

Court finds that GLENETT trademark does not evoke Scotch Whisky GI

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Introduction

The Patent and Market Court (PMC) recently decided that the trademark GLENETT could be registered, even though it included the element 'glen', which – according to the Scotch Whisky Association – was closely associated with the registered geographical indication (GI) Scotch Whisky. The Scotch Whisky Association had asserted that the trademark GLENETT would evoke an association between any products bearing the trademark and the GI in the minds of the relevant public and would thus result in a false perception as to such products' origin. By applying the ECJ's decision in *Glen Buchenbach* (C-44/17), the PMC dismissed the opposition.

Facts

The Swedish Trademarks Office granted protection to the trademark GLENETT in relation to various types of alcoholic beverage. The Scotch Whisky Association filed an opposition, claiming that the trademark evoked the geographical origin of Scotch Whisky and that its use would give consumers a false perception as to the products' origin.

The Swedish Trademarks Office dismissed the opposition on the grounds that the word 'glen' had no conceptual meaning for the informed consumer and that there was no conceptual similarity between the trademark GLENETT and Scotch Whisky. Therefore, it was unlikely that consumers, when perceiving the trademark, would make a direct reference to the GI.

The Scotch Whisky Association appealed the decision to the Patent and Market Court and requested that the trademark's registration be annulled.

Decision

Chapter 2(7)(5) of the Trademarks Act stipulates that a trademark which "contains a protected geographical indication" may not be registered. The rule implements Article 4(1)(i) of the EU Trademark Directive (2015/2436/EU).

The PMC found that such wording would only hinder a trademark if it explicitly contained the protected GI. However, Article 4(1)(i) of the EU Trademark Directive states only that trademarks which are excluded from registration pursuant to EU legislation on GIs will not be registered (or, if registered, invalidated).

According to EU Regulation 2019/787, GIs for spirit drinks (eg, Scotch Whisky) are protected against "any misuse, imitation or evocation" of the GI.

The PMC found that an interpretation of the Trademarks Act which considered the EU Trademark Directive provided a broad interpretation of "contain". Therefore, the evocation of a GI by a trademark's conceptual similarity would be sufficient for such trademark to be denied registration.

The PMC referred to *Glen Buchenbach*, which clarified that the decisive criterion is whether, when a consumer is confronted with a disputed designation, the image triggered directly in their mind is that of the product whose GI is protected.

The PMC shared the Swedish Trademark Office's reasoning that:

AUTHOR

[Annalena Nordin](#)



- the trademark GLENETT was neither visually nor phonetically similar to the GI Scotch Whisky; and
- there were no conceptual similarities between the trademark and the GI, as 'glen' had no conceptual meaning for Swedish consumers.

Therefore, the trademark GLENETT did not evoke the GI in such a way as to justify the trademark's refusal. The market survey and further evidence submitted by the Scotch Whisky Association led to the same assessment.

Comment

The PMC's decision took a different direction to that of the Hamburg District Court, the referring court in *Glen Buchenbach*, which ruled in favour of the Scotch Whisky Association, finding that the use of the term 'glen' was liable to falsely convey to the average European consumer the impression that whisky which bore the trademark GLEN BUCHENBACH was Scotch whisky.

A possible reason for the different decisions is the fact that the trademark GLENETT is a fantasy word which comprises the elements 'glen' and 'ett', rather than two separate words – 'glen' and a word which evokes a geographical place (Buchenbach). The composite mark GLENETT may make a different overall impression to a mark which comprises the combination of the word 'glen' and another word element.

Further, the PMC had to consider only the relevant Swedish sector of consumers in the question of the trademark's registration, while the Hamburg District Court had to consider the average European consumer. Besides, 'glen' is a Scottish term that refers to a particular type of mountain valley. The PMC apparently deemed Swedish consumers to have no conceptual idea of the word, so it was therefore found to make no clear reference to Scotch Whisky.

It remains to be seen whether the Swedish case will be appealed.

For further information on this topic please contact [Annalena Nordin](mailto:annalena.nordin@westerberg.com) at Westerberg & Partners Advokatbyrå Ab by telephone (+46 8 5784 03 00) or email (annalena.nordin@westerberg.com). The Westerberg & Partners Advokatbyrå Ab website can be accessed at www.westerberg.com.

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