

Trade marks and brand identity newsletter

Haseltine Lake
celebrating
40 years in
Munich!

There's something about chocolate and trade marks

Branding is of critical importance in the highly competitive food and drinks sector and this year has seen a wide range of IP disputes of interest to those with a sweet tooth.

Slabgate

In June of this year luxury chocolatier Hotel Chocolat (HC) published allegations in the media that supermarket chain Waitrose had created a range chocolate of bars which too closely mimicked HC's range. In response to a series of tweets directed against it, swiftly dubbed #Slabgate by HC on social media, and threats of legal action, Waitrose agreed to stop producing its high-end chocolate slabs. HC is now triumphantly capitalising on its media momentum and offering "amnesty" exchanges to customers for the HC original. All returned copycat bars are donated to foodbanks.

KITKAT SPAT

The latest chapter in the one of the most famous chocolate wars between Nestlé and Mondelez over the registrability of the KitKat four finger shape as a trade mark has come to a close. On 25 July, the Court of Justice of the European Union (CJEU) issued its hotly anticipated ruling. Mondelez (parent company of rival Cadbury) challenged the EUIPO's decision to grant protection for the four-finger biscuit shape in the first place. The CJEU has now ruled that Nestlé has not sufficiently shown acquired distinctiveness across all 28 EU Member States and so protection should never have been granted.



This case joins a line of cases which illustrate the difficulties in registering confectionery shapes as trade marks, Lindt's gold bunnies being another example.

Meanwhile, Mondelez has announced that, after facing public outrage, its Toblerone bars will revert to their original shape, which is registered as a trade mark. Victory must be sweet, but Nestlé just cannot seem to catch a break!

Cool trade marks

This summery weather has made even the GC think about ice cream. Turkish confectioner Şölen launched a second appeal following dismissal of its opposition against an application for BOBO CORNET figurative mark featuring a rabbit holding a chocolate ice cream (right, top image). Şölen maintained the application was confusingly similar to its earlier registration OZMO CORNET for identical goods chocolate, cakes and chocolate creams (right, bottom image). The GC concluded that, in spite of the common word “CORNET”, there was no likelihood of confusion as the rabbit and BOBO elements created a sufficiently different impression. Given the clear descriptive meaning of “cornet”, this is an unsurprising, and sensible decision.

Cookie-shaped cushions

Meanwhile in Italy... the Milan Court found infringement of confectioner Barilla’s IP when textile manufacturer Italy Fashion s.r.l started selling cushions shaped like some of its best-selling breakfast biscuits.

The defendant argued that Barilla had no protection in place for textiles and that the biscuits themselves were common in the marketplace and only the packaging and overall get-up linked the products to Barilla in the mind of the consumer.

Nevertheless, the Milan Court concluded that Italy Fashion’s activities were “parasitical” and affected the origin function of Barilla’s rights. Hence it found in favour of Barilla and held Italy Fashion had infringed Barilla’s rights in the biscuit range.

And that is just the way the cookie crumbles.



Brexit: an update

As readers will be aware, negotiations between the UK and EU negotiators over a Brexit deal are ongoing. There have, however, been some welcome moves towards certainty in the area of trade marks and designs:

During a House of Commons debate on 19 July a Minister from the Department for Exiting the European Union announced that *“we have agreed to protect all existing EU trademarks, community-registered designs and unregistered designs in the UK as we leave the EU. In place of those EU-level rights, 1.5 million new UK trademarks and registered designs will be granted automatically and for free”*.

Following the publication of its Brexit paper in March, this is another clear signal that the Government agrees with the position proposed by the EU and provides welcome news for brand owners.

The UKIPO subsequently clarified that this is the position subject to agreement being reached and we await news on the Government’s position in the event of a “no deal” Brexit.

Contact us

For further information, please contact our Trade Marks Team:

E: hlmarks@haseltinlake.com

T: +44 (0) 117 910 3200