



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

The Boards of Appeal

**DECISION  
of the First Board of Appeal  
of 3 December 2009**

In Case R 1743/2007-1

**POULSEN ROSER A/S**

Kratbjerg 332

DK-3480 Fredensborg

Denmark

Cancellation Applicant/Appellant

represented by BARDEHLE, PAGENBERG, DOST, ALTENBURG, GEISLER,  
Galileiplatz 1, D-81679 München, Germany

v

**VERDIA SARL**

5, rue Guy Mocquet

F-91400 Orsay

France

CTM Proprietor/Respondent

represented by T MARK CONSEILS, 31, rue Tronchet, F-75008 Paris, France

APPEAL relating to Cancellation Proceedings No 1681 C 001421320/1 (Community  
trade mark No 1 421 320)

**THE FIRST BOARD OF APPEAL**

composed of Th. Margellos (Chairperson), Ph. von Kapff (Rapporteur) and  
U. Wennermark (Member)

Registrar: J. Pinkowski

gives the following

## Decision

### Summary of the facts

- 1 On 14 December 1999 and claiming the priority of a French trade mark No 99 800 244, VERDIA SARL ('the CTM proprietor') applied for the registration of the word mark

## VESUVIA

for the following goods in Class 31:

Agricultural 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.

- 2 The application was published in Community Trade Marks Bulletin No 61/2000 of 31 July 2000 and the mark subsequently registered on 12 March 2001 as CTM No 1 421 320 ('the registered CTM').
- 3 On 20 June 2006, POULSEN ROSER A/S ('the Cancellation applicant') filed an application, pursuant to Articles 53(1)(a) (ex Article 52) 'in conjunction with Article 7' and Article 53(1)(b) of (EC) No 207/2009 of 26 February 2009 on the Community trade mark, OJ L 78 of 24.3.2009, p. 1, codified version of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ('CTMR'), for a declaration that the Community trade mark was invalid in respect of all the goods. In its reasoned statements, the Cancellation applicant argued in particular as follows:
  - VESUVIUS was a 'generic term' for a variety of roses which has been in cultivation and commerce for 80 years. The female ending with '-a' instead of '-us' in the Community trade mark 'VESUVIA' is a likely variation as roses in most European languages are 'female'. Therefore, the trade mark may serve in trade to designate the kind and quality of goods, as specified in Article 7(1)(c) CTMR. In principle, the Office must examine absolute grounds for declaration of invalidity *ex officio* (Article 76(1) CTMR, ex Article 74). The case is similar to the decisions of the Cancellation Division of 29 August 2002 in Case 170 C 896290/1 – in which the trade mark MASUR was cancelled for trees, as the generic Masurbirch existed as a variety name for wood, and of 6 June 2001 in Case 102 C 402354/1 in which Boskoop Glory was cancelled for grapevines.
  - The Community trade mark further deceives the public as far as the trade mark is used for roses other than VESUVIUS in the sense of Article 7(1)(g) CTMR.

- The fact that the CTM proprietor uses VESUVIA for VESUVIUS variety roses shows that it had filed the trade mark in bad faith in the sense of Article 51(1)(b) CTMR.
  - Both parties being strong competitors, the CTM proprietor has started several actions against the Cancellation applicant based on the disputed Community trade mark, against which the Cancellation applicant defends itself by the present cancellation request.
- 4 In order to support its claim, the Cancellation applicant presented the following evidence:

<p><b>Vesuvius (Variety denomination),</b>  ARS approved Horticultural classification: Modern Roses: Hybrid Tea. ARS Colour classification: dark red, 1923, McGredy, Bud long, pointed; flowers dark velvet crimson, single (6 petals), large, fragrant, foliage light, leathery, vigorous growth.</p>	<p>MODERN ROSES XI – The World Encyclopedia of Roses (10<sup>th</sup> Edition 1993 and 11th Edition, dated 2000, edited by Academic press, London, published by the Amercian Rose Society ARS, page 623.</p>
<p><b>Vesuvius, bred by McGredy, Ireland 1923.</b></p>  <p>If you like roses like 'Altissimo' but don't want a large shrub, then perhaps 'Vesuvius' is a good choice for you. This is one of the more obscure single-bloomed Hybrid Teas, of which there used to be quite a few. 'Dainty Bess' is likely the most famous survivor of this style, and is much more widely grown than 'Vesuvius'.</p> <p>This is a very nice rose, growing in the short Hybrid Tea manner to about 3.5 feet. It blooms in clusters of 3 to 7 usually, and the blooms last well for a single-petalled rose. The color is as rich and lovely as you could desire and is very much like 'Altissimo' in hue. This rose should be seen much more often in gardens, for it is an exceptionally beautiful single rose.</p> <p>ARS merit rating: NA  Personal merit rating: 8.0  Hardiness: Likely USDA zones 6 to 10, zone 5 with considerable protection.  Shrub size: 2.5 to 4 feet tall X 2 feet wide.  Fragrance: 2.0, light fragrance.</p>	<p><a href="http://www.rdrop.com/~paul/hybridteas/vesuvius.html">http://www.rdrop.com/~paul/hybridteas/vesuvius.html</a></p> <p>20.06.2006</p>

<p><b>Vesuvius</b></p>  <p>At the time that 'Vesuvius' was introduced it was not so unusual to find single blossomed Hybrid Teas, but in modern times the single bloom form is rare in Hybrid Teas. 'Vesuvius' is one of the early McGredy roses dating to 1923, and it has recently re-emerged to enjoy popularity once again. Rich red 5 petaled blooms are produced in sprays all season, much like a Floribunda, and the growth habit is compact and bushy (to 3 feet), unlike many modern HT's. If you like 'Altissimo', but want a shorter, more manageable shrub, this rose is a great choice. This beautiful rose deserves to be seen more often.</p> <p>Our plants of Vesuvius are 6 to 9 inches tall in bands or 4 inch pots. In the spring, the plants may be slightly smaller, while later in the season, they may be larger. These are one to two year old plants grown on their own roots. To minimize the amount of soil shipped and therefore the shipping expense, these plants are smaller than typical grafted varieties purchased at local garden centers.</p> <p>Color:  dark crimson red</p> <p>Class: Hybrid Tea</p> <p>Secondary Classifications: 1920s</p> <p>Growth Habit: Upright, but bushier than most Hybrid Teas, to 3 feet</p> <p>Bloom Habit: cluster flower habit</p> <p>Hardiness: Zone 6-10 Requires protection in cold areas</p> <p>Fragrance Rating: 2.0 - slight fragrance</p> <p>Introduction Year: 1923</p> <p>... Hybrid Tea - Vesuvius (bands or 4 inch pots) \$12.95</p>	<p><a href="http://uncommonrose.biz/r/vesuvius.html">http://uncommonrose.biz/r/vesuvius.html</a></p> <p>20.6.2006</p>
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<p><b>Rosa (Vesuvius Rose )</b>  'Vesuvius' is a Hybrid Tea rose which produces large, single, dark red flowers. In general, roses are a large group of flowering shrubs, most with showy flowers that are single-petalled to fully double petalled. Leaves are typically medium to dark green, glossy, and ovate, with finely toothed edges. Vary in size from 1/2 inch to 6 inches, five petals to more than 30, and in nearly every color. Often the flowers are very fragrant. Most varieties grow on long canes that sometimes climb. Unfortunately, this favorite plant is quite susceptible to a variety of diseases and pests, many of which can be controlled with good cultural practices.</p> <p><b>How to Grow this Plant:</b></p> <p><b>Characteristics</b>  Cultivar: Vesuvius  Family: Rosaceae  Size: Height: 0 ft. to 0 ft.  Width: 0 ft. to 0 ft.  Plant Category: shrubs,  Plant Characteristics: high maintenance,  Foliage Characteristics: medium leaves,  Foliage Color: dark green, green,  Flower Characteristics: showy, single,  Flower Color: reds,  Tolerances:</p> <p><b>Requirements</b>  Bloomtime Range: not applicable  USDA Hardiness Zone: 5 to 10  AHS Heat Zone: Not defined for this plant  Light Range: Sun to Full Sun  pH Range: 5.5 to 7.5  Soil Range: Sandy Loam to Some Clay  Water Range: Normal to Moist</p>	
<p><b>14 Vesuvius</b>  McGredy (Irland) 1924 Teehybride, Moderne Rose, dunkelrot, öfterblühend, leichter Duft, [14. <i>Vesuvius, McGredy (Ireland) 1924 Hybrid Tea rose, Modern Rose, dark crimson blossoming often, light fragrance</i>]  Rot wie ein Vulkan - wie der Vesuv (der einzige aktive Vulkan auf dem europäischen Festland am Golf von Neapel) ist diese Rose</p>	<p><a href="http://www.welt-der-rosen.de/duftrosen/uv_duftrosen.htm">http://www.welt-der-rosen.de/duftrosen/uv_duftrosen.htm</a>  20.06.2006</p>
<p><b>Vesuvius (Variety denomination),</b>  ARS approved Horticultural classification: Modern Roses: Hybrid Tea. ARS Colour classification: dark red, year of registration: 1923, bud long, pointed; flowers dark velvet crimson, large, single, 6 petals, moderate fragrance; foliage light, leathery; vigorous growth. McGredy,</p>	<p>ENCYCLOPEDIA OF ROSE SCIENCE, published in the United Kingdom by Elsevier Ltd, Oxford. Editors are Andrew Roberts, Thomas Debener (Germany), Serge Gudin (France).</p>

<http://www.decorosiers.com/index.php?flashplayer=1> under: gamme – Vesuvia

20.06.2006

According to the Cancellation applicant, the rose shown is a Vesuvius rose.

5 The CTM proprietor repudiated all the claims for cancellation and requested the application for a declaration of invalidity of its Community trade mark to be rejected. It argues in particular as follows:

- The evidence filed by the Cancellation applicant is not sufficient to prove that the sign is a descriptive indication. The website [www.rdrop.com](http://www.rdrop.com) does not – as claimed by the Cancellation applicant – commercialize any roses or other plants. The German extract is not in the language of proceedings. The use of the term VESUVIUS in bold typeface and/or in quotation marks is the normal use of a distinctive sign eligible for protection. The quotation of a VESUVIUS in *MODERN ROSES XI – The World Encyclopedia of Roses* without a tm or ® symbol does not mean that it may not be a trade mark. In addition all the documents were dated after the filing date.
- Nor is VESUVIA ‘exclusively’ descriptive in the sense of Article 7(1)(c) CTMR, nor can the simple fact that the term VESUVIUS is known at the filing date be sufficient to consider that the trade mark application VESUVIA was made in bad faith.
- Contrary to the CTM proprietor’s claim, VESUVIA is not the usual designation of a variety of roses. If it was a usual designation of a variety of roses, it should appear in the following catalogues:

[www.knowyourgardening.com](http://www.knowyourgardening.com) portraying itself as the ‘most comprehensive online garden plant directory currently available’.

[www.tradeaplant.com](http://www.tradeaplant.com)

*ENCYCLOPEDIA OF ROSES – Definitive A-Z Guide, Charles & Brigid Quest-Ritson, 2003,, London, a catalogue containing almost 2000 species of roses. The book mentions the McGredy family of four generations of nurserymen who became all specialized in breeding hybrid teas. It does not mention the Vesuvius variety.*

6 On 12 September 2007, the Cancellation Division adopted a decision stating that the application for cancellation of Community trade mark No 1 421 320 was rejected on the following grounds:

- Article 7(1)(c) CTMR expressly refers to trade marks which consist exclusively of descriptive terms. This is not the case here. A Latin name of a plant is not generally misspelled according to modern languages rules in order to modify its gender. The specialized consumer (e.g. florists) would use the

correct Latin name (in this case VESUVIUS) to identify the plant species when showing it to possible purchasers. The remaining public would probably not be aware of the technical Latin name of the plant and would rather use its trivial name or another descriptive term in order to identify it.

- Bearing in mind the above, when faced with the term VESUVIA, the targeted consumers may either perceive it as fanciful or as suggestive of the VESUVIUM [sic] rose species, but not descriptive thereof. Actually suggestive terms are those which suggest certain characteristics of the goods without really describing them. That is how the word VESUVIA may be perceived.
- The earlier decisions cited by the applicant in support of its case seem to rather confirm the above finding. In fact, in the cited cases the marks which were declared invalid or partially invalid (MASUR and BOSKOOPS GLORY) actually served on their own (and not in some misspelled forms) to indicate a type of plant.
- The applicant has not provided any evidence which could refute the above interpretation, such as evidence showing that the word VESUVIA is actually commonly used instead of VESUVIUM [sic] (and not as a – possibly suggestive – trade mark) in order to identify a particular kind of rose.
- The applicant has not provided any arguments or evidence in support of its claim based on Article 7(1)(d) CTMR. In particular, it failed to prove that the word VESUVIA as such is customarily used in the current language or in trade.
- To be in conflict with Article 7(1)(g) CTMR the mark must contain an objective indication about characteristics of the goods which is clearly in contrast to the reality contained in the relevant list of goods. This assessment can only be made with respect to the list of goods, assuming that the mark be used for the goods and services claimed but, if possible, in a non-deceptive manner. If there is a possible non-deceptive use, the mark cannot be declared invalid. Even assuming that the term VESUVIA might be deceptive for plants and flowers not belonging to the VESUVIUS species (which is however not necessary to assess here), there clearly exists a possible non-deceptive use in relation to goods listed in the specification, inasmuch as all of them include the VESUVIUS rose species and their use may thus be limited thereto. It is therefore evident that the mark VESUVIA was not registered in breach of the provision of Article 7(1)(g) CTMR.
- The situation in relation to bad faith has to be examined by reference to the circumstances at the filing date of the contested CTM. The Internet printout of the CTM proprietor's website which was submitted by the applicant in support of this claim is dated 20 June 2006, that is, almost six years after the filing date of the CTM. The applicant in any case assumes that the proprietor must have been aware of the existence of the VESUVIUS variety at the relevant date, as this variety was bred over eighty years ago and a reference is also made to in rose manuals dating from 1993. However, the mark was not

filed in breach of the provisions of Article 7. Therefore, the mark is neither descriptive nor deceptive. In view of this, the Cancellation Division cannot envisage any lack of honest intention on the part of the CTM proprietor at the time of filing.

7 On 9 November 2007, the Cancellation applicant filed a notice of appeal against the Cancellation Division's decision. On 11 January 2008, the Cancellation applicant filed the grounds of appeal against the contested decision.

8 The Cancellation applicant requests that the contested decision be cancelled and that the registration be declared invalid. Its arguments may be summarized as follows:

- The contested decision correctly held that VESUVIUS is a generic term designating a certain variety of roses which has been in cultivation and commerce for a large number of years. However, it incorrectly considered that the relevant public will keep VESUVIUS and VESUVIA apart. The term VESUVIA is obviously the female form of VESUVIUS. The public may therefore naturally take the female version of VESUVIA of the generic term VESUVIUS in order to designate this kind of rose. In fact, the Cancellation Division itself incorrectly wrote VESUVIUS instead of VESUVIA (par. 16) and twice VESUVIUM instead of VESUVIUS (par. 23).
- The Cancellation Division based its decision on the wrong assumption that the specialised public will not be taken to use the female version. Further, contrary to the unfounded argument in the contested decision, there is no trivial name or any other descriptive term apparent which could serve for a trade mark proprietor to identify the species.
- Article 7(1)(c) does not require that a trade mark actually serves in trade to designate a quality or the kind of a product, but it expressively states that it is sufficient that the mark 'may serve' as such a designation.
- Both arguments relating to Article 7(1)(g) CTMR (deceptive marks) and Article 51(1)(b) CTMR (bad faith) are maintained.

9 The CTM proprietor requests that the contested decision is confirmed and that the request for invalidating the application is rejected. Its arguments may be summarized as follows:

- VESUVIUS is only a name given to a rose created by a person during the last century but it is absolutely not the generic term of a kind of roses or name commonly used for roses. No valid evidence is provided in support of the applicant's assertion that the mark is anything more than a plant variety that was invented by some person in the beginning of the last century. This is not sufficient to prove that VESUVIUS is a generic term. Otherwise, the Cancellation applicant would have been capable of showing more conclusive evidence such as publications, magazines, brochures, leaflets, etc.
- On the contrary, the CTM proprietor has filed a list of documents showing that VESUVIUS is not the usual designation of a variety of roses and that it is

not commonly used. Furthermore, copies from the following four books, available in bookshops and libraries specialized in roses, is enclosed:

*LES ROSES ANGLAISES, les 100 meilleures variétés, David Austin, original version in English (the English roses) (2005), translated into French in 2006, published by Larousse.*

*LES ROSES – Variétés, origine, utilisation, entretien, Les Petites Encyclos –original version (Roses) in Dutch (2004) and translated in French in 2008, published by Editions Gründ.*

*ROSES DU JARDIN – 1200 variétés. Tous les conseils pour les planter et les entretenir, published in France in 2009 by Hachette,*

*ROSES, Paul Starosta, Éléonre Cruse, published in France in 2008 by Chêne.*

- Even if it should be held that VESUVIUS is a generic term for designating a variety of roses, it remains that the contested mark is VESUVIA. Such word is not identical to VESUVIUS and therefore it does not consist exclusively of signs or indications which may serve, in trade, to designate the kind of the goods in question.
  - As VESUVIUS is not a generic term for designating a variety of roses, when faced with roses commercialized under the mark VESUVIA, the public will never make any link with a supposed variety of roses. Therefore, the mark VESUVIA is not misleading, contrary to the applicant's assertion.
  - The fact that the owner's website reproduces a picture of the roses marketed under the mark VESUVIA which is identical to the photo of a VESUVIUS rose as produced by the adverse party is insufficient to prove the owner's bad faith at the date of filing of the CTM. Furthermore, all the documents supplied by the applicant to show the generic nature of the term VESUVIUS are later than the filing date of the mark VESUVIA (14 December 1999). Therefore, the action based on Article 51(1)(b) CTMR must be rejected.
  - The present proceedings have been introduced by the Cancellation applicant in response to the counterfeit action filed before the French courts by the CTM proprietor against the Cancellation applicant and one of its French distributors. Therefore, the present proceedings have been introduced in bad faith with the sole purpose of delaying the proceedings before the French courts.
- 10 When preparing the decision, the Board considered it appropriate to make a communication to the parties, which was dated 23 January 2009. It contained *inter alia* the following:
- It seems that from the relevant public's point of view, i.e. end consumers and professional gardeners, VESUVIA will be considered as being virtually identical to VESUVIUS, taking into consideration that the variation of the Latin ending 'us' into 'a' will be perceived rather as a grammatical (albeit incorrect) variation of the name. Such a variation seems to be perfectly compatible with the practice of naming roses by using feminine courtesy titles. For example in France, it is common knowledge that roses are generally named using the French feminine courtesy title 'Madame ...' at the

beginning, even though the following name may be that of a man (e.g. Madame or Mme David, named after the painter Jacques Louis David).

*([http://www.welt-der-rosen.de/namen\\_der\\_rosen/hobby\\_rosennamen.htm](http://www.welt-der-rosen.de/namen_der_rosen/hobby_rosennamen.htm): "Übrigens - zur Namensgebung der vielen Madame... Rosen mit männlichem Namen - in Frankreich bevorzugte man es, die Rose, obwohl einem Mann gewidmet, trotzdem "Madame" und nicht "Monsieur" zu benennen ...").*

- Furthermore, it should be mentioned that VESUVIUS is the English/Latin name of the volcano Vesuvius situated in the bay of Naples in Italy, the spelling of which varies in other languages, c.f. Vesuv (DE), Vesuvio (IT), Vésuve (FR).
- As to the legal context, it is to be further understood that ‘VESUVIA’ would be rejected as a plant variety denomination because it comes too close to ‘VESUVIUS’. Reference is made to the Council Regulation (EC) No. 2100/94 of 27 July 1994 on Community plant variety rights. According to Article 63(3)(c) of this regulation there is an impediment to the registration of a variety denomination where a denomination 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. According to section (d) of the same article the situation is the same if the denomination is identical or may be confused with other designations which are commonly used for marketing of goods or which have been kept free under other legislation. Furthermore, section (f) of the same article stipulates that there is also an impediment for the registration of a variety denomination which is liable to mislead or to cause confusion concerning the identity of the variety or the identity of the breeder or any other party to proceedings.
- The registration of VESUVIA, which would not be allowed as a name of a plant variety, 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.
- Non-protected names of non-protected plant varieties, such as Vesuvius for roses of the above mentioned hybrid, would be rejected as trade marks under the provisions of Article 7(1)(b) – (d) CTMR. Therefore, VESUVIA will be perceived as the generic name of Vesuvius roses in accordance with Article 7(1)(c) CTMR. It will not be perceived as a trade mark for a rose hybrid. At most it would be considered a variation/misspelling of Vesuvius for roses of that kind in which case, the sign would not exercise its function of indicating the commercial origin of the product and would therefore be devoid of any distinctive character in accordance with Article 7(1)(b) CTMR.
- Assuming that VESUVIA would not be registered and used for Vesuvius roses, it would be a deceptive term for other kinds of roses. Using a generic term in relation to products other than the one it is describing is misleading and in conflict with Article 7(1)(g) CTMR.

- From the above it follows that Article 51(1)(b) CTMR may also be applicable as the CTM proprietor may have been acting in bad faith at the time of the filing.’
- 11 The CTM proprietor answered by repeating previous arguments. It confirmed that there is no protected plant variety denomination VESUVIA or Vesuvius for roses. So, it does not seem appropriate to take into consideration the provisions of the Plant Variety Regulation to appreciate whether VESUVIA is valid or invalid in respect of Article 7 CTMR.
  - 12 The Cancellation applicant considered the Board’s observations correct and referred to its previous submissions.
  - 13 On 18 November 2009, the CTM proprietor filed a judgment of the Court d’Appel de Paris (Pôle 5 – Chambre 1), reference number 08/02793, of 18 November 2009. The judgment was rendered in proceedings in which the CTM proprietor acted against a third party, the company SARL CENTREFLOR, for infringement of their trade mark VESUVIA by use of the trade mark VESUV for roses and in which the defendant claimed by means of a counterclaim for invalidity that the CTM proprietor’s trade mark VESUVIA here at issue was registered in breach of the absolute grounds under Article 7(1)(b), (c) and (d) CTMR. The Court d’Appel de Paris *inter alia* rejected the appeal against a judgment of the Tribunal de Grande Instance de Paris of 9 November 2007<sup>1</sup> that rejected the request for declaration of invalidity of the contested Community trade mark VESUVIA. The judgment considered in particular that the evidence provided by the appellant in that case were not sufficient to establish that VESUVIUS was known in ‘France or in the European Union’ and used in current language or amongst professionals. The judgment held essentially the following (text extract reproduced in the language of proceedings):

*‘considérant que la société VERDIA conteste la force probante des extraits d’ouvrages, non datés, et les reproductions de sites Internet versés au débat par l’appelante pour démontrer l’ancienneté de la dénomination ‘VESUVIUS’ pour désigner des roses de couleur rouge; qu’elle relève pertinemment que rien ne permet de mesurer la diffusion en France ou dans l’Union Européenne de ces documents d’origine des États-unis d’Amérique et que rien ne garantit l’authenticité de la reproduction des extraits de sites Internet produits en l’absence de toute indication concernant les conditions techniques observées pour leur captation; qu’elle ajoute que les pièces ainsi produites ne permettent pas de définir précisément à quelle réalité s’appliquerait le terme VESUVIUS;*

*Considérant, en toute hypothèse, que la preuve n’est pas rapportée que le terme ‘VESUVIUS’ serait répondu dans le langage courant ou même parmi les professionnels européens pour désigner des roses à fleurs cramoisies dans des conditions telles que le terme VESUVIA serait, de ce fait, privé de toute propriété distinctive à cet égard; qu’il résulte que ce même terme ne peut être regardé comme susceptible d’induire le consommateur en erreur en l’incitant à croire que le rosier ‘VESUVIA’ serait une variété d’un rosier VESUVIUS puisque l’existence d’une variété identifiée comme telle n’est pas démontrée;*

*Considérant par ailleurs, que forcé est de constater que le vocable ‘VESUVIA’, s’il évoque le volcan de la baie de Naples, ne comporte aucune référence quant à l’espèce,*

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<sup>1</sup> published in PIBD Nr 867, II; 86, further available on <http://oami.europa.eu/ows/rw/pages/CTM/caseLaw/judgementsCTMCourtsList.en.do>.

*la qualité, la quantité, la destination, la valeur, la provenance géographique ou l'époque de la production d'un rosier à fleurs de couleur rouge;*

*Considérant qu'il résulte de ce qui précède que le terme 'VESUVIA' possède un pouvoir distinctif au regard du produit désigné et n'est nullement descriptif; que le jugement du 9 novembre 2007 doit en conséquence être confirmé en ce qu'il a rejeté la demande de la société CENTREFLOR tendant à voir constater la nullité des marques contestées de la société VERDIA.'*

## **Reasons**

- 14 The appeal complies with Articles 58, 59 and 60 CTMR (ex Articles 57, 58, 59) and Rules 48 and 49 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing the CTMR. It is therefore admissible.
- 15 The appeal is well founded in respect of the order sought and the decision of the examiner must be annulled in its entirety. The Community trade mark must be declared invalid on the basis of Article 7(1)(c) CTMR (descriptive indications), Article 7(1)(b) CTMR (absence of distinctive character), Article 7(1)(d) CTMR (generic indication) and Article 52(1)(b) CTMR (bad faith). The request is rejected with respect to Article 7(1)(g) CTMR (deceptive indication).

### *Article 52(1)(a) CTMR in conjunction with Article 7(1)(c) CTMR*

- 16 Under Article 7(1)(c) CTMR, trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, intended purpose or other characteristics of the goods or services, shall not be registered. Thus Article 7(1)(c) CTMR pursues the aim, which is in the common interest, of ensuring that signs or indications which describe the categories of goods or services in respect of which registration is applied for remain available. Hence, this provision does not permit such signs or indications to be reserved for use by one undertaking as a result of their registration as a trade mark (judgment of the Court of Justice of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* ('Chiemsee') [1999] ECR I-2779, at paragraph 25-26; OJ OHIM 7-8/1999, p. 1054; of 8 April 2003 in Joined Cases C-53/01, C-54/01 and C-55/01 *Linde AG, Winward Industries Inc. and Rado Uhren AG v Deutsches Patent- und Markenamt* ('Linde') [2003] ECR I-3161; of 6 May 2003 in Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* ('Orange') [2003] ECR I-3793; of 12 February 2004 in Case C-265/00 *Campina Melkunie BV v Benelux-Merkenbureau* ('Biomild') [2004] ECR I-1699).
- 17 Only indications which are purely and directly descriptive are subject to the grounds for refusal set out in Article 7(1)(c) CTMR, as indeed follows from the word 'exclusively' contained in said provision. It is not mandatory for the sign in question to be already in use as a descriptive indication; it is indeed sufficient for it to be capable of this, as follows from the words 'may serve' of Article 7(1)(c) CTMR. However, there must be definite and specific grounds for it

to be reasonable to assume that such an association may be established in the future (cf. Chiemsee, loc. cit., at paragraphs 30 and 31).

- 18 The descriptiveness of a trade mark must be assessed, first, by reference to the goods or services, in respect of which registration of the sign is sought and, second, by reference to the perception of the relevant section of the public.

*The goods*

- 19 Following the cancellation request, the present case exclusively deals with the question whether the word sign VESUVIA was correctly registered as a trade mark for ‘roses’. Even though there are indications that VESUVIA might be the plant variety designation of plants other than roses, the case does not examine whether the contested trade mark may have to be declared invalid for goods other than roses.
- 20 In the context of the present proceedings, the goods may be grouped into two, namely those that may include rose plants, flowers or seeds and those that may not include products related to roses.
- 21 The second group of products comprises  
Class 31 - fresh fruits and vegetables (except maize), fresh fruit.
- 22 These goods do not include roses, as roses do not belong either to fruits or vegetables, as unprepared roses are not for consumption, or as far as they are used to give flavour to jam or rose oil, are not covered by the specification in Class 31 (see decision of the Boards of 19 November 2009 in Case 241/2009-1 – BIONESSE / BIONESSERE at paragraphs 27, 30).
- 23 Roses or their seeds may however be included in the broad and partially ambiguous specifications of  
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.

*The public*

- 24 To assess whether a trade mark is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst the consumers of the said goods or services (see judgment of the Court of 9 March 2006 in Case C-421/04 *Matratzen Concord AG v Hukla Germany SA* (‘Matratzen’) [2006] ECR I-2303, at paragraph 24). As stated by the Cancellation Division, the goods covered by the Community trade mark targets both a professional public (e.g. gardeners, farmers, florists) and the end consumer, either buying rose plants or cut flowers.
- 25 Reference is made to the average public who is deemed to be reasonably well informed and reasonably observant and circumspect (see, to that effect, judgment of the Court of Justice of 16 July 1998 in Case C-210/96 *Gut Springenheide*

*GmbH and Rudolf Tusky v Oberkreisdirektor des Kreises Steinfurt - Amt für Lebensmittelüberwachung* ('Gut Springenheide') [1998] ECR I-4657, at paragraph 31, OJ OHIM 3/1999, p. 561; judgment of 22 June 1999 in Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* ('Lloyd Schuhfabrik') [1999] ECR I-3819, at paragraph 26, OJ OHIM 12/99, p. 1568).

- 26 The consumer's level of attention is likely to vary according to the category of goods involved, and it normally perceives a mark as a whole and does not proceed to analyse its details.
- 27 It is worth mentioning that rose traders or amateur rose enthusiasts often are highly passionate and precise with respect to the different species and varieties. Being aware that there are numerous rose variants in the world, traders often consult specialised literature. As shown by both parties, specialised literature is not only published nationally and rose names are not limited to individual Member States. In fact, all books mentioned by the parties were translated into various languages. Websites are accessible throughout the whole world and often refer to other specialised websites on an international level. In particular, the American Rose Society's publications are highly influential for the collection and classification of rose names world wide and their publications are consulted by rose traders or authors of other encyclopaedias in Europe, such as *MODERN ROSES – The World Encyclopaedia of Roses* (e.g. the previous X Edition 1993 and XI Edition 2000, published by ARS) and the *ENCYCLOPAEDIA OF ROSE SCIENCE*, published in the United Kingdom by Elsevier Ltd, Oxford, with a team of international authors from the United Kingdom, Germany and France.
- 28 As to the end consumer, it is to be considered that roses belong to the most popular flowers, both as plants and as cut flowers.

*Vesuvius as the designation of a rose variety*

- 29 It is undisputed between the parties that a Mr Samuel McGredy, a nurseryman in Ireland specialised in roses, grew a new variety of roses in 1923 to which it gave the name Vesuvius. That rose variety is described as being fragrant, with long pointed buds, the flowers being of dark velvet crimson, having only five of six petals and light leathery foliage. The particular rose variety having received the name of Vesuvius appears to have no alternative name.
- 30 The parties did not explain whether Mr Samuel McGredy had ever enjoyed any legal protection for that variety of rose or the name; even if this had been the case, it is not relevant to these proceedings.

31 Photos of the rose are reproduced herewith:

		
<a href="http://www.rdrop.com/~paul/hybridteas/vesuvius.html">http://www.rdrop.com/~paul/hybridteas/vesuvius.html</a>	<a href="http://uncommonrose.biz/r/vesuvius.html">http://uncommonrose.biz/r/vesuvius.html</a>	<a href="http://www.sactorose.org/rose/s/56shrubs.htm">http://www.sactorose.org/rose/s/56shrubs.htm</a>

32 According to the horticultural classification of the American Rose Society, the rose belongs to the group of 'hybrid tea', a group within the category of modern roses. However, probably due to its vigorous growth, it is sometimes included in the category of shrub roses.

33 In that context it is worth mentioning that the CTM proprietor itself markets Vesuvia roses or roses that look like Vesuvia roses under the figurative mark VESUVIA, as alleged by the Cancellation applicant in its cancellation request which makes reference to the CTM proprietor's website, an extract of which can be seen here below:

*La volupté du rouge*




- › Rosier arbustif à port recouvrant.
- › Fleurs simples rouges de 4 cm de diamètre contrastant avec des étamines jaunes d'or.

**Hauteur**  
60 à 80 cm

**Plantation**  
3 rosiers au m<sup>2</sup>

**Floraison**  
De Mai/Juin jusqu'aux premières gelées

**Qualités**  
Résistance naturelle aux maladies  
Entretien minimum

**Utilisations**  
Massifs, talus, bordures, haies basses, rocailles, vasques...

*Les DÉCOROSIERS existent aussi en Tiges.*

34 Even though the CTM proprietor was meticulous when contesting various details of the Cancellation applicant's evidence, it did not refute the allegation that the

rose variety traded under VESUVIA® was in fact a Vesuvius variety or at least a rose imitating the Vesuvius rose features.

- 35 However, the CTM proprietor argues that Vesuvius variety was not generally used any more and insinuated that the Vesuvius rose species was in fact extinct; at least in Europe. It quoted a number of specialised books on roses that did not mention Vesuvius or VESUVIA roses. According to the CTM proprietor, Vesuvius was not used as a name for roses within the European Union and, therefore, the request based on Article 7(1)(c) CTMR had to be rejected.
- 36 However, this argument cannot be followed. It emanates from incorrect interpretation of Article 7(1)(c) CTMR, as there is no need for a descriptive indication to be in general use in the Europe Union, as already results from the wording ('may use').
- 37 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.
- 38 The criteria for assessing the descriptiveness of a trade mark for plants are no different from those applicable to other categories of trade mark. The provisions of trade mark law apply to plants as to other categories of goods. It results that the name of a plant, in principle and independently if the variety and its name are new or old, must be rejected under Article 7(1)(c) CTMR unless it has acquired distinctiveness under the conditions of Article 7(3) CTMR.
- 39 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.
- 40 The allegation that the Vesuvius roses are extinct at least in Europe cannot be accepted. The evidence submitted by the Cancellation applicant shows that Vesuvius roses are described by different authors independently. *The MODERN ROSES – The World Encyclopaedia of Roses* and the *ENCYCLOPEDIA OF ROSES* (see extracts above at paragraph 4) are both books out of which copies of relevant pages were filed and which are distributed for sale in the European Union. These books are standard reference books for rose experts (see above, at paragraph 26). Further descriptions of Vesuvius roses on various websites

mentioned by the Cancellation applicant (see extracts above at paragraph 4) such as on [www.rdrop.com](http://www.rdrop.com), [www.uncommonroses.biz](http://www.uncommonroses.biz), <http://www.backyardgardener.com> and (in German) on <http://www.welt-der-rosen.de> show that these rose varieties are still cultivated and sold. Contrary to the documents mentioned by the Courts in Paris, the evidence was dated within the relevant time period; Internet extracts filed in the form of paper printouts with valid dates which could all be traced back as they were either still on the Internet, or could be confirmed by using the 'wayback' search engines for the dates indicated. Also, the CTM proprietor did not even allege that the websites quoted and printed by the Cancellation applicant were manipulated.

- 41 The CTM proprietor argues further that the relevant date for examination was the filing date, i.e. 14 December 1999 and that the evidence was mostly prior to this and certainly before the registration date of 5 February 2001. This argument must be rejected. Independently of the date of the evidence, all documents refer to historic facts, namely that there was a rose variety Vesuvius in existence since 1923 and that it still exists to this day. Even if part of the evidence should therefore be considered as being dated after the relevant date, it nevertheless demonstrates that it existed before that date.
- 42 Even considering that most of the evidence has its source in the United States and Canada, it has been sufficiently established that the name of the variety *may* become a descriptive indication known within the European Union in the sense of Article 7(1)(c) CTMR. It is highly unlikely that a rose breed that was created in Ireland and is known and grown in the United States and Canada is not known or at least may not become known in the European Union (see judgment of the Court of First Instance of 21 January 2009 in Case T-307/07 *Hansgrohe AG v OHIM* ('Airshower') [2009] ECR publication pending, at paragraph 32). This is at least true for the relevant specialised trade circles (see judgment of the Court of First Instance of 17 September 2008 in Case T-226/07 *Prana Haus GmbH v OHIM* ('Pranahaus') [2008] ECR publication pending, at paragraph 29) within the global market of plant varieties, which includes in particular the United States and Canada and other Member States of UPOV.
- 43 As to the evidence presented by the CTM proprietor, showing that in some books of roses, Vesuvius or Vesuvia roses were not mentioned, it should be stressed that the fact that the name is not mentioned in all publications on Roses does not mean that the name Vesuvius is not descriptive for Vesuvius roses. Furthermore, these books do not claim to have an exhaustive list of all recognised rose varieties.

*Vesuvia equals Vesuvius in the perception of the trade and/or the consumers*

- 44 The CTM proprietor further argues that 'Vesuvius' is not a synonym of 'VESUVIA' and producers and traders as well as end consumers could hold them apart, even if applied to roses of the Vesuvius sort.
- 45 In the context of plants, and in particular in the context of roses, specific rules apply in the practice of finding new names for plant varieties. Such practice is influenced by various factors, such as the association of roses with beauty, perfume and love; the rose being sacred to the goddess of love Aphrodite.

- 46 It would appear that for example in France, rose varieties are often called ‘Madame ...’. For example, the rose variety ‘Madame David’, despite starting with a feminine courtesy title, was named after the male painter Jacques Louis David (30 August 1748 – 29 December 1825).
- 47 Evidence of such practice is given on the website [http://www.welt-der-rosen.de/namen\\_der\\_rosen/hobby\\_rosennamen.htm](http://www.welt-der-rosen.de/namen_der_rosen/hobby_rosennamen.htm):
- ’Übrigens - zur Namensgebung der vielen Madame ... Rosen mit männlichem Namen - in Frankreich bevorzugte man es, die Rose, obwohl einem Mann gewidmet, trotzdem "Madame" und nicht "Monsieur" zu benennen ...’.*
- 48 Of further prime importance is the fact that the Latin name for a rose is the feminine word *Rosa* of the family of *Rosaceae*. In that context, the Cancellation Division erred in its assessment of the facts. It considered that Vesuvius was the ‘correct Latin name to identify the plant species’. However, Vesuvius cannot possibly be the botanical name for a species of the genus rose in Latin.
- 49 All Latin botanical names for rose species are feminine as they must start with ‘Rosa’, which is the Latin botanical name for roses, and must then be followed by a further Latinized name often ending in ‘a’, such as the species *Rosa californica* (California Rose), *Rosa canina* (Dog Rose, Briar Bush), *Rosa carolina* (Pasture Rose), *Rosa gallica* (Gallic Rose, French Rose, Rose of Provins, Apothecary’s Rose), *Rosa glauca* [synonym *Rosa rubrifolia*] (Redleaf Rose), *Rosa Moschata* (Musk Rose), *Rosa virginiana* [synonym *Rosa lucida*] (Virginia Rose) etc.<sup>2</sup>. Even though there are examples of Latin names ending differently, such as *Rosa acularis*, a big majority end in –a.
- 50 Contrary to the findings of the Cancellation Division, ‘Vesuvius’ is not ‘the correct Latin name to identify the plant species’ nor is it the ‘technical Latin name of the plant’ and therefore the public will not ‘use its trivial name or another descriptive term in order to identify’ a Vesuvius rose, as there is no other name for that variety.
- 51 Vesuvius is simply the name of a rose variety, not a species. There is no botanical Latin name for the Vesuvius rose variety. Most of modern rose breeds do not have botanical Latin names, since they are obtained through intensive hybridization of a group of rose species. Vesuvius simply sounds Latin and the Roman name Vesuvius is the same as the English (Dutch, Finnish, Swedish) name of the volcano Mount Vesuvius, situated in the bay of Naples in Italy, and the name of which varies in other languages, for example Vesuv (Danish, German), Vesuvio (Italian), Vésuve (French), Vezúv (Hungarian).
- 52 In particular in the world of roses, therefore, traders and even more so consumers will not be aware, when being confronted with VESUVIA in relation to Vesuvius roses that VESUVIA is ‘just allusive to Vesuvius roses’. To the contrary, both names will be considered synonyms, in the sense of a modification into Latin.

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<sup>2</sup> see 326 rose species under [http://www.ars-grin.gov/cgi-bin/npgs/html/tax\\_search.pl](http://www.ars-grin.gov/cgi-bin/npgs/html/tax_search.pl) by indicating ‘rosa\*’.

- 53 For the purpose of applying Article 7(1)(c) CTMR, it is necessary to consider, on the basis of the relevant meaning of the word sign at issue, whether, from the viewpoint of the public addressed, there is a sufficiently direct and specific relationship between the sign VESUVIA and the goods for which it is registered, including Vesuvius roses. VESUVIA will certainly be assimilated by the public familiar with roses, with the word ‘Vesuvius’, which does have a meaning in English. The target public will therefore consider that ‘VESUVIA’ has been adapted or simply misspelled. When the word is applied to Vesuvius roses, the relevant public will consider immediately and without any thought that ‘VESUVIA’ must obviously be substituted for ‘VESUVIUS’. In relation to roses, there is no perceptible difference between the neologism VESUVIA or the word Vesuvius and it does not create an impression which is sufficiently far removed from that produced by the Vesuvius breed (see judgment of the Court of First Instance of 26 November 2003 in Case T-222/02 *HERON Robotunits GmbH v OHIM* (‘Robotunits’) [2003] ECR II-4995, at paragraph 44; of 12 June 2007 in Case T-339/05 *MacLean-Fogg Co. v OHIM* (‘Lokthread’) [2007] ECR II-61\*, at paragraph 29, 45; of 22 May 2008 in Case T-254/06 *Radio Regenbogen Hörfunk in Baden Geschäftsführungs-GmbH v OHIM* (‘RadioCom’) [2008] ECR II-80\*, at paragraph 44).
- 54 For this reason, 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, 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.
- 55 The request for declaration of invalidity is rejected for the following goods (see above at paragraph 21):
- Class 31 – fresh fruits and vegetables (except maize), fresh fruit.

*Article 52(1)(a) CTMR in conjunction with Article 7(1)(b) CTMR*

- 56 As is clear from Article 7(1) CTMR, for a sign not to be eligible for registration as a Community trade mark, it is sufficient for one of the absolute grounds for refusal to apply (see judgment of the Court of Justice of 19 September 2002 in Case C-104/00 P *DKV Deutsche Krankenversicherung AG v OHIM* (‘Companyline’) [2002] ECR I-7561). In the context of Article 7 CTMR, each of the absolute grounds for refusal listed is independent of the others and calls for a separate examination (Judgments of the Court of Justice of 12 February 2004 in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (‘Postkantoor’) [2004] ECR I-1619, at paragraph 67, and of 8 April 2003 in Joined Cases C-53/01, C-54/01 and C-55/01 *Linde AG, Winward Industries Inc. and Rado Uhren AG v Deutsches Patent- und Markenamt* (‘Linde’) [2003] ECR I-3161, at paragraph 67). Even if those grounds are applicable separately, they may also be applied cumulatively (judgment of the Court of First Instance of 26 October 2000 in Case T-345/99 *Harbinger Corporation v OHIM* (‘Trustedlink’) [2000] ECR II-3525) to the same trade mark applied for.

- 57 At first sight, it would appear from the reasoned statements of the Cancellation applicant that it limited its request for declaration of invalidity to Article 52 in conjunction with Article 7(1)(c), (d) and (g) CTMR. However, interpreting the reasoning given for the cancellation request and throughout the proceedings, it appears that the Cancellation applicant also argues that the trade mark was registered even though it was not recognised as a trade mark, and therefore, as a consequence, Article 7(1)(b) CTMR is in issue as well (cf. decision of the Boards of 30 June 2006 in Case R 1466/2005-1 – World Cup 2006, at paragraph 14-18 with further references). It should be noted that the Cancellation applicant does not need to quote precisely all specific norms if it is clear from its pleadings to which norms the request refers (see judgment of the Court of First Instance of 30 September 2009 in Cases T-75/08 and T-191/08 *JOOP! GmbH v OHIM* ('! / !')) [2009] ECR publication pending, at paragraph 17). Both parties were heard in accordance with Article 63(1) in conjunction with Article 75 CTMR as to whether the Board's understanding was correct and were given the possibility to submit their observations. No new further facts or arguments were submitted by either party on that point. In addition, in proceedings on absolute grounds before it, the Office shall examine the facts of its own motion, as results from Article 76(1) CTMR.
- 58 Under Article 7(1)(b) CTMR, trade marks which are devoid of any distinctive character, meaning that they are not capable of distinguishing the goods claimed by the applicant from those of other undertakings, shall also be refused registration. The notion of general interest underlying Article 7(1)(b) CTMR is, manifestly, indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. The trade mark must make it possible to distinguish the goods or services by their business origin, not by their name or their characteristics (see judgment of the Court of 8 May 2008 in Case C-304/06 *P Eurohypo AG v OHIM* ('Eurohypo') [2008] ECR I-3297, at paragraph 56, 69).
- 59 The distinctiveness of a trade mark within the meaning of Article 7(1)(b) CTMR is equally assessed by reference to the goods and services in the application and to the perception of them by the relevant public (see judgment of the Court of 12 February 2004 in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* ('Postkantoor') [2004] ECR I-1619, at paragraphs 34 and 35 and the decisions cited therein).
- 60 It was argued by the CTM proprietor that the general wording of the specification of goods, such as 'natural plants' or 'natural flowers' is so large that it must be considered as referring mainly to goods of current consumption by the general public, rather than to the specialist public of rose traders (cf. judgment of the Court of First Instance of 12 March 2008 in Case T-341/06 *Compagnie générale de diététique SAS v OHIM* ('Garum') [2008] ECR II-35\*, at paragraph 33).
- 61 It is to be admitted that the general consumer is not aware of the names of most existing rose varieties, including the Vesuvius variety. This cannot, however, lead

to the assumption that Vesuvius or VESUVIA become automatically distinctive for 'roses' in a trade mark sense.

- 62 Firstly, it cannot be upheld that the general public is completely ignorant of different rose varieties but will normally have the choice between different roses. It is in fact more likely to be more observant to the name of the plant variety than to specific trade marks. Trade marks for individual plants such as roses are still relatively unusual compared to the variety designation. The more the relevant consumer is interested in roses, the more he will be attentive to the name of the rose variety.
- 63 Secondly, the specialist cannot be ignored in the context of Article 7(1)(b) CTMR. Allowing applicants to hide very specific goods addressed to specialists in broad specifications cannot lead to the result that the perception of the relevant public becomes a different one and that the name of the specific product can be registered as a trade mark.
- 64 In other words, if VESUVIA is non-distinctive for Vesuvius roses, it cannot be distinctive for broader specifications such as roses, flowers, plants or agricultural products in general, as they all may include Vesuvius roses. Therefore, distinctiveness of VESUVIA must in the first place be assessed in relation to Vesuvius roses.
- 65 In that context, a further aspect is of importance. The relevant specialised consumer is used to roses or, more generally, plants being given names. In the specific field of plants, specific traditions and legislation make sure that names of different species keep a certain distance from each other. The more similar the plants are, the more the designations must keep apart. For example, it results from Article 63(3)(c) of Council Regulation (EC) No. 2100/94 of 27 July 1994 on Community plant variety rights (CPVRR) that the denomination of a plant variety may not be registered under the following circumstances:

*Article 63 - Variety denomination*

...

*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 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;*

...

*(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.*

- 66 Therefore, a designation of a variety denomination shall not be registered if it may be confused with a variety denomination under which another variety has been marketed in a Member State or in a contracting party to UPOV, unless the other

variety no longer remains in existence and its denomination has acquired no special significance.

- 67 As the variety remains on the market at least in the United States and Canada, both Members to UPOV, and as further references to VESUVIUS roses can be found in specialised encyclopaedias and websites within the Community, registration of VESUVIA for Vesuvius roses as a Community Plant Variety depends on the question of whether it ‘may be confused’ in the sense of the Plant Variety Regulation. Here, it would appear that the case is border-line, on the one hand because of the strong structural and conceptual similarity for identical varieties of roses and on the other due to a rather mechanical approach chosen by the CPVO. According to its official guidelines<sup>3</sup> to Article 63(3) CPVRR, a difference of two letters would in general be sufficient not to confuse two plant denominations.
- 68 It should be emphasized that the relevant question in relation to Article 7(1)(b) CTMR is not if Vesuvius is a protected plant variety in the sense of the CPVRR, or whether VESUVIA could be accepted as a designation of a plant variety, but how VESUVIA will be perceived by the relevant public, in particular in relation to Vesuvius roses.
- 69 Since the creation of the trade mark VESUVIA follows the general pattern used for the creation of rose names, the difference in the ending will go unnoticed and the registered CTM will not be understood as an indication of the commercial origin, i.e. as a trade mark for a rose hybrid which includes Vesuvius roses. At most it would be considered a (grammatically incorrect) Latin or modern variation/misspelling of Vesuvius for roses. The sign would not exercise its function of indicating the commercial origin of the goods that may include Vesuvius roses without any likelihood of confusion and would therefore be devoid of any distinctive character in accordance with Article 7(1)(b) CTMR. The situation is different for fruits and vegetables (see above at paragraph 21).

*Article 52(1)(a) CTMR in conjunction with Article 7(1)(d) CTMR*

- 70 As regards Article 7(1)(d) CTMR, it must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (see Case T-322/03 *Telefon & Buch v OHIM – Herold Business Data* (WEISSE SEITEN) [2006] ECR II-835, paragraph 49 and the case-law cited).
- 71 It follows from the factual findings above that VESUVIA or Vesuvius, might have been perfectly acceptable trade marks before 1923. The simple reference to the

<sup>3</sup> [http://www.cpvo.eu.int/documents/lex/guidelines/VD\\_Guidelines\\_explanatory\\_note\\_EN.pdf](http://www.cpvo.eu.int/documents/lex/guidelines/VD_Guidelines_explanatory_note_EN.pdf).

volcano in Italy does not impede the sign from being recognisable as a trade mark. There are no indications to the contrary. Still, it follows from the evidence above that Vesuvius became customary in trade as the name of a particular rose species. In accordance with the principles above, VESUVIA is considered in the bona fide and established practices of the trade a synonym for Vesuvius roses.

*Article 52(1)(a) CTMR in conjunction with Article 7(1)(g) CTMR*

- 72 The Cancellation applicant further invoked Article 52(1)(a) CTMR in conjunction with Article 7(1)(g) CTMR, arguing that VESUVIA would be of such a nature as to deceive the public for instance as to the nature, quality or geographical origin of the goods.
- 73 Recognising however that Vesuvius roses exist and that they are included in most of the broad specifications used by the applicant, it is difficult to see how VESUVIA can be deceptive in the sense of Article 7(1)(g) CTMR when used in relation to Vesuvius roses.
- 74 For the sake of completeness, it should be mentioned that the Cancellation applicant never had alleged that the CTM proprietor used the VESUVIA trade mark for roses other than Vesuvius roses, an action which could trigger the ground of revocation of misleading use in the sense of Article 51(1)(c) CTMR. To the contrary, the Cancellation applicant gave *a priori* evidence that the CTM proprietor used VESUVIA as a trade mark for Vesuvius roses.

*Article 52(1)(b) CTMR*

- 75 The Cancellation applicant argues that CTM proprietor had filed the VESUVIA trade mark in bad faith as it knew or must have known that Vesuvius was a descriptive indication for roses. Bad faith is an absolute ground for the invalidity of a Community trade mark in accordance with Article 52(1)(b) CTMR.
- 76 However, the pure application for registration of a designation that was descriptive and non distinctive at the filing date and where several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration was sought cannot be considered automatically an application made in bad faith.
- 77 In accordance with the jurisprudence of the Court (see judgment of the Court of 11 June 2009 in Case C-529/07 *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* ('Lindt Goldhase') [2009] ECR publication pending), whether the applicant was acting in bad faith, within the meaning of Article 51(1)(b) CTMR, 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 registration of the sign as a Community trade mark, in particular:
- The intention of the applicant by reference to the objective circumstances of the particular case, namely whether the applicant knew or must have known 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;

- The applicant’s intention to prevent that third party from continuing to use such a sign; and
- the degree of legal protection enjoyed by the third party’s sign and by the sign for which registration is sought.

78 First, with regard to the intention of the CTM proprietor at the moment of filing, it appears to be sufficiently demonstrated that it knew that Vesuvius was the name of a rose variety when filing the trade mark VESUVIA. The fact that the number of rose breeders is relatively small even on a global scale, that it is highly specialised and attentive when choosing names for roses, along with the fact that Vesuvius is mentioned in the decisive rose encyclopaedia for decades and the fact that the CTM proprietor used VESUVIA for Vesuvius type roses on its website, strongly suggests that the choice of name was not by chance but done intentionally to monopolize that name as a trade mark and thereby monopolize the whole plant variety of Vesuvius roses.

79 Second, it appears that the CTM proprietor had the intention to prevent third parties such as the Cancellation applicant from marketing roses. In fact it has meanwhile engaged different infringement proceedings against competitors using rose names such as ‘VESUV’.

80 That said, it cannot be excluded that even in such circumstances, and in particular when several producers were using, on the market, identical or similar signs for identical or similar products capable of being confused with the sign for which registration is sought, the applicant’s registration of the sign may be in pursuit of a legitimate objective. In particular, Article 7(3) CTMR specifically foresees the possibility to obtain trade mark protection of initially descriptive or non-distinctive signs. Moreover, the nature of the mark applied for may also be relevant to determining whether the applicant is acting in bad faith.

81 In a case where the sign for which registration is sought consists of the entire shape and presentation of a product, the fact that the applicant is acting in bad faith might more readily be established where the competitors’ freedom to choose the shape of a product and its presentation is restricted by technical or commercial factors, so that the trade mark proprietor is able to prevent its competitors not merely from using an identical or similar sign, but also from marketing comparable products.

82 Similarly, the fact that the CTM proprietor tries to monopolize the generic name or highly similar name of a variant of roses for which at least today no plant variety protection exists, for which nobody could obtain a new plant variety protection and where the designation could probably not be used to register any new rose variety (see above under paragraph 65), the further fact that the CTM proprietor distributes that Vesuvius rose itself and then tries to impede competitors in the distribution of the Vesuvius roses or other roses under the names of Vesuvius or Vesuv is trying to sidestep the limited protection of plant variety names and cannot be considered as acting in good faith at the moment of

filing, independently whether there is a likelihood of confusion in the sense of Article 9(1)(b) CTMR in conjunction with Article 12(b) CTMR.

*Other registrations and proceedings*

- 83 As regards the CTM proprietor's argument that the trade mark VESUVIA has been accepted in France and that a cancellation request was rejected by French courts between different parties, it must be stressed that the registrability of a sign as a Community trade mark must be assessed solely on the basis of the CTMR, as interpreted by the Community judicature. In addition, national judgments may come to different results because of different parties, different facts and evidence and different procedural provisions. Even though the judgment of a national court cancelling a trade mark in application of Article 100 CTMR (ex Article 96) in conjunction with Article 53 CTMR (ex Article 52) would be binding *erga omnes* (see Article 55(2) CTMR, ex Article 54), any decision rejecting the request for declaration of invalidity is just binding *inter partes*, independently of whether proceedings had been stayed or not (cf. Article 104 CTMR, ex Article 100).
- 84 The trade mark is therefore to be declared invalid on the grounds of Article 52(1)(a) in conjunction with Article 7(1)(b), (c), (d) CTMR and of Article 52(1)(b) CTMR.

**Costs**

- 85 Since the both parties succeed on some and fail on other heads, the Board decides that each party shall bear its own fees and costs in accordance with Article 85(1) CTMR (ex Article 81(2)).

**Order**

On those grounds,

THE BOARD

hereby:

**1. Annuls the contested decision and declares the trade mark VESUVIA invalid for the following goods:**

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;

**2. Rejects the request for declaration of invalidity for the following goods:**

Class 31 – fresh fruits and vegetables (except maize), fresh fruit;

**3. Orders that each party bears its own fees and costs of the cancellation and appeal proceedings.**

Th. Margellos

Ph. von Kapff

U. Wennermark

Registrar:

J. Pinkowski