same breeder or if there is a biologic relationship between the varieties or if the word Impact is generic (common to other denominations of varieties of the same species and from different breeders)”.

It can, therefore, be inferred that where (1) the proposed denomination comes from the same breeder who owns the previous conflicting denomination or (2) there exists a “botanical relation” between the varieties at issue, these two circumstances, in principle²⁹, rule out a risk of confusion in variety identification.

In this regard, it is worth highlighting that Article 63 CPVRR provides for an impediment to the registration of the variety denomination *inter alia* 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 Unit 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; (...)

(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.”

Whereas, as seen above, Article 4 of the ‘CPVO Guidelines on Variety Denominations with Explanatory Notes on Article 63 of Council Regulation (EC) 2100/94 of 27 July 1994 on Community plant variety rights’ points out that “(A) variety no longer remains in existence’ shall be considered to mean a variety of which material no longer exists”.

Therefore, it seems reasonable to conclude that the framework described above remains valid - thus preventing, in principle, third parties from registering a variety denomination identical or

²⁸ Another relevant example in the Guidelines concerns the case of colour names, where, at page 20, provides as follows: “‘Caramel’, ‘Ruby’, ‘Salmon’ are suitable denominations for a variety of *Festuca pratensis* Huds as these colour indications are not relevant for meadow fescue. In order to be considered suitable, however, a biologic relation is needed when the proposed denomination is part of a series. For instance, the Office will ask for a biologic relation among ‘Caramel Candy’ and an existing series ‘Caramel Toffee’, ‘Caramel Dream’ from the same breeder”.

²⁹ However, it should be borne in mind that the CPVO carries out its assessment on a case-by-case basis. Moreover, other and different factors, provided for in the mentioned CPVO Guidelines, may affect its assessment.

misleading or in any case capable of causing confusion - as long as a variety is in commerce, or rather, in the commercial registers³⁰.

It follows that, when a reference to an expired or widely recognized variety is made – or rather, when its variety denomination is used - without justified reason, it constitutes deceptive or anyway misleading use of that denomination, also assuming relevance in terms of unfair competition.

Moreover, it is a common principle in the IP field that, in order for a sign to be suitable as an IP asset it must not mislead the public about the characteristics, nature, quality, or geographical origin of goods or services referred to. All the more so where the agri-food sector is concerned. In this context, reference to the legislation on geographical indications comes naturally, where the topic of misleading indications is particularly sensitive³¹.

In Italy, the Antitrust Authority³² is responsible for overseeing commercial practices. This includes any act, omission, conduct, statement, or commercial communication—such as advertising, direct marketing, and product packaging—that a trader engages in while promoting, selling, or supplying goods or services to consumers. Business practices are considered unfair when they violate the principle of professional diligence and significantly distort the economic behaviour of the average consumer they reach or target.

Therefore, it could be a possible way forward for the initial holder of the variety to which the designation refers, or for anyone interested in, to approach the competent competition and market protection authority by reporting unfair commercial practices and/or unlawful misleading and comparative advertising. The intervention of the competent authority would, in this case, fall under the scope of protection of public interest and would not be precluded by the existence of intellectual property rights in force.

The former PVR titleholder—and/or the variety owner, if applicable—certainly has a legitimate interest in ensuring that the denomination of a variety is used correctly. This is important to prevent or counteract misuse by third parties, thereby preventing confusion among users regarding the product. Avoiding consumer confusion when purchasing a food product with a name that identifies a different variety is especially critical.

It goes without saying that, in the absence of a clear regulatory definition, issues concerning the use of a variety denomination when the PVR to which it refers expires must be addressed and analysed on a case-by-case basis and lend themselves to different interpretations.

³⁰ For example, the fact that the ‘Cripps Pink’ variety is no longer covered by PVRs in the EU, does not affect the obligation to use the corresponding variety denomination to identify that – and only that - variety.

³¹ See, for example, in the EUIPO Trade Mark Guidelines, cited, [paragraph 4.3 - Other misleading indications and practices](#), referring to the CJEU ‘Scotch Whisky’ judgment (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 61-71), where the Court has identified the circumstances under which “misleading information” exists, pointing out that an indication may be considered misleading if it includes information, *inter alia* in the form of words or an image, that is capable of providing information on the provenance, origin, nature or essential qualities of that product (§ 66); the context in which the possible misleading indication is used is not to be taken into account (§ 63). See also, [paragraph 3.1.2 Evocation, imitation, misuse and misleading indications and practices](#). For a more in-depth look at the relation between geographical indications and variety denomination, read the in-depth article “[Greek court finds that similar GIs and plant variety names can lawfully coexist in Kalamata Olives decision](#)” by Jocelyn Bosse, dated 19 December 2024, commenting on the recent decision of Greek Council of State (Συμβούλιο της Επικρατείας) of 2nd of April 2024 (Case No. 428/2024), also mentioning the journal article “[Lawful Coexistence of Similar Names of a Plant Variety and a PDO](#)” published in GRUR International, ikae154, <https://doi.org/10.1093/grurint/ikae154>, on 18 December 2024 and the article “[When Geographical Indications and Plant Variety Denominations Collide: Champagne Case Study](#)” by Ángela H. Martínez López, published in the European Intellectual Property Review, 46(10):624, on October 2024.

³² For more details, please consult the AGCM website at <https://en.agcm.it/en/>. For a specific in-depth look at unfair commercial practices to the detriment of consumers and micro-businesses, see <https://www.agcm.it/competenze/tutela-del-consumatore/pratiche-commerciali-scorrette/> (Italian, only).