

# ABCOR'S ABChronicle

## Trademarks

### Five Years of Abcor, the "other" Trademark Agency

A little over 5 years ago the time was ripe for a new kind of trademark agency in the Benelux. On October 1<sup>st</sup> 2007 Abcor was launched as a new and innovative kind of trademark agency. Time has taught us that there was a need for our new approach. Within five years Abcor grew into a reliable midsized firm, attending many new (international) companies, all over the world.

Abcor, a paperless office, did not set out to become another "filing factory", but rather as a multidisciplinary, transparent, innovative and out of the box firm; a strategic partner for the client with an important focus on online branding/protection, which was very innovative five years ago.



Abcor also launched new services, such as outsourcing of lawyers to work inhouse at IP department of various companies. Furthermore, Abcor paid much attention to transparency and provision of information, for example through our own App, Facebook, Twitter, quizzes, seminars and publications.

We would like to thank all clients that have chosen to work with us in the past five years. Many clients have indicated that our differing multidisciplinary and strategic approach has a definitive extra value. In this newsletter we will therefore not only pay attention to the latest cases, but also to some older cases, to give you an indication of how the work of a trademark agency has changed in the last five years.

### NOA- VIANOA: (online) prohibition within ten days

Travel agents are becoming more and more specific in the type of arrangements they

offer. One of our clients launched NOA as a specific travel arrangement, namely camping vacations for Christian families. It appeared to be a success formula. Our client's competitor Rent-a-tent/Vakantieplezier introduced the website VIANOA, offering vacations, a year later.



A classic example of trademark infringement. Especially since VIANOA also used the name NOA on her website quite a few times.

We immediately made screen prints of this website in order to obtain proof, since websites can be easily adapted and all evidence of its former looks can easily be deleted forever.

An amicable solution was not possible, especially since VIANOA claimed there was no infringement. In the interim injunction that followed our client was victorious. Since NOA is the distinctive component of VIANOA and the services were identical there was obvious infringement. VIANOA's website was ordered to go offline within ten days, under threat of damages of € 1,000.- per day.

### JOOP! – JUP: Board of Appeal agrees with JUP

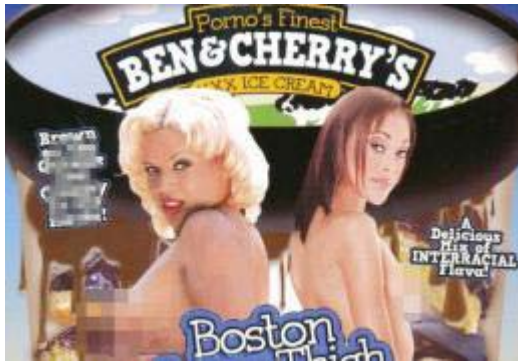
A few years ago Jurjen Veldhoen starts a new, high fashion spectacles brand: JUP. Because the first sales were very positive our client decided to have his trademark protected as a CTM. Cosmetics giant JOOP! opposes this application. Since the costs of rebranding would be substantial our client followed our advice to stand up to JOOP!



Both the Opposition department and the Board of Appeal agreed with our assessment that JUP would win. The trademarks involved are rather short, so any difference between them has an immediate impact. The vowels are also completely different, which makes them aurally different. The mere fact that both trademarks contain a J and a P, is insufficient. The trademarks are sufficiently different to coexist on the market. JOOP!'s claims are rejected.

### Court prohibits BEN & CHERRY'S movies

BEN & JERRY'S is one of the most famous ice cream brands in the world. Third parties sometimes try to take advantage of this fame. Sometimes, from very unexpected fields. American porn producer Rodax had recently distributed a series of adult films under the name BEN & CHERRY'S.



The logo that was used strongly resembled BEN & JERRY'S. Furthermore, the names of the films were also references to BEN & JERRY'S flavors. For example 'Boston Cream Pie' was changed into 'Boston Cream Thighs' and 'Peanut Butter Cup' into 'Peanut Butter D-Cups'. The DVD covers also resembled the ice cream packaging. The court in New York took the side of BEN & JERRY'S and temporarily prohibited the distribution of the movies.

### OLIVE LINE: broad scope of protection for descriptive trademarks accompanied by a logo

The European Court of First Instance has made a rather peculiar decision this summer. The decision indicates that a broad scope of protection is given to descriptive trademarks if they are accompanied by a logo. The case focused on whether the O.LIVE's logo infringed OLIVE LINE's. Both trademarks were applied for cosmetics on the basis of olive oil.



OHIM decided in first instance that the trademarks differed sufficiently. Both contained the word OLIVE, but that was purely descriptive considering the ingredients of the products. OLIVE was therefore not very distinctive and the differences in design were deemed sufficient to alleviate any confusion. The Court does not agree with this. In complex trademarks (logo's), according



to the court, relatively weakly distinctive parts may still be dominant. The size and font of the words play a big role in this. The trademarks were deemed to be somewhat similar because of this, and since the products are identical and similar the application is refused.

More and more companies these days use semi-descriptive trademarks, in light of this decision it would be a good idea to register these in combination with a logo.

### Trademark application in bad faith

Lufo has been a producer and distributor of foodstuffs aimed at the Surinamese kitchen since the 1980's. Their products have been sold under the name LUFO from the beginning. Such was also the case for one of their products LUFO "pomtayer" (Surinamese spices). LUFO had been protected as a word mark and the packaging of the product was registered as a logo. The trademarks expired in 1998 due to a non-renewal. A competitor registered the trademark LUFO in 2009, using the identical label of our client Lufo. The products are being distributed via a customer of Lufo's.

Because this is done with exactly the same packaging prohibition is necessary. Because the original trademark rights expired Lufo had to file an expedited application. We also performed a search for the other party's prior rights and took actions to catch claims regarding copyrights.



Lufo developed the original package almost thirty years ago. This means the copyrights are still valid. Since the other party registered a trademark identical to this package and the market involved is rather small, it stand to reason that the other party was aware of the existence of Lufo's trademark. The trademarks were therefore applied in bad faith. The defendant was ordered to cancel the registrations and not use the identical packaging any longer.

### Athletes and trademarks

Sports is big business. Top athletes often register their name as a Trademark so they may invoke it against others. However, not

every athlete has the same commercial awareness. Usain Bolt has not only registered his name, but also his typical pose as a trademarks. His name is linked to sportswear company PUMA and VISA. According to Forbes Bolt receives about \$ 15,000,000.- annually for his commercial exploits.

Wimbledon champion Roger Federer has registered not only his name, but also his autograph as a trademark.



In the Netherlands we are a bit behind on these matters. Our gold medal winner in gymnastics Epke Zonderland, did not register his name as a trademark, not even after winning the gold. We noticed this and sent a tweet about it. A few days later a third party registered the name. All Epke Zonderland could do now is register the word EPKE. He will take legal action against the other registration, though. Our advice to celebrities: register your name and portrait on time before someone else does.

#### Pharma

##### Protection scope semi-descriptive pharmaceutical brands

For some time our lawyers have worked, through outsourcing, as inhouse attorneys for the trademark department of Solvay Pharmaceuticals BV.

In the pharmaceutical sector trademarks are often composed of two descriptive elements. Typically these trademarks are almost never refused, because the authorities are not able to recognize their descriptive origins. Once registered the protection scope is generally very large. Such was also the case with BIFITERAL, a lactose based drug against constipation. BIFI refers to the bifido bacteria: a Group of bacteria that Works on the intestines. The last element is often the name of the compound. LATERAL is a medical reference to this. When an



application was filed for BIFISTEROL (a drug containing bacteria that work on the intestines), an opposition is filed. STEROL refers to fat solubility. OHIM decides that the two trademarks are too similar and refuses the application for BIFISTEROL.

#### Designs

##### Junktrunk table determined by technical function

In 2007 the JUNKTRUNK kids table is launched. The table features a desktop that can be opened. In the space below toys can be stored. This table had been registered as a design. In 2009 Wehkamp introduces the Benji table, a table based on the same idea: A desktop that can be opened exposing an area to store things. Junktrunk immediately starts a case against Wehkamp based on her design rights.



The court does not agree with Junktrunks stance. Designs focus on the appearance of products. In this case, however, the central issue is the fact that the table may be opened, something that cannot be protected through design registration. As far as the actual looks of the two products concerned they are different enough to ward of any design infringement. Junktrunks claims are rejected.

#### Advertising

##### Charlie Sheen – Bavaria 0% commercial no implicit ad for alcohol

The newest Bavaria commercial features their 0.0% beer featuring Charlie Sheen. The commercial shows Sheen right after his release from the Rehab Clinic on his way home.

He sees many people, such as construction workers, cab drivers and even a pregnant lady drinking beer. Once home at his own party he finds out that it concerns alcohol free beer, 0.0% from Bavaria.

A complaint was filed with the Dutch Advertising Committee, because the commercial was aired before 8 pm, a time when alcohol commercials are not allowed. Since Bavaria's logo was frequently shown, the complaint stated that it also involved an implicit commercial for regular beer. The



Advertising Committee disagreed with this and rejected the complaint. The commercial clearly focuses on alcohol free beer and BAVARIA is only shown together with 0.0%. Although a commercial for alcohol free beer may remind people of regular beer, this commercial is not in contravention with the Dutch Advertising Code.

### Internet

#### The new gTld's – Trademark Clearinghouse

ICANN received over 1,900 requests for the new top level extensions. Right now the applications are being processed. It seems, however, that a shady organization has filed a large request for a few important generic names (such as .HEALTH, .BANK etc.). The applicant has been convicted several times in the past on phishing. Everyone is therefore warned. It is important to have a look at the entire list right now. The bulk of the requests concern generic names. Third parties cannot object against those. However, it is advisable to have a look at the list to determine your online strategy.



Mid-2013 the new extensions will be available. Trademark owners may at that time apply for a domain name registration with priority during the Sunrise period. Because of the large number of new extensions there will also be a separate procedure for this, the Trademark Clearinghouse. The Trademark Clearinghouse enables trademark owners to claim priority, but also gives them the

opportunity to save their trademarks in a separate register, which will be used to inform them should a third party register a domainname containing their trademark. As said before, it is important to have an online policy in advance, which trademarks need to be registered and for which extensions? Considering the large amount of new extensions it is not possible for most companies to register everything, choices need to be made. The complete list can be found at: <http://newgtlds.icann.org>.

### Social Media

#### Youtube - ADO Den Haag support bands

Recent research indicates that a large portion of online products is not the original product from the trademark owner. The same holds true for merchandise products. Our client, soccer club ADO Den Haag, was



confronted by supportbands that sported their colors and were presented as if they were from ADO. There were even short films on Youtube advertising the product along with the name ADO Den Haag. The movies featured former star player Aad Mansveld as well as ADO Den Haag's new logo. A clear case of infringement on all levels imaginable. Because ADO registered all the necessary trademarks, the Youtube films were removed immediately upon request.

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### Abcor

#### Abcor and social entrepreneurship

In order to help our society we have worked along with several non-profit organization for the past couple of years. Non-profit organizations are often small and lack the funds to hire IP lawyers. Unfortunately trademark infringement does not limit itself to the profit market and often targets the non-profit market as well. For this reason we have worked, for free, for the following organizations in the past few years: Stichting Bits For Freedom, LCKV Jeugdvakanties, Voedselbank, Stichting No-House-Wine.

#### 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](mailto:info@abcor.eu)

Sources: Adformatie, BIE, BMM, Boek9.nl, Class46.eu, Domjur.nl, Elsevier, GPD, IER, IE-Forum.nl, INTA bulletin, Nu.nl, OHIM.eu, PCM-newspapers, Quote, SIDN, Trademark Reporter and WIPO