

Denomination of a plant variety and descriptive use of a third-party trade mark

In Judgment no. 1065/2025 of 4 July (ECLI:ES:TS:2025:3162), the Supreme Court (Civil Division) dealt with an interesting case involving fruit trade marks, variety denominations and designations of origin.

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1. Variety denominations, geographical indications and trade marks

- 1.1. The marketing of fruit may involve different types of intellectual property rights. Firstly, the fruit may belong to a plant variety that is protected by a plant variety right, which is regulated internationally by the International Convention for the Protection of New Varieties of Plants (hereinafter the UPOV Convention); in the European

Union by Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights, and in Spain by the Plant Varieties Protection (Legal Regime) Act 3/2000 of 7 January.

Secondly, fruit may have a specific geographical origin that is indicated by a protected designation of origin or geographical indication (currently covered by Regulation (EU) 2024/1143 of the European Parliament and of the

Council of 11 April 2024 on geographical indications for wine, spirit drinks and agricultural products, as well as traditional specialities guaranteed and optional quality terms for agricultural products).

Thirdly, it is also possible, and indeed very common, for the fruit to be distinguished by the corresponding trade-marks of the producer and the trader (protected under Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark and the Spanish Trade Mark Act 17/2001).

- 1.2. An overlap of these rights in the same fruit means that the fruit could be marketed under different signs: with a designation of origin or geographical indication, with one or more trade marks and with the denomination of the plant variety to which the fruit belongs.

In any case, the variety denomination is not a distinguishing mark in which there are exclusive rights, but rather a generic term that identifies the variety and may be used freely by anyone who lawfully works it. It should be recalled that, according to Article 20 of the UPOV Convention, “[t]he variety shall be designated by a denomination which will be its generic designation” and that “[a]ny 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”. And therefore, as provided for in Council Regulation (EC) No 2100/94 (Article 18(1)), the holder of a plant variety right “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”.

Furthermore, all marketed plant varieties also have a registered variety denomination, even if they are not varieties protected by a plant variety right. This is because the marketing of a variety requires prior authorisation, which is subject to the variety meeting a number of conditions and the assignment of a denomination that allows it to be identified without risk of confusion with others and that is intended to be its generic designation, as set out in Spain in the Nursery Seeds and Plants and Plant Genetic Resources Act 30/2006 of 26 July (Article 11).

- 1.3. The recent Supreme Court (Civil Division) Judgment No. 1065/2025 of 4 July (ECLI:ES:TS:2025:3162) has addressed an interesting case involving fruit trade marks, variety denominations and designations of origin.

2. Variety denominations and descriptive use of third-party trade marks

- 2.1. The case decided by the Supreme Court pits the Regulatory Board for the designation of origin “kaki Ribera

del Xúquer” against a commercial company that markets persimmons¹. For these purposes, it should be noted that, according to the specifications of the aforementioned designation of origin, these refer to the “persimmon fruit (*Diospyros kaki*) of the ‘Rojo Brillante’ variety intended for fresh consumption” produced in the geographical area of the designation of origin. The Regulatory Board for the designation of origin is also the owner of a number of European Union and Spanish trade marks (individual or collective) consisting of the sign ‘Persimon’ (word or figurative marks), either on its own or accompanied by other elements (“Persimon Kids”, “Persimon D.O.”, “Persimon Ribera”, etc.), registered to distinguish products in class 31 of the international nomenclature.

That being the case, the regulatory board is suing a commercial company that markets persimmons and promotes them on bus shelters with a poster showing the following image next to a smiling child:



on the grounds that the use of the term ‘Persimmon’ constitutes an infringement of its trade mark rights, a term also used by the defendant on the labels it affixes to its products.

The claim was dismissed at first instance, as the Alicante Provincial Court (EUTM Court) understood that the term had been used to identify the product. However, the same court, in Judgment No. 948/2020 of 28 September, considered that there was indeed a trade mark infringement, stating, among other things, that “the likelihood of confusion is obvious given the practical coincidence of the word element, which differs only in one letter that does not affect its pronunciation (Persimon/*Persimmon*), and the complete identity of the products at issue (in both cases, a persimmon that has undergone a desastringent treatment).” With regard to the statement in the first instance judgment that the term ‘Persimmon’ is not used as a trade mark but to identify a variety of *caqui*, the EUTM Court holds that, with that statement, the court appears to want to protect the use in the limitation of trade mark rights that allows the use of signs to refer to the characteristics of the goods or services. However, such limitation only applies when the use of the sign is in accordance with honest practices in industrial or commercial matters, which, in the opinion of the

¹ In Spanish, two spellings are accepted for this fruit: *kaki* and *caqui*. Both are used in this paper because, as there are direct quotations where both are used, the spelling used in the sources is respected. In text that is not a direct quotation or the designation of origin, we have standardised the spelling using *caqui*.

EUTM Court, is not the case here because, when the defendant includes the term ‘Persimmon’, it is seeking to present its product as an imitation of the product identified by the sign ‘Persimon’.

2.2. For its part, the Supreme Court upheld the appeal against the judgment of the Alicante Provincial Court and considered that the use of the term ‘Persimmon’ falls within the aforementioned limitation of trade mark rights which protects the descriptive use of third-party trade mark. It should be recalled that Article 14(1)(b) of the EU Trade Mark Regulation provides that an EU trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, “signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or services”, adding in the second paragraph of that article that this “shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters”. A similar provision is found in Article 37 of the Spanish Trade Mark Act.

According to the Supreme Court:

...the dispute in cassation revolves around whether the limit invoked applies, namely that the use of the term ‘Persimmon’ by the defendant was to identify a specific variety of *caqui*.

As stated in the first instance judgment, and not contradicted by the appeal judgment, there is a variety of *caqui*, bright red in colour, not astringent and which can be eaten directly without waiting for it to ripen, which is identified by the term ‘persimon’.

If we look at the signage used in the advertising campaign on street furniture in Valencia, the term ‘Persimmon’ is used in a sentence: “PERSIMMON READY TO EAT!”, in the same font and size, alongside images of several *caquis* of the Persimon variety and a smiling child holding a *caqui* in his hand. The phrase used identifies the product (‘Persimmon’) with a reference to one of its characteristics (ready to eat) in a way that is not considered contrary to fair commercial practices, especially since the defendant’s own trade mark is also highlighted.

Furthermore, with regard to the use of the term ‘Persimmon’ on the label affixed by the defendant to the fruit, consisting of a small round label bearing, on the one hand, the defendant’s trade mark (Kaki Estrella) and, on the other, the term ‘Persimmon’, the Supreme Court states as follows:

... although it could give rise to greater doubt, given the uniform typeface used for both mentions and the isolated location of the term ‘persimon’ [sic], the Court considers that it can be percei-

ved by an average consumer of this product (who is reasonably well informed and reasonably observant and circumspect) as an indication of that variety of *caqui*. This use does not appear to be contrary to honest practices, since, in addition to the fact that the *caquis* to which the label is affixed are of this variety, the way in which the name ‘persimon’ [sic] appears, together with the defendant’s trade mark, suggests that there is no intention to create a likelihood of confusion with *caquis* of this variety covered by the claimant’s designation of origin, whose trade marks have been found not to be well known or renowned.

- 2.3. As can be seen, the Supreme Court’s reasoning is based on the premise that ‘Persimmon’ is the name of the variety of *caquis* marketed by the defendant, so that, even though it is a sign very similar to the term ‘Persimon’ which makes up the claimant’s trade marks, its use is covered by the limitation allowing the use of descriptive indications of the goods or services marketed.

There is no doubt that the registered name of a plant variety may be used

by anyone marketing plant material of that variety. It should be recalled that the legislation on plant varieties itself expressly provides that the name of a variety is its generic designation.

The name of a variety is intended to be its generic designation

Therefore, the use of such a registered name cannot be prevented by invoking a trade mark right.

However, in the specific case, the Supreme Court’s statement that “the term ‘Persimmon’ was used by the defendant to identify a specific variety of *caqui*” is striking. This is because ‘Persimmon’ is not the name of the variety, but ‘*Roja Brillante*’, as recorded in the Register of Commercial Varieties². In fact, as highlighted in the appeal judgment, the defendant “repeatedly asserts that ‘Persimmon’ is the name commonly used to refer to this fruit in the various languages of the European Union”, which would imply that it is not the name of a variety. It would therefore have been desirable for the judgment to provide a more detailed explanation of all these issues, because identifying a variety by its name is not the same as identifying it by another sign that is not its name.

² See in this [link](#).