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Generous scope of protection for HALLOUMI designation of origin

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Introduction

This case concerns a trademark application for the device mark "Falloumi!" which was refused after opposition based on the protected designation of origin Halloumi.⁽¹⁾

Protection as designation of origin covers the term used to describe foodstuffs which are produced, processed and prepared in a specific geographical area and the protected form is an absolute ground for refusal of trademarks. Compared to trademarks, designations of origin have a broader scope of protection and the overall evaluation in an opposition based upon a designation of origin differs from the evaluation of risk for confusion that is carried out in oppositions based on earlier trademark rights.

The case highlights the difference in purpose and scope of protection between trademarks and designations of origin. This is especially of note in view of an earlier decision between the same parties, in which the EU collective trademark registration for HALLOUMI did not constitute a bar against the word mark "Falloumi".

Facts

A company was granted trademark registration for the below device mark.



Figure 1: "Falloumi!" device mark

The registration covered services in class 43, which includes restaurant services, bar services, café services and catering services.

The Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi filed an opposition based on:

- its earlier EU collective word mark HALLOUMI for cheese in class 29;
- the well-known status of the trademark; and
- the designation of origin Halloumi.

PRV decision

The Patent and Registration Office (PRV) rejected the opposition and upheld the registration. The PRV found that:

- there was no likelihood of confusion;
- the foundation had not shown that the collective mark was well-known; and
- the trademark Falloumi! did not allude to the protected designation of origin.

Accordingly, the PRV rejected the opposition.

The decision was appealed to the Patent and Market Court (PMC).

PMC decision

In its appeal, the foundation only relied upon the designation of origin and argued that trademarks and designations of origin are different types of rights with different purposes and scopes of protection. The assessment carried out by the PRV had excluded the crucial test of whether the device mark Falloumi! fell within the scope of protection for the designation of origin.

In the decision, the PMC initially referred to CJEU case law stating that an overall assessment of all relevant circumstances must be conducted to determine whether a trademark alludes to the designation of origin. The decisive factor was whether use of the trademark gave rise to a clear link between the mark and designation of origin. If the trademark caused the average consumer to immediately think of the designation of origin, the use would be considered an unlawful evocation of the designation.



JOANNA
WALLESTAM



HELENA
WASSEN
ÖSTRÖM

The Court held that there was a visual and phonetic similarity between the trademark and designation of origin and that Falloumi! could be seen as a play on words for the word "Halloumi". The Court further found that all services covered by the trademark registration were similar to a certain degree to the cheese covered by the designation of origin.

Taking into account the visual and phonetic similarity between Falloumi! and Halloumi, as well as the link between the services and the product (cheese) covered by the designation, the Court concluded that the average consumer would associate the device mark Falloumi! with Halloumi. Consequently, the use of the trademark constituted an unlawful evocation of the designation of origin. The Court therefore annulled the PRV's decision and the registration for Falloumi! was revoked in its entirety.

Comment

The PMC's decision is obviously a huge win for the foundation and it confirms the strong protection provided for designations of origin.

A few years earlier, the foundation was unsuccessful in an opposition against the application, filed by the same applicant as in the present case, for the word mark FALLOUMI filed for the product falafel in class 29.⁽²⁾ The main difference between the two cases is that the foundation, in the earlier case, had only relied upon its registered collective EU trademark for Halloumi and the well-known status of that mark. The designation of origin was not registered until after the earlier case had already been initiated and the foundation was therefore not able to rely on it as basis in those proceedings. The fact that the foundation was able to rely on the protected designation of origin in the present case is clearly a key factor for winning.

The case is an important reminder of the different purpose and scope of protection between trademarks and designations of origin, as well as the difference in evaluation that comes into play when these types of rights are relied upon as basis for actions against third parties' trademarks.

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Endnotes

(1) PMC, PMÄ 12476-23.

(2) PMCA judgment, case PMÖÄ 5507-20, 16 December 2021.