

## World OREO Cookie Day

# In what ways does Oreo protect itself against copies or similar versions?



Today, March 6th, is World OREO Cookie Day. This date commemorates the impact of this iconic product in the food industry and invites us to reflect on the **importance of the rights that emanate from its well-known trademarks**, which are protected under Intellectual Property Regulations.

OREO is not just a biscuit, but a global phenomenon that has transcended generations and borders, becoming a symbol of the sweet goods market.

The unmistakable design and effective marketing of this product have established it as a global trademark. Its history demonstrates how a well-structured protection strategy can **safeguard a product's commercial value and authenticate its identity in the face of imitation.**

In a competitive business environment where the importance of product differentiation is paramount to the success of companies, **Intellectual Property** has become a vital asset for safeguarding a brand's identity and value.

A product's longevity in the market is significantly influenced by the **legal strategy that protects its distinctive features, design, and exclusivity** against imitation or exploitation.

This underscores the pivotal role of Intellectual Property, not only for businesses but also for consumers, who greatly benefit from the ability to **identify and trust authentic goods.**

The success of a product in the global market, as demonstrated by OREO biscuits, is not solely dependent on its quality or popularity, but also on the **strength of the Intellectual Property rights that protect it.**

A thorough analysis of the positioning and worldwide recognition of these renowned biscuits reveals that their notoriety is not merely a matter of chance, but rather the result of a meticulous **strategy encompassing the effective protection of their trademarks and designs.**

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As OREO's business history demonstrates, this approach prevents the **exploitation** of their goods and ensures their exclusivity over time.

Since the launch of these biscuits in 1912, the OREO trademark has undergone **extensive registration and protection processes in multiple jurisdictions**.

This comprehensive registration and protection process has enabled the owners of the trademark to develop a strategy that covers not only **word and three-dimensional trademarks, but also designs and related rights**.

From the outset, the creators of OREO biscuits recognized the importance of trademark protection, which not only grants exclusive rights of use but also **prevents third parties from marketing identical or similar goods that could generate a risk of confusion or association among consumers**. Furthermore, the prestige acquired by their trademarks is invaluable.

When analyzing the success of these biscuits, we can identify several key aspects that contribute to their recognition and popularity. Of particular note is the fact that their renown is not only limited to the trademarks that endorse them under the OREO name, but is also due to their unmistakable design: two dark chocolate biscuits with a raised pattern that reveals a layer of white cream on the inside.

## IN WHAT WAYS ARE THESE BISCUITS PROTECTED?

This set of visual features has been protected through various **legal mechanisms**.

Firstly, **three-dimensional trademarks** allow the specific shape of a product to be registered, provided that it has a **distinctive character** and is not merely functional.

Secondly, **designs** guarantee the protection of the aesthetic appearance of the product, ensuring its exclusivity and preventing competitors from engaging in unfair practices.

Finally, the concept of **trade dress** can protect the complete set of visual characteristics of the product, preventing third parties from imitating its appearance in a way that is misleading or confusing for consumers.

Despite the strength of the legal protection of OREO biscuits, there have been attempts to replicate their appearance without using their well-known name.

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In such cases, the central legal question is whether these imitations constitute an infringement of Intellectual Property rights or whether, on the contrary, they are part of a legitimate competition strategy. This requires an analysis of several factors, such as the **likelihood of consumer confusion**, the **degree of distinctiveness acquired by the trademark** and whether the competitor is trying **to benefit from its reputation**.

## CONSEQUENCES OF UNFAIR TRADEMARK USE

In circumstances where there is potential risk of confusion or where trademarks are being used inappropriately, trademark owners may pursue legal actions for **trademark infringement** and unfair competition with regard to their **trademarks, graphic elements, or designs**.

However, it is not uncommon to find biscuits that bear a strong resemblance to OREO cookies, which suggests that **registering a trademark alone may not be sufficient to fully protect these well-known biscuits from imitations**. In order to ensure exclusivity, it is crucial to **continuously monitor the market and respond promptly to potential infringements through legal actions**.

In view of these possible scenarios UNGRIA advises to carry out an **active monitoring across different jurisdictions** to detect goods that may be infringing the rights of a company.

To fight against these activities, we can **initiate various administrative and judicial procedures**, including oppositions to the registration of similar trademarks, nullity actions against improper registrations, injunctions for the immediate withdrawal of infringing goods, and lawsuits for damages resulting from the illicit exploitation of reputation.

This case demonstrates how **Intellectual Property is an essential pillar in the consolidation of a trademark in the global market**, not only by protecting the interests of the owner company, but also by benefiting consumers by guaranteeing the authenticity and quality of the goods they purchase.

In the context of intensifying competition and frequent product imitation, having a **comprehensive legal strategy** is not a luxury, but a need for any company that wishes to maintain its exclusivity and market differentiation.

**Trademarks and designs protection** is not merely an administrative formality, but a strategic investment in the legal and commercial security of a product.

## REAL CASE EXAMPLE

- 1 In 2023, the General Court of the European Union published an important judgment upholding the European Union Intellectual Property Office (EUIPO) in its refusal to register Gullón's 'Twins' biscuits as a trademark because they were very similar to the well-known Oreo biscuits.
- 2 In this case, the Court held that Gullón could take advantage of the notoriety of the Oreo trademark. However, this ruling did not result in the immediate withdrawal of the 'Twins' from the market.
- 3 Oreo has a robust Intellectual Property strategy that includes trademarks, designs, trade secrets and active surveillance to protect its dominant position in the global sandwich biscuit market.

These strategies prevent the unauthorized use of their name, design and packaging to avoid consumer confusion. However, this does not necessarily mean that all similar biscuits must be withdrawn from the market.

Courts often assess whether the similarity actually causes **consumer confusion** or whether it is simply a legitimate competing product. Therefore, some trademarks can continue to market similar biscuits as long as the differences are sufficient to avoid infringement.

## Want to protect your trademark?

At UNGRIA we have Intellectual Property experts with extensive experience in **prosecuting, protecting and enforcing trademarks**.

Our **U-Watch service** (trademark monitoring) detects and eliminates counterfeiting and misuse of trademarks on the internet through our technology platform.

Contact us here if you would like more information about our global trademark advisory services.

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