

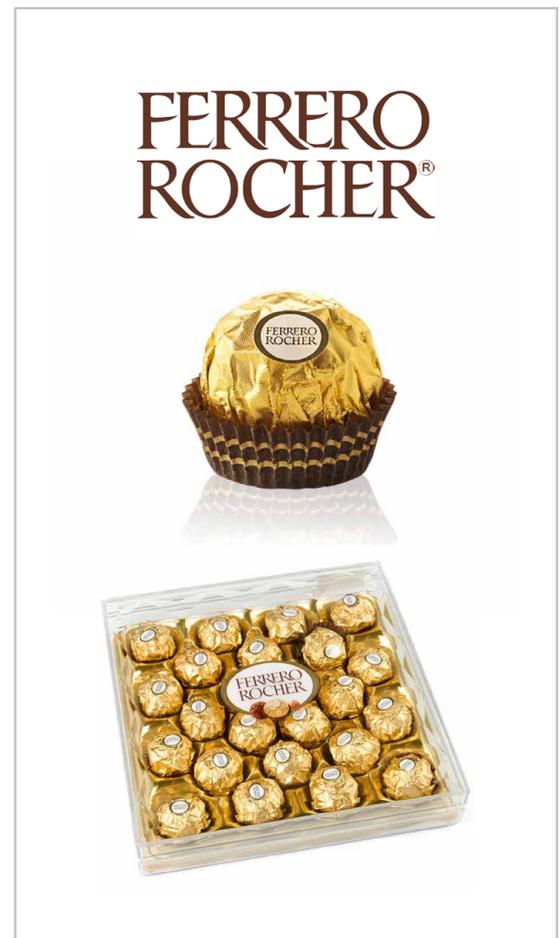
## **FERRERO ROCHER:** Unauthorized use of the three-dimensional trademark.

“Ferrero Rocher” represents a story of success of a family business, founded by Piera and Pietro Ferrero who after World War II transformed a pastry shop into Italy’s first manufacturing company. Together with their son Michele they launched their first products and Michele played a key role in the company’s expansion abroad. In 1956, the company expanded with a large factory in Germany, then France and other countries in Europe, becoming today a worldwide known brand with factories in different continents.

“Ferrero Rocher” is made with the best hazelnuts that are dipped in a smooth chocolate cream and surrounded by crunchy wafers and pieces of hazelnuts; whose presentation consists of a golden wrapper resting on a brown corrugated paper with golden lines. Becoming the famous golden chocolate.

### **The facts**

During the year 2021 we became aware by investigations performed that in the markets of the city of La Paz - Bolivia, chocolate sweets were being offered with a trade dress similar to FERRERO ROCHER sweets.



**FERRERO S.P.A., is the owner of three trademarks in Bolivia, among them a three-dimensional design trademark:**

**118272-C**, Three-Dimensional Design Trademark, Class 30, bakery and confectionery, chocolate and chocolate products.



Therefore, we investigated the origin of these products and obtained information about the company that imported them and its address.



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## **Actions taken**

In view of this situation, and having identified the importing company that was distributing the products to different markets in the city of La Paz, it was ordered to cease the use, distribution and commercialization of products imitating the FERRERO ROCHER trade dress, to provide information regarding the origin of the merchandise, to destroy the infringing merchandise and to pay the costs incurred.

The notarial notice had a positive result, the legal representative of the importing company contacted us in order to settle the matter out of court.

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## **About Trade Dress and unfair competition**

Trade Dress refers to the commercial appearance of a product or service, it protects the total image of the product, which may include patterns of colors, textures, sizes, drawings, shapes and the placement of words, graphics and decorations on the product or its packaging.

In Bolivia and under the regulations of the Andean Community - Decision No. 486 the figure of the Trade Dress is not recognized as such; however, it is part of the vast doctrine and case law on intellectual property and in countries such as Bolivia, its registration and protection is possible by registering a three-dimensional trademark.

The trade dress is a construct related to unfair competition, offices such as the Superintendence of Industry and Commerce (SIC) of the Republic of Colombia and the National Institute for the Defense of Competition and Protection of Intellectual Property (INDECOPI) of the Republic of Peru, have recognized that “*acts of unfair competition involve as well as trademarks, the appearance of products (or services) in the market (trade dress)*”<sup>1</sup>.

Therefore, based on the case law, on the grounds of articles 258<sup>2</sup>, 259<sup>3</sup> and 267 of Decision No. 486 and 267 of Decision No. 486 and paragraph 2) of article 69<sup>4</sup> of the Bolivian Commercial Code, it may be possible to take legal action before a Civil and Commercial Court for trade dress infringement of a product or service due to acts of unfair competition.

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## Out of court settlement

The out of court agreement included the following:

- ▶ the company acknowledged the infringement committed;
- ▶ changed the packaging and presentation of its product for one that does not imitate FERRERO ROCHER’s trade dress;
- ▶ provided information on the origin of the products;
- ▶ handed over the infringing products for its corresponding destruction;
- ▶ and reimbursed the expenses incurred.

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1. Prejudicial interpretation 110-IP-2016

2. Decision 486 – Article 258. - Any act related to industrial property performed within the business sector that is contrary to proper usages and practices is considered unfair.

3. Decision 486 – Article 259. - The following, among others, constitute acts of unfair competition involving industrial property: a) any act capable of producing confusion, by any means whatsoever, with respect to the business establishment, the products or the industrial or commercial activity of a competitor; (...)

4. Bolivian Commercial Code – Article 69.- A trader may be deemed to have committed acts of unfair competition if: 2) he/she makes use of assumed names, distorts known names or adopts distinctive signs that may be confused with the products, activities or advertising of other competitors.

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## **Destruction of the infringing products**

Following the signed out of court agreement, there were handed over several boxes of chocolates that were confusingly similar to FERRERO trade dress to be submitted to destruction.



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## **Conclusions**

- ▶ There were being commercialized in the market of the city of La Paz products that imitated and were confusingly similar due to its appearance (trade dress) to FERRERO ROCHER sweets.
- ▶ The origin of these products was investigated and the importer was identified, therefore we proceed to order the cease of the commercialization of the products imitating the FERRERO ROCHER sweets.
- ▶ It was obtained a suitable response to the written demand, solving the matter out of court
- ▶ The importer and distributor of the product in imitation of FERRERO ROCHER chocolates modified the appearance and packaging of the product, in order to ensure that it was distinctive and to prevent it from taking advantage of the positioning of the FERRERO ROCHER brand in the Bolivian market.

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