

Victory for Ferrero in Tic Tac shape mark case

Simone Verducci Galletti

Bugnion SpA

15 June 2023



ITALY

Legal updates: case law analysis and intelligence

- After Ferrero sued Mocca for infringement of its shape mark for the Tic Tac packaging, Mocca argued that the mark was invalid
- The case went all the way to the Court of Cassation, which confirmed that Ferrero's 3D mark was valid
- The court clarified the distinction between a "necessary shape" and a "substantial shape"

The Italian Court of Cassation has issued an intriguing ruling on the validity and infringement of shape marks (Case No 11531/2021), affirming the validity of the three-dimensional (3D) mark relating to the shape of the Tic Tac box.

Background

Ferrero SpA brought an infringement action before the Court of Turin, seeking a declaration that its shape mark for the packaging of the Tic Tac sweets had been infringed by Czech company Mocca spol sro's packaging for its Bliki product. The decision of the Court of Turin, which was the subject of the present cassation ruling, was issued in 2019.



In its defence, Mocca requested the invalidation of the 3D trademark, arguing that the shape of the Tic Tac box was necessary to achieve a technical result and was thus functional. Mocca also mentioned the existence of four previous patents protecting the shape. However, both the Court of Turin and the Court of Cassation rejected these arguments.

Court of Cassation decision

The Court of Cassation reaffirmed that Article 9 of the Italian Intellectual Property Code states that a "shape" cannot be registered as a trademark if it is necessary to obtain a technical and functional result.

In particular, the court clarified the distinction between a "necessary shape" and a "substantial shape": a "necessary shape" is one that is needed to achieve a technical result and is inseparably connected to the utility of an invention, while a "substantial shape" is a shape that adds substantial value to the product without changing its function. The court emphasised that the imitation of a "necessary shape" is lawful if there is an element of inseparability and necessity, while the registration of a "substantial shape" as a trademark is questionable.

The Court of Cassation thus confirmed the assessment of the court of first instance, which had correctly determined that the shape of the Tic Tac packaging was extrinsic to the product and did not constitute an indispensable characteristic of the packaging. Such confirmation of the validity of the trademark indicates that it clearly distinguishes the shape from the manufactured product. As a result, the Court of Cassation concluded that Ferrero's 3D trademark for its Tic Tac packaging was valid and infringed by Mocca's product.

Comment

This judgment is significant because it specifically addresses the validity and infringement of 3D trademarks that are based on the shape of the packaging of a product, rather than the product itself. It is noteworthy that the position of Italian and EU case law on the matter is more favourable and permissive than in the case of 3D trademarks based on the shape of the product itself.

Simone Verducci Galletti

Author | Partner

simone.verducci@bugnion.eu

Bugnion SpA