

ABCOR's ABChronicle

Trademarks

Burberry Pattern stops SACHA shoe

For many years now the BURBERRY pattern has been a familiar sight in the fashion industry. Because the pattern is very distinct and recognizable, Burberry has been able to register the pattern as a European figurative trademark.



SACHA schoe



EU reg. 377580

This fact, however, does not stop everyone from introducing similar marks on the market. Recently SACHA, a fashion designer that specializes in shoes, introduced a new shoe which had a pattern similar to Burberry's. SACHA claimed that Burberry's pattern could not be a trademark because it was nothing more than a Scottish pattern. The judge, however, did not share this vision. Not only did Burberry's pattern have distinctive abilities when it was first registered in 1996, it also deserved a large scope of protection due to its reputation.

'One giant leap for mankind'

This past July marked the 40th anniversary of Neil Armstrong becoming the first man to set foot on the moon.

Armstrong spoke the now famous words: *"That's one small step for a man, one giant leap for mankind."*

Real Sociedad de Futbol (from San Sebastian in Spain) commemorated the event by registering a new European Trademark for her merchandising activities.



LIBER
EL FUTBOLISTA LUNAR

CTM reg. 3359734

KEIN HEINEKEN

Over the past few years Heineken has bought many small breweries in Switzerland. Quite to the dissatisfaction of some Swiss. An action group, comprised of multiple small breweries decided to sell the beer under the name KEINEKEN (Kein Heineken, German for no



Heineken) When they applied for their trademark on August 18, Heineken took immediate

action. Using her trademark rights Heineken confiscated over 1.200 bottles of beer along with 110 glasses. Both parties do not seem willing to end this dispute amicably and are awaiting the court's final decision on the matter.

Importer and distributor, but nothing more

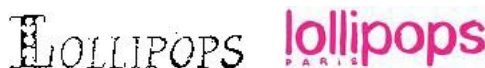
Since 1994 'Scotch & Soda Polska' had been the exclusive Polish distributor of clothing company Scotch & Soda BV from the Netherlands. In 1998 POLSKA decided, in an effort to protect her marketing activities, to register the trademark SCOTCH & SODA in the Polish Trademark Register.



When both parties eventually decide to end their cooperation, problems arise. POLSKA has the trademark rights in Poland, and Scotch and Soda does not. The lawsuit that follows was eventually won by Scotch & Soda. Reason for this was the fact that POLSKA did not register the trademark with the explicit consent of Scotch and Soda. Our advice to distributors: always make sure you have the exporter's explicit consent before you apply for a trademark. And an extra advice for exporters: Always register your own trademark in your most important export countries.

Dangers of restyling

In the Benelux holders of earlier trademark rights have the ability to prevent the registration of a new trademark application, though an opposition procedure. Lollipops SA, known for her handbags, wanted to prevent the trademark LOLLY POP from being registered. This should not have been a problem, were it not that trademarks older than 5 years have to provide proof of use. And that is where it all went wrong.



Internat registratie 768275

Logo gebruik anno 2009

Through various restyling processes over the year the present LOLLIPOPS logo did not resemble the registered version at all. The differences were of such magnitude that the new logo did not fall under the scope of protection of the trademark registration. (A major difference was, for example the use of a big L in the registration) The consequence of this was that Lollipop could not prevent LOLLY POP from being registered. Therefore: Always register your trademark as a wordmark if possible and ALWAYS check your registration when restyling.

Shape of yoghurt containers distinctive

For years already it has been very difficult to get a package registered as a trademark in the Benelux. A big problem for manufacturers, because often a lot of money is invested in giving a certain package a special place on the market.

Dairy producer De Zuivelhoeve has been waging a constant battle against other parties trying to copy the distinctive look of their yoghurt package. They have been quite successful in this. When a deal with a large retailer did not



came to a close the retailer, Lidl, decided to market her own yoghurt product, sporting a very similar package as

De Zuivelhoeve, under the name Oma's Yoghurt. De Zuivelhoeve started a court procedure. The court decided that the package of Oma's Yoghurt resembled that of De Zuivelhoeve to a very large degree. De Zuivelhoeve had a trademark registration and has been using the packaging consistently for many years. Research has shown that the package was actually very recognizable and attained a reputation on the market. Because of this it acquired distinctiveness. The consequence: Lidl was prohibited to sell Oma's Yoghurt and was fined € 30.000,-.

Designs

SENSEO Stops ALDI SOAP PUMP

In designing the SENSEO Philips realized a unique concept for the shape of a coffee machine. In order to protect this shape, Philips has registered various designs.



Int Design Senseo



Aldi Soap Pump

Retailer Aldi recently sold a soap dispenser which had all the characteristic traits of the SENSEO design. Philips immediately started a procedure on the basis of the design registrations and copyrights. The court decided in Philips favor and prohibited Aldi from further selling the soap dispenser. Coercive measures could amount to up to € 250.000,-.

Advertising

Swiss or Austrian?

With regards to global advertising the same campaigns are sometimes used in many different countries. This is not without always risk.



The image above provided some commotion in Switzerland, since the pictured cow is Austrian according to the ear brands.

SEE BUY FLY

Humor and trademark law do not go well together. In order to prevent any misuse by third parties it is advisable to always register your slogans. The Dutch national airport Schiphol has recently been a live testimony of this importance. The company Optitrade started a campaign for selling hot glasses under the name TRY BUY SEE. The main prize: a free airline ticket. Schiphol uses the slogan SEE BUY FLY for her shopping services.



2009 Optitrade



BX reg 0620952



2004 Terrorism gala

In 2004 Schiphol was also unpleasantly surprised. In promoting the artist manifestation The Great Gala of Terrorism yellow bags were printed with the print: SEE FLY DIE. The threat of a law suit was enough to have these bags replaced with the real SEE BUY FLY bags. Against Optitrade Schiphol demanded a direct prohibition on the basis of her trademark registrations. The court decided in Schiphol's favor. The slogans were too much alike, and in the advertisement unjust reference was being made to Schiphol's slogan. A prohibition with coercive measures followed.

Domain Names

TomTom stops GRATISTOMTOM.NL

Using the website GRATISTOMTOM.NL (freetomtom.nl) funeral insurances were being sold. In order to attract customers various products were being offered for free if an insurance deal was made. One was allowed to chose from a SOLARA picture frame, APPLE iPod or a TOMTOM navigation system. The big question was whether or not it was permissible to use



www.gratistomtom.nl

for this. It was decided that this type of use for the website was not allowed. The name was mostly used to attract people using the good name of TOMTOM. The domain name will be transferred to TOM TOM.

Abcor BV

Abcor is an IP law firm, located in the Netherlands. Our specialty is consultation with regards to intellectual property matter, trademark, designs and domain names in particular. Our services include the registration of trademarks and designs, searches, infringements and oppositions.

Suggestions for ABCOR's ABChronicle may be sent to info@abcor.nl

Sources: Adformatie, BIE, BMM, Boek9.nl, Class46.eu, Domjur.nl, Elsevier, GPD, IER, INTA bulletin, Nu.nl, OHIM.eu, PCM-dagbladen, SIDN, Trademark Reporter, Vrij Nederland en WIPO