

World Trademark Review *Daily*

**SIPO confirms that TEFLON is well-known trademark
Slovenia - ITEM d.o.o**

**Examination/opposition
National procedures**

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The [Slovenian Intellectual Property Office](#) (SIPO) has refused to register the trademark VEFLON based on five earlier TEFLON marks (Decision 31207-1468/2008-27, March 23 2013). SIPO found that the mark TEFLON is not generic or descriptive in the Slovenian language. Therefore, based only on the visual and phonetic comparison of the marks, SIPO concluded that the mark VEFLON could cause confusion with the earlier TEFLON marks.

On September 9 2008 Cinkarna Celje dd applied for registration of the mark VEFLON (No 200871468) for various goods and services in Classes 7, 17, 37, 40 and 42 of the [Nice Classification](#).

[El du Pont de Nemours and Company](#) filed an opposition against the application based on five earlier TEFLON marks, covering goods and services in all classes. El du Pont alleged that the marks had a reputation for goods - including cookware - coated with the substance called polytetrafluoroethylene, which has very low friction.

In 2009 SIPO refused the opposition against the registration of VEFLON, finding that 'Teflon' is a generic term known to the Slovenian public, and is defined in the *Dictionary of Slovenian Language (Slovar slovenskega knjižnega jezika)* as a substance for coating cookware, especially pans, to prevent the food from adhering to the pans.

El du Pont filed an administrative action against SIPO's decision before the Administrative Court, arguing that the trademark TEFLON had not become generic and that SIPO had wrongly rejected the opposition. El du Pont informed the court that the publisher of the *Dictionary of Slovenian Language* had been asked to remove the entry 'Teflon' from the dictionary, and that the latter had immediately removed this entry from the online version of the dictionary.

The Administrative Court followed the argumentation of El du Pont; it set aside SIPO's decision and remitted the case back to SIPO. The Administrative Court disagreed with SIPO's finding that the word 'Teflon' is undoubtedly a generic term due to its long-term presence on the market and the popularity of the products coated with the substance marketed under the trademark TEFLON. The word 'Teflon' was apparently entered into the dictionary by mistake, so SIPO had to compare the trademarks TEFLON and VEFLON in new proceedings.

In the new proceedings, SIPO followed the Administrative Court's judgment and held that, although the trademark TEFLON has been present on the Slovenian market for half a century and is well known to Slovenian consumers, one could not conclude that it had become a generic term. On the contrary, the trademark TEFLON must be regarded as a well-known trademark benefiting from enhanced protection, so the 'likelihood of confusion' test had to be applied more rigorously.

Following a visual and phonetic comparison of the signs, SIPO established that the trademarks were confusingly similar because they differed only in one letter. As both VEFLON and TEFLON have no meaning in the Slovenian language, a conceptual analysis was not possible.

Therefore, SIPO refused to register the trademark VEFLON based on the earlier TEFLON marks.

This decision is particularly interesting in that it shows that there is a thin line between a well-known and widely used mark on the one hand, and a mark that has potentially become generic due to its longstanding and intensive use on the other. The case shows that, if the trademark holder obtains the removal of its trademark as a generic term from the dictionary, it is very likely that the mark will not be deemed to be generic.

Peter Zorin, ITEM doo, Ljubljana

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