

ABCOR's ABChronicle

Trademarks

Red Bull – The Bulldog: is prior use a due cause?

Since 2003 Red Bull and The Bulldog have been entangled in a legal dispute over the use of the name THE BULLDOG for energy drinks. RED BULLS oldest trademark dates from July 11th 1983, the Bulldog's oldest registration (not registered for energy drinks) is a few days younger, July 14th 1983. Tensions arise when The Bulldog introduces their own energy drink under their name. The District Court rejected all of Red Bull's claims (2007). However, in the appeal case in 2010 most of Red Bull's claims are sustained. The Court of Appeal states that RED BULL is a reputable trademark. BULL is more distinctive than RED and is a part of The BULLDOG. Because of this the consumer will assume a link between the two marks.



The Bulldog filed for appeal with the Court of Cassation. The Bulldog claimed that the Court of Appeal did not interpret the due cause it has in using their name for energy drinks correctly. The Bulldog has been used since 1975 for various goods. Using this trademark for any additional products, such as energy drinks, is a logical step. The Court of Appeal only judged whether or not use of the name is necessary and not if there was another due cause. Because of the various AdWords cases the term due cause has been stretched somewhat. The Court of Cassation referred the matter to the European Court of Justice. The European Court will have to clarify what constitutes due cause. It is expected that this would entail more than was previously assumed. All is most certainly not lost for The Bulldog.

COOL RIVER does not infringe COOL WATER

Ever since 2008 a dispute has been running in Poland regarding the launch and use of the Trademark COOLRIVER for eau de toilettes. Zino Davidoff objected against this trademark on the basis of his reputable trademark COOL WATER. The goods are identical and the trademarks are similar.

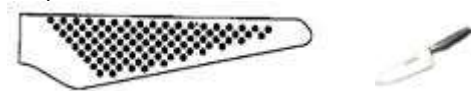
Furthermore, COOL RIVER uses an almost identical packaging, so the application was in bad Faith according to Davidoff.



Davidoff loses in the opposition procedure with the trademark authorities as well as the appeal procedure. The trademarks were considered dissimilar, because visually and aurally WATER and RIVER are entirely different. COOL is the same, but it is also a very common word to describe something that is fresh. Davidoff's claim on bad faith also did not succeed.

Knife handles valid EU trademarks

Yoshida's kitchen knives are easily identified by their handles. The handle has a pattern of small black dots, which appear to be indented upon further inspection. In order to protect her rights on these knives, several patents were applied for as well as several trademarks. The European trademark applications are objected, because the dotted pattern is part of an anti-slip structure. The structure is supposed to prevent the knife from slipping out of your hand, and is not a distinctive but rather functional feature. Aspects that have a technical component cannot be protected as a trademark. To substantiate evidence the patents are provided as are the real knives. The European Authorities agreed that the handles could indeed not be protected as a trademark.



The European Court of First Instance, judging on this matter in appeal, decides differently, however. The fact that the trademark was filed as a figurative mark and not as a shape mark does not matter. What matters is that the image in the application, as applied for, and not the actual characteristics of the knife. In the image only black dots can be seen, the fact that there are indentations in real life is invisible. The Court rules that OHIM erroneously assumed that this is an anti-slip structure, since it is not possible to determine that the holes are indentations

on the basis of the application. There is also no further description where it states this. The trademarks are therefore deemed valid. Apparently it seems that it may sometimes be wise to use a stylized image instead of a photo when trying to protect a certain shape.

COATTAIL RIDING BEATLE wheelchair

Apple Corps, the company owned by ex-Beatles Sir Paul McCartney en Ringo Starr, has been in a Legal battle over the registration of the word BEATLE for wheelchairs. The two remaining Beatles do not want their trademark THE BEATLES associated with electrical wheelchairs. The name BEATLE was merely registered to ride the coattail of the reputation of THE BEATLES. OHIM (the EU trademark authority) rejects this claim, stating that the products involved are too different for the consumer to make a link between the trademark. Music and entertainment on one hand and wheelchairs on the other are simply too dissimilar. The European Court, in appeal, however, agrees with the Beatles. After 50 years THE BEATLES is still a trademark that has a youthful and positive image. A part of the target audience is familiar with the music and because of that the wheelchair manufacturer profits from The Beatles reputation. It is after all easier to sell the wheelchairs if they evoke a sense of freedom an joy that is often associated with The Beatles.



Beatle Power Chair

HIJOPUTA – Registration SOB

Another European trademark has been refused due to bad morals. The logo 'Qué bueno ye! HIJOPUTA' (Spanish for 'How good is that, SOB') was applied for alcoholic drinks.



Unfortunately the authorities did not appreciate the Spanish humor. The trademark was considered to be offensive to the Spanish speaking population of the European Union. The applicant claimed that they have freedom

of speech and that the word could also be understood in a more positive light. These arguments were to no avail, however. In Spain the Catalan producer is allowed to continue to sell his products under the mark, though.

Pharma

VIAGUARA a stimulating drink

A Polish company named Viaguara markets an energy drink named VIAGUARA. The energy drink is made of the Guarana fruit, which contains a high doses of caffeine. The company files the application for VIAGUARA with the European trademark register. Pharmaceutical company Pfizer objects this application on the basis of their drug VIAGRA, which helps against erectile dysfunctions. After much deliberation the European Court decides that the trademarks are too similar. As a rule it is assumed that consumers have a higher level of attention when it comes to pharmaceutical trademarks. However, since VIAGRA has acquired a large reputation within a large part of the European Union, the trademark is considered to be well known with the entire population. Because of this the scope of protection of VIAGRA is large.



Both VIAGRA and VIAGUARA are used by young people who are going out. Both products have a stimulating effect and mind and body. The consumer may therefore expect the same characteristics from VIAGUARA as from VIAGRA, namely a libido increasing ability. This means that a connection is more easily made between the two trademarks. The trademark VIAGUARA is refused, because it tries to profit from VIAGRA's reputation. VIAGUARA would be able to easily increase their profits over the back of VIAGRA's investments without any Financial retribution to Pfizer.

Shape Marks - Designs

Tea bad Wars

The world of tea bags is a unique and large market. The form of the pyramid shaped tea bag was therefore registered in 2007 as a shape mark. Tea Forté opposed this application based on older trademark and design registrations (dated from 2004) Both in first and second instance the authorities conclude that the filed shape mark is different from the older Trademark and design. Visually and conceptually there is some similarity, but that is solely due to the pyramid shape. This is a common shape and the older trademarks are clearly different because of their form, the letter F and the leaf on the wire.



The differences are sufficient to avoid confusion. As far as the other design is concerned, the same reasoning goes (different shape and leaf, the F is missing). This judgment clearly demonstrates that the scope of protection of shape marks is limited, certainly when non-identical marks are concerned.

Copyrights

Unlawful Imitation Blond - Xenos

Blond has marketed pottery and tin cans since 2002, under the name 'Even bijkletsen', which loosely translated mean "catching up". The products are decorated with images of cupcakes, coffee beans, sugar cubes and written text. On one of the tin cans two chatting women are depicted, sitting at a table. Xenos, the competitor, sells tin cans as well, and introduces one that also has two chatting women at a table, enjoying a snack. Blond claims that this is an infringement of her copyright and an unlawful imitation of her renowned product line. Xenos' product is clearly in the same type of style as that of Blond. The Court of First Instance declined Blond's claims, stating that a style cannot be protected by copyright or any other right for that matter. The court further states that there is no unlawful imitation. The Court of Appeal, however, has a somewhat different opinion.



fig. 1



fig. 2

The Court of Appeal agrees with the Court of First Instance in that there is no copyright infringement. The differences between Xenos' product and Blond's products is large enough to avoid copyright infringement. The Court of Appeal does believe though, that Blond's products have their own position on the market. When examining the decorations on Xenos' product the Court finds that the drawings have the same feeling to it, the colors, text and layout all seem very similar. Ultimately leading to an end product that is very much like that of Blond. The resemblance

is of such severity that the consumer may get confused. Xenos could have just as easily chosen an entirely different style. The Court of Appeal decided that Xenos imitated Blond's products unlawfully. An injunction followed with a € 1.000.000 fine on any further sales.

Advertising

The (commercial) fire of the OLYMPICS

On July 27th, 2012 the Olympic Games will commence in London. This seems to be the time for all sorts of underhanded commercial tactics. The IOC will do whatever it can to prevent this. For this reason the Olympic logo is protected by various trademark registrations.



Things have forever changes, though, through the introduction of social media. For that reason special laws were adopted in England regarding use of a trademark in relation to the Olympics, even ticket conditions were adapted due to this. Photos and video material and even sound material of the Olympic Games are not to be used for anything else but private use. Ticketholders are not allowed to publish anything on social media sites or on the internet in general. The objective of these new rules is to prevent that people will exploit their "home made" images commercially. Athletes are not allowed to be in pictures that contain trademarks of third parties. Twitter even prohibits the use of Olympic trademarks all together, or even #London2012 op Twitter, by no official sponsors.

Internet

Trademark policy necessary with more than two thousand new gTLD's

Since January it is possible to apply for new generic top-level domain names with ICANN. At the moment there are only 21 gTLDs (such as .com and .org). The new top-level names can be generic words, such as .shop, but also geographic indications such as .georgia, or even a brand name, such as .canon are all possible. The introduction of the new gTLDs has been postponed due to some software problems. ICANN (the organization that coordinates registrations) has indicated that there have currently been filed over two thousand new

applications. The list of application was due at the end of April, but has been postponed until at least the end of March.



What are the consequences of the new gTLDs for trademark holders? For companies it may be very essential to have

an online branding policy. One of the most important choices that need to be made is how to deal with the new gTLDs. In the old situation you always had the choice to register the most relevant domain names. This usually meant most gTLDs and some relevant cTLDs. Now, however, a more restrictive choice needs to be made on which domain names need to be claimed during the Sunrise period. The portfolio should also be checked for Chinese, Japanese, Cyrillic and other signs which are all available. Companies should also consider how to handle online trademark infringement. It will no longer be possible to act against any and all registrations simply due to the vast amount of possibilities.

It is expected that the new gTLDs will not be active until 2013. There is still much to be decided on the Clearinghouse procedure and the new URS procedure. Apart from trademark strategy marketing is another aspect that needs to be revamped. It will no longer be possible to act against any and all domain name registration. Choices, internal communication and focus are essential to act on time (even before the first new gTLDs are operational). A good online branding policy is therefore a must.

ASTERIXTOUR.COM – due cause

When a trademark is infringed by use of a domain name, two procedures are available to act against the other party: A court procedure or a UDRP procedure with WIPO. The procedure with WIPO is much quicker, but different rules apply. During a WIPO procedure it must be confirmed that: (1) the domain name is similar to the trademark, (2) the holder does not have its own rights on the name, (3) the domain name has been registered and is being used in bad faith. Often these procedures go wrong because they are approached from a



trademark's perspective. This also happened with ASTERIXTOUR.COM. The domain name ASTERIXTOUR.COM was registered in 2002. The domain name ASTERIXTOUR.COM was registered in 2002. The defendant organized various tours to Turkey under the name AsterixTours. Les Editions Albert René, the proprietor of the Asterix comic books, started a UDRP-procedure and demanded that the website would be transferred to them. The claim was denied. Defendant claims that they have been using the name for fifteen years and that the name refers to a mythological hero and not the comic book character. This outcome was to be expected, and it is rather strange that Les Editions Albert René chose this route.

Social Media

Pinterest

Pinterest is the newest sensation in social media. The website was launched in 2010. Ever since launching the app the number of users has grown explosively, from 10.000 to 11 million. The site acts like a giant notice board. The user can pin pictures on a board and place them in a collection (moodboard). This way users can share their photos and favorite items. Users can use the moodboards to decorate the house, plan a wedding etc. On the website multiple moodboards may be found: fashion, religion, entertainment, but also company information may be found, however, mostly visual. By repining images of products can be spread quickly.



Pinterest has its own regulations with regards to copyright and trademark infringements. Complaints may be filed against moodboards and images which are misleading or form an infringement on copyright or trademark rights. However, Pinterest determines whether or not there is an actual infringement or not (as is usual with social media). Transfer or sale of a Pinterest account is not possible, only when Pinterest acts as an intermediate. Since an ounce of prevention is worth a pound of cure, kindly advise you to register your Pinterest account timely, for e-commerce reasons, as well for prevention of trademark conflicts.

Abcor BV

Abcor is an IP Law firm, located in Europe (the Netherlands). Our specialty is consultation with regards to intellectual property matter, trademarks, designs, copy right 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.eu

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