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Portugal: Recent Decision of Appeal Court on “misleading trademarks”

João Paulo Mioludo (CMS Rui Pena & Arnaut) · Wednesday, March 16th, 2016

The Lisbon Court of Appeal has recently confirmed a decision – debatable, as we will further develop – from the IP Court.

In this matter, a wine company owns a trademark “QUINTA DE PANCAS”, which refers to a wine producing. The bottles in which these wines are commercialized show an image of a manor, the so-called “SOLAR DE PANCAS”, which is situated inside the “QUINTA DE PANCAS”.

The question here revolved around the fact that the so-called “SOLAR DE PANCAS” is not owned by the wine company, but by an individual person. During several years, the bottles of “QUINTA DE PANCAS” have been sold with that image and no consent from the individual person was needed.

Recently, the wine company decided to broaden its activity and for that reason filed several trademarks, one of which contained the element “SOLAR DE PANCAS”, for “*wines*” (class 33), “*cultural activities*” (class 41) and “*restoration services (food); temporary accommodation*” (class 43).

In view of a conflict with the wine company and despite having tacitly accepted the use of the designation and image of “SOLAR DE PANCAS” by the wine company, the individual person decided to oppose the new application, alleging that it would be a misleading trademark. The opponent claimed that the applicant is not the owner of the “SOLAR DE PANCAS” and that the covered goods and services may not be registered in connection with the mentioned manor.

The Portuguese PTO took the following curious decision: it granted the trademark “SOLAR DE PANCAS” in relation to “*wines*” (class 33), but refused the trademark in relation to “*cultural activities*” (class 41) and “*restoration services (food); temporary accommodation*” (class 43). According to the PTO, the trademark is not misleading in relation to wines, since the owner of the manor tacitly accepted the use by the wine company of the designation and image of the “SOLAR DE PANCAS”. On the other hand, the PTO considered that the trademark is misleading concerning the above-mentioned services, as it would not be possible to render these services in the manor at stake.

The described decision has been followed and confirmed by the decisions of the IP Court and of the Appeal Court.

These decisions leave room for discussion, as it is not clear why the trademark is deemed to be misleading in relation to these services, but not in relation to wines.

If the main consideration to find it misleading focuses on the fact that the owner of “SOLAR DE PANCAS” is not the owner of the trademark, this should also be an argument to consider it misleading concerning any other goods or services. In this sense, to ascertain whether the consumer will be misled or not, it is not important if the individual person accepted or not the use “SOLAR DE PANCAS”, since this is not an information that will be transmitted to the consumer.

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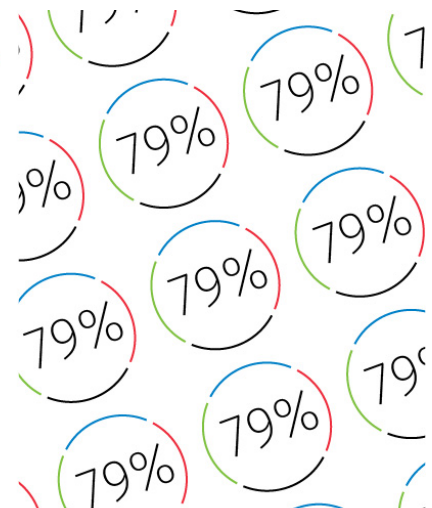
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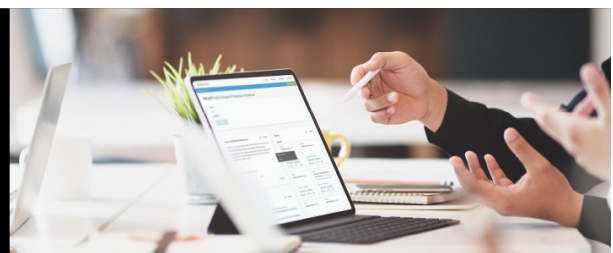


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