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Why is legal assessment vital even in the early stages of marketing?

Michaela Ring (Hoffmann Eitle) · Thursday, June 2nd, 2016

The General Court decided on 14 April 2016 (T-20/15) that the “PICCOLO” trademark of a German producer of sparkling wines had not been used in a right-preserving way. Just as in my last contribution, it is again a producer of beverages who is at the center of a trademark dispute.

The German producer of sparkling wines, Henkell & Co. Sektkellerei KG (hereinafter: Henkell), is the proprietor of European Union wordmark “PICCOLO”, no. 00952770, registered for the goods and services “alcoholic beverages (except beers), in particular wines, still wines, sparkling wines, herb wines and vermouths, and spirits” in class 33 and “providing of food and drink; temporary accommodation” in class 42.

After the Italian producer of sparkling wines, Ciacci Piccolomini d’Aragona di Bianchini Società Agricola (hereinafter: Ciacci), had the EU word mark “PICCOLOMINI” filed for the goods “alcoholic beverages (except beers)” in class 33, Henkell lodged an opposition against the EU trademark application “PICCOLOMINI” on the basis of its earlier EU mark “PICCOLO”. As grounds for its opposition, Henkell set forth the obstruction to registration as stipulated in Art. 8 I b CTMR. On the request of the adverse party, Henkell also submitted proof of use for the trademark PICCOLO / PIKKOLO (hereinafter: PICCOLO) for sparkling wines in several Member States. Upon this, the EUIPO held that Henkell had furnished proof of genuine use of this earlier mark and allowed the opposition, but the Board of Appeal later reversed this decision upon the appeal by Ciacci.

Henkell filed an action against this decision asserting violation of Art. 42 II CTMR, but again did not prevail. On the contrary, the General Court decided on 14 April 2016 that Henkell had failed to abide by the compulsion of genuine use of the mark “PICCOLO”.

The Court held that the trademark “PICCOLO” was not used as a trademark, i.e. corresponding to its main function which is to guarantee the identity of the origin of the goods or services for which

it is registered. Rather, the Court found that the specific manner of representation of the expression “PICCOLO” only indicated the size of the bottle, and was therefore only used in a descriptive manner. As might be known to the average reader, the term “PICCOLO” is often associated with a small-sized, sparkling wine bottle. However, the Court took its decision irrespective of the question of whether “PICCOLO” as such is a technical/descriptive term commonly used in the winery sector for small sparkling wine bottles.

To the contrary, the Court focused primarily on the graphical representation of the sign “PICCOLO” on the bottle and the packaging. The Court substantiated this opinion using a remarkable degree of details as to the configuration of a PICCOLO bottle. “PICCOLO” had not been presented in an emphasized manner on the sparkling wine bottles and for this reason would not attract the attention of the consumer. On the contrary, it is the sign “HENKELL” that appears as the predominant sign, both on the products and on the packaging. Since the term “HENKELL” is shown in the uppermost position on the label on the neck of the bottle highlighted by a banner and is written in large bold letters on the label in the center of the bottle, “HENKELL” was regarded as the actual trademark of the product. The designation “PICCOLO” only appears further below in smaller print and in conjunction with the descriptive term “dry sec”. The closeness and similar graphic design of the two designations reinforces the impression of the descriptive nature of “PICCOLO”. Therefore, the expression “PICCOLO” has just a secondary or ancillary character to the average consumer who will associate this with a 0.2 liter bottle. Thus it was not “PICCOLO” that was used as a trademark, but “HENKELL”.

What can we deduce from this judgement? Is there any significance for the IP practice? Perhaps this judgement could be seen as a “wake-up call” for companies planning to launch a new product.

The initial filing and potential infringements are not the only times when the assessment of an IP professional should be sought – it is vital that an IP lawyer is included in the entire marketing strategy from the very outset and throughout the “life span” of a product. Thus, it can be avoided that, for instance, the kind of graphical representation turns out to be detrimental to a trademark right.

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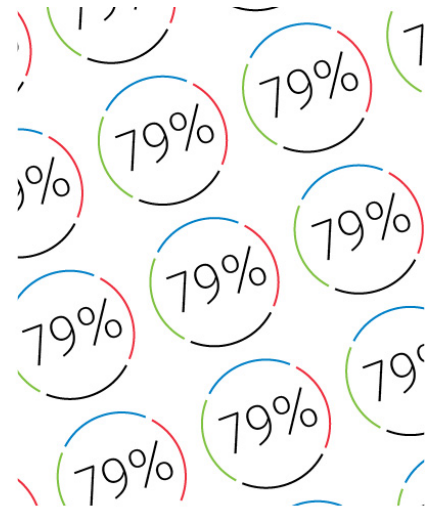
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