

FERRERO ROCHER

Recognition of trade dress and distinctiveness of the figurative Trademark “bombón” in Uruguay.

Background

Ferrero is the owner in Uruguay of the brand Figurative, N° 393.728, Figurative, N° 359.365 and Device N° 393.728, that protects the products included in the international class 30.

In December 2010 it was learned that there were chocolates marketed by a Uruguayan company / importer, whose wrapper and “*trade dress*” was similar and confusable to that used by the “Ferrero Rocher” chocolate on sale in supermarkets.

Faced with this situation, Ferrero files a lawsuit against the company requesting the cessation of use of the packaging, the wrapping of the product, “*trade dress*”, unfair competition and claim for damages and losses caused.

RULING OF FIRST INSTANCE:
Condemn to cease on the use of the product due to “trade dress” similarities on the packaging.

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| Client | FERRERO S.P.A. |
| Trademark | Figurative, N° 393.728, Figurative, N° 359.365 and Device N° 393.728 , that cover the products in International Class 30. |
| Court | Judge of First Instance in Civil matters of 19th shift, Dra. Beatriz Tomassino Ferraro. |
| Court of Appeals | Court of Appeals in Civil matters of 4th shift. Editing Minister: Dra. Graciela Gatti Signing Ministers: Dr. Eduardo J. Turell Dra. Ana M. Maggi. |



Figurative
N° 359.365



Figurative
N° 393.728



Device
N° 393.728

By judgment No. 79/2012, the First Instance Judge Magistrate resolves to **accept the complaint and condemns the defendant to cease use of the mark in relation to the chocolate candy product with similar packaging, trade**

dress and presentation that the Ferrero Rocher chocolate or any other that may be confused with said product and condemns to pay the damages and losses incurred.

In this resolution, the elements that constitute infringement by trade dress are analyzed with precision, and the product confusion test is of special relevance. Such is so, that the ruling states *“the presentation of the product includes the elements of external conditioning and packaging of a merchandise that serve to distinguish it from another.”*

The Court emphasizes the importance of the figure of the trade dress in commercial practice, and the ways of granting legal protection to the appearance of products or services when they are a whole with distinctive aptitude. When making the comparison between the products, the remarkable similarity of the same stands out:

“In the present case, having both products at sight, the ROCHER brand chocolates and the chocolates of the defendant, the similarity is clear, in terms of the packaging of the product-its presentation-and also in its wrapping or dressing (trade dress)”;



“Contemplating the boxes of one and another product, one notices a well-known similarity between these, that have the same form (rectangular, the classic tree of the Ferrero Rocher chocolates); and in regard to each bonbon unit, there is also a similarity that leads to confusion, between the wrappers of one of these and the papers where they are placed, elements also distinctive of the mark of the plaintiff”.

RULING OF SECOND INSTANCE:

The Court of Appeals confirm the ruling of First Instance.

Ruling No. 79/2012 referred, was **appealed by the defendant** arguing that there was a wrong valuation of the proof due to Ferrero Spa did not prove correctly that the similarity of the products leads to confusion on the consumer.

Moreover, the Court of Appeals **maintained the arguments** referred to in the judgment of first instance by saying: *“It is clear that a sector of the public can be induced in error and acquire XX chocolates when their intention was to buy Ferrero Rocher chocolates. The name of the products themselves are not confusing, but the presentation of the same (trade dress); ... In our country, many examples of the subject covered by the figure of the trade dress have*

always been protected both by the laws of trademarks and by the regime of unfair competition. ... And resorting to the regulation of unfair competition the presentation or visual appearance of products and services have been protected against the copy of designs, styles, formats, colors, packaging, etc. by third parties that have sought to take advantage of another's prestige and generate confusion in the consumer to attract customers (quotation Juan Manuel Gutiérrez Carrau, ob.Cit., 2009, page 202)".

Ultimately, in this second instance, the arguments put forward by the Court, clearly highlight the figure of "trade dress" and therefore the importance of the appearance of the products involved to resolve disputes.

ADMINISTRATIVE MEANS: An annulment action was requested by the defendant and was proved that Ferrero Trademark is distinctive.

In January 2011, the defendant **filed an annulment action** with the National Directorate of Industrial Property (onwards DNPI) against the registration of the trademark Figurative, N° 393.728, considering that the design of the Ferrero chocolate is not fantasy, therefore, lacking novelty, specialty and distinctiveness. They claim that the DNPI suffered an error when granting the mark, since it is impossible to think that the wrapper of a chocolate and a candy cup could be considered a trademark. What is essential is the distinctiveness element as well as the individualization of the product, elements that are missing in the Ferrero Rocher chocolate. That the decision to grant the trademark is vitiated by nullity, as it is a generic and necessary term to distinguish the products in question.

Faced with **this action, this party evacuates the hearing of the annulment action**, stating that the action requested by the opponent is malicious, contrary to law, ethical principles and good customs. In addition, the Figurative, N° 393.728 brand meets all the requirements by law: novelty, specialty and distinctiveness. The originality of the design is indisputable, it presents special characteristics, it combines forms, colors and visual textures, all of which allows the consumer to identify it fully as an identifier of its origin and not as a necessary or generic representation of the type of product. The brand in question, is not a simple "wrap of a sweet on a paper", on the contrary, the sign presents sufficiently characteristic, distinctive, aesthetic, ornamental and novel elements that determines the fulfillment of the required trademark function. On the other hand, it is evident and indisputable that the trademark Figurative, N° 393.728 of Ferrero S.p.A is fully identified with its owner, allowing it to be distinguished from others of the same species.



It is important to consider that we are facing a notorious worldwide brand. Ferrero S.p.A. is a firm founded in 1946 and to date, is considered one of the largest chocolate industries in the world.

The aforementioned authority **did not give rise to the annulment action**, considering that the figurative mark No. 393.728 is a sign that has special characteristics that make it original, perfectly distinguishable from others, all of which allows the consumer to identify it fully with the firm Ferrero SpA. Understands that: *cannot be considered a misleading brand, since it is the same firm, owner of the notorious brand of chocolates, which on this occasion, extends the protection of its products to those detailed in the request for works, without it involve cheating the consumer. Consequently, since the configurative elements of the invoked cause are not proved, it would be appropriate not to make room for the nullity action filed.*

Conclusions

In Uruguay there is no specific regulation regarding the figure of the trade dress, this is increasingly used by the doctrine and jurisprudence to comprehensively protect the industrial property rights of those affected.

It is a great advance in the defense of industrial property rights and demonstrates once again the preponderant role that Uruguayan jurisprudence is having in the defense of the rights of brand owners, to avoid taking advantage of the prestige of others, always prevailing loyalty and commercial good faith in defense of consumer rights.

by:



**Dr.
Virginia Cervieri**

Senior Partner
vcervieri@cmlawyers.com.uy



**Dr.
Natalia Paladino**

Senior Partner
npaladino@cmlawyers.com.uy