

World Trademark Review Daily

MARTINI SPIRITO granted protection despite initial objections on absolute grounds Examination/opposition grounds
Slovenia - ITEM d.o.o National procedures

November 19 2013

On August 28 2013 the [Slovenian Intellectual Property Office](#) (SIPO) granted protection to the international trademark MARTINI SPIRITO in Slovenia for all the claimed goods, despite having refused it provisionally on the grounds that it was devoid of any distinctive character and that it served to designate the kind of the goods in the course of trade.

In September 2012 [Bacardi & Company Limited](#) (Liechtenstein) applied to register the international word mark MARTINI SPIRITO (International Registration 1139586) for goods in Class 33 of the [Nice Classification](#), namely "alcoholic beverages (except beers)". The mark designated several countries, including Slovenia.

In February 2013 SIPO issued a provisional refusal and invited Bacardi to respond. However, SIPO did not provide any specific facts and reasons for the provisional refusal - that is, it did not specify which part of the sign was allegedly devoid of any distinctive character and why (nor did it state that the sign as a whole was devoid of any distinctive character), and it did not explain why the mark allegedly designated the kind of the goods.

In its response, Bacardi argued that SIPO had breached its duty to enable Bacardi to comment on the reasons for refusal, and to protect and enforce its rights in the best way possible. From a substantive point of view, Bacardi defended its mark by attempting to guess SIPO's reasons for provisionally refusing the mark; based on these assumptions, Bacardi set forward substantial arguments in favour of the registration of the mark.

In particular, Bacardi argued that the mark MARTINI SPIRITO did not designate the kind of the goods, since it was neither identical, nor similar, to the Slovenian translation of 'alcoholic beverages' ('*alkoholne pijače*'); therefore, the average Slovenian consumer would not recognise, perceive or interpret MARTINI SPIRITO as meaning 'alcoholic beverages'.

Further, Bacardi argued that the mark could not be considered to be descriptive, because MARTINI SPIRITO, and MARTINI itself, were marks owned by Bacardi for certain types of alcoholic beverages. The trademark MARTINI had been in use since 1863 for vermouth produced in Bacardi's (or its predecessors') distilleries, and Martini vermouth was known worldwide. It had even been listed among the top 10 of the world's most powerful spirits and wine brands over several decades. Bacardi added that 'Martini' is even mentioned in the "Dictionary of the Slovenian Language", where it is referred to as a brand, and not as a descriptive term: "vermouth, manufactured by the Italian company Martini".

Bacardi also argued that MARTINI SPIRITO had distinctive character and was capable of distinguishing Bacardi's goods from identical or similar goods of other undertakings, because - as a result of its worldwide fame - consumers associated MARTINI with Bacardi and its goods. Moreover, MARTINI had a strong inherent distinctive character, which had enabled it to be registered as a word mark with the [World Intellectual Property Organisation](#) in 1962 (International Registration 255561) and with the [Office for Harmonisation in the Internal Market](#) (OHIM) in 2003 and 2010 (CTM 003511301 and CTM 010105922). Finally, Bacardi argued that MARTINI SPIRITO had been registered as a word mark with OHIM in 2001 (CTM 002325462), which meant that, in OHIM's opinion, it was sufficiently distinctive to be registered.

Upon receipt of Bacardi's response, SIPO adopted Bacardi's arguments and granted protection to the mark for all the claimed goods.

Although Bacardi successfully defended its MARTINI SPIRITO mark in Slovenia, the case reveals a deficiency in the Slovenian trademark examination procedure - SIPO failed to provide specific facts and reasons for its provisional refusal, leaving Bacardi in the dark even after the mark was granted protection.

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World Trademark Review *Daily*

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