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Shape of Ferrero Rocher chocolate and packages registered as 3D marks Examination/opposition
Israel - Gilat, Baret & Co, Reinhold Cohn Group National procedures

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The deputy registrar has allowed the registration as three-dimensional (3D) trademarks of the shape of the Ferrero Rocher chocolate praline and of four transparent packages containing the chocolate pralines (Applications 198944 and 199650 to 199653 in the name of Ferrero SpA, January 16 2011).

Ferrero SpA, the manufacturer of the Ferrero Rocher chocolate pralines, applied for the registration of the following 3D marks:

- the shape of the Ferrero Rocher chocolate praline (Application 198944):



- four transparent packages containing the chocolate pralines (Applications 199650 to 199653):



The examiners at the Trademarks Office refused to register the marks on the grounds that they consisted of a 3D description of the design of the products/packaging and, therefore, were ineligible for registration.

However, the deputy registrar subsequently allowed the registration of the marks. First, the deputy registrar was satisfied that Ferrero had no intention of claiming exclusivity for the product itself or for the separate elements constituting the packaging. The deputy registrar held that, despite being three-dimensional, the marks at issue did not depict the product design itself.

Observing that Ferrero sought to protect the get-up of the product (which is ordinarily protected under the laws of passing off), the deputy registrar confirmed that such protection was also available under the trademark laws by way of registration of the product get-up.

The deputy registrar allowed the registration of the marks based mainly on:

- the proof, by way of a consumer survey, that the get-up at issue was well known and that the public identified it with Ferrero; and
- Ferrero's longstanding use of the image of its chocolate praline as a trademark.

The deputy registrar observed that the image of the chocolate praline was printed on the packaging of the product alongside the product name. The deputy registrar held that the picture was not descriptive of the content, but was used as a trademark, due to the fact that the packaging was transparent and that there was no need to add a description of the product.

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The deputy registrar also relied on Ferrero's declaration that it did not seek exclusivity with respect to the elements of the product get-up taken separately, but with respect to the get-up as a whole. The four packages were thus registered subject to a disclaimer.

The decision joins a growing case law on the registrability of product shapes, and seems to be in line with the guidelines laid down by the Supreme Court in the *Toffifee* case (for further details please see "[Product configuration cannot be registered based on inherent distinctiveness](#)"). Interestingly, in the same week the deputy registrar issued another decision refusing to register 3D marks.

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