

Infringement of Trademarks Protecting the Form and Packaging Shape of Product

The recent decision no. 962 of June 4, 2008 of the Bucharest Tribunal set a precedent in Romania regarding the protection of the product form, and packaging shape of the product by registered trademarks.

The plaintiff, Ferrero SpA of Italy (“**Ferrero**”), is the owner of internationally well-known trademarks such as DUPLO, ROCHER, and KINDER BUENO. These products are protected by sixteen trademarks registered in accordance with the Madrid Agreement. These trademarks protect the form and packaging shape of Ferrero products. The above court decision held that the protection conferred to the form and packaging shape of the products by the registered trademarks of Ferrero is fully enforceable under Romanian law.

In the case under review, Ferrero asked the Court to oblige a Romanian importer to cease the import, and marketing on the Romanian market of the products carrying DIAMOND and GO FRESH trademarks produced by a Turkish manufacturer, to pay damages caused by the offering and marketing of such products, and to publish the Court decision in a newspaper.

The Court found that the defendant’s actions represent abusive acts and infringements of the plaintiff’s rights conferred by its registered trademarks given that the products sold under the names of DIAMOND and GO FRESH imitate the form and packaging shape of DUPLO, KINDER BUENO, and FERRERO ROCHER.

The plaintiff submitted evidence in the form of photos of the infringing product forms and packagings and of the products and packagings protected by Ferrero’s trademarks.

The Court further found that a visual examination of the graphic representation of the form and packaging shape of infringing products shows that they are almost identical with the plaintiff’s products protected by registered trademarks. Such infringements caused damages to Ferrero SpA, by creating a risk of confusion among the consumers between the plaintiff’s products and those imported and marketed by the defendant. Such practice is not permissible under Art. 35 (b) of the Romanian Trademarks Law no. 84 of 1998.

The Court also took into account as documentary evidence, the extra-judicial technical expert’s report submitted by Ferrero, which established the existence of the similarity of the products, and, implicitly, the risk of confusion generated by the imitation of Ferrero’s product forms and packagings. Specifically, the counterfeited product GO FRESH imitates the shape of the DUPLO chocolate protected by Ferrero’s registered trademark, while the packaging imitates the packaging of KINDER BUENO, also protected by a Ferrero trademark, which depicts a bar of chocolate with cream and hazelnuts and a glass of milk. Also, the counterfeited product DIAMOND - hazelnut chocolates - imitates to the smallest details, the design of the box of chocolates, the label on the box, the individual packaging of every piece of chocolate and the shape of the ROCHER chocolates. While comparing the products, it could also be easily noticed that the arrangement of the chocolates within the box is identical. The label of the products marketed by the defendant contains the same elements as Ferrero’s products, i.e. packed chocolates, chocolates with hazelnuts with a leaf on the package. Therefore, the expert established that the marketed products imitated not only the form of Ferrero’s products, respectively the chocolates, but also the packages in which the chocolates are marketed, packages which are protected by Ferrero’s trademarks. Such trademarks have a double role: (1) to protect the market of Ferrero products, and (2) to protect the consumers from counterfeited products.

The Court pointed out that according to Art. 35 (2) and Art. 83 (2) of the Romanian Trademarks Law, it is prohibited to use, without the consent of the owner of the trademark, a sign which, given either the identity or the similarity of the products or services to which the sign is affixed with the products or services for which the trademark was registered, could create in the perception of the public a risk of confusion, including the risk of association of the trademark with the sign. Based on these provisions, the owner of the trademark may apply to the courts of competent jurisdiction for protection against third parties which are offering, selling, importing, or exporting their products, or services, under such infringing sign.

The Court concluded that the activity carried out by the defendant, i.e. the trading of the products GO FRESH and DIAMOND in their current form, creates confusion with the products of the plaintiff and, consequently, represents an infringement of the rights of the plaintiff resulting from the registration of its trademarks, facts which caused damages to the plaintiff. Therefore, the Court granted the action filed by the plaintiff and compelled the defendant to cease the use, the offering, and sale activities of products bearing GO FRESH and DIAMOND trademarks, obliged the defendant to pay damages, and court costs, and to publish the Court decision in a newspaper on its own expenses.

Corina Papuzu
Attorney-at-law

Buzescu Ca
For more information please visit www.buzescu.com