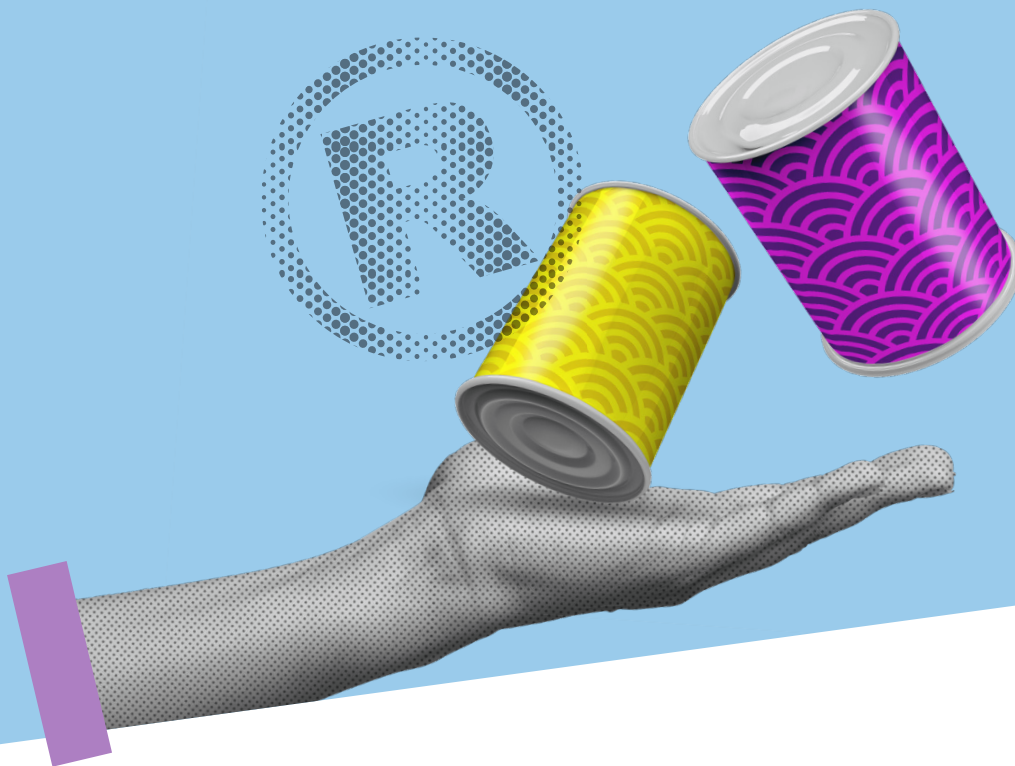




JULY 2024

PROTECTION OF PACKAGING THROUGH TRADEMARKS: A SUCCESSFUL CASE STUDY

Packaging is of paramount importance in the commercialization of products.

A visually appealing packaging is more likely to sell better because it catches the customer's eye and is easy to remember.

The market is crowded with products that have gained worldwide renown thanks to their legendary packaging, but also with products that evoke that packaging in the attempt to ride the wave of its success.

Protecting packaging through IP rights is therefore a key factor in marketing strategies.

Here we wish to focus our attention on **packaging protection through trademarks**, and more particularly to a recent case where **a client of ours has successfully achieved all-round protection for their packaging** within the EU territory.

The family-owned Italian company Rondolino Società Cooperativa Agricola – hereinafter for brevity 'Rondolino' – has been active in the rice-growing sector since 1935 and for over three decades has been particularly dedicated to the production of a special rice variety named

'**Acquerello**' that is grown, processed and packaged on the family farm and is sold in over 70 countries all over the world.

Several famous chefs have expressed their enthusiasm for the 'Acquerello' rice, including Alain Ducasse, who has called it "the Rolls-Royce of rice varieties".

The first protection of the word mark 'Acquerello' in Italy dates back to as early as 1991 and protection was then progressively extended to other countries of interest.

With the increasing widespread of Rondolino's flagship project 'Acquerello', Rondolino became afraid that third parties may profit from their success by using packages whose combination of colours and/or graphic elements might evoke the iconic tin can in which the 'Acquerello' rice is sold, which until a short time ago was protected only in Italy and only as shape trademark.

Rondolino therefore came to the decision to protect the unique appearance of 'Acquerello' tin can in order to prevent competitors from exploiting its powerful marketing and communication work done over the years to promote not only the quality, but also the image, of its main product.

The **strategy proposed by Interpatent** in this respect was a multilateral approach to the issue that involved simultaneous filing of several trademark applications with the EUIPO (European Intellectual Property Office).

The filing of three applications for different types of trademarks has enabled our client Rondolino to enjoy a level of protection that could not have been attained by filing one of such applications.

A first aspect consisted in protecting the tin can as a whole, by filing a **3D trademark application** covering the overall visual impression given by the packaging – i.e. the combination of graphic elements, shape, colours and wordings – and not the shape of the tin can alone. Of course, descriptive elements such as 'IL RISO' ('THE RICE') appearing on the package were deleted from the views to be filed at the EUIPO.

EUTM Trademark Application No. 018945197 filed on 2 November 2023 and granted on 22 May 2024



To enhance the level of protection, the second aspect was filing a colour trademark. To do so, we had to identify the colours that are most representative of Rondolino's packaging and communication, determine the percentages in which said colours are present in the logo and packaging, provide the Pantone code of each of said colours and indicating the sequence of said colours, by specifying also the direction in which said colours are arranged (e.g. from top to bottom, from right to left, and so on).

In this connection, it should be noted that EUIPO rejects colour combinations that are not original or refer directly some features of the product to be distinguished or consist of colours customarily used in practice with reference to certain products, such as, for example, red for fire extinguishers, green for

eco-friendly products, yellow for lemon-based products.

EUTM Trademark Application No. 018945190 filed on 2 November 2023 and granted on 17 February 2024



Last but not least, as a third aspect, a **position trademark** application was filed.

According to EUIPO, position trademarks are trademarks "consisting of the specific way in which the mark is placed on or affixed to the goods", where the term 'mark' includes words, patterns, graphic motifs, 3-dimensional images and the like.

In this case, the application aimed to protect the specific position of the image of Rondolino's family farm, which always appears in the middle horizontal strip of all Rondolino's 'Acquerello' rice cans.

EUTM Trademark Application No. 018945189 filed on 2 November 2023 and granted on 29 February 2024



The above case study is of course not exhaustive of all the aspects and possibilities involved in packaging protection by means of IP rights, but it certainly stresses the importance of carefully evaluating the strategy to protect not only clients' products themselves, but also the packaging in which they are marketed.

BIG MAC BEFORE COURT: A HISTORY OF USE AND LAPSE

The news is all over the newspapers: from what we read it would appear that the giant McDonald's has been deprived of the possibility of using its 'BIG MAC' trademark.

However, not everything one reads is true: being in the age of fake news, one has to look deeper into the matter.

Let's start from the beginning.

In 1996, McDonald's International Property Company, Ltd. (hereinafter Supermac's) filed a EUTM application for 'BIG MAC' (word mark) for goods and services in classes 29, 30 and 42.

Over 15 years later, the Irish company Supermac's (Holdings) Ltd filed a EUTM application for 'SUPERMAC'S' for goods in class 30.

McDonald's then filed an opposition against 'SUPERMAC'S' claiming a risk of confusion with their own trademarks.

As a reaction thereto, in 2015 Supermac's filed a cancellation action against the trademark 'BIG MAC' before the EUIPO for non-use claiming that said trademark had not been effectively used for the distinguished products indicated upon filing for a continuous period of five years.

In reply, McDonald's submitted proofs of use, especially with respect to Germany, France and the United Kingdom (which at that time was still an EU Member State), but these proofs mainly consisted of so-called internal documents, i.e. company documents such as affidavits, advertising brochures and posters and extracts from their websites and Wikipedia pages.

As the evidence provided was not supported by other 'external' elements such as invoices, newspaper articles and the like, the EUIPO's Cancellation Division, considered it insufficient as failing to prove effective and genuine use of the 'BIG MAC' trademark.

The EUIPO thus granted the request for cancellation submitted by Supermac's and declared the 'BIG MAC' trademark lapsed for

non-use in respect of all the goods and services covered by it.

McDonald's, however, did not give up and appealed against such decision. The EUIPO's Board of Appeal partially annulled the decision of the Cancellation Division and declared that the 'BIG MAC' trademark should not be considered lapsed in respect of some goods, including 'edible sandwiches', 'meat sandwiches' and 'chicken sandwiches'.

Supermac's in turn appealed to the Court of Justice of the European Union (CJEU) requesting that the decision of the EUIPO's Board of Appeal be overturned. Particularly, Supermac's challenged this decision with respect to edible sandwiches and chicken sandwiches by claiming that no effective use thereof had been proved by McDonald's.

The CJEU did, in fact, agree with Supermac's, stating that no sufficient evidence of effective use had been submitted by McDonald's with regard to the products 'chicken sandwiches' and 'foods prepared from poultry products' as well as to services 'associated with operating restaurants, drive-through facilities and preparation of carry-out foods'.

According to the CJEU, McDonald's did not provide any indication as to the extent of use of the trademark 'BIG MAC' for such goods and services, especially as far as the volume of sales, the duration of the period in which the acts of use were carried out and their frequency are concerned.



In the end, McDonald's indeed lost protection of their trademark for the products mentioned in the penultimate paragraph above, but – we would add – 'only' for them and not for all the products for which protection was sought in 1996.

Although media reports claim that McDonald's has lost its rights to the 'BIG MAC' trademark, this is only true for chicken sandwiches and other

chicken-based foods. Instead, McDonald's will be able to use it for the famous meat sandwiches for which the name BIG MAC is known worldwide.

The lesson we can draw from this case is that not even the reputation McDonald's enjoys has allowed it to win on all fronts: no matter how famous one is, the same burden of proof is imposed upon all trademark owners when it comes to proving genuine use of their rights.

UNIFIED PATENT COURT (UPC): OPENING OF THE MILAN SECTION OF THE CENTRAL DIVISION



A new section of the **Central Division of the UPC's Court of First Instance** opened in Milan, Italy, on 27 June 2024.

Until then, only a Local Division had been operating in Milan, responsible for handling actions for or relating to infringement, counterclaims for patent invalidity, provisional and protective measures and injunctions, and damages or compensation.

As you know, the UPC's Central Division with its main seat in Paris and its Munich and Milan sections deals with actions for revocation or non-infringement.

Specifically, the Milan section of the UPC's Central Division will handle cases concerning patents in IPC class A (**Human Necessities**), with the exclusion, however, of Supplementary Protection Certificates, which fall within the competence of the Paris section.

The aim of this newsletter is to keep our Clients and Associates updated about developments in the sector of Intellectual Property in general and our firm in particular. In this way, we wish to provide a broader view of the tools that the field of trade marks, domain names, patents, designs and related rights offers to entrepreneurs to enhance and protect their efforts in researching and developing new solutions and ideas.



Members of FICPI and AIPPI

INTERPATENT Studio Tecnico Brevettuale S.R.L. - Registered Office Via Caboto, 35 - 10129 TORINO - Share Capital € 50000
Company Register of Torino 08327040013 - Fiscal Code and VAT Registration Number 08327040013
REA (Economic and Administrative Index) Number 963838

email@interpatent.com - www.interpatent.com