

CRUFI: "CRUFI BLACK" vs. "CONO BLACK: not confusingly similar.

CRUFI S.A. is a Uruguayan company engaged in the industrialization and commercialization of ice cream and desserts, known for its wide variety and high level of quality.

The company's vision is to become a leader in the Uruguayan market and to expand to other markets in the region. The sole proprietorship X is the importer and seller of CRUFI products in the Bolivian market, located in the city of Santa Cruz de la Sierra.

Facts

In 2019, the owner of the company X was notified of a claim for infringement of industrial property rights filed by "Compañía de Alimentos (CAL) Ltda", a Bolivian company engaged in the manufacture and marketing of ice cream, dairy products and beverages. The trademark that distinguishes this company is called "DELIZIA" and in turn owns other trademark registrations to distinguish the variety of its products.

Accordingly, CAL, under trademark registrations "Cono Black" (name and design) No. 156500-C and "Delizia Helados Cono Black" (name and design) No. 182359-C, both protecting products in the International Class of Nice 30, filed a lawsuit for infringement of the trademark "Cono Black"

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Delizia Ice Cream "Cono Black"



(name and design), filed a claim for infringement of industrial property rights before the Bolivian trademark office (SENAPI) against the owner of X for the import and commercialization of the ice cream product "CRUFI BLACK", arguing that there is such a great similarity between the trademarks that there is a risk of confusion and association among consumers.

Answer to the infringement complaint

In addition to the observations made to the complaint, it was stated it deals with word and device trademarks with compound names (more than two words), therefore, it is necessary to make a comparison of word and device trademarks with compound names. Thus, on the one hand, there is CRUFI - CONO, which are absolutely different, and on the other hand, the word BLACK - BLACK. Regarding the latter, it was argued that for goods in the International Class of Nice 30, which protects products such as: *coffee, tea, cocoa, rice, pastry and confectionery; chocolate; creamy ice creams, sorbets and other ice creams; sugar, honey, molasses syrup*, the term BLACK is generic, descriptive and of common use. To demonstrate this, we point out different examples of goods registered in the same class.



Finally, it was explained that the origin of the trademark CRUFI BLACK, derives from the business origin of the Uruguayan company CRUFI S.A. and as mentioned above, the term BLACK is a generic descriptive word that alludes to the dark color of chocolate ice cream. Therefore, CRUFI BLACK is not an attempt to take advantage of the registered trademarks CONO BLACK and DELIZIA HELADOS CONO BLACK.

First instance resolution N°. IF 90/2020 dated 11/09/20: there is no likelihood of confusion, but there is association of the products and orders CRUFI to cease and desist

SENAPI issued Resolution No. 90/2020 dated 11/9/20 in which our claim that there is no confusion between the trademarks CONO BLACK and CRUFI BLACK, that the term "Black" is of common use, and therefore it is not distinctive and there is no risk of confusion in the consumer's mind was accepted.

Nevertheless, it pointed out that there was a risk of association due to the figurative aspects of the packaging of the products, i.e., the labels, and that the consumer may conclude that there is an association between both

companies considering that the products of both companies are connected in some way. Finally, that between both companies there was a competitive connection by sharing the same commercialization channels and therefore declared that there was an infringement and ordered the immediate cease in the use and commercialization of the CRUFI BLACK products.

Appeal for reversal filed by CRUFI

An appeal for reversal was filed against resolution NO. IF-90/2020 considering that the same was unfounded and that the comparison of the appearance of the ice cream in the shape of a cone was not a valid ground to declare that there was a risk of association, considering in particular that the label in the case of the products clearly differentiated the business origin of the ice creams from each of the companies.



Further evidence was provided showing that there were several registrations of ice cream trademarks with the cone-shaped presentation of ice cream from different manufacturers being of common use and therefore there was no exclusivity in favor of the plaintiff company.

Resolution N°. IF-RV-19/2020 dated 12/30/20: allows the appeal and revokes the resolution - there is no possible confusion or association

SENAPI issued a resolution allowing the appeal for reversal filed by CRUFI. In particular, and regarding the term and the shape of the cone, it pointed out that it is commonly used for ice cream and therefore it may not be exclusive, nor create a monopoly in favor of the plaintiff, as it had been understood in the first instance.

Despite the fact that the signs coincide in "Black", it was pointed out that the first impression is generated by the first terms, i.e., CRUFI on the one hand and CONO and DELIZIA on the other hand, and that it also indicates the business origin, thus avoiding the risk of confusion or association between the signs.

Hierarchical appeal filed by CAL

CAL filed a hierarchical appeal against SENAPI's decision, stressing again the risk of confusion existing between the products, and consequently requesting that the contested reversal decision is fully revoked and that the claim of infringement is declared proven.

Final decision N°. 125/2021 dated 01/12/21: the appeal is rejected and it is confirmed that there is no confusion or association

SENAPI issues resolution concluding that CRUFI BLACK has no similarity with the trademarks DELIZIA or CONO BLACK, there being no risk of association and confusion between the trademarks and products, and therefore understands that there is no infringement of CAL's intellectual property rights. Accordingly, SENAPI declared the infringement action inadmissible.

Significance of the decision

- **It was revoked the decision declaring that there was an infringement and prohibiting the import, commercialization and advertising of CRUFI BLACK products in Bolivia.**
- **It was ratified that common, generic and even descriptive terms of products are not exclusive even if they have been registered as trademarks and therefore may not be monopolized by any company.**
- **CRUFI S.A. may again commercialize CRUFI BLACK ice cream in Bolivia.**

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