

CANNA THÉ SOLUTION FOR GROWTH AND BLOOM:

Recognition and protection of its main element “Canna”.

Jemie B.V., is a company engaged in the production of nutrients and cultivation media for fast-growing plants.

These Dutch experts are recognized worldwide as the leaders in smart plant technology that will allow you to grow your favorite plants in coconut fiber, hydroponics, and soil.

It owns the CANNA trademark and family of trademarks, which are granted to protect products in classes 5 and 31 of the international classifiers.

Client	JEMIE B.V.
Trademark	CANNA THÉ SOLUTION FOR GROWTH AND BLOOM
Granting Authority	National Directorate of Industrial Property (Dinapi)

Background of the case

Trademark Application: On December 26, 2019, the firm A. S.A., domiciled in Paraguay, applied before the National Directorate of Intellectual Property (DINAPI) for the trademark CANNAPAR, under Records No. 19107777, 19107779 and 19107781, to protect products included in international classes 1, 35, 42.

On July 31, 2020, Jemie B.V. filed an opposition based on the following grounds:

- ▶ Its vested local rights to the CANNA THÉ SOLUTION FOR GROWTH AND BLOOM trademark, granted in Int. class 1.
- ▶ The notoriety of their trademark, the recognition by the consuming public in the relevant sector not only



regionally but globally of the CANNA trademark and its trademark family.

- ▶ The almost identical nature of the conflicting trademarks as the trademark CANNA is 100% contained within the trademark applied for.
- ▶ The likelihood of direct and indirect confusion which may arise considering the identity between the classes protected by both trademarks.

Favorable decision: confusing similarity and vested rights over “Canna”

On October 27, 2022, the Directorate of Trademark Litigious Matters, issued Resolutions No. 1116, 1117 and 1118, in which it upholds the oppositions and orders the rejection of the trademark CANNAPAR, based on the following points:

- ▶ *“...upon comparing the conflicting trademarks: CANNAPAR (trademark applied for) vs CANNA THÉ SOLUTION FOR GROWTH AND BLOOM (opposing trademark) as a whole and successively upon replying it is noted that they have similarities in the visual, phonetic and ideological aspects.”*
- ▶ *“That, upon analyzing the conflicting trademarks, it is possible to confirm that the prominent element in the name of the opposing trademark is CANNA, and when visualizing its label, it shows that indeed it is that one, which it has in common with the trademark applied for, therefore, this Directorate considers that the trademark applied for is similar to the opposing trademark, they intend to identify products in the same class, a circumstance that makes the possibility of confusion/association of trademarks even greater”.*
- ▶ *“That the opposing trademark was able to prove the national registration of its trademark CANNA THÉ SOLUTION FOR GROWTH AND BLOOM and the foreign registrations of its trademarks BIOCANNA, CANNA and others similar trademarks.”*

Prohibitions under the Trademark Law

The Trademark Law in force No. 1294/98 provides in its article 2 as follows: The following may not be registered as trademarks:

(a) Signs or distinctive means in violation of the law, public order, morality, and decency and **those that may lead to deception or confusion as to the origin, manufacturing method, characteristics or fitness and purpose of use of the goods or services in question.**

f) signs identical or similar to a trademark registered or applied for previously by a third party, for the same goods or services, or for different goods or services when they might cause a risk of confusion or association with that trademark.

g) Signs consisting of a total or partial reproduction, imitation, translation, transliteration or transcription of a distinctive, identical or similar sign that is well known in the relevant sector of the public, owned by a third party, regardless of the goods or services to which the sign is applied, when its use and registration would likely cause confusion or a risk of association with such third party, or would imply an exploitation of the notoriety of the sign or the dilution of its distinctive force, regardless of the way or means through which the sign has become known;

Likewise, Article 15 provides that *“The registration of a trademark pursuant to this law grants its owner the right to the exclusive use of the same and to exercise before the courts the respective actions and procedures against whoever infringes his/her rights. It also grants the right to oppose to the registration and use of any other sign that may directly or indirectly lead to confusion or association between the goods or services, whatever the class in which they are included, provided that they are related to each other”.*

- ▶ *“That this Directorate considers that the trademark applied for is likely to cause confusion or trademark association in the consuming public; and falls under the grounds for prohibition provided for in paragraph “f” of Article 2 of Law 1294/98.”*

Conclusions

The conclusions drawn by DINAPI were wise and it continues to uphold its criteria at the time of issuing its Resolution, in order to prevent third parties from using a distinctive element protected by foreign owners not only in Paraguay but also in several countries around the world.

The comparison between trademarks must be carried out avoiding their division into parts, however sometimes it appears that the elements within the set are of such nature that one of them assumes a main role, as in this case is the word CANNA. Therefore, the reproduction of this word, even within other sets of trademarks, leads to the confusion of the consumer. This aspect was duly considered by the Office when issuing its decision.

Therefore, the present case serves as an example for trademark owners that by protecting their registered trademarks and using the mechanisms provided by the trademark law, may prevent third parties from registering and using similar trademarks to the extent of confusing the consumer.

by



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