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Common English word for alcoholic drink held not to be descriptive

Examination/opposition

National procedures

Slovenia - ITEM d.o.o

June 25 2010

In *Pivovarna Laško dd v Slovenian Intellectual Property Office* (Case I U 1087/2009, March 9 2010, only recently released), the Administrative Court has set aside a decision of the **Slovenian Intellectual Property Office** (SIPO) in which the latter had refused to register the trademark CIDER for goods in Classes 30, 32 and 33 of **Nice Classification** on the grounds that it was partly descriptive and partly deceptive. The court remitted the case back to SIPO for further consideration.

In 2008 Slovenian company **Pivovarna Laško dd** applied for the registration of the word mark CIDER (Application 200871194) for goods and services in Classes 30, 32, 33, 35 and 39, including "non-alcoholic fruit beverages, fruit drinks and fruit juices" in Class 32 and "alcoholic beverages (except beer), alcoholic mixed fruit drinks" in Class 33.

In 2009 SIPO refused to register the mark for all the goods in Classes 30, 32 and 33. In particular, it held that the mark consisted merely of the word 'cider', a common English word meaning "a beverage made from juice pressed from apples". Therefore, the mark was exclusively descriptive of beverages made of apples and misleading for other beverages.

Pivovarna appealed to the Administrative Court.

The court first held that, to determine whether a word in a foreign language is descriptive or deceptive, one must establish the extent to which that language is known in Slovenia - in particular, whether the word is known by consumers, and how often it is used in the course of trade. The court further held that the English word 'cider' would not be understood by the average Slovenian consumer, because this particular alcoholic beverage is not sufficiently present in the Slovenian market.

The judgment of the court is rather surprising: it is contrary to established case law of SIPO, which regularly refuses to register trademarks consisting of common English words describing the goods and/or services covered by the mark. The court correctly held that it

should take into consideration the extent to which the foreign language and the word at issue are understood in Slovenia. Therefore, it is striking that the court concluded that the word 'cider' would not be understood in Slovenia - especially in light of the fact that the English language is the most widely known foreign language in Slovenia. Furthermore, contrary to the court's findings, cider is consumed in Slovenia.

It will be interesting to see how SIPO will rule in this case in the renewed procedure. If SIPO follows the court's view, the current practice will be altered significantly. This, in turn, may lead to an increase in applications for the registration of descriptive marks in English or other languages. However, SIPO may still refuse to register the mark, but give additional reasons for the refusal.

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