

ABCOR's ABChronicle

Trademarks

Prohibition on Lindt's packaging based on Gold Bears word mark

Haribo has been producing wine gums since 1967 in the shape of a bear. The sweets are sold under the brand GOLD BEARS in bags. The packaging contains a golden bear (a cartoon character) with a red bow around his neck. Haribo registered the word mark HARIBO GOLD BEARS in 1975.

In line with her golden chocolate bunnies, the Swiss chocolate manufacturer Lindt introduced a golden bear in November 2012. The bear is wrapped in a gold foil with a red bow around his neck. On the belly of the bear are the words LINDT / TEDDY. Haribo starts a law case, claiming the packaging infringes the mark GOLD BEARS.



Lindt disputes this: the trademark is TEDDY and not GOLD BEAR. GOLD is the usual color for Lindt's packages. The packaging is in line with the bunnies from Lindt (also gold foil with red bow).

The court is not convinced. Buyers see the chocolate bears (the package) and refer to them as Gold Bears. This could cause confusion with the bears from Haribo. Lindt gets a sales ban imposed. Typical in this case is that a word mark is responsible for a packaging being prohibited. Lindt has announced to appeal.

BMW claims letter M for its M-Series

BMW has registered the letter M as a trademark. The German Trademark Office decided that the letter

sufficiently distinctive for sports cars. Important in the consideration of the trademark authorities is the fact that the letter M has no special meaning in relation to sports cars.



Also there is not a special reason for keeping the letter M free for competitors. BMW now has a monopoly on the use of the letter M for its BMW M-series in the market.

KitKat acquired distinctiveness in EU – How will the Benelux authorities react?

Trademarks that do not have distinctive character should be refused. This applies to all types of marks, word marks, shape marks etc. The policy used to be that integration should always be shown in the entire area where the mark is not distinctive. With a shape mark this is usually the entire area where protection is sought. A European registration would be across the entire EU, a Benelux registration in all three countries: Belgium, Netherlands and Luxembourg. KitKat wants to protect the shape of her four-fingered bar and applies for a trademark registration and based on acquired distinctiveness.



OHIM refuses KitKat's application, however. The mark is used in fourteen of the fifteen member states (at the time of application), but it acquired distinctiveness in only six countries. KitKat appeals this decision and the Board of Appeal chooses her side. The BOA considers that the European Union should be seen as a unit and not as fifteen (now 27) separate countries. The brand has acquired distinctiveness in a substantial part of the European Union, namely in six countries, and has therefore acquired sufficient distinctiveness throughout the EU. If the BOIP follows this line, it may mean that integration in the Netherlands is sufficient for protection in the Benelux. With this new policy, large national magazines and TV programs could finally secure their rights to a trademark registration.

The Voice of Hollands Kroon

Since 2011, the municipalities Anna Pavlovna, Niedorp, Wieringen and Wieringermeer merged into the new municipality "Hollands Kroon". For the selection of six new employees the municipality wanted to use the success of popular TV show The Voice. As with The Voice the three directors were on a red swivel chair with the back towards the candidate. Candidates are given two minutes to present themselves. When a manager hits a red button and the chair turns, the candidate is through to the next round. The idea worked, because not only have 200 candidates registered for the selection, but Talpa, owner of the TV show, also responded.



The logo of the Voice of Holland Crown appeared to be very much like the logo of The Voice. Not only the image (Hand with microphone), but also the layout and font were virtually taken over. Copyright and trademark infringement was obvious. The

municipality had quickly come to abandon the use of the logo. Especially when Talpa indicated no objection to the re-enactment of the blind auditions. Indeed, Thomas Notermans on behalf Talpa said: "We see this as a compliment to the success of our program." Wise lesson for coat tail riders. Parody and copying is still fun, but stay away from the use of another brand / logo.

Trademarks/ Designs

Restrictive scope of protection for line drawing beer glass holder

Historical KWAK beer is served in a very special glass in a wooden glass holder. Brewery Bosteels has registered a line drawing of the glass in the holder as trademark. Brasserie d'Ebly introduces a special beer "La Corne du Bois", served in a special glass in a wooden container as well, and registered this as a design. Brewery Bosteels claims this is an infringement.



Kwak beer holder

Corne du Bois beer holder

In this issue the glass must be compared with the submitted trademark. Because a line drawing is submitted, the aspect fact that it is made of wood is omitted completely. The only resemblance between them is that there is a separate glass for which a holder is required to support the glass.

It is, therefore, shape mark. The holder is required for the glass not to topple (technically necessary). And everything that is technically necessary, is excluded from protection. The brands, logos, typography and the glass used are completely different. The holders themselves are also very different. Consequence: no trademark infringement and no coat tail riding.

Tradename rights

The Ivy Bar Glasgow infringement on The Ivy in London

Catering Companies often find it unnecessary to perform a search for their trade name prior to starting their company. This is unwise, because clever catering companies register their name to create a monopoly on the use of it. The Ivy Bar in London is a famous bar where celebrities came, from Marlene Dietrich to Tom Cruise.



The name THE IVY is registered as a trademark. Coat tail riding on the reputation of a company is punished. The owner of The Ivy Bar in Glasgow received a cease and desist letter from the lawyer of The Ivy in London to change the name, after six years. That the bar was located 600 km away from London and had a totally different appearance, did not matter. The outcome would be very clear, based on trademark law. For that reason the bar is now named Destill. According to the owner, the whole name change cost him £ 30,000.

Pharma

Little Blue Pill suggests Viagra

Through home-shopper.nl "The Natural Blue Pill" was offered for sale. Although nothing is said about the composition and no medical claims are made, the color blue and the accompanying text suggest that this is an alternative to the famous Viagra pill (the prescription drug and registered trademark).

The question is, is this permissible?
No, the expression is



misleading. By using expressions such as "This is the little blue pill everyone is talking about!" and "Normally you pay up to 50 euros for four pills of 100 mg ... order now for less than 12 euros for ten pills!" the consumer gets the impression that the product of the manufacturer is Viagra. The expression is therefore misleading and also unfair.

Advertising

Mother Pucker Lemonade

Mother Pucker is a new Lemon Fresh drink. The logo and the label state: 'Lemonade'. A complaint with the Advertising Code Committee (RCC) is filed in response. The complainant argues that (1) LEMONADE gives the impression that this is a soft drink, while it concerns a liquor and (2) that the name is contrary to good taste and decency.



With regard to the name, the RCC is clear. The policy is to not be too restrictive in accepting names. Mother Pucker is a humorous reference to the insult Mother Fucker, but the boundaries of the permissible are not exceeded. However, because the drink contains 10% alcohol, the word LEMONADE on the label is in breach of the Advertising Code for Alcoholic beverages. You should never give the impression that it concerns a soda when it is not. It is requested not to use this indication any longer use.

Internet

The new gTld's – Trademark Clearinghouse

There is still much unclear about the procedure and when the first phase of the Trademark Clearinghouse starts. But, because we are already behind schedule, it is expected that one of these days progress will be made. However, it is clear that the preventive blocking of trademarks will cost businesses a lot of money.

It is estimated that the standard fees between are between 200 and 750 USD. Assuming the launch of around 1,200 new gTLDs blocking one trademark would cost around half a million. This would be impossible for many. It is therefore necessary businesses to already have an online brand strategy. Call one of our specialists in this field for further advice.

PARVI.ORG: \$ 100,000 fine for the city of Paris

The city of Paris registered the brands PARVI and PARVI, PARIS VILLE NUMERIQUE as trademarks in 2002, for Internet communications among other things. The trademark is used for WIFI connections in Paris. Jeffrey Walter registers the domain name JAVI.ORG in 2006. Paris claims this domain name, but the parties do not find an amicable solutions. A UDRP procedure at the WIPO follows, in which Jeffrey claims that he is not in bad faith, for he knew nothing of the trademark registrations PARVI. Paris wins and the domain name should be transferred.



Jeffrey does not leave it at that starts a lawsuit in Texas. What companies sometimes forget is that this possibility is explicitly given in a UDRP proceeding. The jurisdiction is then determined by where the registrar is located, in this case Texas. Jeffrey says that the city of Paris has actually claimed the domain name under false pretenses, because he was unaware of the trademark registrations.

Paris does not respond in this case and that has disastrous consequences. The court agrees with Jeffrey and gives him the right to the domain name . The city of Paris is convicted of "reverse domain name hijacking" and fined \$ 100,000.

PORSCHE SPECIALIST.NL not allowed

Wim van den Berg repairs, maintains and sells only Porsches, for many years. Since 1996, he calls his company "Porsche Specialist van den Berg". In 1999 he registers the domain name PORSCHE SPECIALIST. In 2008, Porsche is involved for the first time. Porsche does not want that van den Berg exploits his company under the name "Porsche Specialist". This name gives the impression that there is a special relationship with Porsche, while Van Den Berg not an official dealer.



The court disagrees and rules that the consumer will not assume there is any relationship between Porsche and van den Berg. On appeal, however, Porsche is proven right. The ruling is thus back in line with all earlier case law since BMW/Deenik. In the communication, the unofficial garage does indicate that there is a certain brand of cars they repair, provide service for or sell. Use of a trade name or domain name containing the trademark may not, however, because this suggests there is a commercial connection with the trademark owner.

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

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